

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BINH Q. NGUYEN AND GENNARO A. CUOMO

Appeal No. 2001-0591
Application No. 08/915,655

ON BRIEF

Before THOMAS, KRASS, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-12, which are all of the claims pending in this application.

We REVERSE.

Appeal No. 2001-0591
Application No. 08/915,655

Appellants' invention relates to a technique for visually creating and adding members to a class in an object-oriented environment. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. Computer readable code stored on media for permitting a software developer to visually building a class and displaying contents of the class in an intuitive manner, comprising:

first subprocesses for displaying a container window representing a class upon selection by a user of an option to create a new class;

second subprocesses for permitting the user to populate the class with members by adding visual representations of elements which represent code to the container window;

third subprocesses for displaying the visual representations of the elements which comprise the members of the class within the container window; and

fourth subprocesses for generating code for the class represented by the container window.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

"Rational Rose: Using Rational Rose 4.0," RATIONAL SOFTWARE CORP., Pages 3, 14, 16-21,34, 39, 40, 42, 106, and 175, Copyright date 1996. (Rational Rose)

Claims 1-12 stand rejected under 35 U.S.C. § 102 as being anticipated by Rational Rose.

Appeal No. 2001-0591
Application No. 08/915,655

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 9, mailed Feb. 17, 2000) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 8, filed Jan. 12, 2000) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Appellants argue that not all of the Rational Rose 4.0 user manual has been provided and that generally a modeling tool does not create and is not used to create the code that actually embodies the actual software program. (See brief at page 3.) Appellants further identify the web site "rational.com" to find additional information. A quick review of this website did not provide any easy retrievable documentation concerning the applied reference to Rational Rose 4.0. Therefore, we will decide the appeal upon the limited pages which the examiner relies upon and provides in the file.

Appellants argue that the examiner has provided absolutely no discussion of the rejection of claims 7-12 in any Office action. (See brief at page 4.) We agree with

Appeal No. 2001-0591
Application No. 08/915,655

claims 7-12 were not filed at that time. Therefore, examiner has not set forth a rejection of claims 7-12 in the answer, therefore, we will *pro forma* reverse the asserted rejection thereof.

With respect to independent claim 1, appellants argue that the cited portions of Rational Rose are directed to creating one or more class diagrams to depict classes contained by each package in a model and that this is directed to provide a model of an existing class. (See brief at page 4.) From the limited portion of Rational Rose relied upon by the examiner, we agree with appellants. The examiner relies upon page 14 of Rational Rose which discusses the resizing and minimizing of a diagram window.

Additionally, the examiner cites to page 17 of Rational Rose for creating a new model, but the creation of a new model does not address the limitation of displaying a container window representing a class upon selection by a user of an option to create a new class. From our review of Rational Rose, we find that the toolbar contains the Browse icons for Class Diagram, Interaction Diagram, etc. at page 19 of Rational Rose which opens a dialog box. Additionally, Rational Rose discloses at page 21 that the Diagram Toolbar will be displayed when there is a modifiable diagram window which is active. Rational Rose discloses that a tool is chosen by a point and click of the left mouse button. The selected tool is highlighted and the next click on the diagram executes the tool's function. Rational Rose further discloses a section at page 21

Appeal No. 2001-0591
Application No. 08/915,655

concerning the Creation of Diagrams and that this may be used to create a class diagram at indent 5. With all of these teachings, we do not find a teaching or disclosure of the limitation of displaying a container window representing a class upon selection by a user of an option to create a new class. While the creation of a new class diagram is suggestive of the creation of a new class, it is not the same thing nor is it inherent that it is taught thereby. The examiner relies upon the code generation (cg) tab disclosed at page 34 and the IDL Code Generator disclosed at page 175 which suggests that a skilled artisan can generate IDL source code from the information contained in a Rational Rose model. The IDL code generation is a menu option under the Tools menu as a script. (Rational Rose at page 175.) The examiner maintains that Rational Rose is a visual software model based development tool which is not different than what appellants argue. (See answer at page 4.) While the development tool may or may not be different, we must disagree with the examiner that the selected pages and segments of disclosure relied upon by the examiner support the finding of anticipation. While additional portions of Rational Rose may support the examiner's position, we find that the limited number of pages relied upon by the examiner do not support the examiner's conclusion of anticipation.

