

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(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WILSON K. WEN  
and JOHN D. DI CAMILLO

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Appeal No. 96-1119  
Application 07/690,176<sup>1</sup>

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ON BRIEF

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Before KRASS, JERRY SMITH and CARMICHAEL, 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 final rejection of claims 2, 4, 6, 8, 10,

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<sup>1</sup> Application for patent filed April 12, 1991.

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12, 14 and 16. Claims 1, 3, 5, 7, 9, 11, 13 and 15 had been previously cancelled. A first amendment after final rejection was filed on October 11, 1994 but was denied entry by the examiner [Paper No. 15]. A second amendment after final rejection was filed on August 21, 1995 and was entered by the examiner. This amendment cancelled claims 10, 12, 14 and 16. A third amendment after final rejection was filed concurrently with the reply brief on October 6, 1995. This amendment amended claims 2, 4, 6 and 8 and was marked "Enter this amendment" by the examiner, and the amendment has been entered. As a result of the above amendments, this appeal is directed to the rejections of claims 2, 4, 6 and 8, which constitute all the claims remaining in the application.

The disclosed invention pertains to a method and apparatus for developing application software which is to be operated on multiple processors.

Representative claim 2 is reproduced as follows:

2. A method for multiple software development, comprising:

(a) a host computer directly monitoring at least one master processor;

(b) the host computer indirectly monitoring a slave

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processor, for each master processor, through a slave transmit/receive buffer in a memory shared by the master processor and the slave processor; and

(c) using a tangible memory medium embodying the computer program shown in FIGS. 5 through 182.

The examiner relies on the following references:

Fowler et al. (Fowler)	4,502,116	Feb. 26, 1985
Kneib	4,641,238	Feb. 3, 1987

Claims 2, 4, 6 and 8 stand rejected under 35 U.S.C.

§ 112, second paragraph, for failing to particularly point out and distinctly claim the invention. Claims 2, 4, 6 and 8 also stand rejected under 35 U.S.C. § 101 as being directed to nonstatutory subject matter. Finally, claims 2, 4, 6 and 8 stand rejected under 35 U.S.C. § 102(b). As evidence of anticipation the examiner offers Kneib with respect to claims 2, 4 and 6 and Fowler with respect to claim 8.

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, the arguments

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in support of the rejections and the evidence of anticipation relied upon by the examiner as support for the prior art 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.

It is our view, after consideration of the record before us, that claims 2, 4, 6 and 8 particularly point out the invention in a manner which complies with 35 U.S.C. § 112. We are also of the view that claims 2, 4, 6 and 8 are directed to appropriate subject matter under 35 U.S.C. § 101. Finally, it is our view that the invention as set forth in claims 2, 4, 6 and 8 is not fully met by the disclosures of Kneib or Fowler. Accordingly, we reverse.

We consider first the rejection of claims 2, 4, 6 and 8 under the second paragraph of 35 U.S.C. § 112. The examiner's final rejection made only a single objection to the claims as follows:

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The claims are clearly not distinctly claimed because the claim language references "using (a) computer program" located in the Figures [final rejection, page 2].

This rejection appears to be based on a general proposition that a claim which incorporates material from the drawings cannot be in compliance with 35 U.S.C. § 112. This general proposition is incorrect.

The general rule is that a claim must set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the disclosure as it would be by the artisan. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed in light of the specification. Seattle Box Co., v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984).

We fail to see how the computer program of Figures 5 through 182 could be more specifically recited than the current incorporation of these figures into the claims. The claims would not become clearer simply by writing the computer

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program as part of the claims as the examiner apparently proposes. The artisan having considered the specification of this application would have no difficulty ascertaining the scope of the invention included within the phrase "the computer program shown in FIGS. 5 through 182." Therefore, the rejection of claims 2, 4, 6 and 8 under the second paragraph of 35 U.S.C. § 112 as set forth in the final rejection is not sustained.

