

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NAOMI IIDA and SAKUYUKI ONISHI

Appeal No. 95-4466
Application 08/135,188¹

ON BRIEF

Before THOMAS, JERRY SMITH 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 claim 18, which is the only claim pending in this application.

¹Application for patent filed October 12, 1993. According to appellants, this application is a continuation of application 07/548,691, filed July 5, 1990, now abandoned.

BACKGROUND

The present invention is directed to a process for creating a control program for a programmable controller. The control program includes both basic program instructions which can be directly accessed by the processor and subroutines of program instructions which are not included in the basic elements. These subroutines of program instructions are stored in an auxiliary memory. The auxiliary memory is accessed and the subroutines of program instructions are retrieved and stored in consecutive addresses in the main memory in the sequence in which they were retrieved.

Claim 18 is the sole remaining claim and is reproduced below:

18. A method of creating a control program for a programmable controller for controlling a controlled device, comprising the steps of:

(a) entering into a main memory, by use of an input device, a sequence program making up a sequence of operations to be incorporated into said control program, items which are entered to make up said sequence program including:

(1) basic program instructions which are directly executable by a processing unit;

(2) common operation designation names of application instructions, said application instructions each being the title of a respective subroutine composed of certain ones of said basic program instructions, said subroutines being previously stored in an auxiliary memory; and

(3) data to be acted on by said basic program instructions and said application instructions;

(b) retrieving said subroutines from said auxiliary memory by:

(1) examining which common operation designation names of application instructions have been entered in said step (a) and

(2) retrieving the subroutines which correspond to the entered common operation designation names; and

(c) storing said retrieved subroutines into said main memory at a higher memory location as compared to the sequence program entered at step (a), wherein said retrieved subroutines are stored in consecutive ascending addresses in order of retrieval from said auxiliary memory;

further comprising a step (b) (3) of displaying a status of whether said step (b) has been partially or fully completed.

The prior art reference of record relied upon by the Examiner in rejecting the appealed claim is:

Griffin 4,866,663 Sep. 12, 1989

Claim 18 stands rejected under 35 U.S.C. § 103 as being unpatentable over Griffin.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the appellants, we make reference to the brief and answer for the details thereof.

OPINION

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After a careful review of the evidence before us, we disagree with the Examiner that claim 18 is properly rejected under 35 U.S.C. § 103 and we will reverse this rejection of claim 18.

As pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998).

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. **See In re Rijckaert**, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the

relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837

F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Appellants argue that Griffin does not teach or fairly suggest the retrieval and storage of subroutines from an auxiliary memory and the storage of these retrieved subroutines in the main memory. (See brief at pages 4-5.) Appellants also argue that the execution program sequencing through the function modules of Griffin does not retrieve subroutines from an auxiliary memory and store them in main memory as set forth in claim 18. We agree with appellants. The Examiner acknowledges the deficiencies in the teaching of Griffin in the rejection and in the Examiner's response to appellants' arguments. (See answer at pages 2-7.) The Examiner merely asserts that the limitations set forth in the claims were "notoriously well known." (See answer at page 7.) We disagree with the Examiner. The Examiner has not provided any teaching or suggestion in Griffin or provided any separate line of reasoning as to why it would have been obvious to one of ordinary skill in the art at the time of the invention to retrieve subroutines which correspond to entered common operation designation names from an auxiliary memory and store them in the main memory at consecutive ascending addresses as set forth in the language of claim 18.

After a careful review of the record in this case, we are compelled to agree with

appellants that the Examiner's conclusion of obviousness is not supported by the types of factual findings necessary to reach this conclusion. Our understanding of the Examiner's reasoning for the determination of obviousness causes us to conclude that the Examiner merely believes the claimed invention to be obvious because it seems that it would have been obvious. Although we agree with the Examiner that the data may be stored sequentially in main memory, the Examiner has not addressed the limitations set forth in the language of the claim concerning the retrieval of subroutines from an auxiliary memory and storage in the main memory. The prior art teachings of Griffin only teach the skilled artisan to sequence through the function modules already stored in a library using an execution program, but does not teach retrieving these function modules/subroutines or any other subroutines from an auxiliary memory and then store them in main memory as set forth in the language of claim 18.

The Examiner acknowledges the lack of disclosure in Griffin concerning the interaction between the script, the executive program and the storage in memory. (See answer at page 4.) Again, the Examiner has not addressed the retrieval from an auxiliary memory and storage in main memory of the subroutines which correspond to

the entered common operation designation names as set forth in the language of the

claim. The Examiner has merely addressed the generalized inputting of a program from an external memory and set forth the location where it was known to store programs generally. (See answer at page 4.) Clearly, the Examiner has not addressed the limitations set forth in claim 18. Therefore, it is clear that the prior art applied against the claim does not teach nor fairly suggest the claimed invention as set forth in claim 18 regarding the method of creating a control program where subroutines are retrieved from an auxiliary memory and storing in main memory the subroutines which correspond to the entered common operation designation names.

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claim, to the applied prior art reference, and to the respective positions articulated by the appellants and the Examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the Examiner is not sufficient to establish a *prima facie* case of obviousness with respect to claim 18. Accordingly, we will not sustain the Examiner's rejection of claim 18 under 35 U.S.C. § 103.

CONCLUSION

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To summarize, the decision of the Examiner rejecting claim 18 under 35 U.S.C.
§ 103 is reversed. The decision of the Examiner is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
)	
)	
JERRY SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
JOSEPH L. DIXON)	
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