With respect to the second subprocesses, appellants argue that pages 34 and 39 of Rational Rose do not teach the claim limitation of "permitting the user to populate

Appeal No. 2001-0591
Application No. 08/915,655

code to the container window.” (See brief at page 5.) We agree with appellants. The examiner has not addressed how the code generation of Rational Rose would teach that the visual representations of elements would represent code if the code has not been generated and if the properties of the code generator tab are not set for subsequent generation of code. Therefore, we find that the examiner has not shown that Rational Rose explicitly teaches or inherently teaches the elements of the second subprocesses of independent claim 1.

With respect to the third subprocesses appellants argue that Rational Rose does not teach subprocesses for displaying the visual representations of the elements which comprise the members of the class within the container window. (See brief at page 5.) We agree with appellants since we found above that Rational Rose does not teach or disclose the use of a container window for the class.

With respect to the fourth subprocesses of generating codes for the class represented by the container window, appellants argue that since Rational Rose does not teach or disclose the use of a container window for a class, it follows that Rational Rose does not teach or disclose the generation of code for a class represented by a container window. (See brief at page 6.) Again, we agree with appellants. The examiner maintains that Rational Rose discloses the generation of code at page 175, but the general teaching of code generation does not address the limitation pertaining

Appeal No. 2001-0591
Application No. 08/915,655

examiner has not shown that Rational Rose explicitly or inherently teaches the elements of independent claim 1. Therefore, the examiner has not established a ***prima facie*** case of anticipation.

The examiner maintains in the response to arguments section of the answer at page 4 that Rational Rose allows users to generate classes in an easy and error free manner, but the examiner does not provide specific support for what the examiner “believes.” While Rational Rose 4.0 may or may not perform as the examiner maintains, we do not find adequate support for a case of anticipation as the examiner maintains. Throughout the examiner’s response to appellants’ arguments at pages 4-6, the examiner states that the “examiner believes” and that software reuse is a very well practice in development of software. While these may form findings which may play a part in evaluation of obviousness, they are inappropriate for evaluation of anticipation. Therefore, the examiner’s responses to appellants’ arguments are not persuasive since they are not well supported by the teachings of Rational Rose.

Throughout the brief, appellants have argued that Rational Rose does not “teach, suggest or disclose” the claimed invention. Here, we only address the explicit teachings of Rational Rose relied upon by the examiner and their limited disclosure. We make no findings whether the claimed limitations would have been obvious or whether Rational Rose suggests that the use of code generation from the use of visual

Appeal No. 2001-0591
Application No. 08/915,655

limited discrete portions of Rational Rose relied upon by the examiner are not sufficient to support the rejection under 35 USC § 102, and we have not considered the feasibility of a rejection under 35 USC § 103 since a more complete or detailed copy of Rational Rose forms no part of the administrative record for consideration. Our reviewing Court has made it clear in **In re Lee**, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002), and **In re Zurko**, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997) that rejections must be supported by substantial evidence in the administrative record and that where the record is lacking in evidence, this Board cannot and should not resort to unsupported speculation. As indicated in **Lee**, 277 F.3d at 1343-44, 61 USPQ2d at 1433-34, the examiner's finding of whether there is a teaching, motivation or suggestion to combine the teachings of the applied references must not be resolved based on "subjective belief and unknown authority," but must be "based on objective evidence of record." Other than appellants' disclosed and claimed invention, nothing in the record supports the examiner's conclusions concerning Rational Rose. (See also **In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968) ([t]he examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection.) Therefore, we limit our decision to the limited facts relied upon by the examiner in the rejection and the limited

Appeal No. 2001-0591
Application No. 08/915,655

rejection under 35 USC § 102 cannot be sustained for independent claim 1 and its dependent claims 2-5.

With respect to independent claim 6, we find similar deficiencies in the examiner's *prima facie* case of anticipation. With respect to independent claim 9 and dependent claims 7, 8, and 10-12, if rejected, we would find similar deficiencies in the examiner's *prima facie* case of anticipation and would not sustain the rejection thereof.

Appeal No. 2001-0591
Application No. 08/915,655

To summarize, the decision of the examiner to reject claims 1-12 under
35 U.S.C. § 102 is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	
)	
)	BOARD OF PATENT
ERROL A. KRASS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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JOSEPH L. DIXON)	
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