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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/094,027	03/30/2005	Glen E. Salmon	LOT920050045US1	8297
45544	7590	11/28/2016	EXAMINER	
HOFFMAN WARNICK LLC			GILKEY, CARRIE STRODER	
540 Broadway			ART UNIT	
4TH FLOOR			PAPER NUMBER	
ALBANY, NY 12207			3689	
			NOTIFICATION DATE	
			DELIVERY MODE	
			11/28/2016	
			ELECTRONIC	

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* GLEN E. SALMON

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Appeal 2014-008163<sup>1</sup>  
Application 11/094,027<sup>2</sup>  
Technology Center 3600

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Before BIBHU R. MOHANTY, JAMES A. WORTH, and  
MATTHEW S. MEYERS, *Administrative Patent Judges*.

MEYERS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 1–5, 8–11, 13, 16–20, 23–26, 28, and 29. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> Our decision references Appellant’s Appeal Brief (“Appeal Br.,” filed April 18, 2014) and Reply Brief (“Reply Br.,” filed June 26, 2014), the Examiner’s Answer (“Ans.,” mailed May 22, 2014), and Final Office Action (“Final Act.,” mailed November 14, 2013).

<sup>2</sup> Appellant identifies International Business Machines Corporation as the real party in interest (Appeal Br. 1).

## CLAIMED INVENTION

Appellant's claimed invention relates to "individual and group work space allocation and utilization" (Spec. ¶ 1).

Claims 1, 16, and 29 are the independent claims on appeal. Claim 1, reproduced below, with minor formatting changes and added bracketed notations, is illustrative of the subject matter on appeal:

1. A method for work space allocation, comprising:
  - [a] dynamically mapping, using a computing device, one of a plurality of free spaces in a work environment to a user based on a set of mapping criteria; and
  - [b] updating, using the computing device, an awareness message in an instant messaging system to indicate a location of the free space allocated to the user;
  - [c] wherein the mapping comprises:
    - [d] extracting calendar information for the user from a calendar of the user,
    - [e] wherein the calendar information includes a scheduled meeting on the calendar of the user; and
    - [f] determining user requirements for the free space based on the extracted calendar information,
    - [g] the determining of the user requirements comprising:
      - [h] examining email addresses of invitees to the scheduled meeting in the calendar of the user to determine a location for each of the invitees of the scheduled meeting; and
      - [i] determining a type of free space most appropriate for the meeting based upon the location for each of the invitees of the scheduled meeting,
      - [j] wherein the determining of the type of the free space most appropriate includes:
        - [k] determining whether all of the meeting invitees are located within a same company site;
        - [l] selecting a first type of free space suitable for the meeting having invitees within the same company site in the case that all of the meeting

invitees are located within the same company site;  
and

[m] selecting a second type of free space suitable for the meeting having invitees within distinct company sites in the case that at least one of the meeting invitees is located within a remote company site;

[n] identifying the user when the user enters a work location in the work environment, the identifying performed by monitoring a security system at the work location;

[o] determining an allocation of one of the plurality of free spaces to the user in the work location in response to the identifying of the user in the work location; and

[p] determining a required size of the free space based on a total number of the invitees that have accepted an invitation to the meeting.

#### REJECTIONS

Claims 1–5, 8–11, 13, 16–20, 23–26, 28, and 29 are rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement.

Claims 1–5, 8–11, 16–20, 23–26, and 29 are rejected under 35 U.S.C. § 103(a) as unpatentable over Lakritz (US 2005/0137925 A1, pub. June 23, 2005), Benbassat (US 6,985,872 B2, iss. Jan.10, 2006), and Christenson (US 7,693,734 B2, iss. Apr. 6, 2010).

Claims 13 and 28 are rejected under 35 U.S.C. § 103(a) as unpatentable over Lakritz, Benbassat, Christenson, and Dean (US 5,901,211, iss. May 4, 1999).

## ANALYSIS

### *Written description*

Independent claim 1 recites-in-part “[g] the determining of the user requirements comprising: [h] ***examining email addresses of invitees to the scheduled meeting in the calendar of the user to determine a location*** for each of the invitees of the scheduled meeting” (Appeal Br. 16; Claims App. (emphasis added)).

In rejecting independent claims 1, 16, and 29 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement, the Examiner found the functional claim language “examining email addresses,” as required by independent claims 1, 16, and 29, “is not described in the [S]pecification so as to convey that applicant had possession of the claimed invention at the time of filing” (Final Act. 3). More particularly, the Examiner states

[g]iven that the concept of examining the email addresses is at the core of the invention, the fact that little in the way of specifics about how the email addresses are examined is given demonstrates that the [A]ppellant[] ha[s] failed to reasonably convey possession at the time of the invention. Appellant[']s [S]pecification does not demonstrate a generic invention that achieves the claimed result because there is inadequate disclosure of species (e.g., different formulas, calculations, or algorithms . . . .

