UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RENE L. CAMPBELL, KENT H. JONES, IAN M. GAFFNER, JOHN P. O'REILLY, RAPHAEL D. MCABEE-REHER, DEAN D. RAU, MORTEN S. JENSEN, and RICHARD L. MAURO

Appeal 2007-3698
Application 10/162,836
Technology Center 2100

Decided: November 29, 2007

Before KENNETH W. HAIRSTON, LANCE LEONARD BARRY, and ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-69. We have jurisdiction under 35 U.S.C. § 6(b). An oral hearing on this appeal was conducted on November 14, 2007. We AFFIRM.

THE INVENTION

The disclosed invention relates generally to device usage reporting systems, and more particularly, to systems for reporting usage of devices coupled to a computer network (Spec. 1). Appellants' invention comprises a data extractor for extracting data resource communication activity data from a plurality of network activity data sources, a database of organizational data resource ownership data, and a communication activity report generator for correlating extracted data resource communication activity data and organizational data resource ownership data so that ownership of communication activity may be tracked (Spec. 3).

Independent claim 1 is illustrative:

1. A system for tracking ownership of network activity of data resources comprising:

   a data extractor for extracting data resource communication activity data from a plurality of different kinds of network activity data sources including at least two of a router, mail server, web server, firewall/proxy server, private branch exchange (PBX), softswitch, media gateway, SS7 signaling point, integrated access device, and calling card import, the data extractor including a reformatting module for converting network activity data into data resource communication activity data;

   a database of organizational data resource ownership data; and

   a communication activity report generator for correlating extracted data resource communication activity data and

organizational data resources ownership data so that ownership of communication activity may be tracked.

THE REFERENCES

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

Morrison	US 5,623,540	Apr. 22, 1997
Szlam	US 6,359,892 B1	Mar. 19, 2002

THE REJECTION

Claims 1-69 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Morrison in view of Szlam.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Brief and the Answer for the respective details thereof.

PRINCIPLES OF LAW

"What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under *§ 103*." *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be "more than the predictable use of prior art elements according to their established functions." *Id.* at 1740. Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case

with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). Therefore, we look to Appellants' Brief to show error in the proffered prima facie case.

ISSUE(S)

The issue is whether Appellants have shown the Examiner erred in holding that the cited combination of Morrison and Szlam would have rendered the claimed subject matter obvious to an artisan having ordinary skill and common sense at the time of the invention. More particularly, we have determined that the following issues are dispositive in this appeal:

Combinability under section 103

(1) Whether Appellants have shown the Examiner has failed to articulate an adequate reasoning with a rational underpinning to support the proffered combinability of Morrison and Szlam.[1]

[1] "[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Moreover, "'there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness' . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR*, 127 S. Ct. at 1741 (quoting *In re Kahn*, 441 F.3d at 988).

Elements under section 103

(2) Whether Appellants have shown the Examiner erred in finding that the combination of Morrison and Szlam teaches and/or suggests the argued limitations of extracting data resource communication activity from "a plurality *of different kinds of network activity data sources*" and also tracking "*ownership of communication activity"* (*See* App. Br. 10, ¶4; *see also* Independent claims 1, 10, and 21-69).

ANALYSIS

Combinability under section 103

We begin our analysis by deciding the threshold question of whether Appellants have shown the Examiner has failed to articulate an adequate reasoning with a rational underpinning to support the proffered combinability of Morrison and Szlam.

Appellants contend that "[o]ne skilled in the art would not be motivated to combine the PBX data retrieval system of Morrison with the remote control and access system of Szlam in an attempt to track ownership of communication activity described in Appellants' application, namely extracting communication activity data from different kinds of network activity data sources, and correlating that communication activity data with resource ownership data to track ownership of the communication activity." (App. Br. 10-11).

The Examiner disagrees. The Examiner contends it would have been obvious to a person of ordinary skill in the art to have used Morrison in a network that included different types of network sources (as taught by Szlam), because Morrison teaches a plurality of distributed and remotely located CBXs (i.e., computerized branch exchanges) (*See* Morrison, Fig. 2, col. 5, ll. 47-48, i.e., "wherein the second CBX 201*b* may be located at a different physical site from first CBX 201*a*."). The Examiner reasons that geographically distant CBXs (as taught by Morrison) would have provided a suggestion of different types of network data sources (as taught by Szlam). The Examiner contends it would have been obvious to an artisan to have modified Morrison with the teachings of Szlam in order to have facilitated remote user access of services and devices located at the user's office, corporate enterprise, or home (*See* Szlam col. 3, ll. 23 - 29) (Ans. 11).

