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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MANOJ GUJARATHI, CHARLES T. PERUSSE JR., JIMMY D. PIKE and DRUE REEVES

Appeal 2010-007098
Application 11/422,153
Technology Center 2100

Before JOHN A. JEFFERY, BRUCE R. WINSOR, and TRENTON A. WARD, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-20.[1] We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

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[1] Although Appellants indicate that only the rejection of claims 1 and 11 are appealed (App. Br. 2-3), Appellants nonetheless appealed all rejected claims in their Notice of Appeal. *See* Notice of Appeal filed Sept. 21, 2009 (appealing the final rejection of claims 1-20). Accordingly, we treat all rejected claims in this appeal.

STATEMENT OF THE CASE

Appellants' invention simplifies managing operations of plural server information handling systems by using a server object associated with each server that applies an associated policy to perform listed tasks. *See generally* Abstract; Spec. 5-6; Fig. 1. Claim 1 is illustrative:

> 1. A directory service system for managing plural server information handling systems, the directory service system comprising:
>
> a processor that processes instructions;
>
> storage media accessible by the processor and having intstructions comprising:
>
> plural tool objects, each tool object associated with one or more tools, each tool associated with one or more application images;
>
> a tool box having plural tool box objects, each tool box object having tool distinguished names, each tool distinguished name pointing to a tool object;
>
> a server policy associated with each server information handling system, the server policy defining one or more tasks for an associated server information handling system, the tasks applying one or more tool box objects; and
>
> a server object associated with each server information handling system, the server object applying the server policy associated with the server information handling system to perform the server policy tasks.

THE REJECTIONS

1. The Examiner rejected claims 1-6, 8-12, 14-18, and 20 under 35 U.S.C. § 103(a) as unpatentable over Mishra (US 2003/0126592 A1; July 3, 2003) and Clark (US 2006/0107218 A1; May 18, 2006; filed Jan. 17, 2006). Ans. 3-6.[2]

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[2] Throughout this opinion, we refer to (1) the Appeal Brief filed November 18, 2009 ("App. Br."); (2) the Examiner's Answer mailed February 1, 2010 ("Ans."); and (3) the Reply Brief filed March 22, 2010 ("Reply Br.").

2. The Examiner rejected claims 7, 13, and 19 under 35 U.S.C. § 103(a) as unpatentable over Mishra, Clark, and Melchione (US 2004/0019889 A1; Jan. 29, 2004). Ans. 11-12.

THE OBVIOUSNESS REJECTION OVER MISHRA AND CLARK

The Examiner finds that Mishra discloses a directory service system with every recited feature of representative claim 1 except for the recited server object, but cites Clark as teaching this feature in concluding that the claim would have been obvious. Ans. 3-6, 12-15.

Appellants argue that Clark does not qualify as prior art since the evidence submitted during prosecution establishes that they (1) conceived the claimed invention before Clark's filing date, and (2) were reasonably diligent from a time before that date to when the present application was filed (the constructive reduction to practice). App. Br. 4; Reply Br. 1-2. Appellants add that the cited prior art does not teach or suggest the recited server policy, and that no evidence supports the Examiner's statement that Clark discloses a server object. App. Br. 3-4; Reply Br. 1.

ISSUES

(1) Has the Examiner erred in relying on Clark to reject the claims under § 103? This issue turns on whether Clark qualifies as prior art.

(2) Under § 103, has the Examiner erred in rejecting claim 1 by finding that Mishra and Clark collectively would have taught or suggested a (a) a server policy associated with each server information handling system, the policy defining one or more tasks for an associated system, the tasks applying one or more tool box objects, and (b) a server object associated

with each system, the server object applying the server policy associated with each system to perform server policy tasks?

ANALYSIS

Clark's Qualification as Prior Art

We begin by addressing the key threshold question in dispute, namely whether Clark qualifies as prior art. Although Clark was published after the present invention's filing date of June 6, 2006, Clark was filed before that date (January 17, 2006). Appellants, however, contend that evidence submitted *during prosecution* establishes that they (1) conceived the claimed invention before Clark's filing date, and (2) were reasonably diligent from a time before that date to when the present application was filed (the constructive reduction to practice). App. Br. 4; Reply Br. 1-2.

