

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID UEL SHORTER

Appeal No. 2002-0580
Application No. 08/980,336

ON BRIEF

Before BARRETT, 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, 4-8, 11-16, 19 and 20, which are all of the claims pending in this application. Claims 2, 3, 9, 10, 17 and 18 have been canceled.

We REVERSE

Appellant's invention relates to a unique object identification in a network of computing systems. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method of uniquely identifying an object, comprising:
 - associating a unique host identifier with a data processing system within a plurality of data processing systems;
 - associating a unique data item identifier with an object within a plurality of objects within the data processing system;
 - associating a unique network identifier with a network of data processing systems within a plurality of networks of data processing systems, wherein the network includes the data processing system containing the object; and
 - constructing a unique object identifier for the object by combining a plurality of fields including a first field containing the data item identifier, a second field containing the host system identifier, and a third field containing the network identifier.

The prior art of record relied upon by the examiner in rejecting the appealed claims is as follows:

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|------------------------|-----------|---------------|
| Sidhu et al. (Sidhu) | 5,884,322 | Mar. 16, 1999 |
| Munroe et al. (Munroe) | 5,581,765 | Dec. 03, 1996 |

Claims 1, 4-8, 11-16, 19 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sidhu in view of Munroe.

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Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 21, mailed Nov. 9, 2001) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 20, filed Oct. 16, 2001) for appellant's arguments thereagainst.

OPINION

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

Appellant argues that it the examiner's burden to establish a *prima facie* case of obviousness of the claimed invention and that the examiner has not met this initial burden. (See brief at page 5.) We agree with appellant. Appellant argues that the claimed invention requires that the unique identifier include a network identifier as well as a system identifier and an object identifier. (See brief at page 5.) Appellant argues that the system identifier and object identifier of Sidhu in combination with the process identifier and object identifier of Munroe would not have suggested the unique identifier which includes a network identifier as well as a system identifier and an object identifier.

The examiner maintains that Munroe teaches that it is desirable to be able to uniquely identify objects across some domain including a network of systems. (See answer at page 4.) While we agree with the examiner that Munroe provides a clear motivation for the unique identifier, Munroe also provides teachings of various methodologies to perform this goal, but we find no specific teaching or suggestion of the use of three identifiers or a suggestion to include a network identifier in addition to two other identifiers.

With respect to the examiner's response to appellant's argument concerning no reasonable expectation of success, we find that the examiner is merely speculating as to the extension of the unique identifier to include the network identifier. From the teachings of Munroe, we do find a motivation for a unique identifier across a network of systems, but no realization of the use of a network identifier in combination with other identifiers to make the composite which uniquely identifies the object. Therefore, we find that the examiner has not established a *prima facie* case of obviousness of the claimed invention, and we cannot sustain the rejection of independent claims 1, 8 and 16 and their respective dependent claims which have similar limitations.

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CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 4-8, 11-16, 19 and 20 under 35 U.S.C. § 103 is reversed.

REVERSED

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| LEE E. BARRETT |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| MICHAEL R. FLEMING |) | APPEALS |
| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
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| |) | |
| |) | |
| JOSEPH L. DIXON |) | |
| Administrative Patent Judge |) | |

JLD/vsh

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