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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID G. KUEHR-MCLAREN, PRATIK GUPTA,
GOVINDARAJ SAMPATHKUMAR,
VINCENT C. WILLIAMS, SHARON L. CUTCHER,
SUMIT TAANK, BRIAN A. STUBE, and HARI SHANKAR

Appeal 2010-010703
Application 11/780,956
Technology Center 2100

Before JOSEPH L. DIXON, ST. JOHN COURTENAY III, and
CARLA M. KRIVAK, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Patent Examiner finally rejected claims 1-9. Claims 10-11 were canceled. (App. Br. 1). Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

INVENTION

This invention relates to a method of automatically generating policy recommendations for roles based on the entitlements and non-entitlement attributes of identities. (Spec. 1). Claim 1, reproduced below, is illustrative of the claimed subject matter:

> 1. A method of automatically generating a policy for a role, said role comprising a plurality of identities of individuals, each identity having attributes that include entitlements and nonentitlement attributes, comprising:
>
> [a] automatically obtaining a list of attributes possessed by a predetermined number of the identities in said role;
>
> [b] automatically extracting from said list of attributes a list of entitlements common to all of said predetermined number of the identities in said role; and
>
> [c] automatically forming a policy for said role that said list of entitlements will be given to an identity subsequently added to said role.

REJECTION

The Examiner rejected claims 1-9 as being anticipated under 35 U.S.C. § 102(b) by Win (U.S. Patent No. 6,453,353).

ANALYSIS

A.

***Issue*:** Under § 102, did the Examiner err in finding that the cited Win reference discloses [a] "automatically obtaining a list of attributes possessed by a predetermined number of the identities in said role;" and [b] "automatically extracting from said list of attributes a list of entitlements common to all of said predetermined number of the identities in said role," within the meaning of independent claim 1?

The Examiner relies on Win's list of user record profile information including user name and password, for disclosing the limitation [a] of "automatically obtaining *a list of attributes* possessed by a predetermined number of the identities in said role." (Ans. 5; Win col. 13, ll. 10-16).

The Examiner relies on Win's "users log in process that include[s] [the] users name and password" for disclosing the limitation [b] of: "automatically extracting from *said list of attributes* a list of entitlements common to all of said predetermined number of the identities in said role." (Ans. 5; Win col. 5, l. 66 to col. 6, l. 1).

The Examiner erred by not finding the *same* "list of attributes" in Win as required by the antecedent basis in claim 1: [a] "automatically obtaining *a list of attributes* . . . " and [b] "automatically extracting from *said list of attributes* . . . ." (Ans. 5). Specifically, the Examiner relies on Win's list of user record profile information of user names and passwords for [a] "*a list of attributes*" and erroneously relies on a different list (an individual's list of their user name and password used to log in) for [b] "*said list of attributes*." (Ans. 5).

Moreover, the Examiner fails to show how Win's "users log in process that include[s] [the] user's name and password" discloses the limitation [b] of: "*automatically extracting* from *said list of attributes*" (list of user record profile information) and "*a list of entitlements common to all* of said predetermined number of the identities in said role (emphasis added)." (Ans. 5; Win col. 5, l. 66 to col. 6, l. 1). This is because Win's user login process merely gives a user access to the user's entitlements. (*Id.*). Win's user login does not disclose "*automatically extracting*" a list of entitlements common to a number of the identities in said role. (*Id.*).

B.

***Issue*:** Under §102, did the Examiner err in finding that the cited Win reference discloses "automatically forming a policy for said role that said list of entitlements will be given to an identity subsequently added to said role," within the meaning of independent claim 1, and the commensurate language of independent claim 3?

Appellants' contend that Win does not teach the limitation of: "automatically generating a policy for said role based on said entitlements" as recited in claim 3. (App. Br. 8-9). Appellants also contend: "at col. 13, lines 54-56, Win states, 'Defining roles involves ... ' Neither claim 1 nor 3 recites defining or creating any role-rather, the claims recite automatically creating a policy for an existing role, based on entitlement attributes of member of the role." (App. Br. 9).

The Examiner disagrees:

> Win also teaches defining specific role IDs assigned to users access privileges automatically generating using CGI-program [col 13, line 54-56, col 16, line 13-15, line 53-58], furthermore, Win's system has the flexibility to update, add or delete, delegating privileges to resources strongly defined in the administrative functions is part of the Win's system automatically executed by the CGI-programming [col 16, line 63-67, col 17, line 1-4].

(Ans. 13).

Appellants' contentions are persuasive. The Examiner's cited passages in Win do not disclose "*automatically* generating a *policy* . . ." because Win merely discloses that an *administrator* can create and modify *role records* (not a "policy") (Win col. 13; ll. 8-11). Moreover, Appellants' Specification expressly defines automatically: "[a]s used herein, 'automatically' means without direct human effort, such as via software." (Spec. ¶ [0017]). Given this definition, the cited sections of Win fail to disclose "*automatically* generating a *policy* . . ." because Win discloses only that an *administrator* (a human) can use the system to create and modify *role records.* (Win col. 13; ll. 8-11).[1]

For these reasons, we are persuaded of Examiner error.

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[1] *But cf. In re Venner*, 262 F.2d 91, 95 (CCPA 1958)(under § 103, broadly providing an automatic way to replace a manual activity, which accomplished the same result, is not sufficient to distinguish over the prior art.); *see also Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) ("Applying modern electronics to older mechanical devices has been commonplace in recent years."). However, because a § 103 rejection is not before us on appeal, we leave the guidance of our reviewing court to the further consideration of the Examiner.

We reverse the Examiner's anticipation rejection of independent claim 1, and independent claim 3, which similarly recites "automatically generating a policy for said role based on said entitlements." Because we have reversed the Examiner's anticipation rejection of each independent claim on appeal, we also reverse the Examiner's rejection of each dependent claim on appeal.

DECISION

We reverse the Examiner's anticipation rejection of claims 1-9.

ORDER

REVERSED

Vsh