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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARK A. COLLINS, MANOJ GUJARATHI, and
RAVI D. KUMAR

Appeal 2015-005592
Application 12/493,324
Technology Center 2100

Before ST. JOHN COURTENAY III, THU A DANG, and
JOHN D. HAMANN, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–3, 6–10, 13, and 14. Claims 4, 5, 11, and 12 are cancelled. Claims 15–30 are withdrawn. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Invention

The disclosed and claimed invention on appeal “relates to information handling systems and more particularly to surrogate management capabilities for heterogeneous systems management support.” (Spec. ¶ 1).

Representative Claim

1. A method for performing heterogeneous systems management comprising:

configuring, via a surrogate systems management system, creation of a suite of systems management functionality the surrogate systems management system executing via a proxy environment;

hosting a vendor provided management console onsite, within a firewall, via a services appliance, the hosting being performed virtually, the services appliance comprising a Remote Monitoring and Management appliance; and,

creating correlating metadata by leveraging analytics intelligence of the services appliance, the correlating metadata tying the vendor provided management console to a respective vendor provided management mechanism; and wherein

an operator managing services operations can launch the console remotely from a managed services network operations center (NOC), the vendor provided management console being virtualized on the services appliance;

the surrogate systems management system provides a dynamically tiered services library, the dynamically tiered services library comprising an inventory collection and dynamic analytics portion, the inventory collection and dynamic analytics portion of the surrogate systems management system creating a correlation between a vendor system and systems management offering.

Rejection

Claims 1–3, 6–10, 13, and 14 are rejected under 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of Fitzgerald (US 2008/0134178 A1; June 5, 2008) and Patrick (US 2002/018869 A1; Dec. 12, 2002).

Grouping of Claims

We decide the appeal of all claims rejected under § 103 on the basis of representative claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

ANALYSIS

We have considered all of Appellants' arguments and any evidence presented. We find Appellants' arguments unpersuasive for the reasons discussed *infra*. We adopt as our own: (1) the findings and legal conclusions set forth by the Examiner in the action from which this appeal is taken, and (2) the findings, legal conclusions, and explanations set forth in the Answer in response to Appellants' arguments (Ans. 2–7). We highlight and address specific findings and arguments for emphasis in our analysis below.

Rejection of Independent Claim 1 under 35 U.S.C. § 103(a)

Issue: Under 35 U.S.C. § 103(a), did the Examiner err in finding the cited combination of Fitzgerald and Patrick would have taught or suggested the limitations recited by Appellants on pages 4 and 5 of the principal Brief?

At the outset, we find the Examiner provides sufficiently detailed mappings of the claim terms to the corresponding features found in the cited references to support the prima facie case of obviousness. The Federal Circuit guides, “the prima facie case is merely a procedural device that enables an appropriate shift of the burden of production.” *Hyatt v. Dudas*, 492 F.3d 1365, 1369 (Fed. Cir. 2007).

[A]ll that is required of the office to meet its prima facie burden of production is to set forth the statutory basis of the rejection and the reference or references relied upon in a sufficiently articulate and informative manner as to meet the

notice requirement of [35 U.S.C.] § 132. As the statute itself instructs, the examiner must “notify the applicant,” “stating the reasons for such rejection,” “together with such information and references as may be useful in judging the propriety of continuing prosecution of his application.”

In re Jung, 637 F.3d 1356, 1363 (Fed. Cir. 2011).

Here, the Examiner’s burden of establishing a prima facie case is met by “adequately explain[ing] the shortcomings [the USPTO] perceives so that the applicant is properly notified and able to respond.” *Hyatt*, 492 F.3d at 1370.

In reviewing the record, we find the Examiner has met the notice requirement of 35 U.S.C. § 132 by providing a detailed statement of rejection with sufficiently clear mappings and explanations. (Final Act. 3–7).

We note it is only “when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection” that the prima facie burden has not been met and the rejection violates the minimal requirements of 35 U.S.C. § 132. *Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990). Such is not the case here.

In traversing the Examiner’s rejection of representative claim 1, we note Appellants: (1) reproduce paragraphs 30 and 43 of the Fitzgerald reference, (2) merely assert the claim limitations are not taught or suggested by Fitzgerald or Patrick, and (3) fail to respond to the detailed, specific findings set forth in the rejection of claim 1 (Final Act. 3–7), wherein the Examiner maps the claim terms to corresponding features found in the cited references. (*Id.*).

In the Answer, the Examiner echoes our assessment regarding the conclusory form of Appellants’ arguments:

The Examiner notes that Appellant's arguments fail to comply with 37 CFR 1.111 (b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Instead, the Appellant makes a general allegation that the prior art of record doesn't teach various claim limitation that are reproduced on pages 4 and 5 of the Appeal Brief. The Appellant does not provide any sort of discussion or reasoning explaining how the prior art does not allegedly teach the limitations in question.

