

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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS L. NOWATZKI, BARRY R. RUZEK,
SYLVIA M. WILHELMI and LOREN R. LENNIE

Appeal No. 2001-0966
Application No. 08/852,660

ON BRIEF

Before RUGGIERO, BARRY, and BLANKENSHIP, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1, 2, 4, 8-11, 13-21, and 23-30, which are all of the claims pending in the present application. Claims 3, 5-7, 12, and 22 have

Appeal No. 2001-0966
Application No. 08/852,660

second computer. The first computer utility in turn subsequently receives the processed request from the second computer.

Claim 1 is illustrative of the invention and reads as follows:

1. In a data processing system having a first application program resident on a first computer platform, and further having a second computer platform coupled to the first computer platform, the improvement comprising:

a. utility call provided in the first application program, said utility call providing a request;

b. utility means provided in the first computer platform for receiving said utility call, and for providing the corresponding request to the second computer platform wherein said utility means formats the request prior to providing the request to the second computer platform and wherein the second computer platform provides a result in response to the request provided by said utility means; and

c. wherein said utility means receives the result provided by the second computer platform and wherein said utility means provides the result into a buffer on the first computer platform after receiving the result from the second computer platform.

The Examiner relies on the following prior art:

Duxbury et al. (Duxbury) 5,604,896 Feb. 18, 1997

Claims 1, 2, 4, 8-11, 13-21, and 23-30, all of the pending claims, stand finally rejected under 35 U.S.C. § 103(a) as being

Appeal No. 2001-0966
Application No. 08/852,660

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Brief along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as recited in claims 1, 2, 4, 8-11, 13-21, and 23-30. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v.

Appeal No. 2001-0966
Application No. 08/852,660

stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to the Examiner's 35 U.S.C. § 103(a) rejection of independent claims 1, 23, and 29 based on Duxbury, Appellants assert that the Examiner has failed to establish a prima facie case of obviousness since all the claimed limitations are not taught or suggested by the applied Duxbury reference. At page 11 of the Brief, Appellants assert that the Examiner has erred in

Appeal No. 2001-0966
Application No. 08/852,660

programs which issue a request (claim 23), or the provider of a program call from a program call statement embodied in the application program (independent claim 29).

After reviewing the Duxbury reference in light of the arguments of record, we are in general agreement with Appellants' position as expressed in the Brief. Although claims are to be given the broadest reasonable interpretation consistent with the specification, the Examiner is required to provide a basis for interpreting claim language in a particular manner. Our review of Duxbury reveals that although several programs in the disclosed system are identified as "application" programs (e.g. banking application 11 and server applications 14), the transaction processing monitor 18 is not identified as such. While this fact alone is not conclusive of whether the transaction processing monitor 18 of Duxbury can reasonably be interpreted as an "application program," it, at least in our view, requires the Examiner to provide some basis for the asserted interpretation.

In reviewing the Examiner's stated position, we note that when

Appeal No. 2001-0966
Application No. 08/852,660

Cir. 1983). The Examiner's sole basis for interpreting Duxbury's transaction processing monitor as an application program is his own proffered definition of an application program as any program which performs a function, such as, in Duxbury's case, steering requests to a server. We find absolutely no support for any such definition and, indeed, if this were correct there would be no distinction between application programs and other programs, a result which, in our view, one of ordinary skill would recognize as clear error.

We further find that Appellants' asserted characterization (Brief, page 11) of the transaction processing monitor (TP monitor 18) in Duxbury as "a mere software switch" in contrast to the claimed "application program" to be consistent with the accepted understanding of a TP monitor in the art. The ordinary and accustomed definition of a TP monitor is a "control program that manages the transfer of data between multiple local and remote terminals and the application programs that serve them." Computer Desktop Encyclopedia, (9th Ed., Copyright(c) 1981-2001) (copy attached). Also attached to this decision are copies of excerpts

Appeal No. 2001-0966
Application No. 08/852,660

Dictionary (Microsoft Press[®], 2nd Ed. 1994) also indicates the art recognized distinction between system software, such as TP monitors, and application software.¹

In view of the above discussion, it is our view that, since all of the limitations of independent claims 1, 23, and 29 are not taught or suggested by the applied prior art Duxbury reference, the Examiner has not established a prima facie case of obviousness. Accordingly, the 35 U.S.C. § 103(a) rejection of independent claims 1, 23, and 29, as well as claims 2, 4, 8-11, 13-21, 24-28, and 30 dependent thereon, is not sustained.

In summary, we have not sustained the Examiners' 35 U.S.C. § 103(a) rejection of any of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1, 2, 4, 8-11, 13-21, and 23-30 is reversed.

Appeal No. 2001-0966
Application No. 08/852,660



REVERSED

JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
LANCE LEONARD BARRY)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
HOWARD B. BLANKENSHIP)	
Administrative Patent Judge)	

JFR/lp

Appeal No. 2001-0966
Application No. 08/852,660

CHARLES A. JOHNSON
UNISYS CORPORATION
2276 HIGHCREST ROAD
ROSEVILLE, MN 55113