This evidence is said to be in the form of three declarations from: (1) one of the inventors, Manoj Gujarathi, filed January 26, 2009 ("Gujarathi Decl."); (2) all of the inventors filed May 11, 2009 ("Inventors' Decl."); and (3) Appellants' attorney, Robert Holland, filed August 21, 2009 ("Holland Decl."). *See* App. Br. 4; Reply Br. 1-2. *But see* Ans. 16 (referring to only the first two declarations above). Notably, none of these declarations were provided in the Appeal Brief's Evidence Appendix, let alone accompanied with the requisite statement setting forth where in the record the Examiner entered this evidence under 37 C.F.R. § 41.37(c)(1)(ix) (2010). *See also* MPEP 1205.02. Rather, the Brief's Evidence Appendix indicates "None."

Although this practice runs counter to standard procedure for proper appeal briefs,[3] both Appellants and the Examiner nevertheless discuss at least some of this evidence—namely, the Gujarathi and Inventors' declarations—in connection with their respective positions. App. Br. 4; Reply Br. 1-2; Ans. 16-20. Despite this procedural error, we nonetheless consider only these declarations to the extent they are referred to the Briefs and Answer in connection with this appeal.[4] We do not, however, consider the Holland declaration filed after the Examiner's final rejection, for the Examiner did not enter it—let alone consider it—in connection with this appeal. *See* Examiner's Advisory Action mailed Sept. 9, 2009 (indicating non-entry of the after-final amendment and accompanying declaration). *Accord* App. Br. 2 (acknowledging the Examiner's refusal to consider this declaration in the Brief's status of amendments section); Ans. 2 (confirming this status as correct). Appellants' assertion that the unentered Holland Declaration was "timely submitted" (App. Br. 4) is not only belied by the record before us, but Appellants' characterizing this unentered declaration

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[3] *See* MPEP 1205.02 ("It is essential that the Board be provided with a brief fully stating the position of the appellant with respect to each ground of rejection presented for review in the appeal so that no search of the record is required in order to determine that position. Thus, the brief should not incorporate or reference previous responses."); *see also id.* ("If in his or her brief, appellant relies on some reference, he or she is expected to provide the Board with a copy of it in the evidence appendix of the brief.").

[4] *Accord Ex parte Matsumoto*, No. 2010-008375, 2011 WL 3253409, at *2 n.1 (BPAI 2011) (considering inventor's declaration despite not being provided in the Evidence Appendix). *But see Ex parte Morton*, No. 2007-0121, 2007 WL 1277910, at *4 (BPAI 2007) (refusing to consider evidence referred to in Appellants' Brief since a copy was not provided in the Evidence Appendix along with a statement showing where in the record the Examiner entered this evidence).

on appeal as "additional evidence of diligence" (*id.*) actually runs counter to regulations that prohibit referring to this evidence on appeal. *See* 37 C.F.R. § 41.37(c)(1)(ix) (2010) ("Reference to unentered evidence is not permitted in the brief.").

Turning to the Gujarathi declaration, the attached Exhibit A is a Dell invention disclosure form entitled "Directory Service Tool Box for Simplifying System Management Operations" with a submission date of November 29, 2005 which precedes Clark's filing date of January 17, 2006. Based on the content of this disclosure, including Figure 1 and its corresponding description, we agree with Appellants (App. Br. 4; Reply Br. 1-2) that this disclosure evidences their conceiving the claimed invention on November 29, 2005. We reach this conclusion noting that Figure 1 of this disclosure form is reasonably commensurate with the claimed invention and Figure 1 of the present application in terms of the depicted relationships between tool objects, tool box objects, server policies, and server objects.

We disagree with Appellants, however, that the Gujarathi and Inventors' declarations establish reasonable diligence from before Clark's filing date of January 17, 2006 to when the application was filed (the constructive reduction to practice) on June 5, 2006. Even assuming, without deciding, that the delay between filing the invention disclosure in November 29, 2005 and Dell's approving filing a patent application based on this disclosure in February 2006 is reasonable "given the holiday season" as Appellants assert (App. Br. 4), we still cannot say that Appellants or their attorney were reasonably diligent from February 2006 to June 5, 2006 based on the evidence before us. Although the Gujarathi and Inventors' declarations indicate that Appellants worked with Dell's outside patent

attorney to prepare and file the application starting in March 2006, there is insufficient evidence on this record detailing the specific activities and circumstances on the part of Appellants or their attorney during the approximately three-month period from March 2006 to June 5, 2006.