(Ans. 2–3, “Response to Arguments”).

Because Appellants fail to provide any evidentiary basis to support their assertions, we find Appellants’ arguments are merely conclusory, and do not meet the burden of showing error in the Examiner’s prima facie case of obviousness. (App. Br. 3–5). To the extent Appellants reproduce paragraphs 30 and 43 of Fitzgerald (App. Br. 3–4), Appellants fail to specifically explain *why* the Examiner has erred. Mere conclusory statements that are unsupported by factual evidence are entitled to little probative value. *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984).

Therefore, we agree with the Examiner (Ans. 2–3) that Appellants have failed to substantively traverse the merits of the rejection (the Examiner’s legal conclusion of obviousness, based on underlying factual findings) by specifically explaining *why* the Examiner erred. Under our PTAB procedural rule: “A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.” 37 C.F.R. § 41.37(c)(1)(iv).¹

¹ See *In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (“[W]e hold that the Board reasonably interpreted Rule 41.37 to require more substantive

The Examiner additionally concludes the claim language is very broad. (Ans. 3).² We agree, and note Appellants’ liberal use of claim terms such as: “surrogate systems management system . . . a suite of systems management functionality . . . a vendor provided management console . . . a *services appliance*, . . . , the *services appliance* comprising a *Remote Monitoring and Management appliance* . . . creating correlating metadata by leveraging analytics intelligence of the services appliance . . . a managed services network operations center (NOC) . . . a dynamically tiered services library . . . comprising *an inventory collection* and *dynamic analytics portion*, the inventory collection and dynamic analytics portion of the surrogate systems management system creating a correlation between a vendor system and systems management offering.” (Claim 1, emphasis added).

In the Briefs, Appellants have not pointed to definitions of these terms, nor have Appellants substantively distinguished the recited claim language over the specific corresponding features found by the Examiner in the references. (Final Act. 3–7).

It is the Appellants’ burden to precisely define the invention, not the PTO’s. *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997). Although a patent applicant is entitled to be his or her own lexicographer of patent claim

arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.”).

² Because “applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee.” *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (internal citation omitted).

terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions in the specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).³

Because Appellants essentially repeat the same pattern of argument in the Reply Brief (merely reciting the claim language and asserting it is not taught by the cited references), we find Appellants have not met their burden of coming forward with evidence or argument to rebut the Examiner’s legal conclusion of obviousness. We note that arguments not made are considered waived. *See* 37 C.F.R. § 41.37(c)(1)(iv); *see also In re Watts*, 354 F.3d 1362, 1368 (Fed. Cir. 2004).

If an Appellant fails to present arguments on a particular issue – or, more broadly, on a particular rejection – the Board will not, as a general matter, unilaterally review those uncontested aspects of the rejection. *Ex parte Frye*, No. 2009-006013, 2010 WL 889747, at *4 (BPAI Feb. 26, 2010) (precedential) (citing, *inter alia*, *Hyatt v. Dudas*, 551 F.3d 1307, 1313–14 (Fed. Cir. 2008) (the Board may treat arguments Appellant failed to make for a given ground of rejection as waived)).

³ Our reviewing “court has repeatedly ‘cautioned against limiting the claimed invention to preferred embodiments or specific examples in the specification.’” *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1346-47 (Fed. Cir. 2015) (quoting *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1328 (Fed. Cir. 2002)).

Therefore, after considering the totality of the record, including the evidence relied on by the Examiner, with due consideration to the insufficiency of the arguments presented, we find Appellants have not shown error in the Examiner's prima facie case of obviousness. Therefore, on this record, we find a preponderance of the evidence supports the Examiner's underlying factual findings and ultimate legal conclusion of obviousness regarding representative claim 1.

Accordingly, we sustain the rejection of representative claim 1, and the rejection of the associated grouped claims, which fall with claim 1. *See Grouping of Claims, supra.*

Reply Brief

To the extent Appellants may advance new arguments in the Reply Brief (Reply Br. 1–2) not in response to a shift in the Examiner's position in the Answer, we note arguments raised in a Reply Brief that were not raised in the Appeal Brief or are not responsive to arguments raised in the Examiner's Answer will not be considered except for good cause. *See* 37 C.F.R. § 41.41(b)(2).

DECISION

We affirm the Examiner's rejection of claims 1–3, 6–10, 13, and 14 under 35 U.S.C. § 103(a).

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 41.50(f).

AFFIRMED