

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT P. ST. PIERRE and GLENN C. SCOTT

Appeal 2008-2011
Application 10/206,932
Technology Center 2400

Decided: December 29, 2008

Before LANCE LEONARD BARRY, JAY P. LUCAS,
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 1-20. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

THE INVENTION

The disclosed invention relates generally to software. More particularly, the present invention relates to dynamic routing of web procedure calls. (Spec. p. 1, ll. 11-12).

Independent claim 1 is illustrative:

1. In an electronic device interfaced with a network, wherein the network includes at least two servers providing a type of service, a method comprising the electronic device implemented steps of:

receiving a request for an abstract service, said request including a service symbol,

upon receiving a request, programmatically and dynamically resolving the service symbol to a service provider on a selected one of the servers; and

programmatically submitting a request to the service provider on the selected server.

THE REFERENCES

The Examiner relies upon the following references as evidence in support of the anticipation and obviousness rejections:

Goldszmidt	US 6,195,680 B1	Feb. 27, 2001 (filed Jul. 23, 1998)
Arnold	US 6,167,449	Dec. 26, 2000 (filed Nov. 19, 1997)

THE REJECTIONS

1. The Examiner rejected claims 1-8 and 20 under 35 U.S.C. § 102(b) as being anticipated by Arnold.
2. The Examiner rejected claims 9-19 under 35 U.S.C. § 103(a), as being unpatentable over Goldszmidt in view of Arnold.

“[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. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Therefore, we look to Appellants’ Briefs to show error in the proffered *prima facie* case.

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).

Anticipation under 35 U.S.C. § 102

We consider the Examiner’s rejection of claims 1-8 and 20 under 35 U.S.C. § 102(b) as being anticipated by Arnold. Since Appellants’ arguments have treated these claims as a single group which stand or fall together, we select claim 1 as the representative claim for this group. *See* 37 C.F.R. § 41.37(c)(1)(vii).

APPELLANTS' CONTENTIONS

1. Appellants contend that Arnold fails to teach the limitations of “programmatically and dynamically resolving the service symbol to a service provider on a selected one of the servers.” (App. Br. 6).
2. Appellants also contend that Arnold only partially resolves a request and requires a user to pick from the list before the actual request is submitted. Thus, Arnold fails to programmatically and dynamically resolve the request. (*Id.* 7).

ISSUE

Have Appellants shown the Examiner erred in determining that Arnold teaches “programmatically and dynamically” submitting a request to the service provider on a selected server,” and “programmatically submitting a request to the service provider on the selected server?”

FINDINGS OF FACTS

The following findings of facts (FF) are supported by a preponderance of the evidence:

Arnold

1. Arnold is directed to identifying and locating computer network services. (Abst., ll. 1-2).
2. Arnold teaches that the client application can browse for network services based on the type of service. (*Id.*, ll. 9-14).

3. Arnold teaches that in response to a request for a particular type of service, the application may display a list of services that support the request. (*See* Col. 7, l. 66 – Col. 7, l. 16).
4. Arnold teaches that the user may select a particular item from the list. (Col. 7 ll. 32-35).

Specification

5. The Specification teaches “dynamic discovery of service access points,” and “dynamic routing to find an alternate service when the originally requested service is unavailable.” (Spec. p. 4, ll. 7 – 9).
6. The Specification teaches that the “present invention may initiate the abstract service request programmatically without the participation of a user.” (Spec. p. 8. ll. 14-15) (underline added).

PRINCIPLES OF LAW

Anticipation under 35 U.S.C. § 102

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citation omitted).

ANALYSIS

As discussed above, Appellants contend that Arnold fails to teach the limitations of “programmatically and dynamically resolving the service symbol to a service provider on a selected one of the servers” and

“programmatically submitting a request to the service provider on the selected server.”

Claim Construction

“[T]he PTO gives claims their ‘broadest reasonable interpretation.’”
In re Bigio, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)).

At the outset, we note that the Specification states that the initiation of the abstract service request may be performed programmatically, i.e., without participation of the user. (FF. 6). However, the step of initiating an abstract service request is not recited in claim 1, nor will this limitation be read into claim 1. Further, the Specification indicates that user interaction is optional, i.e., “. . . may initiate” (FF 6). Otherwise, the term “programmatically” may be broadly interpreted to mean that the action takes place on a computer or with user participation, without express claim language that user interaction is precluded. Thus, we broadly but reasonably construe the “dynamically and programmatically” elements as not precluding user intervention.

Based on the above claim construction, it is our view that Arnold teaches programmatically and dynamically (via a computer) resolving the service symbol to a service on a selected one of the servers (FF 2-3). Further, Arnold teaches programmatically submitting a request to the service provider on the selected server (user selects a particular item from the list) (FF 4).

Appellants contend that Arnold requires the user to manually select a service provider, unlike claim 1. (Reply Br. 5). Based on the discussion above, we do not find this argument to be persuasive. We agree with the Examiner's assertion that claim 1 does not preclude user intervention. (Ans. 21, § B). Therefore, we will not read this limitation into the claim. We further note that the Examiner's assertion was not rebutted by Appellants.

Based on the record before us, we conclude that Appellants have not shown that the Examiner erred in determining that Arnold anticipates claim 1, and claims 2-8 and 20 which fall therewith. Accordingly, we sustain the Examiner's rejection of claims 1-8 and 20 as being anticipated under 35 U.S.C. § 102(b) by Arnold.

Obviousness under 35 U.S.C. § 103

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, “[w]hat 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.

