

The opinion in support of the decision being entered today 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* RAMAKRISHNAN RAJAMONY,  
and FREEMAN LEIGH RAWSON III

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Appeal 2007-1268  
Application 10/177,845<sup>1</sup>  
Technology Center 2100

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Decided: July 13, 2007

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Before ALLEN R. MACDONALD, JAY P. LUCAS, and  
SCOTT R. BOALICK, *Administrative Patent Judges*.

BOALICK, *Administrative Patent Judge*.

#### DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-21, all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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<sup>1</sup> Application filed June 20, 2002. The real party in interest is International Business Machines Corporation.

## STATEMENT OF THE CASE

Appellants' invention relates to the collaborative manipulation of a document from remote locations using an application such as a Web browser. In the words of the Appellants:

Generally speaking the present invention contemplates a system and method that enable two or more users at remote locations to work collaboratively using only a ubiquitous application such as a conventional web browser. An image of a document such as a web page is provided to both users by their respective applications. Events that occur on one of the applications are then mirrored or replicated on the other. In this manner, the users can cooperatively work on a networked document.

(Specification 3:8-13.)

Claim 1 is exemplary:

1. A method of document collaboration in a networked data processing system, comprising:
  - transferring a first event code sequence from a server to a first client system responsive to a first ubiquitous application on the first client system accessing a first page on the server wherein the first event code sequence is configured to monitor events occurring in a second window launched by the first ubiquitous application;
  - transferring a second event code sequence to a second client system responsive to a second ubiquitous application on the second client system accessing a second page on the server;
  - responsive to the first event code sequence detecting a first application event occurring in the

second window, communicating information indicative of the event to the server;  
forwarding information indicative of the first application event from the sever to the second application; and  
replicating the first application event on the second client system with the second event code sequence.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Ohkado	US 2001/0016873 A1	Aug. 23, 2001 (Filed February 15, 2001)
Elliott	US 6,690,654 B2	Feb. 10, 2004

Claims 1-21 stand rejected under 35 U.S.C. § 103(a) as being obvious over Ohkado and Elliot.

Rather than repeat the arguments of Appellants or 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).<sup>2</sup>

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<sup>2</sup> Except as will be noted in this opinion, Appellants have not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See* 37 C.F.R. § 41.37(c)(1)(vii).

## ISSUE

The only issue before us is whether Appellants have shown that Ohkado is disqualified as a reference by 35 U.S.C. § 103(c) and therefore the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a).

## FINDINGS OF FACT

1. In a non-final office action mailed October 19, 2005 ("Non-Final Office Action"), the Examiner rejected claims 1-21 under 35 U.S.C. § 102(e) as anticipated by Ohkado. (Non-Final Office Action 3-5.) The Non-Final Office Action did not reject the claims under 35 U.S.C. § 102(a) or otherwise mention 35 U.S.C. § 102(a), even though Ohkado also qualifies as a § 102(a) reference because it has a publication date of August 23, 2001. (Non-Final Office Action *passim*.)
2. In a response to the Non-Final Office Action filed February 20, 2006, ("Response to Non-Final Office Action"), Appellants amended all of the independent claims (claims 1, 9, and 17) and argued that Ohkado did not anticipate the claims as amended. (Response to Non-Final Office Action 3-5, 7-9.)
3. In a Final Office Action mailed May 17, 2006 ("Final Office Action"), the Examiner entered a new ground of rejection. Specifically, the Examiner rejected claims 1-21 under 35 U.S.C. § 103(a) as being obvious over Ohkado and Elliot. (Final Office Action 2-5.)

