UNITED STATES PATENT AND TRADEMARK OFFICE

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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 CHRISTOPHER J. DAWSON, LYDIA M. DO,
BRIAN M. O'CONNELL, and JAMES W. SEAMAN

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Appeal 2015-005479
Application 13/106,380
Technology Center 2400

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Before JEFFREY S. SMITH, JON M. JURGOVAN, and
AARON W. MOORE, *Administrative Patent Judges.*

MOORE, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants[1] appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 1, 3–9, and 11–20, which are all of the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

THE INVENTION

The application is directed to "a dynamic, user-driven service catalog based on real-time inputs by an end-user based on an automated evaluation process." (Abstract.) Claim 1, reproduced below, is illustrative:

> 1. A system for implementing a dynamic, user-driven service catalog comprising:
>
> at least one processing unit;
>
> a computer-readable memory operably associated with the at least one processing unit; and
>
> a catalog update tool storable in the computer-readable memory and executable by the at least one processing unit, the catalog update tool comprising program instructions, stored on the computer readable memory for execution by the catalog update tool and the at least one processing unit, to:
>
> > receive a request to add a service to a service catalog, the request received directly from an end-user of the service catalog without pre-approval from another user;
> >
> > evaluate whether the service can be added to the service catalog based on an analysis of system-integrated criteria;
> >
> > determine a cost for fulfilling the request to add the service to the service catalog; and

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[1] Appellants identify International Business Machines Corporation as the real party in interest. (*See* App. Br. 2.)

> add the service to the service catalog based on the analysis of system-integrated criteria and the cost for fulfilling the request to add the service to the service catalog.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Putt	US 2003/0097296 A1	May 22, 2003
Soares et al.	US 2005/0044099 A1	Feb. 24, 2005
Tate et al.	US 2006/0218127 A1	Sept. 28, 2006
Shestakov et al.	US 2007/0038566 A1	Feb. 15, 2007
Koretz et al.	US 2008/0195506 A1	Aug. 14, 2008
Smith et al.	US 7,467,126 B2	Dec. 16, 2008

Edson Manoel and Sebastien Fardel, *Implementation Best Practices for IBM Tivoli License Manager* (IBM International Technical Support Organization, May 2006)

THE REJECTIONS

1. Claims 1, 4, 5, 9, 12, and 15–18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Soares and Tate. (*See* Final Act. 5–11.)

2. Claims 3 and 11 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Soares, Tate, and Shestakov. (*See* Final Act. 11–12.)

3. Claims 6, 13, and 19 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Soares, Tate, and Koretz. (*See* Final Act. 12–14.)

4. Claims 7 and 20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Soares, Tate, and Putt. (*See* Final Act. 14–15.)

5.   Claim 8 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Soares, Tate, and Smith, and Manoel. (*See* Final Act. 15–16.)

6.   Claim 14 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Soares, Tate, and Manoel. (*See* Final Act. 16–17.)

7.   The Answer newly rejected claims 1, 3–9, and 11–20 under 35 U.S.C. § 101 on the grounds that the claimed invention is directed to non-statutory subject matter. (*See* Ans. 2–7.)

APPELLANTS' CONTENTIONS

Appellants argue the rejections are in error for the following reasons:

1.   Soares and Tate fail to disclose, either alone or in combination, the "receive . . . ," "evaluate . . . ," "determine . . . ," and "add . . ." steps because "neither reference focuses on actually adding a service to a service catalog, and defining steps/requirements for doing so." (App. Br. 9.)

2.   "Soares fails to disclose, *inter alia*, determining a cost for fulfilling the request to add the service to the service catalog." (App. Br. 10.)

3.   Tate does not disclose "adding the service to the service catalog based on the analysis of system integrated criteria and the cost for fulfilling the request to add the service to the service catalog" because "Tate provides an approach for end users to request/subscribe a service for use from the service catalog." (App. Br. 11.)

4.   With respect to the Section 101 rejection, "the claimed invention is not drawn to an abstract idea and does not foreclose upon an area of impermissible activity." (Reply 3.)

