

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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JOAN C. TENG and THOMAS B. REMAHL

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Appeal 2007-0954  
Application 09/999,074<sup>1</sup>  
Technology Center 2100

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Decided: May 10, 2007

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Before JAMES D. THOMAS, LEE E. BARRETT, and JOHN A. JEFFERY,  
*Administrative Patent Judges.*

JEFFERY, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 1-63. We have jurisdiction under 35 U.S.C. § 6(b).

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<sup>1</sup> This application claims benefit of the following U.S. Provisional Applications: (1) 60/258,087 filed Dec. 22, 2000, and (2) 60/285,524 filed Apr. 20, 2001.

## STATEMENT OF THE CASE

Appellants invented an identity system that uses workflows to manage identity profiles (i.e., information associated with particular entities, such as users, groups, organizations, etc.) (Specification 10: 31-32). Specifically, a first workflow can invoke one or more nested subflows. Such a process reduces administrative costs of creating and maintaining workflows. Additionally, the technique allows workflows to implement processes requiring multiple applications.<sup>2</sup> Claim 1 is illustrative:

1. In an identity system, a method for using workflows to manage an identity profile, comprising the steps of:

a computer performing a first workflow, said first workflow performs a first task on an identity profile; and

starting a second workflow as a subflow of said first workflow, said second workflow performs a second task.

The Examiner relies on the following prior art references to show unpatentability:

Berg	US 5,999,911	Dec. 7, 1991
Hsu	US 5,581,691	Dec. 3, 1996
Flores	US 5,734,837	Mar. 31, 1998
Diener	US 2002/0013777 A1	Jan. 31, 2002 (filed Mar. 16, 2001) <sup>3</sup>
Guheen	US 6,519,571 B1	Feb. 11, 2003 (filed May 27, 1999)

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<sup>2</sup> See generally Specification Page 2, line 28 – Page 3, line 25.

<sup>3</sup> This published application is based on Provisional Application No. 60/189,988, filed Mar. 17, 2000.

Alcorn	US 2004/0153509 A1	Aug. 5, 2004 (filed Aug. 19, 2003) <sup>4</sup>
Ahluwalia	US 6,728,685 B1	Apr. 27, 2004 (filed Apr. 5, 2000)

The Examiner's rejections are as follows:

1. Claims 1-3, 5, 7-15, 17-20, 24, 26-28, 38, 39, 41, 43-46, 48, 49, 53, 54, and 58-60<sup>5</sup> are rejected under 35 U.S.C. § 103(a) as unpatentable over Berg in view of Guheen.
2. Claims 4, 21, 22, 40, 47, 52, 55, and 56 are rejected under 35 U.S.C. § 103(a) as unpatentable over Berg in view of Guheen and further in view of Flores.
3. Claim 23 is rejected under 35 U.S.C. § 103(a) as unpatentable over Berg in view of Guheen, Flores, and further in view of Diener.
4. Claim 29 is rejected under 35 U.S.C. § 103(a) as unpatentable over Berg in view of Guheen and further in view of Alcorn.
5. Claims 6, 16, 25, 30-32, 34, 36, 37, 42, 50, 51, 61, and 62 are rejected under 35 U.S.C. § 103(a) as unpatentable over Berg in view of Guheen and further in view of Hsu.

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<sup>4</sup> This published application is a continuation-in-part of Application No. 09/608,208 filed Jun. 30, 2000.

<sup>5</sup> Although the Examiner omitted claim 59 in the statement of the rejection on Page 3 of the Answer, claim 59 was nevertheless included in the discussion of the rejection. *See* Answer 6; *see also* Br. 2 (indicating that claims 1-63 stand rejected). We therefore presume that the Examiner's omission of claim 59 in the grouping on Page 3 of the Answer was an inadvertent typographical error and the Examiner intended to include claim 59 in this rejection statement.