4. In a response under 37 C.F.R. § 1.116 filed June 27, 2006 ("Section 116 Amendment"), Appellants provided a summary of a telephone interview with the Examiner that had been conducted on June 23, 2006 and argued that Ohkado was disqualified as a reference by 35 U.S.C. § 103(c). (Section 116 Amendment 2.) Appellants filed a declaration under 37 C.F.R. § 1.132 ("Section 132 Declaration") with the Section 116 Amendment.
5. The Section 132 Declaration recited that: (1) Ohkado had been asserted as prior art under 35 U.S.C. § 102(e) in the Non-Final Office Action; (2) Ohkado was assigned to International Business Machines, the assignee of the present application; (3) the inventive entity of Ohkado is distinct from the present inventive entity; and (4) the present application was filed after the critical deadline of November 29, 1999. (Section 132 Declaration 1-2.) Therefore, the Section 132 Declaration asserted that Ohkado was disqualified as a reference under 35 U.S.C. § 103(a) by 35 U.S.C. § 103(c). (Section 132 Declaration 2.)
6. The Section 132 Declaration did not address the qualification of Ohkado as prior art under 35 U.S.C. § 102(a). (Section 132 Declaration *passim*.)
7. In an advisory action mailed July 20, 2006 ("Advisory Action"), the Examiner refused to enter the Section 116 Amendment. The Advisory Action stated that the application was not in condition for

allowance because "[t]he Applicant failed to show a good and sufficient reason why the [Section 132] affidavit was not presented earlier in prosecution (i.e. prior to the final rejection)." (Advisory Action 2.)

8. The Advisory Action also stated that:

in regard to the telephone conversation dated June 23rd, 2006, the Examiner would like to clarify that it was only stated that the prior art might not qualify under 35 U.S.C. 103(a). Confirmation of the validity of the 35 U.S.C. 103(a) rejection would be reviewed through an official office action upon an appropriate submission of an affidavit under 37 C.F.R. 1.132. Examiner would also like to note that Applicant is responsible for complying with section 706 of the MPEP.

(Advisory Action 2.)

9. On July 26, 2006, Appellants filed the instant appeal.
10. In the Appeal Brief filed August 10, 2006 ("Brief"), Appellants submitted for the first time a single page of an invention disclosure in the Evidence Appendix of the Brief. (Brief 13.)
11. In the Examiner's answer mailed November 1, 2006 ("Answer"), the Examiner clarified the statement in the Advisory Action regarding the timeliness of the Section 132 Declaration and further explained why

the Section 132 Declaration failed to place the application in condition for allowance. (Answer 7-8.)

12. In the Answer, the Examiner also considered the new evidence submitted in the Evidence Appendix of the Brief, treating it as a declaration of prior invention under 37 C.F.R. § 1.131. (Answer 8-10.) The Examiner found the new evidence ineffective to disqualify Ohkado as a reference under 35 U.S.C. § 102(a). (Answer 10.)

#### PRINCIPLES OF LAW

The Board must necessarily weigh all of the evidence and argument in reviewing the Examiner's decision on appeal. *See In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

The Examiner bears the initial burden of showing a prima facie case of unpatentability. *In re Piasecki*, 745 F.2d at 1472, 223 USPQ at 788. When that burden is met, the burden then shifts to the applicant to rebut. *Id.*; *see also In re Harris*, 409 F.3d 1339, 1343-44, 74 USPQ2d 1951, 1954 (Fed. Cir. 2005) (finding rebuttal evidence unpersuasive). If the applicant produces rebuttal evidence of adequate weight, the prima facie case of unpatentability is dissipated. *In re Piasecki*, 745 F.2d at 1472, 223 USPQ at 788. Thereafter, patentability is determined in view of the entire record. *Id.*

"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,

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1734, 82 USPQ2d 1385, 1391 (2007). "If a court, or patent examiner, conducts this analysis and concludes the claimed subject matter was obvious, the claim is invalid under § 103." *Id.* at 1734, 82 USPQ2d at 1391.

Certain subject matter is disqualified from precluding patentability under § 103. 35 U.S.C. § 103(c). In particular, § 103(c) provides that:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

35 U.S.C. § 103(c)(1).

#### ANALYSIS

Appellants contend that Examiner erred in rejecting claims 1-21 under 35 U.S.C. § 103(a). Reviewing the findings of facts cited above, we do not agree. In particular, we find that the Examiner made a prima facie showing of obviousness with respect to claims 1-21 and Appellants failed to meet the burden of overcoming that prima facie showing.

