

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID LARS EHNEBUSKE and BARBARA J. A. MCKEE

Appeal No. 2002-0001
Application No. 08/989,674

ON BRIEF

Before THOMAS, JERRY SMITH, and FLEMING, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner's final rejection of claims 1 through 12.

Representative claim 1 is reproduced below:

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1. A method, implemented in a computer system, for providing user indications for manipulating the operation of an object-oriented object, comprising the steps of:

identifying and describing a plurality of triggers for a plurality of control points for said object-oriented object on a static object model;

attaching a notation to each of said plurality of triggers describing a before, during and after operation related to said plurality of triggers on said static object model;

binding one of said plurality of triggers to one of said plurality of control points for said object-oriented object in said computer system based upon said notation; and

displaying results of said identifying step and binding step based upon said notation to a user at said computer system.

The following reference is relied on by the examiner:

Martin, "Principles of Objected-Oriented Analysis and Design", Prentice Hall (1993) Chapters 9-11, pages 111-168. ¹

Claims 5 through 8 stand rejected under the enabling portion of the first paragraph of 35 U.S.C. § 112. Claims 1 through 3, 5 through 7 and 9 through 11 stand rejected under 35 U.S.C. § 102(a, b) as being anticipated by Martin. Finally, claims 4, 8, and 12 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Martin alone.

¹ Only these noted portions of this reference have been provided to us by the examiner notwithstanding certain indications in the answer that the examiner relies upon the entire book.

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Rather than repeat the positions of appellants and the examiner, reference is made to the briefs and to the final rejection and answer for the respective details thereof.

OPINION

We turn first to the rejection of certain claims under the enablement portion of the first paragraph of 35 U.S.C. § 112. Notwithstanding the examiner's assertions at page 4 of the answer that all claims on appeal, claims 1 through 12, stand rejected under this portion of 35 U.S.C. § 112, page 2 of the final rejection, from which appellants have appealed, maintains only the rejection of claims 5 through 8 and indicated that the rejection of claims 1 through 4 and 9 through 12 had been withdrawn.

As to the enablement issue, the specification of the patent must teach those skilled in the art how to make and use the claimed invention without undue experimentation. Genentech, Inc. v. Novo Nordisk A/S, 108 F.3d 1361, 1365, 42 USPQ2d 1001, 1004 (Fed. Cir.), cert. denied, 118 S.Ct. 397 (1997). This same case indicates that the scope of the claims must bear a reasonable correlation to the scope of enablement provided by the disclosure. Enablement is also not precluded even if some

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experimentation is necessary, although the amount of experimentation needed must not be unduly excessive. Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987).

We agree with the appellants' urgings at pages 5 and 6 of the brief that the apparatus/system environment set forth as various means in claims 5 through 8 corresponds to the hardware embodiment shown in Fig. 4 and discussed at specification page 11, where the teaching is that the computer software comprising the invention and the various means of these claims is loaded from the diskette 96 in this Fig.

From our study of the examiner's position at pages 4 through 6 and pages 9 through 13 of the answer, the examiner has not established a prima facie case of non-enablement within the first paragraph of 35 U.S.C. § 112. Claims 1 through 12 and certainly claims 5 through 8 are consistent with the operation and scope of enablement and disclosure of the appellants' contribution in Fig. 3 within the environment of system Fig. 4. The nature of the elements recited in each independent claim on appeal, which clearly correspond to each other among the various independent claims, is consistent with the description at pages 8 through 10

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of the specification as filed as depicted in Fig. 3. Appellants' contribution appears to be an improvement over the object model using the Object Modeling Technique notation as defined by James Rumbaugh, the discussion of which begins at page 6, line 10 of the specification as filed.