6. Claims 33 and 35 are rejected under 35 U.S.C. § 103(a) as unpatentable over Berg in view of Guheen, Hsu, and further in view of Ahuwalia.
7. Claim 57 is rejected under 35 U.S.C. § 103(a) as unpatentable over Berg in view of Guheen, Flores, and further in view of Hsu.
8. Claim 63 is rejected under 35 U.S.C. § 103(a) as unpatentable over Berg in view of Guheen, Hsu, and further in view of Flores.

Rather than repeat the arguments of Appellants or the Examiner, we refer to the Briefs and the Answer for their respective details. In this decision, we have considered only those arguments actually made by Appellants. 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).

#### OPINION

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention set forth in the claims on appeal. Accordingly, we affirm.

We first consider the Examiner's rejection of claims 1-3, 5, 7-15, 17-20, 24, 26-28, 38, 39, 41, 43-46, 48, 49, 53, 54, and 58-60 under 35 U.S.C. § 103(a) as unpatentable over Berg in view of Guheen. 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 must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). If that burden is met, the burden then shifts to the Appellants to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to the independent claims, the Examiner's rejection essentially finds that Berg teaches a computer that performs a first workflow as claimed including performing a task on an "identity profile." Under one interpretation of "identity profile," the Examiner contends that the limitation corresponds to Berg's behavioral description of a circuit design under Appellants' definition of the term "identity profile."

The Examiner adds that even under an alternative interpretation of "identity profile" (i.e., corresponding to a "user profile"), Guheen teaches notifying administrators and knowledge managers to maintain profiles including adding new users, changing user IDs, re-establishing user passwords, etc. Under this alternate interpretation, the Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Guheen's teaching into Berg's workflow to handle administration tasks so that user profiles could be managed in a workflow environment (Answer 3-7).

Regarding the independent claims,<sup>6</sup> Appellants argue that the prior art does not teach or suggest performing a first workflow, the first workflow

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<sup>6</sup> Although Appellants provide separate arguments in connection with each independent claim (Br. 13-15), the arguments are all directed to

performs a task on an identity profile as claimed (Br. 8, 13-15). Appellants argue that although Berg discloses workflows for automated computer-aided design, the reference fails to suggest that Berg's workflows may be used to manage an identity profile (Br. 8).

Appellants further contend that Guheen customizes web interfaces based on known qualities of web customers, but the reference is not directed to user or group administration (Br. 9). Appellants argue that although Guheen teaches that administrators or knowledge managers perform administrative tasks as the Examiner indicates, Guheen does not teach or suggest any software program or tool for performing such duties. Appellants add that Guheen fails to disclose an identity profile or that administrative tasks might be performed as part of managing an identity profile (Br. 10; Reply Br. 3-4).

Appellants also argue that there is no motivation to combine Berg with Guheen. According to Appellants, Guheen does not disclose any technological means to perform user management, and Berg fails to disclose any user management whatsoever (Br. 11-12).

The Examiner responds that Berg compiles a behavioral description of a circuit design. According to the Examiner, an "identity profile" can be any information associated with a particular circuit design; therefore, Berg's workflow is used to manage an identity profile as claimed (Answer 16).

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commensurate limitations, namely performing a first workflow that performs a first task (or operates) on an identity profile. In essence, Appellants have not presented arguments for separate patentability for each respective independent claim. *See* 37 C.F.R. § 41.37(c)(1)(vii). Accordingly, we select claim 1 as representative of all independent claims.

The Examiner further contends that Guheen provides various tools for, among other things, administering distributed systems and managing user accounts (Answer 17).

We will sustain the Examiner's rejection of representative claim 1. At the outset, we find the Examiner's interpretation of "identity profile" as corresponding to the behavioral description of a circuit design problematic essentially for the reasons noted by Appellants.<sup>7</sup> Nevertheless, we find that Berg amply discloses not only this limitation, but all other limitations of claim 1 giving the terms their broadest reasonable interpretation.