Appellants have not argued the merits of the rejection. Instead, Appellants' sole argument is that Ohkado is not a proper reference and therefore it cannot be used to render obvious the claimed subject matter. Specifically, Appellants argue that Ohkado is disqualified as reference under 35 U.S.C. § 103(a) by 35 U.S.C. § 103(c) because Ohkado is prior art under 35 U.S.C. § 102(e), was invented by a different inventive entity than the

present application, and is owned by the same entity as the present application. (Brief 4-5.)

We agree with the Examiner that Ohkado is not disqualified by 35 U.S.C. § 103(c) because it qualifies as prior art under 35 U.S.C. § 102(a). (Answer 7.) As the Examiner correctly points out, 35 U.S.C. § 103(c) only disqualifies a reference "which qualifies as prior art **only under one or more of subsections (e), (f), and (g)** of section 102 of this title." (Answer 7 (quoting 35 U.S.C. § 103(c) with emphasis added).) There is no dispute that Ohkado qualifies as prior art under 35 U.S.C. § 102(e). But Ohkado also qualifies as prior art under § 102(a) because it was published on August 23, 2001, which is before the June 20, 2002 filing date of the present application. As discussed below, Appellants have not made a sufficient showing to disqualify Ohkado as a § 102(a) reference. Therefore, Ohkado is not disqualified as a reference by 35 U.S.C. § 103(c) because it qualifies as prior art under both § 102(a) and § 102(e).

Appellants contend that the Examiner improperly based the refusal to remove Ohkado as a reference on the rationale that Appellants failed to show a good and sufficient reason why the Section 132 Declaration was not presented prior to the Final Office Action. (Brief 5-6.) Initially, we observe that the "[r]eview of an examiner's refusal to enter an affidavit as untimely is by petition and not by appeal to the Board of Patent Appeals and Interferences." *In re Deters*, 515 F.2d 1152, 1156, 185 USPQ 644, 648 (CCPA 1975); *see also* MPEP § 1002.02(c) (petitions relating to formal sufficiency and propriety of affidavits under 37 C.F.R. § 1.132 are decided by Technology Center Directors); MPEP § 1201 ("The line of demarcation between appealable matters for the Board of Patent Appeals and

Interferences (Board) and petitionable matters for the Director of the U.S. Patent and Trademark Office (Director) should be carefully observed.").

We agree with Appellants that the Examiner was incorrect to state in the Advisory Action that the Section 132 Declaration was untimely submitted. The new ground of rejection under 35 U.S.C. § 103(a) was first presented in the Final Office Action, and therefore the first opportunity for Appellants to submit the Section 132 Declaration was in the Section 116 Amendment. This error, however, is harmless. Appellants did not petition to have the Examiner's decision reversed. Furthermore, the Examiner actually considered the merits of the Section 132 Declaration. In particular, the Examiner addressed the merits of the Section 132 Declaration somewhat obliquely in the Advisory Action (*see* Finding of Fact 8) and more directly in the Answer (*see* Finding of Fact 11). We agree with the Examiner that the Rule 132 Declaration was not effective to disqualify Ohkado as a reference under 35 U.S.C. § 103(c) because it did not remove Ohkado as prior art under 35 U.S.C. § 102(a).

Appellants argue that Ohkado is not eligible as a reference under 35 U.S.C. § 102(a). (Brief 6-7.) In an apparent attempt to prove earlier invention, Appellants submitted for the first time on appeal a single page of an invention disclosure in the Evidence Appendix of the Brief. (Brief 7, 13; Finding of Fact 10.) This evidentiary submission was untimely. 37 C.F.R. § 41.33(d)(2) ("All other affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1)."). However, the issue of untimeliness has been rendered moot because the Examiner considered the new evidence in the Answer and

correctly found that it was not sufficient to remove *Ohkado* as prior art under 35 U.S.C. § 102(a) (Finding of Fact 12).

