

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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ALAN W. CARTER

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Appeal No. 2000-1704  
Application No. 08/484,999

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ON BRIEF

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Before JERRY SMITH, BARRY and LEVY, Administrative Patent Judges.  
JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-3, 17-21 and 23-25. Claims 4-16 and 22 have been allowed by the examiner.

The disclosed invention pertains to the field of compiling computer programming language source code into executable software programs. More particularly, the invention addresses the problem of maintaining compatibility of successively modified and compiled versions of a program with all other programs that make use of such program.

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Representative claim 1 is reproduced as follows:

1. A method in a computer system of automatically compiling version compatible object servers, the method comprising the steps of:

compiling a first program into a first version object server having a set of one or more interfaces;

compiling a second program into a second version object server to be version compatible with the first version object server, said compiling into the second version object server comprising:

verifying whether the second program can compile into a second version object server that provides at least each interface of the first version object server; and

if the verifying step shows that second program can be compiled into the second version object server that provides at least each interface of the first version object server, generating a set of interfaces for the second version object server so as to comprise interfaces that match each interface of the first version object server.

The examiner relies on the following references:

"Management of Programming Compatibility Within a System of Separate Dependent Elements," IBM Technical Disclosure Bulletin, Vol. 31, No. 8, January 1989, pages 317-320 (IBM Bulletin).

IBM System Object Model Guide and Reference, version 2.00, 1991, chapter 1, page 1-2; chapter 2, pages 2-1, 2-8; chapter 6, pages 6-3 to 6-4 (IBM Model Guide).

IBM OS/2 2.0 Application Design Guide, 1992, chapter 7, pages 7-4 to 7-12 (IBM Design Guide).

K. Brockschmidt, Inside OLE, 2ND Edition, June 1995 by Microsoft Press, pages 27-29, 145-151.

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Claims 1-3, 17-21 and 23-25 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers the IBM Design Guide in view of the IBM Model Guide with respect to claims 1, 2 and 24, adds Brockschmidt to this combination with respect to claims 17, 18, 23 and 25, and adds the IBM Bulletin to the second combination with respect to claims 3 and 19-21.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

#### OPINION

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

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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 obviousness of the invention as set forth in claims 1-3, 17-21 and 23-25. 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. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must 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).

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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). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

We consider first the rejection of claims 1, 2 and 24 based on the IBM Design Guide and the IBM Model Guide. With respect to independent claim 1, the examiner finds that the IBM Design Guide teaches the claimed invention except for the step of verifying whether the second program can compile into a second version object server that provides at least each interface of the first version object server before the generation of the set of interfaces for

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the second version object server. The examiner finds that the IBM Model Guide teaches allowing changes to SOM objects while maintaining compatibility and verifying an object's version information for compatibility checking. The examiner asserts that the artisan would have been motivated to apply the teachings of the IBM Model Guide to the IBM Design Guide because it would avoid recompilation of client programs when certain compatible changes occur. The examiner also asserts that the step of verifying before the step of generating would have been obvious to the artisan [answer, pages 4-5]. With respect to independent claim 24, the examiner additionally asserts that it would have been obvious to the artisan to include a user selectable compiler option to expose the functionality of the IBM Design Guide as modified by the IBM Model Guide [id., page 5].

With respect to independent claim 1, appellants argue that the IBM Model Guide operates only to verify if an already compiled object server is a compatible version. Appellants argue that there is no suggestion within the IBM Model Guide that it can be used by a computer at the time of compiling a program to verify whether modified and as yet uncompiled source code of the object server can be compiled so as to yield a still compatible object server. Appellants also argue that the proposed combination is impossible

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because it requires that a function requiring a compiled value be used before the compiled version is available. Appellants also argue that the IBM Design Guide teaches away from the claimed invention because it provides its own techniques for maintaining compatibility between versions of an object server. Finally, appellants argue that there is no support within the applied prior art for the examiner's proposed motivation for combining the references [brief, pages 6-9]. With respect to claim 24, appellants argue that the applied prior art lacks any teaching that would suggest the recited compiler option having the recited operation [id., page 15].

With respect to independent claim 1, the examiner responds that the IBM Model Guide is both a development system and a run-time environment. The examiner asserts that the artisan would recognize that version management is an issue at both compile time and at run time, and therefore, would have been motivated to apply this teaching of the IBM Model Guide to the IBM Design Guide. The examiner also responds that he is only relying on limited teachings of the references [answer, pages 11-13]. With respect to independent claim 24, the examiner notes that he is relying on the knowledge of one of ordinary skill in the art to meet the claimed compiler option [id., page 15].

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Appellants respond that there can be no suggestion from the IBM Model Guide to apply the function to check version compatibility at compile time. Specifically, appellants argue that the IBM Model Guide provides no teaching how a compiler would analyze version compatibility before the object is compiled [reply brief].

We agree with the position argued by appellants for essentially the reasons presented by appellants in the briefs. The examiner's arguments do not persuade us that the verifying step of claim 1 or claim 24 is taught or suggested by the applied prior art. The examiner relies on unestablished knowledge of the skilled artisan to support the proposed combination of the teachings of the IBM Design Guide and the IBM Model Guide. We cannot find any teachings on this record to support the examiner's position that it would have been obvious to apply the teachings of the IBM Model Guide to verify whether a modified program can compile into a second version object server before the second version object server is generated. Therefore, the examiner has failed to establish a prima facie case of obviousness. Accordingly, we do not sustain the examiner's rejection of claims 1, 2 and 24.

We now consider the rejection of claims 17, 18, 23 and 25 based on the IBM Design guide, the IBM Model Guide and

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Brockschmidt. The IBM Design Guide and the IBM Model Guide are applied as discussed above. Brockschmidt is cited as teaching the representation of an object's interface information by type information. The examiner finds that it would have been obvious to the artisan to combine the teachings of Brockschmidt with the other applied references so as to provide additional OLE capability [answer, page 6].

With respect to independent claim 17, appellants make the same arguments discussed above with respect to claim 1. Appellants also argue that the conventional type checking and type library referred to by the examiner fail to teach the comparison step of claim 17 [brief, pages 10-13].

Since the rejection of claim 17 relies on the improper combination of the IBM Design Guide and the IBM Model Guide for reasons discussed above, and since Brockschmidt does not overcome the basic deficiencies in that combination, we do not sustain the examiner's rejection of claims 17, 18, 23 and 25. Since the rejection of dependent claims 3 and 19-21 also relies on the improper combination of the IBM Design Guide and the IBM Model Guide, and since the IBM Bulletin does not overcome the basic deficiencies in that combination, we also do not sustain the examiner's rejection of claims 3 and 19-21.

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In summary, we do not sustain any of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-3, 17-21 and 23-25 is reversed.

REVERSED

JERRY SMITH	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
LANCE LEONARD BARRY	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
STUART S. LEVY	)	
Administrative Patent Judge	)	

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Klarquist, Sparkman, Campbell,  
Leigh and Whinston  
One World Trade Center  
Suite 1600  
121 SW Salmon Street  
Portland, OR 97204