

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEVIN H. DeGRAAF

Appeal No. 95-3641
Application 07/992,069¹

HEARD: October 14, 1997

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

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed December 17, 1992.

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This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-8, which constitute all the claims in the application.

The claimed invention pertains to a method and apparatus for providing compatibility between a prior version of a computer program and a later version of the computer program.

Specifically, when a given version of a computer program saves data, it stores the data in both a file format specific to the version of the program and in a file format which is independent of the specific version and is universally recognizable. That way, when one version of the program seeks to access data from a different version of the program, it reads the specific format version if it understands it or reads the independent format version if it does not recognize the specific version.

Representative claim 1 is reproduced as follows:

1. A method executed in a computer system for providing compatibility between a prior version of a computer program and a later version of the computer program, the computer including a memory storing a file with data in both a version dependent external format specific to the prior version of the computer program and data in a version independent data format, the method comprising the steps of:

receiving a request to process the data stored in the file using the later version of the computer program;

determining whether the data stored in the version dependent external format can be processed by the later version of the computer;

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OPINION

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

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 1-8. 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

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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 Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). 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).

With respect to claims 1-8, the examiner's rejection notes that WP 5.1 has the ability to store data files in either a version specific format or in ASCII format which is a version independent format. Although WP 5.1 typically only stores files in a single one of the formats, the examiner observes that files in WP 5.1 can be automatically stored and retrieved in different formats using conventional macros. The examiner concludes that it would have been obvious to the artisan to use the features of

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WP 5.1 in a manner to carry out the claimed invention [final rejection, pages 2-3].

Appellant responds that the examiner has failed to establish a prima facie case of obviousness. Specifically, appellant argues that 1) The examiner has not shown any suggestion in the prior art to automatically store data in two formats in a file; 2) The examiner has not shown any compelling motivation to write a macro to automatically store data in two formats; 3) The examiner is using hindsight reconstruction; and 4) The examiner has mischaracterized appellant's invention as a design choice [brief, pages 5-7]. Appellant also argues that even the obviousness of writing a macro in WP 5.1 would not have suggested the invention as recited in claims 1-8.

The examiner does not respond specifically to these points argued by appellant, but rather, argues that the known use of a universal data format as a translation bridge between different data formats would have made it an obvious design choice to employ any of a combination of multiple data formats [answer, pages 3-6].

When the evidence as a whole is considered and the relative persuasiveness of the examiner's and appellant's arguments are factored in, we agree with appellant that the

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claimed invention is not suggested by WP 5.1. We can find nothing in the conventional features of WP 5.1 which would have suggested the invention as claimed by appellant. The examiner's reliance on the obviousness of a translation bridge between data formats does not seem pertinent to the storage of files in WP 5.1. This concept only arises because the examiner is trying in hindsight to justify doing what appellant has done. The "translation bridge" teachings of Wright have not been considered as noted above. In our view, absent advance knowledge of this invention gained by reading appellant's specification, the artisan would not have found the claimed invention suggested by the conventional operation of WP 5.1.

We also note that the examiner's motivation for modifying WP 5.1 to arrive at the claimed invention amounts to nothing more than a recognition of the advantages of the invention described in appellant's specification. We are not convinced that these advantages were at all apparent to the artisan based only on the teachings of WP 5.1.

In summary, we are not persuaded that the teachings of WP 5.1 would have suggested to the artisan the obviousness of the invention as recited in any of claims 1-8. Therefore, the decision of the examiner rejecting claims 1-8 is reversed.

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REVERSED

ERROL A. KRASS
Administrative Patent Judge

JERRY SMITH
Administrative Patent Judge

JAMES T. CARMICHAEL
Administrative Patent Judge

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