To be sure, reasonable diligence can be established by showing that "the attorney worked reasonably hard on the particular application in question *during* the continuous critical period." *Bey v. Kollonitsch*, 806 F.2d 1024, 1027 (Fed. Cir. 1986) (emphasis added). But here, we have no such evidence, apart from statements in the Gujarathi and Inventors' declarations indicating when work began on the application and when it was filed: there is no evidence before us of what specifically occurred during that period, and when it occurred.

Since Appellants have not established reasonable diligence from a time before Clark's filing date to the constructive reduction to practice, Clark therefore qualifies as prior art.

Claims 1-6 and 8-10

We next address whether Mishra and Clark collectively would have taught or suggested the recited server policy and object limitations of representative claim 1. At the outset, we note a discrepancy between the arguments raised in the Appeal Brief and the Reply Brief. In the Appeal Brief, Appellants repeatedly quote the recited server *policy* limitation, and argue that the cited prior art does not teach or suggest this limitation. App. Br. 3-4. The Examiner's Response to Arguments likewise focuses on the server policy limitation and how Mishra teaches that feature. Ans. 12-15.

In the Reply Brief, however, Appellants acknowledge that they erroneously indicated in the Appeal Brief that the Examiner admitted that Mishra failed to disclose this limitation, but rather the server *object* limitation. Reply Br. 1. *Accord* Ans. 6 (citing Clark for teaching the recited server object). According to Appellants, not only are Mishra's workstations clients, not servers, but Clark's view-based navigation model for graphical user interfaces does not teach the recited server object. Reply Br. 1. *Accord* App. Br. 3 (arguing that the Examiner's statement that Clark discloses a server object is unsupported).

Although this clear shift in emphasis between the Appeal Brief and the Reply Brief is puzzling, we are nonetheless unpersuaded of error in the Examiner's reliance on both Mishra and Clark for teaching both the server policy and server object limitations. First, even assuming that Mishra's workstations are limited to clients as Appellants contend (Reply Br. 1), Appellants still provide no persuasive argument or evidence proving that Mishra's relied-upon functionality would not be applicable to servers, particularly in view of Mishra's teaching that the described computers can be not only servers but also personal computers. *See* Mishra ¶¶ 0023-25. That Mishra's Paragraph 25 indicates particular arrangements of the various files, objects, and processes may be arranged in "virtually any number of ways among the various network devices" only bolsters the Examiner's position.

Second, although Clark's objects are the end point items of a hierarchical tree as Appellants argue (App. Br. 3), that hardly precludes these objects from being at least associated with each server information handling system or applying the server policies to perform tasks as claimed,

particularly since these objects pertain to server configuration as the Examiner indicates. Ans. 6 (citing Clark ¶¶ 0020, 0025; Fig. 1). *See also* Clark ¶¶ 0023, 0049; Figs. 1, 5 (disclosing server objects associated with containers). We see no reason why skilled artisans could not at least associate such objects with each server as claimed to improve efficiency as the Examiner indicates (Ans. 6), for such an improvement predictably uses prior art elements according to their established functions—an obvious improvement. *See KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 417 (2007).

We are therefore not persuaded that the Examiner erred in rejecting representative claim 1, and claims 2-6 and 8-10 not separately argued with particularity.

Claims 11, 12, 14-18, and 20

Despite nominally arguing representative claim 11 separately, Appellants reiterate similar arguments made in connection with claim 1 including Clark's alleged failure to disclose a server object for each server. App. Br. 4-5. We are not persuaded by these arguments, however, for the reasons previously discussed.

THE OTHER OBVIOUSNESS REJECTION

Since Appellants do not contest the Examiner's rejection of claims 7, 13, and 19 (*see* App. Br. 3-5; Reply Br. 1-2; Ans. 11-12), we summarily sustain this rejection. *See* MPEP § 1205.02 ("If a ground of rejection stated by the examiner is not addressed in the appellant's brief, that ground of rejection will be summarily sustained by the Board.").

CONCLUSION

The Examiner did not err in rejecting claims 1-20 under § 103.

ORDER

The Examiner's decision rejecting claims 1-20 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

gvw