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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* DMITRY ANDREEV, PAUL GREGORY GREENSTEIN, and  
GREGORY VILSHANSKY

Appeal 2010-009467<sup>1</sup>  
Application 11/452,181  
Technology Center 2400

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Before JEAN R. HOMERE, JASON V. MORGAN, and JOHN G. NEW,  
*Administrative Patent Judges.*

HOMERE, *Administrative Patent Judge.*

DECISION ON APPEAL

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<sup>1</sup> The real party in interest is International Business Machines, Inc. (App. Br. 1.)

## I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1-7, 10, and 13-34. Claims 8, 9, 11, and 12 have been canceled. (App. Br. 1.) We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

### *Appellants' Invention*

Appellants invented a method and system for porting an information technology (IT) structure from one IT environment to another. In particular, an abstract IT structure in the first IT environment is translated into a virtual IT structure by using a prioritized list of optimization classes upon which an optimization function is applied. The virtual IT structure is subsequently translated into a real IT structure in a second environment. (Abstr.)

### *Illustrative Claim*

Independent claim 1 further illustrates the invention. It reads as follows:

1. A method for porting an abstract Information Technology (IT) structure into an IT delivery environment, said method comprising:
  - translating, by a processor of a computer system, an abstract IT structure A that is currently within an IT delivery environment X, said translating generating a virtual IT structure V from the abstract IT structure A through specification of an IT delivery environment Y;
  - delivery binding the virtual IT structure V to the IT delivery environment Y to generate a delivery-bound virtual IT structure D; and
  - deploying the delivery-bound virtual IT structure D in the IT delivery environment Y, resulting in a real IT structure

instance R capable of operating in the IT delivery environment Y,

wherein said translating comprises optimizing the virtual IT structure V by using a specified prioritized list of optimization classes and applying each optimization function of an associated optimization class from the specified prioritized list of optimization classes to the virtual IT structure V, and

wherein said applying each optimization function comprises applying in tum each optimization function, starting with a lowest and ending with a highest priority of optimization classes comprising each optimization function which results in said applying the highest priority of optimization classes overriding said applying the optimization classes whose priority is lower than the priority of the highest priority of optimization classes.

*Prior Art Relied Upon*

Nguyen                      US 2003/0172145 A1                      Sep. 11, 2003

*Rejections on Appeal*

The Examiner rejects the claims on appeal as follows:

1. Claims 31-34 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter Appellants regard as the invention.<sup>2</sup>
2. Claims 1-7, 10, and 31-34 stand provisionally rejected on the ground of non-statutory obviousness-type double patenting as

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<sup>2</sup> In the Final action of 5/18/2009, the Examiner also rejected claims 31-34 as being indefinite because the recitation “the total cost of ownership” rendered the claim indefinite. However, the Examiner withdrew the rejection in light of Appellants’ arguments. (Ans. 19-20.)

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being unpatentable over the combination of co-pending application No. 11/011,449 (claim 4), Nguyen, and Official notice.

3. Claims 1-7, 10, and 13-34 stand under 35 U.S.C. § 103(a) as being unpatentable over the combination of Nguyen and Official notice.

### ANALYSIS

We consider Appellants' arguments *seriatim* as they are presented in the Appeal Brief, pages 18-44, and the Reply Brief, pages 3-35.

#### *Indefiniteness Rejection*

Dispositive Issue 1: Have Appellants shown that the Examiner erred in concluding that the recitations "higher priority" and "lower priority" as recited in claim 1 render the claim indefinite?

Appellants argue that because the recitations "higher priority" and "lower priority" are relative terms that are compared with each other in claim 31, they do not render the claim indefinite. (App. Br. 20, Reply Br. 4-5.) Further, Appellants argue that, when fully read in context, the recitation of applying the higher priority optimization function after applying the lower priority optimization function simply means that the higher priority optimization function overrides the lower priority function when the higher priority function is applied after the lower priority function. (*Id.* at 5.)

In response, the Examiner finds the fact that the cited terms are in the same claim does not necessarily cause them to be compared with each other. (Ans. 20.) Further, the Examiner finds that the recitation of "applying the higher priority optimization function" *after* "applying the lower priority

optimization function” indicates that the higher priority function is applied in a lower priority (after) than the latter. (*Id.* at 20-21.) Consequently, the Examiner submits that such language is conflicting, and therefore renders the claim indefinite. (*Id.* at 21.)

On the record before us, we find error in the Examiner’s indefiniteness rejection because one of ordinary skill in the art having read Appellants’ Specification would have been apprised of the scope of the claimed subject matter. In particular, we find that the ordinarily skilled artisan would have been readily apprised that the recitations of a “higher priority” a “lower priority” optimization functions simply imply a plurality of functions that are sorted as some having a higher priority, and others as having a “lower priority.” Therefore, we agree with Appellants that the ordinarily skilled artisan would have readily recognized that these functions are compared with one another. Further, we agree with Appellants that the recitation that higher priority functions are applied after lower priority functions *results* in the higher priority functions overriding the lower priority functions simply set forth a condition precedent for the higher priority function to override the lower priority function. Because the ordinarily skilled artisan would have not found any of the alleged ambiguities or conflicts in the claim, as raised by the Examiner, we find Appellants have shown error in the Examiner’s rejection of claim 31, and the claims depending therefrom.