(Ans. 3–4).

In response, Appellant argues “[t]he feature of ‘examining of email addresses . . . to determine a location for each of the invitees’ is explicitly recited by the present application as it was originally filed” at paragraph 24 of the Specification (Appeal Br. 9). However, the fact that the Specification literally repeats the functional claim language in *ipsis verbis* is not

dispositive. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1350 (Fed. Cir. 2010) (en banc); *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 323 F.3d 956, 968 (Fed. Cir. 2002) (holding that generic claim language appearing in *ipsis verbis* in the original specification did not satisfy the written description requirement because it failed to support the scope of the genus claimed).

Given the identified support in the Specification at paragraph 24, we next must determine whether the scope of the functional claim language is a genus that covers all species for performing the claimed function. *Ariad*, 598 F.3d at 1349. Factors to consider include (a) whether the claim itself recites limitations as to how the function is performed; and (b) whether the Specification identifies a way of performing the claimed function, such as a specific type of microcomputer or an algorithm, that defines the scope of the functional claim language, without importing limitations from the Specification into the claim. *Id.*; see also *LizardTech, Inc. v. Earth Res. Mapping, Inc.*, 424 F.3d 1336, 1346 (Fed. Cir. 2005); *In re Hayes Microcomputer Prods., Inc. Patent Litigation*, 982 F.2d 1527, 1534 (Fed. Cir. 1992).

Here, limitation [h] of exemplary independent claim 1 recites “examining email addresses of invitees to the scheduled meeting in the calendar of the user to determine a location for each of the invitees of the scheduled meeting.” Thus, the claim itself does not recite how the invitees’ email addresses are examined “to determine a location for each of the invitees of the scheduled meeting,” as recited by limitation [h] of independent claim 1, and similarly recited by independent claims 16 and 29. The Specification is similarly silent as to how the email addresses are

examined “to determine a location for each of the invitees of the scheduled meeting,” as the independent claims require. There is no guidance in the form of examples or structure as to how one “determine[s] a location for each of the invitees” from “examining email addresses” based on paragraph 24 of the Specification (*see* Appeal Br. 9–10; *see also* Reply Br. 3–4), and more particularly, we find nothing in the portion emphasized by Appellant, i.e., “[t]his can be determined by examining the email addresses of the invitees to a meeting scheduled in the calendar of the user 18” (Appeal Br. 10 (citing Spec. ¶ 24)).

Appellant also identifies that paragraphs 28–38 of the Specification “describe the computer system 100 used to implement the processes recited in the claims” (Appeal Br. 12–13; Reply Br. 7). However, the cited portions merely disclose a generic “[c]omputer system 100 [which] generally includes a processing unit 102, memory 104, bus 106, input/output (I/O) interface(s) 108, and external devices/resource(s) 110” (*see, e.g.*, Spec. ¶ 29–33) and nothing in the way of examples, instructions, or some algorithm for “examining email addresses of invitees . . . to determine a location.” Thus, we agree with the Examiner that paragraph 24 of the Specification “merely discuss[es] the intended result of the examination of the email addresses without sufficiently disclosing any specific manners or algorithms demonstrating how the [A]ppellant’s invention examines the email addresses” (Ans. 5).

Appellant further points out that “[o]ne of ordinary skill in the art would understand that [paragraph 24 of the Specification] goes well beyond implying the presence of some construct to ‘examine email addresses’, especially in view of the maturity and predictability of the subject art”

(Appeal Br. 10–11; *see also* Reply Br. 4–5). However, the issue is not whether a person of ordinary skill in the art would know how to perform the step of “examining email addresses of invitees . . . to determine a location;” but rather, whether the Specification describes the claimed invention in sufficient detail to convey to a person skilled in the art that Appellant was in possession of the claimed subject matter as of the filing date, *see Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562–63 (Fed. Cir. 1991), i.e., that Appellant possessed the invention, including how to program the disclosed “[c]omputer system 100” to perform the functional limitation, at the time the present application was filed. We further note that the purpose of the written description requirement is to fulfill the goal of the patent system, i.e., that the patentee provide the public with an adequate disclosure of an invention as the quid pro quo for a patent on the claims, which disclosure will pass fully into the public domain upon expiration of the patent, thus increasing the public store of knowledge and encouraging the public disclosure of invention. *See Beidler v. United States*, 253 U.S. 447, 453 (1920); *LizardTech, Inc.*, 424 F.3d at 1346 (quoting *Merrill v. Yeomans*, 94 U.S. 568, 573–74 (1876)).