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ANALYSIS

Regarding their first contention, Appellants argue that "Soares, e.g., teaches a 'service to be brought into existence'" and "further teaches an approval workflow for acquiring and installing a software step," but that "this fails to specifically disclose *a request to add a service to the service catalog* (emphasis added)." (App. Br. 9–10.) The Examiner finds that:

> Soares teaches a computerized process to receive end user orders for IT service, the process which executes on a computer, generates appropriate workflow and gathers statistics about cost to implement the IT service, the process receives and stores user input indicating a desire to create a new service (Soares: Fig. 3A, step 62; paragraph [0036]), Soares further teaches an approval workflow that eliminates the approval from another user if the cost to purchase hardware equipment is within a preset threshold (paragraphs [0115] and [0121]), furthermore this approval workflow is one of a step in a series of step to add a service to the service catalog. In other words, the approval workflow is part of the process of adding a service to a service catalog, hence Soares teaches both of the above-argued limitations.

(Ans. 8.) Appellants respond that "to the extent that Soares shows an approval policy, the policy is at best based on a selection of conditions that must be fulfilled or if unfulfilled is subject to user" and that "[a]s such, Soares fails to teach a request from an end-user that is received without pre-approval from another user." (Reply Br. 4–5.)

We agree with the Examiner. Soares states in paragraph 115 that the service action "*may* also point to an approval workflow," meaning that it also may not, and paragraph 121 specifically describes a "no approval" policy where "the computer would automatically approve implementation." This *does* teach or suggest "a request from an end-user that is received without preapproval from another user."

Regarding their second contention, Appellants argue that "Soares fails to disclose, *inter alia*, determining a cost for fulfilling the request to add the service to the service catalog" because the cited portions of Soares "merely provide[] a general discussion of assigning cost to a service." (App. Br. 10.) Citing paragraphs 43–44 and 51, the Examiner responds that "Soares teaches when a user requests for a new service, the cost to fulfill the service is defined" and "furthermore the data structure that defines a service includes cost information." (Ans. 8–9.) Consistent with the Specification,[2] we interpret the scope of "determine a cost for fulfilling the request to add the service to the service catalog" to encompass that the cost for providing the service is determined in assessing whether to add the service to the catalog. (*See* Spec. ¶ 24 ("Cost engine 158 provides the function of determining whether the cost of a request/transaction exceeds a predetermined threshold resulting in an unprofitable outcome (e.g., [cost of request] < [revenue] - [operating costs]).").[3]) In view of that construction, we agree with the Examiner that the cited portions of Soares teach or suggest the claimed feature. (*See* Soares ¶ 51 ("The data structure that defines a service includes . . . cost information which are constants or formulas which define the cost of creating and/or using the service. . . .").)

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[2] *See In re American Academy of Science Tech. Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004).

[3] The language "to add the service to the service catalog" was added by amendment on May 28, 2013. The original disclosure does not describe determining a cost of making an addition to a catalog, the amendment did not identify any support, and page 3 of the Appeal Brief cites paragraph 23 of the Specification, which does not describe any costs, much less calculating a cost associated with modifying a catalog.

Regarding their third contention, Appellants argue that "Soares fails to disclose . . . adding the service to the service catalog based on the analysis of system integrated criteria and the cost for fulfilling the request to add the service to the service catalog" and that Tate "fails to cure this deficiency, as Tate provides an approach for end users to request/subscribe a service for use *from* the service catalog." (App. Br. 11.) We agree with the Examiner that Tate's disclosure of the consideration of technical parameters that may include a minimum amount of available resources (¶ 20) would have taught or suggested to one of skill in the art adding a service to a catalog based on the analysis of system integrated criteria. In other words, we agree that it would have been obvious to determine whether a service could, in fact, be provided before adding it to a catalog.

For these reasons, we sustain the rejections of claims 1, 3–9, and 11–20 under 35 U.S.C. § 103(a).

We do not reach a decision on the 35 U.S.C. § 101 rejection because our decision on the 35 U.S.C. § 103(a) rejection is dispositive.

DECISION

The rejections of claims 1, 3–9, and 11–20 are 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