In view of the Supreme Court's recent opinion in *KSR Int'l Co. v. Teleflex Inc.*, our analysis here does not turn upon whether the Examiner has provide an adequate teaching, suggestion, or motivation to combine the references. Instead, we view the question before us to be whether sufficient difference exists between the prior art and Appellants' claims to render the claims nonobvious. In *KSR*, the Supreme Court reaffirmed that "[w]hen a patent 'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement, the combination is obvious." *KSR*, 127 S. Ct. at 1740 (quoting *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282 (1976)).

Moreover, "[w]hen 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 . . . of ordinary skill and common sense." *KSR*, 127 S. Ct. at 1742.

This reasoning is applicable here. We note that PBXs (private branch exchanges) and CBXs (computerized branch exchanges) were well known in the art at the time of the invention, as evidenced by the teachings of both Morrison and Szlam (*See* Morrison, col. 1, ll. 19-39; s*ee* also Szlam, col. 2, l. 33, col. 8, l. 27). The Examiner has merely relied on Szlam for its teaching of *different kinds* of network activity data sources, such as a PBX system, (col. 8, l. 27), a router (*Id.*), a server (col. 8, ll. 26 and 60), and a gateway (col. 8, ll. 26 and 59). Our reviewing court has reaffirmed that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR*, 127 S. Ct. at 1739). Moreover, Appellants have not shown that the claimed combination of familiar elements produces a new function. Appellants have not provided any factual evidence of secondary considerations, such as unexpected or unpredictable results, commercial success, or long felt but unmet need. For at least the aforementioned reasons, we find Morrison and Szlam have complementary features that

would have reasonably led an artisan having ordinary skill and common sense to combine their teachings in the manner suggested by the Examiner.

Elements under section 103

Independent claim 1

We consider the Examiner's rejection of independent claim 1 as being unpatentable over the teachings of Morrison in view of Szlam.

Appellants argue that neither Morrison nor Szlam teaches or describes systems or methods for extracting data resource communication activity from a plurality of different kinds of network activity data (App. Br. 10). Appellants further argue that neither Morrison nor Szlam teaches anything about correlating extracted data resource communication activity data and organization data resources ownership data so that ownership of communication activity may be tracked (App. Br. 10).

The Examiner disagrees. The Examiner notes that Morrison expressly teaches: "[t]elephone calling information could then be automatically tracked based on departments, divisions, or other hierarchical groupings (col. 3, ll. 15-17). The Examiner further notes that each CBX is coupled to collection computer 214 (*See* Morrison, Fig. 2., col. 5, ll. 63-65). Thus, the Examiner finds Morrison teaches a plurality of network activity data sources (*See* Morrison, col. 5, ll. 40-59). The Examiner merely relies on Szlam for its teaching of *different kinds* of network activity data sources, such as a

PBX system, (col. 8, l. 27), a router (*Id.*), a server (col. 8, ll. 26 and 60), and a gateway (col. 8, ll. 26 and 59).

After considering the record before us, we find the weight of the evidence supports the Examiner's position. We agree with the Examiner that the language of the claim that requires tracking the ownership of communication activity is met by Morrison's teaching of tracking telephone calls within an organization (*See* Morrison, col. 3, ll. 15-17). We find Morrison's telephone calling information reasonably attributes ownership of communication activity to the employee associated with a particular telephone (*Id.*). Likewise, we agree with the Examiner that Szlam clearly teaches *different kinds* of network activity data sources, e.g., a PBX system, (col. 8, l. 27), a router (*Id.*), a server (col. 8, ll. 26 and 60), and a gateway (col. 8, ll. 26 and 59).

Therefore, Appellants have not shown the Examiner erred in finding that the combination of Morrison and Szlam teaches and/or suggests the claimed subject matter. After considering all of the evidence before us, we agree with the Examiner that the proffered combination of Morrison and Szlam reasonably teaches and/or suggests all that is claimed. Moreover, we have fully addressed the combinability of Morrison and Szlam *supra*. Accordingly, we sustain the Examiner's rejection of independent claim 1 as being unpatentable over Morrison in view of Szlam.

Independent claims 10 and 21-69

We note that each of independent claims 10 and 21-69 contains the same limitations Appellants previously argued with respect to independent claim 1. Therefore, we sustain the Examiner's rejection of these claims as being unpatentable over Morrison in view of Szlam for the same reasons discussed *supra* with respect to claim 1.

Dependent claims 2-9 and 11-20

Appellants have not presented any substantive arguments directed to the separate patentability of dependent claims 2-9 and 11-20. Therefore, we sustain the Examiner's rejection of these claims as being unpatentable over Morrison in view of Szlam for the same reasons discussed *supra* with respect to independent claims 1 and 10, respectively. *See In re Young,* 927 F.2d 588, 590 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii)(2006).

DECISION

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1-69 under 35 U.S.C. § 103(a) for obviousness. Therefore, the decision of the Examiner rejecting claims 1-69 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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