The Federal Circuit has held that the written description requirement may be satisfied when the particular steps, i.e., an algorithm, necessary to perform the claimed function, are “described in the specification.” *See, e.g., Hayes*, 982 F.2d at 1533–34. The Federal Circuit acknowledged that the level of detail required for the written description requirement to be met is case-specific. *Id.* Here, as discussed in greater detail above, we find that Appellant’s Specification provides nothing in the way of example, instruction, or algorithm for “examining email addresses of invitees . . . to

determine a location,” as recited in independent claims 1, 16, and 29, in sufficient detail that a person skilled in the art could reasonably conclude that Appellant possessed the invention, including how to program the disclosed computer to perform the claimed function, at the time the application was filed.

Accordingly, we agree with the Examiner that the scope of “examining email addresses of invitees . . . to determine a location” is a genus that covers all species for performing the claimed function. And as the Specification does not disclose any species for “examining email addresses of invitees . . . to determine a location,” independent claims 1, 16, and 29 fail to meet the written description requirement of 35 U.S.C. § 112, first paragraph. *See LizardTech*, 424 F.3d at 1346 (“[T]he description of one method for creating a seamless DWT does not entitle the inventor . . . to claim any and all means for achieving that objective”); *See also Ariad*, 598 F.3d at 1349 (“the specification must demonstrate that the applicant has made a generic invention that achieves the claimed result and do so by showing that the applicant has invented species sufficient to support a claim to the functionally-defined genus”).

#### *Obviousness*

We are not persuaded by Appellant’s argument that the Examiner erred in rejecting independent claims 1, 16, and 29 under 35 U.S.C. § 103(a) as unpatentable over the combination of Lakritz, Benbassat, and Christenson (*see* Appeal Br. 14; *see also* Reply Br. 9). More particularly, Appellant argues that Christenson, upon which the Examiner relies, “only generally discusses tracking the location of a user with GPS,” and as such, “does not

contemplate using a security system at a work location to identify whether a user has entered the location,” as required by limitation [n] of exemplary independent claim 1, and similarly recited by independent claims 16 and 29 (*see* Appeal Br. 14; *see also* Reply Br. 9).

However, we agree with the Examiner that Christenson discloses the argued feature (*see* Ans. 6 (citing Christenson, col. 6, ll. 4–27)). In this regard, Christenson discloses

information may be available to the conference resource reservation system that will allow the conference resource reservation system to determine the projected location of the conference coordinator. Such technologies include the location at which the conference coordinator last “swiped” a security badge on a particular campus, RFID information integrated into a security badge of the conference coordinator, or the location at which the conference coordinator last used electronic equipment that was or is being tracked by the conference resource reservation system.

(Christenson, col. 6, ll. 4–27; *cf.* Spec. 26).

We also are not persuaded by Appellant’s argument that the Examiner erred in rejecting independent claims 1, 16, and 29 under 35 U.S.C. § 103(a) as unpatentable over the combination of Lakritz, Benbassat, and Christenson because Christenson fails to disclose or suggest “determining an allocation of one of the plurality of free spaces to the user in the work location in response to the identifying of the user in the work location,” as recited by limitation [o] of exemplary independent claim 1, and similarly recited by independent claims 16 and 29 (*see* Appeal Br. 14; *see also* Reply Br. 9).

Instead, we agree with the Examiner that Christenson discloses the argued limitation (*see* Ans. 6 (citing Christenson, col. 6, l. 16 – col. 7, l. 16)). In this regard, we note that Christenson discloses

the conference resource reservation system uses the projected locations identified above to select optimal fixed resources. The optimal fixed resources are those that satisfy, or substantially satisfy, one or more of the conference resource criterion specified by the conference coordinator and/or administrator. For example, if the conference resource reservation system determines that the conference coordinator will be attending a meeting on the 12th floor of Building 21 of the San Jose campus, the optimal conference room may be the conference room that satisfies any criterion given by the conference coordinator (e.g., capacity of ten persons) that is nearest to the 12th floor of Building 21 of the San Jose campus.

(Christenson, col. 6, ll. 28–40).

In view of the foregoing, we sustain the Examiner's rejection of independent claims 1, 16, and 29 under 35 U.S.C. § 103(a). We also sustain the Examiner's rejections of dependent claims 2–5, 8–11, 13, 17–20, 23–26, and 28, which are not argued separately except based on their dependence on independent claims 1 and 16 (*see* Appeal Br. 15; *see also* Reply Br. 10).

#### DECISION

The Examiner's rejection of claims 1–5, 8–11, 13, 16–20, 23–26, 28, and 29 under 35 U.S.C. § 112, first paragraph, is sustained.

The Examiner's rejections of claims 1–5, 8–11, 13, 16–20, 23–26, 28, and 29 under 35 U.S.C. § 103(a) are sustained.

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