

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LUDO GYS

Appeal No. 2006-2723
Application No. 09/891,264

ON BRIEF

Before JERRY SMITH, BARRY, and SAADAT, Administrative Patent Judges.

SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-11.

We affirm.

BACKGROUND

The Appellant's invention generally relates to a communication means connected to a communication network, and more specifically, to a method for

providing personal services independent of the network (specification, page 3).¹

Further, Appellant's invention provides for a service computer which executes a service container that provides the personal service (id.). The service container uses a network lock, which is a predefined interface to the communication network offered by the service computer (id.).

Claim 1 is representative of the invention and is reproduced as follows:

1. A method for providing personal services for a communication means of a user, said communication means being connected to a communication network, wherein the method comprises;

transmission by a service server of a first service container containing a service machine to a service computer

execution by said service computer of said service machine, said service machine managing the execution of a personal service for said communication means,

provision by said service computer of at least one network lock for said first service container, said at least one network lock offering to said first service container a predefined interface to said communication network for the provision of said personal service, and

provision of said personal service by execution or by application by said service machine of at least one service component being transmitted to said service computer via said first service container or via a second service container.

¹ Appellant's specification has two sets of numberings, which are inconsistent with one another. For instance, the page with number 2 at the top of the page has number 3 at the bottom of the page. We will refer to the page number at the top of the page.

Appeal No. 2006-2723
Application No. 09/891,264

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are

Yates et al. (Yates)	6,330,586	Dec. 11, 2001
Beck et al. (Beck)	6,604,140	Aug. 5, 2003

Claims 1-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yates and Beck.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and Appellant regarding the above-noted rejections, we make reference to the answer (mailed March 8, 2006) for the Examiner's complete reasoning in support of the rejections, and to the brief (filed December 14, 2005) and reply brief (filed May 8, 2006) for Appellant's arguments thereagainst.

Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the briefs have not been considered. *See* 37 CFR § 41.37(c)(1)(vii).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, and the evidence of obviousness relied upon by the Examiner as support for the rejections.

Appeal No. 2006-2723
Application No. 09/891,264

We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the briefs along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's answer.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole, knowledge generally available to one having ordinary skill in the art or the nature of the problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); *ACS Hosp. Sys., Inc. v.*

Appeal No. 2006-2723
Application No. 09/891,264

Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. *Note In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. *See id.*; *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976).

Turning to claim 1, we find from our review of the record that the teachings of Yates and Beck would have suggested to an artisan, for the reasons advanced by the Examiner and amplified by our comments, *infra*, the invention recited in claim 1.

The Examiner's position is that Yates discloses the claimed service computer as a terminal agent (answer, page 14) that executes the claimed service machine such as the "code" and "SIBB" (answer, pages. 15 and 18). The Examiner also argues that Yates discloses the claimed network lock as the

Appeal No. 2006-2723
Application No. 09/891,264

“interface” (answer, page 14) for the first service container, i.e., the “modules” (answer, page 15). The Examiner further argues that Yates discloses that the claimed service machine executes a service component such as the “rules” or “policies” (answer, page 15). The Examiner relies on Beck for teaching a service server that transmits a service container to a service computer. The Examiner explains that it would have been an obvious enhancement of Yates to incorporate therein the concept of a server to transmit Yates’s modules to the agents (answer, page 15, line 22 through page 16, line 2).

Our discussion will first focus on Appellant’s arguments directed to whether the claimed features are taught by the combination of Yates and Beck. We will then turn to arguments directed at the combinability of Yates and Beck. Finally, we will discuss Appellant’s arguments directed to dependent claims 2 and 4.

1. Whether the combination of Yates and Beck teaches or suggests all the claimed features

Appellant alleges that Yates does not teach “service component” limitation required by claim 1. Appellant states the following in support of his position:

Appeal No. 2006-2723
Application No. 09/891,264

The Patent Office has asserted that the code and SIBBs of Yates modules teach the service machine. However, according to the portions of Yates cited by the Patent Office, the policy is either embedded in the object, or downloaded from a policy data store 1104 shown in Fig. 11. Obviously, the code and SIBB of Yates, constituting parts of the agents, are not included in the policies.
(Brief, page 15).