The examiner made several additional objections to the claims under 35 U.S.C. § 112 in the examiner's answer. These objections were made for the first time in the examiner's answer, but the examiner never identified these objections as constituting a new ground of rejection which they were. As a result of these new objections under 35 U.S.C. § 112, appellants filed an amendment concurrently with a reply brief to specifically address these new objections to the claims. As noted above, this amendment was entered by the examiner. For reasons which remain a mystery at this point, the examiner never addressed what effect the entered amendment had on the rejection under 35 U.S.C. § 112.

The examiner objected to the terms "directly,"

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"indirectly" and "using" in claim 2, but never indicated why these terms were considered to be imprecise [answer, page 3]. Since these terms would appear to be definite in view of the specification, and since the examiner has not provided any explanation in support of his objection, we do not sustain this basis for objecting to the claims. The examiner also noted several "antecedent basis problems" in the claims which no longer exist in the amended claims now before us.

The examiner has also objected to the claims as being incomplete and for being unclear as to how and where the computer program is implemented or run [answer, pages 4-5]. The examiner provides no cogent explanation for these objections and we are unable to come up with any on our own. We see no reason why the artisan would not understand what is within the scope of the claimed invention.

In summary, we do not sustain any of the examiner's objections to the claims under the second paragraph of 35 U.S.C.

§ 112.

We now consider the rejection of claims 2, 4, 6 and 8 under 35 U.S.C. § 101. The basis for this rejection is that

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the monitoring steps of claim 2 could be performed mentally by a human and the invention of these claims is directed to a computer program [answer, pages 5-9]. The amendment filed with the reply brief amended claim 2 to recite that the monitoring steps were performed by a host computer. Thus, to the extent that the mental step rejection was appropriate, a doubtful proposition at best, the examiner's rejection does not apply to the claims as amended. The amendment also amended claim 2 to reflect that the computer program shown in Figures 5 through 182 was embodied in a tangible memory medium.

The examiner's rejection of the claims, which was based on the belief that the claims were directed to a computer program, was not appropriate even without the amendment. Claim 2 was clearly directed to the operations performed by a computer and not to the computer program per se. It is not clear to us why the method recited in claim 2 was indicated by the examiner as not belonging to any of the four statutory classes of 35 U.S.C. § 101. A method is one of those statutory classes. Additionally, a claim directed to a method performed on a

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computer is not the same as a claim directed to a computer program per se. Thus, we do not sustain the rejection of the claims under 35 U.S.C. § 101.

We now consider the rejection of claims 2, 4, 6 and 8 under 35 U.S.C. § 102(b) as anticipated by the disclosures of Kneib or Fowler. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

With respect to the rejection of claims 2, 4 and 6, the examiner states that "Kneib does not explicitly disclose the computer program shown in Figs. 5 through 182, but this feature is inherent in Kneib because both the Application and the Kneib reference perform the same function. Therefore, the equivalent of the program listed in Figs. 5 through 182 must

be in Kneib" [answer, pages 9-10]. The examiner makes the exact same statements with regard to the rejection of claim 8 as anticipated by Fowler [answer, page 11]. Thus, the examiner's position is that the claimed step of using the computer program shown in Figures 5 through 182 is inherently part of the operation of Kneib or Fowler.

Appellants argue that the software implementation of the claims is not equivalent to the hardware implementation of Kneib and Fowler. We agree. The fact that software can be designed which is logically equivalent to hardware fails to properly address the requirements of making a prior art rejection. Independent claim 2 recites that a specific program shown in Figures 5 through 182 must be used in carrying out the method of the invention. There is no evidence that the hardware of Kneib and Fowler uses this specific program. There can be no anticipation of the using step of claim 2 in the absence of a disclosure that the incorporated computer program exists. The examiner has also provided no evidence to support a position that the specific computer program recited in claim 2 would have been obvious over the hardware disclosed by Kneib and Fowler. Thus, there

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is no basis on this record to support a rejection of claims 2, 4, 6 and 8 under either 35 U.S.C. §§ 102 or 103.

In conclusion, we have not sustained any of the examiner's rejections of claims 2, 4, 6 and 8. Therefore, the decision of the examiner rejecting claims 2, 4, 6 and 8 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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