

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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** RAYMOND P. PEKOWSKI

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Appeal No. 2002-0596  
Application No. 08/763,135

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ON BRIEF

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Before KRASS, RUGGIERO, 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 1-3, 5-12, 14-18, and 25, which are all of the claims pending in this application. Claims 4, 13, 19-24 and 26-38 have been canceled.

We REVERSE.

Appellant's invention relates to an apparatus and method for demand load analysis. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method, implemented in an information handling system, for selecting one or more dynamic link libraries (DLLs), utilized in an application program, to be demand loaded, said method comprising the steps of:

identifying a DLL referenced by the application program;

tracing outputs from the DLL;

examining the traced output of the DLL to determine whether the DLL was executed; and

selecting the DLL to be demand loaded if the DLL was not executed.

The prior art of record relied upon by the examiner in rejecting the appealed claims are as follows:

Cobb	5,835,749	Nov. 10, 1998 (filed May 5, 1995)
Johnson et al. (Johnson)	5,878,384	Mar. 02, 1999 (filed Mar. 29, 1996)

Claims 1-3, 5-12, 14-18, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of Cobb.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the examiner's

Appeal No. 2002-0596  
Application No. 08/763,135

answer (Paper No. 23, mailed Jul. 31, 2001) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 22, filed Apr. 16, 2001) for appellant's arguments thereagainst.

### **OPINION**

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

Appellant argues that the initial burden of establishing a *prima facie* case of obviousness lies with the examiner and Office. (See brief at page 6.) Appellant argues that the combination of Johnson and Cobb does not teach or suggest the second and third steps of the claimed method. Specifically, the combination of Johnson and Cobb does not teach or suggest "tracing outputs from the DLL" and "examining the traced output of the DLL to determine whether the DLL was executed." (See brief at page 6.) We agree with appellant.

The examiner maintains that the combination would have taught the claimed invention even though the examiner admits that Johnson does not teach the second through fourth limitations. (See answer at page 3.) The examiner maintains that the motivation to combine the teachings is that the use of dynamic linked libraries (DLL's) adds flexibility to the system operation. (See answer at page 3.) While we agree with

the examiner that the use of DLL's adds flexibility, this aspect is already realized by Johnson since the calling program is embodied in a DLL and is demand loaded. We find no teaching or suggestion in either reference and the examiner has provided no convincing line of reasoning as to why it would have been obvious to one of ordinary skill in the art to look to the teachings of Cobb to further enhance the performance of the system of Johnson.

Appellant argues that the examiner has not provided support for the allegations that Cobb teaches the claimed tracing and examining steps of the claimed method. (See brief at pages 7-10.) We agree with appellant and find that the examiner's conclusions throughout the answer that "the identifier is considered to be the traced output" and "the criteria is also equated to be the traced output" are not adequately rationalized with respect to the claimed invention. We find that to "trace" something there must be some following of the path of operation whereas a mere identifier does not follow a path, but merely identifies a state. Further, we find that a list of criteria also does not follow the path of operation whereas mere criteria do not follow a path of operation, but merely identify meeting the set condition(s).

Appellant argues that Johnson does not teach demand loading of DLL's and improving system performance. Appellant argues that neither of Johnson or Cobb teach or suggest the problem which appellant addresses. (See brief at page 11.) We agree with appellant, but agree with the examiner that the language of independent

claim 1 does not explicitly recite an improvement in performance. Therefore, this argument is not persuasive.

Appellant argues that the broad allegation that Johnson and Cobb teach using a dynamic linked library (DLL) does not provide an adequate basis, in itself to establish an obviousness rejection. (See brief at pages 11-12.) We agree with appellant. The examiner maintains that the limitations have not been ignored and that Johnson teaches that a DLL is demand loaded by an intermediate DLL and Cobb teaches that a DLL can selectively load a DLL if it is unprocessed in order to enhance performance and the examiner refers back to the prior responses. (See answer at page 10.) We disagree with the examiner as discussed above and do not find that the examiner has established a *prima facie* case of obviousness of the claimed invention, and we will not sustain the rejection of independent claim 1 and its dependent claims. Claims 10 and 25 contain similar limitations concerning the tracing and examining steps/means. Therefore, we will not sustain the rejection of independent claims 10 and 25 and their dependent claims.

### **CONCLUSION**

To summarize, the decision of the examiner to reject claims 1-3, 5-12, 14-18, and 25 under 35 U.S.C. § 103(a) is reversed.

Appeal No. 2002-0596  
Application No. 08/763,135

**REVERSED**

ERROL A. KRASS	)	
Administrative Patent Judge	)	
	)	
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	)	
	)	BOARD OF PATENT
JOSEPH F. RUGGIERO	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
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	)	
JOSEPH L. DIXON	)	
Administrative Patent Judge	)	

JD/RWK

Appeal No. 2002-0596  
Application No. 08/763,135

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