

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

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UNITED STATES PATENT AND TRADEMARK OFFICE

PAT & TM OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte JEFFREY S. BROOKS and STEPHEN L. DOHANICH

Appeal No. 95-4426  
Application 07/812,598<sup>1</sup>

ON BRIEF

Before THOMAS, HAIRSTON, BARRETT and FLEMING, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claim 8, the only claim pending in the application.

<sup>1</sup> Application for patent filed December 23, 1991.

Claim 8 is reproduced below:

8. An integrated system for creating a process model and writing software based on the process model, including a group decision support subsystem for creating and ordering a process model according to a protocol, an application development subsystem for writing software based on the output of the group decision support subsystem and a bridge sub-system therebetween for converting output of the group decision support subsystem into input of the application development subsystem, wherein:

a. said group decision support subsystem comprises one or more of:

(1). means for substantially simultaneously and anonymously collecting information, and exchanging ideas and comments about the said information from participants;

(2). issue analysis and idea organization means for the participants to group, categorize and define issues and ideas from the collected information;

(3). voting application means and alternative evaluation means for the participants to rank and prioritize issues and ideas;

(4). topic commenter means for participants to view and comment upon issues and ideas; and

(5). dictionary means;

b. said application development subsystem comprises rules repository means; and

c. said bridge subsystem comprises means to convert the output of the group decision support subsystem to compatible input of the application development subsystem, including:

(1). means for opening output of the group decision support subsystem and scanning directories thereof for object files;

Appeal No. 95-4426  
Application 07/812,598

(2). means for creating and opening initially empty input files of the application development subsystem;

(3). means for parsing an object file output of the group decision support system into object names and object definitions to determine the file contents of the group decision support subsystem output file, and thereafter writing the dissected object names and object definitions into application development subsystem files;

(4). means for building application development subsystem compatible files and writing the application development subsystem compatible files to the application development subsystem, comprising:

i. means to remove the software system delimiters and protocols inserted by the group decision support system;

ii. means to concatenate token numbers to name data and property codes to support data; and

iii. means for uniformly writing out the application development subsystem files.

There are no references relied on by the examiner.

Claim 8 stands rejected under 35 USC 112, first paragraph, as being based upon a disclosure which allegedly fails to provide an "enabling" disclosure of claim 8. According to the examiner, the issue is not directed to clause (a) reciting the group decision support system and it is further not directed to the application development subsystem of clause (b). The examiner's position is that the entire subject matter of clause (c), the bridge subsystem, is not enabled by the present

Appeal No. 95-4426  
Application 07/812,598

disclosure since, in the examiner's view, it is either difficult to determine or cannot be determined what disclosed structure corresponds to the different means comprising the claimed bridge subsystem. Therefore, the examiner concludes that appellants' failure to describe a suitable structure for performing the functions of the claimed bridge subsystem would have led the artisan to resort to undue experimentation to make and use the claimed invention.

Rather than repeat the positions of the appellants and the examiner, reference is made to the brief<sup>2</sup> and the answer for the respective details thereof.

#### OPINION

To comply with the enablement clause of the first paragraph of 35 U.S.C. 112, the disclosure must adequately describe the claimed invention so that the artisan could practice it without undue experimentation. In re Scarbrough, 500 F.2d 560, 566, 182 USPQ 298, 302 (CCPA 1974); In re Brandstadter, 484 F.2d 1395, 1407, 179 USPQ 286, 294-95 (CCPA 1973); and In re Gay, 309 F.2d 769, 772, 135 USPQ 311, 315 (CCPA 1962). If the examiner had a reasonable basis for questioning the sufficiency of the disclosure, the burden shifted to the appellants to come

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<sup>2</sup> Appellants' communication received on March 24, 1995, indicates that no reply brief will be filed.

Appeal No. 95-4426  
Application 07/812,598

forward with evidence to rebut this challenge. In re Doyle, 482 F.2d 1385, 1392, 179 USPQ 227, 232 (CCPA 1973); In re Brown, 477 F.2d 946, 950, 177 USPQ 691, 694 (CCPA 1973); and In re Ghiron, 442 F.2d 985, 992, 169 USPQ 723, 728 (CCPA 1971). However, the burden was initially upon the examiner to establish a reasonable basis for questioning the adequacy of the disclosure. In re Angstadt, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976); and In re Armbruster, 512 F.2d 676, 678, 185 USPQ 152, 154 (CCPA 1975).

