

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. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MICHAEL C. POWERS, DOUGLAS A. SUDBERRY,  
JAMES A. EILER, ROBERT S. BENNETT  
and CLIFFORD R. PHILLIPS

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Appeal No. 2004-0755  
Application No. 09/110,109

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ON BRIEF

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Before JERRY SMITH, FLEMING, and OWENS, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

*DECISION ON APPEAL*

This appeal is from the final rejection of claims 1-9, 11-14 and 16-21, which are all of the claims pending in the application.

*THE INVENTION*

The appellants claim a method and system for providing access privileges for a user in a performance evaluation system.

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Claim 1, which claims the method, is illustrative:

1. A method for providing access privileges for a user in a performance evaluation system, comprising:

storing an organizational structure for an enterprise, the organizational structure including a plurality of levels and a plurality of members assigned to the levels;

storing a view for the user, the view specifying the levels and the members of the organizational structure to which the user is allowed access;

storing a class of services for the user, the class of services specifying services of the performance evaluation system that the user is allowed to perform;

determining whether the view for the user specifies a requested level or member;

determining whether the class of services for the user specifies a requested service; and

providing the user with access privileges to perform the requested service for the requested level or member when the class of services for the user specifies the requested service and the view for the user specifies the requested level or member.

*THE REFERENCE*

Deinhart et al. (Deinhart) 5,911,143 Jun. 8, 1999  
(filed Aug. 14, 1995)

*THE REJECTION*

Claims 1-9, 11-14 and 16-21 stand rejected under 35 U.S.C.

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§ 102(e) as being anticipated by Deinhart.<sup>1,2</sup>

*OPINION*

We reverse the aforementioned rejection. We need to address only the independent claims, i.e., claims 1, 9 and 14.

*Claim 1*

Deinhart discloses a system and method for authorizing and controlling access rights of subjects on objects of a computer system using parameterized role types and access control lists derived from capability lists that provide access rights on a per-subject basis (col. 3, lines 5-26; col. 12, lines 8-30).

The examiner argues that "performance evaluation system" in the preamble of the appellants' claim 1 is mere intended use which does not provide a structural, operational or functional difference relative to Deinhart and, therefore, does not provide a patentable distinction over Deinhart (answer, pages 5-10).

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<sup>1</sup> Twelve rejections of claims 1-9, 11-14 and 16-21 under 35 U.S.C. § 102 are withdrawn in the examiner's answer (page 4).

<sup>2</sup> The "First ACM Workshop on Role-Based Access Control" publication relied upon by the examiner (answer, page 9) is not included in the statement of the rejection and, therefore, is not properly before us. See *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). Consequently, we do not consider that publication in reaching our decision.

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A term appearing in a preamble is limiting when it is found to be required to confer meaning on the claim. *See Phillips Petroleum Co. v. Huntsman Polymers Corp.*, 157 F.3d 866, 872, 48 USPQ2d 1161, 1166 (Fed. Cir. 1998). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999) (quoting *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 480-81 (CCPA 1951). That is, "the preamble may be limiting 'when the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention.'" *Allen Engineering Corp. v. Bartell Industries Inc.*, 299 F.3d 1336, 1346, 63 USPQ2d 1769, 1774 (Fed. Cir. 2002) (quoting *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995).

The appellants' specification states that "[t]his invention relates generally to evaluation tools, and more particularly to a system and method for providing access privileges for users in a

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performance evaluation system" (page 1, lines 24-27). Thus, the

specification indicates that the body of claim 1, which does not specify that the steps are steps of a performance evaluation system, does not fully and intrinsically set forth the complete invention. Instead, the specification indicates that the preamble is used, along with the body of the claim, to define the claimed subject matter. Hence, the examiner's argument that "performance evaluation system" in the preamble of the appellants' claim 1 is mere intended use is incorrect.

The examiner states that Deinhart discloses each element of the appellants' claim 1, and in support of that statement cites all of Deinhart except the field of the invention (final rejection mailed September 11, 2001, paper no. 21, pages 10-11). The examiner has the initial burden of establishing a *prima facie* case of anticipation by pointing out where all of the claim limitations appear in a single reference. See *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138-39 (Fed. Cir. 1986). The examiner's mere citation of essentially the entire Deinhart reference is not adequate for carrying that burden.

The examiner argues that the steps in the appellants'

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claim 1 of storing a view for the user and storing a class of services for the user mean "that if the user has the job position of Department Manager in the organizational chart they have access privileges to access specific information, service or resources pertaining to Department Managers which constitutes a view as can be seen in figures 2A, table 2B, 3A-5, and related text of col. 7, lines 17 et. seq. in Deinhart et al. and related sections cited by Appellant in the section entitled 'Summary of the Invention' of the instant Appeal Brief" (answer, page 11).

The steps addressed by the examiner require "storing a view for the user, the view specifying the levels and the members of the organizational structure to which the user is allowed access" and "storing a class of services for the user, the class of services specifying services of the performance evaluation system that the user is allowed to perform". The examiner has not pointed out where the subject matter of those steps or the other steps appears, expressly or inherently, in Deinhart. *See Corning Glass Works v. Sumitomo Electric*, 868 F.2d 1251, 1255-56, 9 USPQ2d 1962, 1965 (Fed. Cir. 1989). Consequently, the examiner has not established a *prima facie* case of anticipation of the method claimed in claim 1. We therefore reverse the rejection of that claim and claims 2-8 that depend therefrom.

*Claims 9 and 14*

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The examiner states that claims 9 and 14 "are rejected based on the same reasoning as claims 1-8" (final rejection mailed

September 11, 2001, paper no. 21, page 17). In the rejection of claims 1-8, the examiner merely states that the subject matter is disclosed by Deinhart and cites all of Deinhart except the field of the invention. See *id.* at pages 10-17.

The examiner has not pointed out where the limitations in claims 9 and 14 are disclosed, either expressly or inherently, by Deinhart. See *Corning Glass Works v. Sumitomo Electric U.S.A., Inc.*, 868 F.2d at 1255-56, 9 USPQ2d at 1965. Hence, the examiner has not carried the burden of establishing a *prima facie* case of anticipation of the systems claimed in those claims. Accordingly, we reverse the rejection of claim 9 and its dependent claims 11-13, and claim 14 and its dependent claims 16-21.

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*DECISION*

The rejection of claims 1-9, 11-14 and 16-21 under 35 U.S.C.  
§ 102(e) over Deinhart is reversed.

*REVERSED*

JERRY SMITH	)	
Administrative Patent Judge	)	
	)	
	)	BOARD OF PATENT
	)	
MICHAEL R. FLEMING	)	APPEALS AND
Administrative Patent Judge	)	
	)	INTERFERENCES
	)	
	)	
TERRY J. OWENS	)	
Administrative Patent Judge	)	

TJO/dpv

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