Relying on Yates (col. 11, lines 27-30; col. 17, lines 33-37) for support, the Examiner takes the position that Yates' "policies" are analogous to the claimed "service component" because the policies are responsible for reconfiguring user terminals such that they are provided with new service functionality (answer, page 19). Further, the Examiner relies on Yates (col. 17, lines 42-67) in asserting that Yates' "policies" are transmitted to Yates' SIBB—which is analogized to the claimed service machine—where the SIBB executes the policy in order to provide the requested service (answer, page 19). The Examiner further argues that since the "policies" of Yates are responsible for providing personal services and are executed by a service machine such as a SIBB, these "policies" qualify as the claimed service component (answer, page 19).

In response, Appellant alleges that the claimed "service component" is not met by Yates. In support of this position, Appellant argues that, "[t]o satisfy the claimed requirements for a service component, the policies would have to be sent

Appeal No. 2006-2723
Application No. 09/891,264

to the terminal agent either in the same container as the module, or in a different container” (reply brief, page 3).

Appellant further points out that the “module” disclosed by Yates does not contain anything, but is itself a building block of executable code. “[T]here is nothing in Yates which corresponds to a container. The modules are executable code portions and a combination of modules may comprise an executable service machine, no module is a ‘container’ of anything” (reply brief, page 4).

The Examiner’s answer presents a reasoned position as to the factual basis for analogizing the “policies” and “module” of Yates to the claimed service component and service container. There is no dispute that Yates discloses software modules. However, there is a dispute about whether the Yates software modules actually contain anything, or—specifically—whether they contain service independent building blocks (SIBBs). Appellant states that the modules of Yates do not contain anything, but are themselves building blocks of executable code (reply brief, pages. 3-4). We agree with Appellant to the extent that the Yates software modules are essentially building blocks of executable code, but we disagree with the statement that they do not contain anything.

Appeal No. 2006-2723
Application No. 09/891,264

Yates' invention is directed to reconfigurable software agents that cooperate to provide a user with access to system services (col. 1, lines 59-64). These software agents comprise, or have access to, a plurality of software modules (col. 2, lines 57-60). Yates teaches the following:

[F]unctionality of at least some of the software modules provides service-independent building blocks (SIBBs) for services to be provided by means of the system. ... Service independent building blocks are then pieces of software, generally incorporating data and functionality, which provide supporting operations that a customer would need in addition to the services themselves.
(Col. 3, lines 5-7, 10-13).

This passage illustrates that the modules encapsulate—or “contain”—individual software building blocks. Yates later describes that the SIBBs are one of the three types of software modules or objects available to an agent (col. 4, lines 3-6; col. 17, lines 17-21).

Thus, we agree that a SIBBs-type software module qualifies as the claimed “service container” because it contains the individual SIBBs—which are pieces of software. As such, the term “service-independent building blocks” does indicate that this broader software module is made up of smaller pieces of software. The fundamental operation of these smaller pieces of software is governed by rules or polices, which are analogized to the claimed “service component”.

Appeal No. 2006-2723
Application No. 09/891,264

Therefore, although Appellant is correct that the “software modules” of Yates are themselves executable blocks of code, this does not answer the question of whether these modules contain anything. We are persuaded by the Examiner’s position that the software modules contain individual blocks of code, since the hierarchical structure of the Yates arrangement shows that—as the claim requires—the smaller blocks of individual code are encapsulated in a larger module.

Turning next to the “communication means” limitation of claim 1, Appellant alleges that neither Yates nor Beck teaches the claimed communication means (brief, page 16). Appearing in the preamble and the second paragraph of the body of the claim, however, we observe that the term “communication means” simply requires a connection to a network and the receipt of personal services. After stating that the “communication means” is not taught by either reference, Appellant proceeds to argue aspects of the Beck reference and concludes that “Beck fails to teach or suggest the transmission of the service container of the claimed invention” (brief, page 16).

