

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JHEROEN PIETER DORENBOSCH, RICHARD LIONEL BENNETT,  
STEVEN JEFFREY GOLDBERG, and W. GARLAND PHILLIPS

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Appeal 2007-0786  
Application 10/262,142<sup>1</sup>  
Technology Center 3600

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Decided: October 10, 2007

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Before HUBERT C. LORIN, JENNIFER D. BAHR, and DAVID B. WALKER,  
*Administrative Patent Judges.*

WALKER, *Administrative Patent Judge.*

DECISION ON APPEAL

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<sup>1</sup> The real party in interest is Motorola, Inc. of Schaumburg, Illinois.

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### STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-27. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We reverse.

### THE INVENTION

Appellants claim a method and apparatus for scheduling and facilitating a meeting (Specification 1:4-5). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A method of scheduling a meeting comprising:
  - specifying a plurality of individuals to participate in the meeting and a list of desired resources for facilitating the meeting;
  - communicating with a plurality of scheduling agents corresponding, respectively, with the plurality of individuals and with a processor function embedded with a resource corresponding to the list of desired resources;
  - negotiating with the plurality of scheduling agents to determine availability of the plurality of individuals and with the processor function embedded with the resource to determine availability of the resource; and
  - scheduling the meeting at a time when the resource and a sufficient number of the plurality of individuals are available.

### THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

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Cesta et al., *Building Interfaces as Personal Agents*, SIGCHI Bulletin, vol. 28, no. 3, 108-113 (July 1996).

T. Small, D. Hennessy, & F. Dawson, RFC 2739, (Jan. 2000)  
<http://www.faqs.org/rfcs/rfc2739.html>.

The following rejections are before us for review.

1. Claims 1-5, 7-10, 12, 13, and 16-19 stand rejected under 35 U.S.C. § 102(b) as anticipated by Cesta.
2. Claims 6, 14, and 15 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Cesta in view of Applicants' admitted prior art.
3. Claims 11, 20-23, and 25-27 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Cesta in view of RFC 2739.
4. Claim 24 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Cesta in view of RFC 2739 and further in view of Applicants' admitted prior art.

#### ISSUE

The issue before us is whether Appellants have shown that the Examiner erred in rejecting (1) claims 1-5, 7-10, 12, 13, and 16-19 as anticipated by Cesta; (2) claims 6, 14, and 15 as unpatentable over Cesta in view of Applicants' admitted prior art; (3) claims 11, 20-23, and 25-27 as unpatentable over Cesta in view of RFC 2739; and (4) claim 24 as unpatentable over Cesta in view of RFC 2739 and further in view of Applicants' admitted prior art. The dispositive issue is whether the cited references teach a processor function embedded with a resource as

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required by claims 1 and 12 and a controller embedded with a resource as required by claim 21. The resolution of these issues ultimately is a matter of claim construction.

Rather than repeat the arguments of Appellants and the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).

#### FINDINGS OF FACT

We find the following enumerated findings to be supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427, 7 USPQ2d 1152, 1156 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. The Specification teaches that “[i]t is expected that the processing function would be an intimate, embedded part of the resource although is [sic, it] could be remote and operate on behalf of the resource.” (Specification 12:1-3).
2. Cesta teaches a meeting agent that is able to automatically organize meetings, seminars, and small conferences. The meeting agent has a distributed architecture and consists of subagents, including a scheduling agent, a resource agent, a server agent, and a travel agent. There is an

- instance of the scheduling agent for each user while the other agents are shared by a community of users since they hold common information and data. (Cesta, p. 112, para. 40).
3. The scheduling agent can play the role of organizer or guest. Once a meeting is announced, the agents have to reach an agreement to make the event possible while respecting all the constraints on the meeting. The scheduling agent for each user maintains a knowledge base about the user containing his preferences, his interests, his availability, his agenda (Cesta, p. 112, para. 42). The agents extract priority values from the individual user preferences that are utilized to make a first proposal in case of conflict. If an agreement is not possible, a negotiation phase starts in which the organizer can ask the agents to relax some constraints (Cesta, p. 112, para. 43).
  4. The resource agent knows the cities in which the users live, the places usually hosting meetings and the available resources. It can figure out the distance between places to select the most convenient town and place to organize the meeting (Cesta, p. 112, para. 45).
  5. Cesta does not teach the location of the resource agent nor does it teach a processor function or controller embedded with a resource.
  6. RFC 2739 discusses calendar attributes for vCard and LDAP, but makes no mention of resources needed for meetings nor does it teach a processor function or controller embedded with a resource.

## PRINCIPLES OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications “not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (en banc) (quoting *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004)). The properly interpreted claim must then be compared with the prior art.

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations.

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*Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). *See also KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls”).

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the appellant. *Id.* at 1445, 24 USPQ2d at 1444. *See also Piasecki*, 745 F.2d at 1472, 223 USPQ at 788. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444; *Piasecki*, 745 F.2d at 1472, 223 USPQ at 788.