Obviousness Rejection

Dispositive Issue 2: Have Appellants shown that the Examiner erred in finding that the combination of Nguyen and Official Notice teaches or suggests *translating an abstract IT structure in a first delivery environment to a virtual IT structure that is optimized to thereby yield a real IT structure in a second delivery environment*, as recited in claim 1?

Appellants argue that the combination of Nguyen and Official Notice does not teach or suggest the disputed limitations emphasized above. (App. Br. 24-32, Reply Br. 11-19.) In particular, Appellants argue that Nguyen's disclosure of a list of questions for customers during the formulation of design requirements does not teach a translation from an abstract IT structure to a virtual IT structure. (App. Br. 25-26.) Further, Appellants argue that while Nguyen discloses optimizing a design, the reference does not teach or suggest applying an associated optimization function to a prioritized list of optimization classes in a virtual structure. (*Id.* at 30.)

Additionally, Appellants argue that the Examiner's Official Notice does not cure the noted deficiencies because the supporting prior art (Pouwelse) relied upon by the Examiner for the official notice does not satisfy the legal standard set forth in the MPEP§ 2144. 03(A) whereby facts stated therein are capable of instant and unquestionable demonstration of facts as to defy dispute. (Reply Br. 18-19.)

In response, the Examiner finds that Nguyen's disclosure of gathering design requirements to create an optimized architectural model for

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subsequently creating a logical design therefor, taken in combination with the well-known fact of starting performance on a highest priority task, and ending with the lowest priority task and vice-versa, teaches the disputed limitations. (Ans. 11, 21-28.)

Based upon our review of the record before, we agree with the Examiner's underlying factual findings and ultimate conclusion of obviousness regarding claim 1. We note at the outset that Appellants' arguments in the Appeal Brief and the Reply Brief failed to address the specific findings made by the Examiner in the Answer. In particular, the Examiner relies upon the following teachings of Nguyen:

1. Paragraphs [0142], [0143] to teach translating an abstract structure into a virtual structure, which is used to subsequently implement a real structure. (Ans. 21-22.)
2. Paragraphs [0232]-[0234] to teach the design requirements within a first environment. (Ans. 22.)
3. Paragraphs [0623], [0624] to create an IP address schema, creating a physical network design. (Ans. 24.)
4. Paragraphs [0580], [0391] to teach optimizing a virtual IT structure by using a prioritized list of optimization classes and applying an optimization function thereupon. (Ans. 26.)

While Appellants address the Examiner's findings with regards to paragraphs [0232]-[0240], [580] (App. Br. 24-30), Appellants' arguments fail to discuss the specific findings with respect to paragraphs [0142]-[0144],

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which form the thrust of the Examiner's rejection. In our view, Appellants' failure to specifically address in the Briefs the portions of the references mainly relied upon in the rejection is not responsive to the Examiner's specific findings made in the Answer. Further, we find that Nguyen's disclosure of identifying service flows for each service to optimize the implementation of an architectural design [0580] teaches that such service flows or classes are optimized by a function of some kind to thereby yield the optimal architectural design. Therefore, we find no error in the Examiner's finding that Nguyen teaches optimizing a prioritized list of classes.

Additionally, to support the taking of Official Notice, the Examiner cited to Pouwelse as evidence that starting performance on the lowest priority task and ending with the highest priority task is well known in the art. (Ans. 28.) In response, Appellants merely allege that the Official Notice does not satisfy the legal standard set forth in section 2144.03 of the MPEP, whereby the facts asserted are unquestionably and undisputedly well-known. Appellants also argue that because the Examiner has taken official notice more than once for different facts, the Examiner violated the spirit of rarely invoking official notice as mandated by the MPEP. (Reply Br. 18-19.) We find Appellants' arguments unavailing. In particular, Appellants failed to explain why the facts provided in the Pouwelse reference are not indisputably and unquestionably well-known according to the legal standard set forth in the MPEP. In fact, Appellants have provided no analysis of Pouwelse at all, nor have Appellants provided any evidence as

to why the noticed fact is not considered to be common knowledge or well-known in the art in accordance with MPEP § 2144.03(C).<sup>3</sup> Consequently, we find that Appellants have failed to adequately traverse the Examiner's taking of Official Notice that the use of a driver conversion file is well-known in the art for the purpose of starting performance on the lowest priority task and ending with the highest priority task. We also find untimely Appellants' arguments in the Reply Brief that the Examiner's taking of official notice for a second time violates the MPEP requirement of rarely invoking official notice. We note that this new line of argument was raised by Appellants for the first time in the Reply Brief, and such new argument is not in response to a new issue brought up by the Examiner in the Answer. We therefore find these new arguments unavailing.<sup>4</sup> Appellants are reminded that:

