

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 9

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARL D. BURCH and RAJIV KUMAR

Appeal No. 1998-1514
Application No. 08/370,963

ON BRIEF

Before HAIRSTON, FLEMING, 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 claims 1 and 2, which are all of the claims pending in this application.

We REVERSE.

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Claims 1 and 2 stand rejected under 35 U.S.C. § 103 as being unpatentable over Graham in view of Janis.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 8, mailed Oct. 27, 1997) for the examiner's reasoning in support of the rejections, and to the appellants' brief (Paper No. 7, filed July 14, 1997) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Appellants describe the operation of shared libraries and the problem which exists in profiling their operation because the shared libraries remain resident in the operating environment as opposed to client programs which are loaded, run and unloaded by the computer operating system. (See brief at page 2.) Appellants argue that Graham does not discuss the problem inherent in instrumenting shared libraries.

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Id. at 3. We agree with appellants. Appellants argue that Graham does not teach the step of “causing said loader to examine said environment to determine if said predetermined environment variable has been set” as recited in claim 1. We agree with appellants. Appellants argue that Janis does not remedy the deficiency in Graham and further does not teach saving information of any kind to a location specified by an environmental variable. We agree with appellants. Appellants further argue that the teachings of Graham could be modified, but that the examiner has not pointed to any suggestion in the prior art to modify Graham to address the inherent problem with shared libraries. We agree with appellants.

Here, the examiner has not, in our view addressed the language of the claims nor has the examiner provided evidence or a convincing line of reasoning to modify the teaching of Graham to address the inherent problem of instrumenting shared libraries. Therefore, the examiner has not set forth a ***prima facie*** case of obviousness, and we will not sustain the rejection of claim 1 or dependent claim 2.

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CONCLUSION

To summarize, the decision of the examiner to reject claims 1 and 2 under 35 U.S.C. § 103 is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JOSEPH L. DIXON)	
Administrative Patent Judge)	

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