

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte LEONARD W. KOSER,  
MARY C. MANGES, FRANCES M. RING,  
CYNTHIA A. ROGERS, MICHAEL J. SNYDER,  
and, JOHN J. VRIEZEN

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Appeal No. 95-3535  
Application 08/095,033<sup>1</sup>

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ON BRIEF

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Before KRASS, JERRY SMITH, and CARMICHAEL, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 32 through 42, the only claims pending in the application.

The invention is directed to a computer system having a downward compatibility function. More specifically, a unit of data from an upper level release computer is allowed to operate

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<sup>1</sup> Application for patent filed July 20, 1993. According to appellants this application is a continuation of Application 07/401,210, filed August 31, 1989, now abandoned.

on a lower level release computer without requiring any modifications to be made to the lower level release computer.

Representative independent claim 32 is reproduced as follows:

32. A method in a data processing system having multiple computers operating at diverse release levels for transferring a unit of data having an executable portion from a computer operating at release level N to a computer operating at a release level N - M, wherein M is greater than zero and less than N, said method comprising the data processing system implemented steps of:

designating a unit of data having an executable portion within a computer operating at release level N;

specifying an intent to transfer said designated unit of data having an executable portion from said computer operating at release level N to a computer operating at release level N - M;

automatically converting said executable portion of said unit of data from operation at said release level N to operation at said release level N - M in response to said specifying of said intent to transfer said designated unit of data; and

thereafter transferring said converted designated unit of data to said computer operating at said release level N - M wherein said converted designated unit of data will execute properly within said computer operating at said release level N - M.

The examiner relies on admitted prior art [APA] set forth at pages 2-3 of the instant specification.

Claims 32 through 42 stand rejected under 35 U.S.C. ' 103 as unpatentable over APA.

Reference is made to the brief and answer for the respective positions of appellants and the examiner.

OPINION

We will not sustain the rejection of claims 32 through 42 under 35 U.S.C. ' 103 because, in our view, the examiner has not set forth a prima facie case of obviousness.

The examiner takes the position that since appellants admit, at page 3 of the specification, that it was known to convert data of upper level release systems to data of lower level release systems where the operation is being performed at the lower level release system, the only difference between the instant claimed invention and that which is admitted to have been well known is that, in the former, "the conversion is installed in the later version computer instead of in the earlier version computer" [page 3-answer].

Identifying the sole issue, with which we agree, as whether it would have been obvious to install the conversion circuit and have the conversion done at the later version computer (upper level) instead of at the earlier version computer, the examiner reaches the conclusion, erroneously, in our view, considering the applied prior art, that it would have been obvious "to have the conversion done at the newly released [sic, released] system because the old system, then, do not have to be recalled and modified" [page 4-answer].

As simple as the solution may appear in hindsight, nothing in the prior art identified at pages 2-3 of the specification suggests performing the conversion at the later version level in

response to an intent to transfer the designated data and prior to the transfer. While there may, in fact, exist some prior art reason why doing this would have been obvious, within the meaning of 35 U.S.C. ' 103, the APA identified by the examiner suggests no such reason and the examiner's rationale for making the required modification to the APA, i.e., so that the old systems would not have to be recalled and modified, is not persuasive because it was appellants, themselves, who taught this reason and the examiner has pointed to nothing in the APA which indicated that artisans recognized that it would have been helpful to perform the conversion at the later version level rather than at the older version level in order not to have to recall and modify each of the older version level computers.

Accordingly, the examiner's decision rejecting claims 32 through 42 under 35 U.S.C. ' 103 is reversed.

REVERSED

Errol A. Krass	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
Jerry Smith	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
James T. Carmichael	)	
Administrative Patent Judge	)	

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