Berg discloses a workflow management system that includes a workflow manager 70 that utilizes a flow management engine 84 (Berg, col. 6, ll. 38-51; Fig. 3). The flow management engine maintains a workflow instance database that stores information about an instance of a workflow. Significantly, the flow management engine keeps track of, among other things, the *identification of a user* (e.g., the user's login name) executing each particular step in a flow. The flow management engine also maintains, among other things, the identification of the user who opened the workflow (Berg, col. 7, ll. 1-25).

Berg's tracking and maintenance of user identifications associated with respective workflow instances fully meets the limitations calling for managing an identity profile and the workflow performing a first task on an identity profile as claimed. When a user executes any given workflow, a "first task" is certainly performed on the "identity profile" maintained by the

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<sup>7</sup> According to Appellants' Specification, an "identity profile" is "a set of information associated with a particular entity (e.g., user, group, organization, etc.)." (Specification 10: 31-32).

flow management engine. Moreover, Berg discloses that a workflow may contain one or more subflows whose user inputs are likewise sent to the flow management engine for processing (Berg, col. 7, ll. 45-52).

In short, Berg actually anticipates representative claim 1. Nevertheless, obviousness rejections can be based on references that happen to anticipate the claimed subject matter. *In re Meyer*, 599 F.2d 1026, 1031, 202 USPQ 175, 179 (CCPA 1979). Furthermore, although we sustain the Examiner's obviousness rejection based on the teachings of Berg alone, we may rely on fewer references than the Examiner in affirming a multiple-reference rejection under 35 U.S.C. § 103. *In re Bush*, 296 F.2d 491, 496, 131 USPQ 263, 266-67 (CCPA 1961); *In re Boyer*, 363 F.2d 455, 458 n.2, 150 USPQ 441, 444 n.2 (CCPA 1966).

Even though we find the teachings of Guheen are merely cumulative to those of Berg for the reasons noted above, we nonetheless find that Guheen also anticipates representative claim 1. Even if we assume, without deciding, that the specific passages in Guheen relied upon by the Examiner fail to teach or suggest software or tools to execute the various administrative tasks performed by administrators or knowledge managers, the reference is nonetheless replete with teachings of using workflows to manage identity profiles.

Indeed, user profile management is touted as a key feature in one embodiment of Guheen. *See* Guheen, column 210, line 32 – column 211, line 7; Figs. 79-81. In that embodiment, user interfaces are customized based on users' profiles – personalized profiles that fully meet “identity profiles” as claimed.

To this end, users' profiles are first developed (Guheen, Fig. 80, Step 2310). Fig. 81 of Guheen details the method employed to create these user profiles. Specifically, a variety of user information is collected and placed in a database (Guheen, Fig. 81, Steps 2320-21). In our view, these database entry functions alone fully meet a workflow performing a first task on an identity profile as claimed. Next, users' buying patterns are estimated for a particular item each time the user uses the system. Users' current activities are then logged and entered into the database (Guheen, Fig. 81, Steps 2322-23). These steps, in our view, reasonably constitute a second subflow of the first workflow that performs a second task as claimed.

After the user profile is developed, the system then displays an item for purchase with a set of features based on the user profile, the presentation of which is customized based on the user profile. Moreover, web content can be matched to specific user profiles (Guheen, col. 210, l. 32 – col. 211, l. 46; Figs. 79-81).

In short, at least this embodiment in Guheen anticipates representative claim 1.<sup>8</sup> Accordingly, we will also sustain the Examiner's rejection of this claim solely on the teachings of Guheen. We reach this conclusion reiterating that obviousness rejections can be based on references that happen to anticipate the claimed subject matter. *Meyer*, 599 F.2d at 1031, 202 USPQ at 179. Moreover, we may rely on fewer references than the Examiner in affirming a multiple-reference rejection under 35 U.S.C. § 103.