Appeal No. 2006-2723
Application No. 09/891,264

The Examiner's position is that Yates' user terminal corresponds to Appellant's claimed communication means (answer, page 19). The Examiner supports this position by referring to Appellant's own specification (specification, page 3, paragraph 3) - which states that the communication means is essentially a user's terminal (answer, page 19).

Upon reviewing the evidence of record, we agree with the Examiner's position. Yates discloses the claimed communication means because the customer terminal accesses the system, which utilizes one or more communication networks and provides personal services to the user (col. 2, lines 40-42; col. 1, lines 56-59). The function of this terminal is consistent with Appellant's own disclosed communication means, including the terminal for providing personal services to a user (specification, page 3).

2. Whether the Combination of Yates and Beck is Proper

Appellant alleges that these two references solve different problems because Beck discloses sharing service implementations between devices 101 and 121 having similar modules, like PDAs, whereas Yates requires transmission between devices that are very different (brief, page 14).

Appeal No. 2006-2723
Application No. 09/891,264

The Examiner responds by asserting that Appellant's position regarding Beck is an inaccurate interpretation of Beck's disclosure because Beck does not limit his invention to devices having similar modules, such as PDA's. The Examiner, relying on Beck (col. 1, lines 25-44), argues that Beck is actually "directed at solving the problem of providing both 'mobile and non-mobile devices' the ability to discover and use services in an efficient manner within a network environment" (answer, page 16). Further relying on several excerpts of the Beck disclosure (including col. 1, lines 9-20; col. 8, lines 9-15; col. 8, lines 62-64), the Examiner contends that Appellant's assertion is in conflict with Beck's goal of allowing both mobile and non-mobile computing devices to share services by interacting with other electronic devices (answer, pages 16-17).

After a review of Beck, we find that the disclosed service framework for computing devices enables computing devices to share services over a network. Beck illustrates an embodiment of this idea in Figure 1, which shows two computing devices, such as PDA's, sharing software services from a common file server 102 over a common network 103. The common file server 102 is a very different type of device than the mobile device. Furthermore, as cited by the Examiner (answer, page 5), Beck shows an embodiment in which the two devices

Appeal No. 2006-2723
Application No. 09/891,264

can be either mobile devices or non-mobile devices (Figure 7, described at col. 7, lines 26-44).

Therefore, we agree with the Examiner that the Beck disclosure is not limited to transmission between like computing devices. It follows that we find Appellant's arguments unpersuasive because the Examiner has shown that the Beck disclosure is not limited to the narrow embodiment that Appellant relies upon in arguing that the references solve different problems.

Appellant further alleges that the combination of Yates and Beck will unavoidably change the principle of operation of the references (brief, page 16). We observe that in support of this conclusion, Appellant uses the same factual characterization of the Beck reference that was used in the above argument. Based on our analysis of the references outlined above, and essentially for the same reasons asserted by the Examiner, we find no error in the combination of references.

3. Arguments Related to Dependent Claims 2 and 4

Regarding claims 2 and 4, Appellant alleges that there is nothing in Yates which causes the terminal agent to send a notification of a condition, or a request for service, to a server (reply brief, pages 5-6).

Appeal No. 2006-2723
Application No. 09/891,264

We observe that claims 2 and 4 are rejected over the combined system of Yates and Beck, not just Yates alone. The Yates reference discloses transmitting messages between objects (col. 9, lines 1-7). The addition of the Beck reference adds a server to the system. Therefore, the messages that were sent between objects in Yates are sent to the server in the system taught by the combination of Yates and Beck.

Accordingly, as the Examiner has established a prima facie of obviousness, we sustain the 35 U.S.C. § 103 rejections of claim 1, 2, and 4, as well as claims 3, and 5-11 which are argued as falling with claim 1.

CONCLUSION

To summarize, the decision of the Examiner rejecting claims 1-11 under 35 U.S.C. § 103 is affirmed.

Appeal No. 2006-2723
Application No. 09/891,264

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

AFFIRMED

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

MDS:pgc

Appeal No. 2006-2723
Application No. 09/891,264

Sughrue, Mion, Zinn, MacPeak & Seas, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3213