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<sup>3</sup> Our reviewing court has held that an Appellant adequately traverses a finding of Official Notice where the Appellant's argument "contain[s] adequate information or argument" to create on its face "a reasonable doubt regarding the circumstances justifying the ... notice" of what is well known to an ordinarily skilled artisan. *In re Boon*, 439 F.2d 724, 728 (CCPA 1971). "To adequately traverse such a finding [of Official Notice], an applicant must specifically point out the supposed errors in the [E]xaminer's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art." Manual of Patent Examining Procedure ("MPEP") § 2144.03(C) (Rev. 9, Aug. 2012).

<sup>4</sup> "[I]t is inappropriate for appellants to discuss in their reply brief matters not raised in ... the principal brief[ ]. Reply briefs are to be used to reply to matter[s] raised in the brief of the appellee." *Kaufman Co. v. Lantech, Inc.*, 807 F.2d 970, 973 n.\* (Fed. Cir. 1986).

[T]he purpose of a reply brief is to ensure the Appellant the opportunity to have the last word on an issue raised by the Examiner. The reply brief enables the Appellant to address any new grounds of rejection the Examiner may have raised in the answer, or to address changes or developments in the law that may have occurred after the principal brief was filed. The reply brief is not an opportunity to make arguments that could have been made during prosecution, but were not. Nor is the reply brief an opportunity to make arguments that could have been made in the principal brief on appeal to rebut the Examiner's rejections, but were not.

Giving cognizance to belated arguments in a reply would vitiate the force of the requirement in Board Rule 37(c)(1)(vii) that "[a]ny arguments or authorities not included in the brief . . . will be refused consideration by the Board, unless good cause is shown." The reference in that section to the "reply brief filed pursuant to § 41.41" does not create a right for the Appellant to raise an argument in the reply brief that could have been raised in the principal brief but was not. Rather, that reference merely puts Appellants on notice that arguments that could be made in the reply brief, but are not, are waived.

*See Ex Parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (informative).

For at least the aforementioned reasons, we find Appellants have not sustained the requisite burden on appeal of providing arguments or evidence persuasive of error in the Examiner's rejection of representative claim 1. It therefore follows that Appellants have not shown that the Examiner erred in finding that the combination of Nguyen and Official Notice renders claim 1 unpatentable.

Regarding claims 2-7, 10, and 13-34, Appellants reiterate substantially the same arguments submitted for patentability of claim 1 above. (App. Br. 32-43, Reply Br. 19-36.) As discussed above, these arguments are not persuasive. See 37 C.F.R. § 1.37(c)(1)(vii). Further,

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while Appellants raised additional arguments for patentability of the cited claims, we find that the Examiner has rebutted in the Answer each and every one of those arguments by a preponderance of the evidence. (Ans. 28-38.)

Therefore, we adopt the Examiner's findings and underlying reasoning, which are incorporated herein by reference. Consequently, Appellants have failed to show error in the Examiner's rejections of claims 2-7, 10, and 13-34.

*Obviousness- Double Patenting Rejection*

Dispositive Issue 3: Have Appellants shown that the Examiner erred in finding that the combination of the co-pending application (claim 4), Nguyen, and Official Notice teaches or suggests *generating a virtual IT structure from an abstract IT structure*, as recited in claim 1?

Appellants argue that while claim 4 of the co-pending application recites "translating a virtual IT structure X into a delivery-bound virtual IT structure XDB, it does not teach translating an abstract IT structure into a virtual IT structure." (App. Br. 21-23.) In response, the Examiner finds that because dependent claim 4 incorporates the limitation of claim 1, which recites, *inter alia*, transforming each virtual abstract into a corresponding virtual entity, claim 4 teaches the claimed limitation. (Ans. 39.) We agree with the Examiner's findings, which we incorporate herein by reference. Further, Appellants argue that Nguyen and Official Notice does not cure the noted deficiencies of co-pending claim 4. (App. Br. 23.) We have already addressed those arguments above, and we find them unavailing as previously

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discussed, and for the same reasons detailed at pages 39-40 in the Answer. It follows Appellants have not shown error in the Examiner's rejection of claims 1-7, 10, and 13-34.

### DECISION

We affirm the Examiner's provisional obviousness double patenting rejection and the obviousness rejection of claims 1-7, 10, and 13-34 as set forth above. However, we reverse the indefiniteness Examiner's rejection of claims 31-34.

Because we have affirmed at least one ground of rejection with respect to each claim on appeal, the Examiner's decision is affirmed. *See* 37 C.F.R. § 41.50(a)(1).

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

ELD