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<sup>8</sup> We note that this example is merely exemplary of Guheen's use of identity profiles. In fact, Guheen discloses other embodiments that automatically customize user interfaces based on user profiles. *See, e.g.*, Figs. 68 and 76-78 and accompanying text.

*Bush*, 296 F.2d at 496, 131 USPQ at 266-67; *Boyer*, 363 F.2d at 458 n.2, 150 USPQ at 444 n.2.

Notwithstanding our conclusion that Berg and Guheen considered separately each independently anticipate representative claim 1, we nevertheless find that the skilled artisan would have had ample reason on this record to combine the teachings of Guheen with Berg.

To determine whether an adequate reason exists to combine known elements, we consider (1) interrelated teachings of multiple patents; (2) the effects of demands known to the design community or present in the marketplace; and (3) the background knowledge possessed by a person having ordinary skill in the art. We need not, however, “seek out precise teachings directed to the specific [claimed] subject matter” as we can account for “the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, No. 04-1350, slip op. at 14 (U.S., Apr. 30, 2007).

Contrary to Appellants' argument,<sup>9</sup> Guheen in fact discloses technological means to perform user management (e.g., developing user profiles via a database and customizing interfaces based on specific user profiles) as we discussed previously.<sup>10</sup> Moreover, Berg’s flow management engine tracks each user’s identification (e.g., the user’s login name) for each particular step in a flow in a database.<sup>11</sup> Based on these collective teachings, as well as the inferences and creative steps that the skilled artisan – an electrical engineer with several years of related industry experience – would

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<sup>9</sup> See Br. 11.

<sup>10</sup> See P. 8-9, *supra*, of this opinion.

<sup>11</sup> See P. 7, *supra*, of this opinion.

reasonably employ, we see no reason why the skilled artisan would not have combined the user management features of Guheen with Berg's workflow management capability. Such a combination would provide, among other things, customized interfaces tailored to particular users in a workflow environment. For at least these reasons, the skilled artisan would have reasonably combined the respective teachings of the references.

For at least these reasons, we will sustain the Examiner's rejection of representative claim 1. Since Appellants have not separately argued the patentability of claims 2, 3, 5, 7-15, 17-20, 24, 26-28, 38, 39, 41, 43-46, 48, 49, 53, 54, and 58-60 with particularity, these claims fall with representative claim 1. *See In re Nielson*, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987); *see also* 37 C.F.R. § 41.37(c)(1)(vii).

With regard to the Examiner's respective rejections of (1) claims 4, 21, 22, 40, 47, 52, 55, and 56; (2) claim 23; (3) claim 29; (4) claims 6, 16, 25, 30-32, 34, 36, 37, 42, 50, 51, 61, and 62; (4) claims 33 and 35; (7) claim 57; and (8) claim 63 (Answer 7-16), we find that the Examiner has established at least a prima facie case of obviousness of those claims that Appellants have not persuasively rebutted. Specifically, the Examiner has (1) pointed out the teachings of the cited references, (2) noted the perceived differences between the references and the claimed invention, and (3) reasonably indicated how and why the references would have been modified to arrive at the claimed invention (Answer 7-16). Once the Examiner has satisfied the burden of presenting a prima facie case of obviousness, the burden then shifts to Appellants to present evidence or arguments that persuasively rebut the Examiner's prima facie case. Appellants, however, did not persuasively rebut the Examiner's prima facie case of obviousness,

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but merely noted that the addition of the other cited references fails to cure the deficiencies of Berg and Guheen in connection with the independent claims (Br. 12). The rejection is therefore sustained.

#### DECISION

We have sustained the Examiner's rejections with respect to all claims on appeal. Therefore, the Examiner's decision rejecting claims 1-63 is affirmed.

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

AFFIRMED

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TOWNSEND AND TOWNSEND AND CREW, L.L.P.  
TWO EMBARCADERO CENTER  
8TH FLOOR  
SAN FRANCISCO, CA 94111-3834