The preamble of independent claim 8 on appeal recites an "integrated system" comprising three "subsystems" set forth in the three clauses (a), (b) and (c). Both clauses (a) and (b), comprising respectively the group decision support "subsystem" and the application development "subsystem", are disclosed as being in the prior art (even as recognized by the examiner in the answer), both of which being computer-assisted or computer-aided software development tools known in the prior art. The above noted positions of the examiner, as well as the more specific position that the examiner has taken in the answer that since there is no computer disclosed with which to embody the claimed means of the bridge subsystem clause (c) of claim 8 the disclosure is inadequate, are both misplaced.

The entire disclosure as filed relates the claimed bridge subsystem (c) to the functions performed according to the

REXX computer program source code listing set forth in the various subfigures of Figure 3. As in the context of the prior art subsystem disclosures of clauses (a) and (b) of claim 8, the claimed bridge subsystem and the various means thereof more specifically recited in subelements (1) to (4) of clause (c) must be considered in the context similar to that which we construe the overall claimed "integrated system" of the preamble and the respective "subsystems" of clauses (a) and (b). The summary of the invention in pages 2 to 4 of the brief correlates subtopics (1) to (3) substantially in their entirety as well as subtopic (4)-iii as being specifically shown in the various subfigures of Figure 3. For the sake of completeness, we observe that the portions of subtopic (4) not directly correlated by appellants in the summary of the invention to specific subfigures of Figure 3 appears to us to be based upon the functional description of Figure 3 in the paragraph bridging pages 22 and 23 of the specification as filed as well as the so-called BUILDER routine set forth in Figures 3I and 3J.

There is no argument that the REXX computer program source code listing in the various subfigures of Figure 3 is inadequate or insufficient by itself. Even though no prior art computer system is identified in the disclosure herein, providing the disclosed REXX computer program listing in a known programming language clearly implies to the artisan the existence

Appeal No. 95-4426  
Application 07/812,598

of prior art computer systems per se within which the disclosed REXX listing may be run. From the artisan's perspective, the presence of the source code listing in the disclosure as filed, under the facts here, greatly lessens the nature and extent of experimentation necessary to make and use the claimed invention as to clause (c) of claim 8 on appeal.

Thus, in view of the foregoing, we conclude that the examiner has not set forth a reasonable basis for questioning the adequacy of the disclosed invention as it applies to the entire subject matter of the bridge "subsystem" set forth in clause (c) of claim 8 on appeal, nor can we conclude that the artisan would have been placed in a position such as to require undue experimentation to make and use the presently claimed invention within 35 U.S.C. 112, first paragraph, in view of the above-noted precedent.

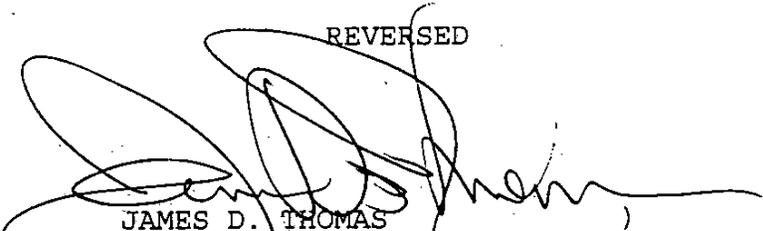
The "subsystem" language of clause (c) in its entirety does not per se set forth the program code of Figure 3 but does in fact set forth the functions attributed thereto in a subsystem environment which, necessarily, requires a known computer to perform the functions in conjunction with the known computer source code specifically shown in the various portions of Figure 3. Stated differently, the entire subject matter of claim 8, and particularly that of the bridge subsystem of clause (c) in claim 8 on appeal, cannot be truly functional without them operating on

Appeal No. 95-4426  
Application 07/812,598

or within a computer system, which is well-recognized as being structure or hardware.

In view of the foregoing, the decision of the examiner rejecting claim 8 under 35 U.S.C. 112, first paragraph, is reversed.

REVERSED

  
JAMES D. THOMAS  
Administrative Patent Judge )

  
KENNETH W. HAIRSTON  
Administrative Patent Judge )

  
LEE E. BARRETT  
Administrative Patent Judge )

  
MICHAEL R. FLEMING  
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Appeal No. 95-4426  
Application 07/812,598

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