The examiner's new theories and bases of the rejection and expansion of it to include more claims than those set forth in the final rejection constitute a new ground of rejection. Nevertheless, all claimed features are recited as part of the prior art in conjunction with appellants' contribution in corresponding terms to the manner of which they have been disclosed. Therefore, it appears that the scope of enablement is consistent with the scope of the subject matter recited in all of the claims on appeal. The examiner's various assertions and reasonings advanced in the earlier noted pages of the answer do not lead us to conclude that the artisan would have necessarily conducted undue experimentation to make and use the claimed invention. As such, we conclude that the rejection of claims 5 through 8 (as well as 1 through 4 and 9 through 12) under the enablement portion of 35 U.S.C. § 112 cannot be sustained.

Turning next to representative independent claim 1 and its corresponding independent claims 5 and 9 under 35 U.S.C. § 102,

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we also reverse this rejection. After considering the examiner's positions with respect to this rejection at pages 7 and 8 and 14 through 18 of the answer, we conclude that the answer has not established a prima facie case of anticipation for the subject matter of representative claim 1 on appeal, which corresponds to the subject matter of independent claims 5 and 9 on appeal as well. The examiner, among these noted pages, makes various assertions and correlations as to the preamble and certain portions of the body of independent claims 1, 5 and 9 on appeal. As argued by appellants at the bottom of page 7 of the brief on appeal, we also understand the examiner's position as not setting forth any assertion at all that the following feature of representative independent claim 1 is shown and/or discussed in any manner within Martin:

attaching a notation to each of said plurality of triggers describing a before, during and after operation related to said plurality of triggers on said static object model.

In other words, the examiner has not asserted any correlation of this feature to any portion of chapters 9 through 11 and pages 111 through 168 of those portions of Martin provided to us as evidence of anticipation. On its face then, the examiner has not established a prima facie case of anticipation within 35 U.S.C. § 102 as urged by appellants.

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It is this quoted portion of representative claim 1 on appeal that goes directly to the heart of appellants' contribution in the art as best characterized by the Summary of the Invention at specification pages 4 and 5. It is appellants' notation system that is the apparent improvement over the "Object Modeling Technique" in the prior art. Moreover, the binding and displaying clauses of representative independent claim 1 on appeal are specifically recited to be "based upon said notation". Again, the examiner has not provided evidence to us of the anticipatory nature of Martin as to these features as well.

Equally misplaced is the examiner's view expressed at the bottom of page 17 of the answer that the above quoted feature of attaching a notation is "taught by Martin with the common knowledge of static objects and the teaching of attaching rules to diagrams such as the Object-Relationship Diagram and Composed-Of diagrams (page 146)." Our reviewing court has indicated clearly that this common knowledge approach is highly disfavored and the examiner must provide substantial evidence to prove the assertion made. "[T]he Board cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense.

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Rather, the Board must point to some concrete evidence in the record in support of these findings." In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). See also, In re Lee, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002). The court in Lee requires evidence for the determination of unpatentability by clarifying that "common knowledge and common sense," as mentioned in In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969), may only be applied to analysis of the evidence, rather than be a substitute for evidence. Lee, 277 F.3d at 1345, 61 USPQ2d at 1435. See Smiths Indus. Med. Sys., Inc., v. Vital Signs, Inc., 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1421 (Fed. Cir. 1999) (Bozek's reference to common knowledge "does not in and of itself make it so" absent evidence of such knowledge).

Because we have reversed the rejection under 35 U.S.C. § 102 of independent claims 1, 5 and 9 on appeal, we also reverse the respective rejection of their dependent claims under 35 U.S.C. § 102, and the separately stated rejection under 35 U.S.C. § 103 of dependent claims 4, 8 and 12 on the basis of Martin alone.

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In summary, the decision of the examiner rejecting various claims on appeal under the first paragraph of 35 U.S.C. § 112, 35 U.S.C. § 102 and 35 U.S.C. § 103 are all reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
JERRY SMITH)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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)	
MICHAEL R. FLEMING)	
Administrative Patent Judge)	

JDT/vsh

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DAVID A. MIMS JR.
INTERNATIONAL BUSINESS MACHINES CORP.
INTELLECTUAL PROPERTY LAW DEPT.
INTERNAL ZIP 4054
11400 BURNET ROAD
AUSTIN, TX 78758