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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ZHONG JIE LI, HE HUI LIU,
NAOMI M. MITSUMORI, KRISHNA RATAKONDA,
HUA FANG TAN, and JUN ZHU¹

Appeal 2012-007809
Application 11/777,340
Technology Center 2100

Before JOHNNY A. KUMAR, MICHAEL J. STRAUSS, and
NATHAN A. ENGELS, *Administrative Patent Judges*.

ENGELS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1, 3, 7, 9–11, 13, and 16–20. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

¹Appellants state that International Business Machines Corporation is the real party in interest. App. Br. 1.

STATEMENT OF CASE

The claimed invention is directed to a method for analyzing testing coverage of software modules to provide process coverage statistics. Claim 1, reproduced below, is exemplary of the claimed subject matter:

1. A method for analyzing testing coverage of one or more software modules to provide process coverage statistics, comprising the steps of:

obtaining one or more coverage measures from a test specification document;

performing a trace on each of the one or more coverage measures during a test;

analyzing each trace to create an initial run-time service choreography model for a process that utilizes one or more of said software modules, wherein the model includes each of one or more service choreography patterns occurring in the process; and

using the model to provide statistical data on test coverage according to a process, wherein one or more steps of said method are performed by a hardware device.

Dismissal of Claims 2, 4-6, 8, 12, 14, and 15

Claims 1–20 are currently pending and finally rejected, but Appellants only appeal the Examiner’s rejection of claims 1, 3, 7, 9–11, 13, and 16–20.²

²Appellants’ Notice of Appeal failed to identify any specific claims from which the appeal was taken, but Appellants identify claims 1, 3, 7, 9-11, 13, 16–20 as those subject to this Appeal. App. Br. 2 (“Claims 1, 3, 7, 9-11, 13, 16-19, and 20 are being appealed.”). Although the “Grounds of Rejection to be Reviewed on Appeal” section of the Appeal Brief lists all claims subject to their respective rejection, including claims 2, 4-6, 8, 12, 14, and 15 (App. Br. 5), Appellants omit these claims from the listing of claims “being appealed” (App. Br. 2), from the Claims Appendix, and from the Arguments

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Accordingly, we lack jurisdiction over claims 2, 4–6, 8, 12, 14, and 15 and the Examiner is advised to cancel those claims consistent with § 1215.03 of the Manual of Patent Examining Procedure. *See Ex Parte Ghuman*, 88 USPQ2d 1478, 1480 (BPAI 2008) (precedential). To the extent it may be found that claims 2, 4–6, 8, 12, 14, and 15 are before us, we summarily affirm the Examiner’s rejections of those claims for lack of separate argument for patentability. *See* App. Br. 2, 5–11; *see also* 37 C.F.R. § 41.37(c)(1)(viii) (2011); *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential).

*Rejections on Appeal*³

1. Claims 1, 3, 7, 9–11, 13, and 16–20 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite.⁴
2. Claims 1, 3, 7, 9–11, 13, and 16–20 stand rejected under 35 U.S.C. § 103(a) as obvious in view of Khan (Ghulam Mustafa Khan, *Test Coverage Analysis: A Method for Generic Reporting*, Indian Institute of Technology, Kanpur, (April 2000)); Barros (Alistair Barros et al., *A Critical Overview of the Web Services Choreography Description Language (WS-CDL)*

section of Appellants’ Appeal Brief. App. Br. 5-11. Accordingly, we find that Appellants have demonstrated a clear intent not to pursue an appeal of claims 2, 4–6, 8, 12, 14, and 15.

³Should there be further prosecution of this application (including any review for allowance), the Examiner may wish to review the claims for compliance under 35 U.S.C. § 101 in light of the recently issued preliminary examination instructions on patent eligible subject matter. *See* “Preliminary Examination Instructions in view of the Supreme Court Decision in *Alice Corporation Pty. Ltd. v. CLS Bank International, et al.*,” Memorandum to the Examining Corps, June 25, 2014.