Claims 9-16

We consider next the Examiner's rejection of claims 9-16 under 35 U.S.C. § 103(a) as being unpatentable over Goldszmidt in view of Arnold. Since Appellants' arguments have treated these claims as a single

group which stand or fall together, we select claim 9 as the representative claim for this group. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellants' Contentions

1. Appellants contend that Goldszmidt is directed to load balancing. (App. Br. 9)
2. Appellants contend that Goldszmidt teaches when a client detects a failure or overload, the client switches from the primary server to the pre-defined alternate secondary server. (*Id.*)
3. Appellants contend that neither Goldszmidt nor Arnold teaches the claimed element of dynamic identification of the alternate server. (*Id.*)

ISSUE

Have Appellants shown the Examiner erred in determining that the cited references teach “programmatically and dynamically identifying a second of the at least two servers that provides the type of service and submitting a second request for the type of service to the second of the servers?”

FINDINGS OF FACTS

The following FFs are supported by a preponderance of the evidence:

Goldszmidt

7. Goldszmidt teaches client-based switching of servers for load balancing. (See Abst. ll. 1-3).
8. Goldszmidt teaches that if the client automatically detects load imbalances, the client dynamically switches to a secondary server. (*Id.* ll. 11-17).

ANALYSIS

Appellants contend that Goldszmidt teaches when a failure or overload is detected, the client switches from the primary server to a secondary server. Appellants further contend that since the secondary server is already known, the secondary server is not “dynamically identified.” (App. Br. 9). We disagree.

As discussed above, Goldszmidt teaches that the client dynamically switches to a secondary server. (FF. 8). We see no indication that the Appellants have given the term “dynamic” any special meaning apart from the term’s common usage.

Further, we note that claim 9 does not recite that the second server is previously unknown, and we decline to read this limitation into the claim. Thus, it is our view that Goldszmidt teaches “dynamically identifying a second of the at least two servers,” as recited in claim 9. Regarding the limitation, “submitting a second request for the type of service to the second of the servers,” we note that Appellants did not make any substantive

arguments with regards to this limitation that we have not previously discussed *supra*.

Based on the record before us, we conclude that Appellants have not shown that the Examiner erred in determining that the cited references teach the limitation of “programmatically and dynamically identifying a second of the at least two servers . . .” as recited in claim 9. Accordingly, we sustain the Examiner’s rejection of claim 9 and claims 10-16 which fall therewith, as being unpatentable under 35 U.S.C. § 103(a) over Goldszmidt and Arnold.

Claims 17-19

We consider next the Examiner’s rejection of claims 17-19 as being unpatentable under 35 U.S.C. § 103(a) over Goldszmidt and Arnold. Appellants contend that the cited references fail to teach or suggest the limitation of “upon receiving the initial request, programmatically and dynamically resolving the service name to a selected one of the servers” and “programmatically submitting a submitted request for the type of service to the selected server,” as recited in claims 17 and 19. (App. Br. 9-10). The Findings of Facts regarding Goldszmidt and Arnold and the Principles of Law regarding § 103(a) discussed *supra* are applicable here.

ISSUE

Have the Appellants shown the Examiner erred in determining that Arnold teaches “programmatically and dynamically” “resolving the service

name to a selected one of the servers,” and “programmatically submitting a request for the type of service to the selected server?”

ANALYSIS

Appellants contend that neither Goldszmidt nor Arnold teaches the programmatic and dynamic resolution of an abstract service request to a single server and subsequent programmatic submitting of the resolved request to the selected server. (App. Br. 10). Appellants further contend that Goldszmidt is not directed to abstract service resolution.

We do not find this argument to be persuasive because, as discussed *supra* with regards to claim 1, we found that *Arnold* teaches this limitation, as well as the limitation of programmatically submitting a submitted request for the type of service to the selected server.

Appellants further contend that Arnold teaches away from the present claims by suggesting the desirability of displaying server names to the user for selection, rather than dynamically and programmatically resolving a service provided and submitting a request. (*Id.*).

We disagree. In addition to the discussion above, we find Arnold does not disavow the features of claims 17 and 19. “[T]he prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed . . .” *In re Fulton*, 391 F.3d 1195, 1201 (Fed Cir. 2004).

Here, Appellants have not shown that Arnold criticizes, discredits or otherwise discourages the limitations of claims 17 and 19. Thus, we do not find Appellants' arguments that Arnold teaches away from any improvements to be persuasive. Based on the record before us, we conclude that Appellants have not met their burden of showing error in the Examiner's prima facie case of obviousness. Accordingly, we sustain the Examiner's rejection of independent claim 17 (and claim 18 which falls therewith), and independent claim 19, as being unpatentable under 35 U.S.C. § 103(a) over Goldszmidt and Arnold.

CONCLUSIONS OF LAW

Based on the findings of facts and analysis above, we conclude the following:

Appellants have not shown that the Examiner erred in determining that Arnold teaches the claimed limitations "programmatically and dynamically" "submitting a request to the service provider on a selected server," and "programmatically submitting a request to the service provider on the selected server."

Appellants have not established that the Examiner erred in rejecting claims 1-8 and 20 as being anticipated by Arnold under 35 U.S.C. § 102(b).

Appellants have not shown that the Examiner erred in determining that the cited references teach "programmatically and dynamically identifying a second of the at least two servers that provides the type of

service and submitting a second request for the type of service to the second of the servers.”

Appellants have not established that the Examiner erred in rejecting claims 9-19 as being unpatentable over Goldszmidt in view of Arnold under 35 U.S.C. § 103(a).

Therefore, claims 1-20 are not patentable.

DECISION

The decision of the Examiner rejecting claims 1-8 and 20 under 35 U.S.C. § 102(b) is affirmed.

The decision of the Examiner rejecting claims 9-19 under 35 U.S.C. § 103(a) 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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