

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte CHARLIE C. BAGGETT, JR. and JOHN J. ADAMS

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Appeal No. 2004-1911  
Application No. 09/558,387

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ON BRIEF<sup>1</sup>

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Before THOMAS, BARRY and SAADAT, Administrative Patent Judges.  
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 32-38, 40-45 and 76-88. Claims 1-31, 39 and 46-75 have been canceled.

We reverse.

BACKGROUND

Appellants' invention is directed to information security assessments that take into account domains within an enterprise. Users are interviewed base on an enterprise type, domains within

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<sup>1</sup> For the reasons discussed in the decision, the oral hearing scheduled for January 11, 2005 was deemed unnecessary by the panel and was vacated.

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an enterprise and users' area of expertise to determine deficiencies in information security based on the users' responses.

Representative independent claim 32 is reproduced below:

32. A computer implemented method for assessing information security for a plurality of domains within an enterprise, comprising:

- (1) Querying an administrator to identify an enterprise type;
- (2) Querying the administrator to define domains within the enterprise;
- (3) Querying the administrator to identify users and user areas of expertise;
- (4) Tailoring user questions according to the enterprise type, the domains within the enterprise, and the user areas of expertise;
- (5) Querying the administrator regarding roll-up options for generating enterprise-wide reports;
- (6) interviewing a first user group regarding a first domain of an enterprise;
- (7) assessing information security for the first domain based upon user responses to step (6);
- (8) interviewing a second user group regarding a second domain of the enterprise;
- (9) assessing information security for the second domain based upon user responses to step (8); and
- (10) assessing information security for the enterprise based on administrator selected options.

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The Examiner relies on the following references:

Cortez et al. (Cortez), "Information Policy Audit: A Case Study of an Organizational Analysis Tool," Special Libraries Association, vol. 87, no. 2, pp. 88-97, (Spring 1996).

Intelligent Resource Program, "Pilot Information Security Assurance Site Is On Line," (September 1997).

"L3 Network Security, Evaluation Guide" (L3), L-3 Communications Network Security Systems, LLC, (1999).

Claims 32-38, 40 and 76-88 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cortez and L3.

Claims 41-45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cortez, L3 and Intelligent Resource Program.

We make reference to the answer (Paper No. 23, mailed January 22, 2004) for the Examiner's reasoning and to the appeal brief (Paper No. 22, filed November 12, 2003) for Appellants' arguments thereagainst.

#### OPINION

The focus of Appellants' arguments is that Cortez does not teach or suggest interviewing users for assessing information security and merely mentions information security policy as a side issue (brief, page 6). Appellants further assert that L3 merely discloses a risk assessment and security planning tool without even suggesting that an enterprise type is identified or

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any domains within the enterprise are defined (brief, page 8). Additionally, Appellants argue that since interviewing the users in Cortez relates to the efficiency of information flow, there is no reason for the skilled artisan to consider its combination with L3 and use the interviews for risk assessment and security planning (brief, page 9).

In response to Appellants' arguments, the Examiner relies on the fifth page of Cortez regarding the brief discussion of safeguarding information and asserts that interviewing the users for assessing the information flow in combination with the security analysis of L3 would teach the claims (answer, page 15). Furthermore, to support the combination, the Examiner asserts that the combination would have been obvious since querying the employees would have "intuitively" be related to the overall security assessment of the network (answer, pages 16 & 17).

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To reach a conclusion of obviousness under § 103, the examiner must produce a factual basis supported by teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Such evidence is required in order to establish a prima facie case.

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In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The Examiner must not only identify the elements in the prior art, but also show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references." In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Upon a review of Cortez, we remain unpersuaded by the Examiner's characterization of the assessment of disclosed user interviews as the claimed security assessment of a domain based on the user responses. Cortez, in fact, interviews users for assessing the efficiency and effectiveness of information flow within the organization (abstract and "Introduction"). On the other hand, what the Examiner characterizes (answer, page 5) in pages 5-8 of L3 as the claimed querying to determine the enterprise type, the domains within the enterprise and users areas of expertise is merely arranging assets, tasks and objectives according to a set of predetermined risk levels associated with their values. Therefore, assessing the information security in L3 would not be dependent on responses from user groups.

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Based on our findings above, we also agree with Appellants (brief, page 9) that there is no connection between the risk assessment of L3 and interviewing users regarding efficiency of information flow of Cortez. Therefore, by merely speculating and extending such interviews to information security assessment, there cannot be any reasonable teaching or suggestion for combining the applied prior art. Accordingly, as the Examiner has failed to establish a prima facie case of obviousness, we do not sustain the rejection of claims 32-38, 40 and 76-88 over Cortez and L3.

With respect to the rejection of the remaining claims, the Examiner further relies on Intelligent Resource Program for teaching a help desk as the claimed working aid. However, nothing in this additional reference, alone or in combination with Cortez and L3, overcomes the deficiencies discussed above with respect to claim 32. Therefore, the 35 U.S.C. § 103 rejection of claims 41-45 over Cortez, L3 and Intelligent Resource Program cannot be sustained.

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CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 32-38, 40-45 and 76-88 under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES D. THOMAS	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
LANCE LEONARD BARRY	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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	)	
MAHSHID D. SAADAT	)	
Administrative Patent Judge	)	

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