⁴ Although claims 1-20 are included within the rejection under 35 U.S.C. § 112, second paragraph, only claims 1, 3, 7, 9–11, 13, and 16–20 are appealed.

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www.BPTrends.com (2005); and Kappel (*Web Engineering - The Discipline of Systematic Development of Web Applications*, John Wiley & Sons, Ltd. (Greti Kappel et al. eds. 2006) (2003). Ans. 6.

Appellants' Contentions

1. Appellants argue that the Examiner erred in rejecting claims 1, 3, 7, 9–11, 13, and 16–20 under 35 U.S.C. § 112, second paragraph, as indefinite. App. Br. 6.

a) Appellants argue that proposed amendments to claims 1, 3, 7, 9, 10, and 19 overcome the Examiner's finding that those claims are indefinite because of the limitation "wherein one or more steps of said method are performed by a hardware device." App. Br. 6.

b). Appellants argue that the claim term "initial" in claims 1, 3, 7, 9–11, 13, and 16–20 does not render the claims indefinite. App. Br. 6.

2. Appellants argue that the Examiner erred in finding that Khan teaches or suggests analyzing a trace to create an initial model, as required by claim 1, 11, 19, and 20. App. Br. 7–8. Specifically, Appellants argue that "using the Examiner's interpretation of Khan, Khan already has an initial model based on the software modules prior to any trace analysis." *Id.* (italics and underline omitted).

3. For each of claims 3, 7, 9, 10, 13, 16–18, and 20, Appellants' Appeal Brief cites the Examiner's rejection, quotes the claim language, and states that the claim language is not taught by the cited reference. *See* App. Br. 9–11. Appellants' Reply Brief addresses the substance of the Examiner's rejection of each claim. *See* Reply Br. 5–10.

ANALYSIS

1. *Are the claims at issue indefinite?*

During examination, a claim is indefinite if the metes and bounds of the claimed invention are not clear. *Supplementary Examination Guidelines for Determining Compliance with 35 U.S.C. 112 and for Treatment of Related Issues in Patent Applications*, 76 Fed. Reg. 7162, 7164 (Feb. 9, 2011). The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted).

a) *“Wherein one or more steps of said method are performed by a hardware device”*

The Examiner rejected claims 1, 3, 7, 9, 10, and 19 as indefinite, concluding that the limitation “wherein one or more steps of said method are performed by a hardware device” makes it unknown who or what is performing which steps. Final Office Action at 6–7. Appellants argue that amendments to those claims contained in an Amendment After Final that Appellants filed on July 25, 2011 overcome those rejections. App. Br. 6; Reply Br. 11.

As stated in the Examiner’s August 12, 2011 Advisory Action, the Examiner did not enter those amendments because the amendments would have improperly raised new issues without a request for continued examination. *See* Advisory Action, August 12, 2011 (citing 37 C.F.R. § 1.116 and 41.33(a)). Because the proposed amendments were not entered and are not currently pending, Appellants’ arguments regarding the proposed

amendments are not commensurate in scope with the claims as pending and are therefore unpersuasive.⁵

b) *“Create an initial run-time service choreography model”*

As an additional basis for the rejection of claims 1, 3, 7, 9–11, 13, and 16–20 as indefinite, the Examiner concludes that the limitation “create an initial run-time service choreography model” is unclear in light of the specification. Final Office Action at 6–7; Ans. 5. Appellants argue that a person of ordinary skill in the art would understand that the claimed step of creating a run-time service choreography model generated from a trace is inherently the “initial” run-time service choreography model. App. Br. 6; Reply Br. 2–3. We agree with the Appellants and conclude that the limitation “create an initial run-time service choreography model” does not, when read in light of the Specification, render the claims indefinite.

Based on the foregoing, we sustain the Examiner’s rejection of claims 1, 3, 7, 9, 10, and 19 under 35 U.S.C. § 112, second paragraph, but we do not sustain the Examiner’s rejection of claims 11, 13, 16–18, and 20 under 35 U.S.C. § 112, second paragraph.