Appellants also complain that:

The Examiner has now recharacterized *Ohkado* as prior art under 35 U.S.C. § 102(a) on pages 6-7 in Examiner's Answer. As noted above, *Ohkado* was originally cited as prior art under 35 U.S.C. § 102(e). Once Examiner rejected Claims 1-21 under 35 U.S.C. § 103(a), Appellants relied on the original citation of *Ohkado* as prior art under 35 U.S.C. § 102(e) to disqualify *Ohkado* under 35 U.S.C. § 103(c). Now on Appeal, Examiner is backtracking on his original position and characterizing *Ohkado* as prior art under 35 U.S.C. § 102(a). Had Examiner cited *Ohkado* as prior art under 35 U.S.C. § 102(a) in the original Office Action dated October 19, 2005, Appellants would have submitted ample evidence to swear back of *Ohkado*. It is difficult for Appellants to predict what Examiner will decide next about *Ohkado*, and Appellants therefore submit that *Ohkado* should be considered an ineligible reference due to Appellants reliance on Examiner's original characterization of *Ohkado* as prior art under 35 U.S.C. § 102(e) and Appellants' timely submission of a declaration meeting the requirements of 37 CFR § 1.132.

(Reply Brief 3.)

We find this argument somewhat disturbing. Although the Examiner based the anticipation rejection in the Non-Final Office Action solely upon § 102(e) rather than upon both § 102(a) and § 102(e) (Finding of Fact 1),<sup>3</sup> the error -- if any -- is harmless. Appellants distinguished Ohkado as a § 102 reference by amending the independent claims in the Response to Non-Final Office Action.<sup>4</sup> Upon receiving the new ground of rejection under 35 U.S.C. § 103(a) in the Final Office Action (Finding of Fact 3), we believe that Appellants should not only have recognized that Ohkado qualifies as prior art under 35 U.S.C. § 102(e), but also should have recognized that Ohkado qualifies as prior art under 35 U.S.C. § 102(a) because the publication date of August 23, 2001 -- which is prior to the filing date of the present application -- appears on the face of Ohkado.

In order to disqualify Ohkado as a reference, Appellants have the burden to prove that Ohkado is not prior art under § 102(a).<sup>5</sup> It is simply not reasonable for Appellants to rely on a prior ground of rejection that only applied Ohkado as an anticipating reference under § 102(e) as a reason not to address the qualification of Ohkado as prior art under § 102(a) when attempting to disqualify it as a reference in connection with a new ground of rejection under § 103(a).

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<sup>3</sup> See MPEP § 706.02(a) ("Even if the reference is prior art under 35 U.S.C. 102(e), the examiner should still consider 35 U.S.C. 102(a).").

<sup>4</sup> Appellants could not have overcome Ohkado as an anticipating reference by affidavit alone because Ohkado's filing date of February 15, 2001 is more than one year prior to the June 20, 2002 filing date of the present application.

<sup>5</sup> See MPEP § 706.02(b) ("A rejection based on 35 U.S.C. 102(a) can be overcome by: . . . (C) Filing an affidavit or declaration under 37 CFR 1.131 showing prior invention.")

Although it may be possible for Ohkado to be disqualified as prior art by 35 U.S.C. § 103(c) under the circumstances explained in MPEP §§ 706.02(1)(1)-(1)(3), such circumstances do not exist in the application presently before us on appeal. Therefore, Ohkado is available as prior art with respect to the subject matter defined by the claims of the present application.

In sum, Appellants have failed to meet the burden of overcoming the prima facie showing of obviousness. Therefore, we affirm the rejection of claims 1-21.

#### CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1-21. The rejection of those claims is affirmed.

#### DECISION

The rejection of claims 1-21 is affirmed.

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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

pgc

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