## ANALYSIS

### **A. Rejection of claims 1-5, 7-10, 12, 13, and 16-19 under 35 U.S.C. § 102(b) as anticipated by Cesta.**

Appellants argue that Cesta does not show or suggest a processor function embedded with a resource or negotiation with such a resource (Br. 10). Appellants correctly point out that the resource agent of Cesta is described as shared by a community of users (Br.10, Finding of Fact 2). The Examiner found that "[i]n light of the examples provided in Appellant's [sic, Appellants'] own specification, the Examiner has interpreted the embedded processor function as being

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programmed and stored within the agent representing the resource.” (Answer 13). Although the Specification teaches that the processor function can either be an embedded part of the resource or be remote and operate on behalf of the resource (Finding of Fact 1), independent claims 1 and 12 require that at least one processor function be “embedded with a resource.” Thus, we do not agree with the Examiner’s construction that would permit the processor function to be stored with the agent remote from the resource and still be considered embedded with the resource. The Specification describes being embedded as a preferred alternative to and not a variant of remote location operating on behalf of the resource (Finding of Fact 1). Thus, the broadest reasonable construction consistent with the Specification necessarily limits embedded to being an embedded part of (e.g., co-located with) the resource. Because Cesta does not teach a processor function embedded with a resource as construed herein (Finding of Fact 5), the Examiner has not made out a prima facie case of anticipation as to claims 1-5, 7-10, 12, 13, and 16-19.

While we reverse the rejection under 35 U.S.C. § 102, the Examiner may wish to consider whether claim 1 in particular would have been obvious over the cited references to one of ordinary skill in the art given that there is no dispute that Cesta shows communicating with/negotiating between scheduling agents and in view of the fact that communicating with a processor function embedded with a resource (e.g., a hotel computer) corresponding to a list of desired resources for facilitating a meeting was well known in the art at the time the application was filed. “The combination of familiar elements according to known methods is likely

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to be obvious when it does no more than yield predictable results.” *KSR*, 127 S.Ct. at 1739, 82 USPQ2d at 1395. In that regard, the record does not include objective evidence of unexpected results.

We further note that Cesta discloses a Travel Agent booking service which searches databases (Cesta, p. 113, para. 46). This may evidence the fact that communicating with a processor function embedded with a resource (e.g., a hotel computer) corresponding to a list of desired resources for facilitating a meeting was well known in the art at the time the application was filed. Reading this disclosure, one of ordinary skill in the art would foresee only two options: the database is on-site or off-site. Given this, it would have been obvious to one with ordinary skill in the art to choose to communicate with an on-site database and, thus, with a processor function embedded with a resource corresponding to the list of desired resources for facilitating the meeting.

When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.

*Id.* at 1742, 82 USPQ2d at 1397.

**B. Rejection of claims 6, 14, and 15 under 35 U.S.C. § 103(a) as unpatentable over Cesta in view of Applicants’ admitted prior art.**

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Appellants argue the patentability of claims 6, 14, and 15 on the bases of their dependency from independent claim 1 or 12 and the fact that Applicants' admitted prior art does not remedy the deficiencies of Cesta asserted by Appellants in connection with the above Section 102 rejection. Because Cesta does not teach a processor function embedded with a resource (Finding of Fact 5) and Appellants do not admit such a structure to be prior art, the Examiner has not made out a prima facie case of obviousness as to claims 6, 14, and 15.

**C. Rejection of claims 11, 20-23, and 25-27 under 35 U.S.C. § 103(a) as unpatentable over Cesta in view of RFC 2739.**

Appellants argue the patentability of claims 11 and 20 on the bases of their dependency from independent claim 1 and 12, respectively, and the fact that RFC 2739 does not remedy the deficiencies of Cesta asserted by Appellants in connection with the above Section 102 rejection. Because neither Cesta nor RC 2739 teach a processor function embedded with a resource (Findings of Fact 5-6), the Examiner has not made out a prima facie case of obviousness as to claims 11 and 20.

With respect to claim 21, Appellants argue that “[n]othing in Cesta, et al or RFC 2739 taken alone or together shows or suggests a controller embedded with a resource as specifically recited by claim 21.” (Br. 15). The Examiner found that Cesta discloses a controller embedded with the resource (Answer 9). The Examiner decided that “[u]ntil the claims are specifically amended to define ‘embedded’ as being location specific, Appellant’s [sic, Appellants’] argued

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interpretation of an embedded processor function will not be read into the claimed invention.” (Answer 16). Based on the claims construction discussed above in connection with the Section 102 rejection, neither Cesta nor RC 2739 teach a controller embedded with a resource (Findings of Fact 5-6), and the Examiner has not made out a prima facie case of obviousness as to claim 21 and its dependent claims 22-23 and 25-27.

**D. Rejection of claim 24 under 35 U.S.C. § 103(a) as unpatentable over Cesta in view of RFC 2739 and further in view of Applicants’ admitted prior art.**

Appellants argue the patentability of claim 24 on the bases of its dependency from independent claim 21 and the fact that Applicants’ admitted prior art does not remedy the deficiencies of the combination of Cesta and RFC 2739 asserted by Appellants in connection with the above Section 103(a) rejection of claim 21. Because neither Cesta nor RC 2739 teach a controller embedded with a resource (Findings of Fact 4-5) and Appellants do not admit such a structure to be prior art, the Examiner has not made out a prima facie case of obviousness as to claim 24.

**CONCLUSIONS**

We conclude that Appellants have shown that the Examiner erred in rejecting claims 1-5, 7-10, 12, 13, and 16-19 under 35 U.S.C. § 102(b) and claims 6, 11, 14-15, and 20-27 under 35 U.S.C. § 103(a).

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DECISION

The decision of the Examiner to reject claims 1-5, 7-10, 12, 13, and 16-19 under 35 U.S.C. § 102(b) and claims 6, 11, 14-15, and 20-27 under 35 U.S.C. § 103(a) is reversed.

REVERSED

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