2. *Does Khan teach or suggest analyzing each trace to create an initial model for a process?*

The Examiner finds that Khan teaches the limitation “analyzing each trace to create an initial . . . model for a process” with its disclosure of “test coverage analyzers,” report generators that “constructs a flow graph for each trace,” and similar disclosures. Ans. 7–8 and 15–16 (*citing* Khan 7, 14, 22,

⁵We note that the Claims Appendix included with Appellants’ Appeal Brief incorrectly lists the claims as proposed in the July 25, 2011 Amendment After Final. Those claims are not pending and therefore are not considered on this Appeal.

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28, and 30). As one example, Khan's Figure 3.1 depicts analyzing block trace information with a Control Structure Representation ("CSR") Processor, which "generates [a] control flow graph of the test program while parsing [a] CSR file." Khan 23.

Appellants argue that Khan does not teach or suggest this limitation because, "using the Examiner's interpretation of Khan," Khan already has a model when it performs a trace analysis. App. Br. 7-8. Appellants also argue that, because Khan teaches creating a model prior to any trace analysis, Khan teaches away from the claimed invention. App. Br. 8.

We find Appellants' arguments unpersuasive, and we agree with the Examiner that Khan teaches or suggests analyzing trace information to create an initial model as required by claims 1, 11, 19, and 20. *See* Khan 18-19, 22-25, and 30. As noted above, Khan teaches a "report generator" that constructs a flow graph for each execution trace, and "[f]or each test execution, the report generator takes the blocks as nodes and link[s] them as they are encountered (in block trace) as an adjacency matrix." Khan 30. Appellants' Specification does not provide a definition for the disputed claim term "initial model," and, under a broad but reasonable interpretation of the disputed limitation, we agree with the Examiner that Khan's test coverage analyzer and report generators that construct a flow graph for each test teaches the claimed limitation "analyzing each trace to create an initial . . . model for a process." *See* Ans. 7-8 and 15-16 (citing Khan 7, 14, 22, 28, and 30). Accordingly, we sustain the Examiner's rejection of claims 1, 11, 19, and 20.

3. *Appellants' failure to substantively address claims 3, 7, 9, 10, 13, and 16–18.*

Regarding claims 3, 7, 9, 10, 13, and 16–18, Appellants' Appeal Brief merely cites the Examiner's finding, quotes the claim language, and then states in conclusory terms that the claim language is not met by the cited reference. *See* App. Br. 9–11. These statements do not point out with particularity the Examiner's purported error nor explain why the limitations of claims 3, 7, 9, 10, 13, and 16–18 are patentable in view of the prior art.

As Appellants' Appeal Brief does not include specific arguments or evidence as to why claims 3, 7, 9, 10, 13, and 16–18 are patentable over the cited prior art, we find Appellants' arguments unpersuasive. *See In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (“[W]e hold that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.”); 37 C.F.R. § 41.37(c)(1)(viii) (2011). To the extent that Appellants raise additional arguments directed to these claims for the first time in Appellants' Reply, having failed to present the arguments in their Appeal Brief, Appellants have waived the arguments. *See Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (informative) (“[T]he reply brief [is not] an opportunity to make arguments that could have been made in the principal brief on appeal to rebut the Examiner's rejections, but were not.”). Accordingly, we sustain the Examiner's rejection of claims 3, 7, 9, 10, 13, and 16–18.

DECISION

For the foregoing reasons, we sustain the Examiner's rejection of claims 1, 3, 7, 9, 10, and 19 under 35 U.S.C. § 112, second paragraph, but

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we reverse the Examiner's rejection of claims 11, 13, 16–18, and 20 under 35 U.S.C. § 112, second paragraph. We sustain the Examiner's rejection of claims 1, 3, 7, 9–11, 13, and 16–20 under 35 U.S.C. § 103(a) as obvious in view of Khan, Barros, and Kappel.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2009).

AFFIRMED IN PART

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