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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BHUSHAN P. JAIN, SANDEEP R. PATIL, DIRK PFEIFFER,
SRI RAMANATHAN, GANDHI SIVAKUMAR, and
MATTHEW B. TREVATHAN

Appeal 2015-006582¹
Application 13/550,830
Technology Center 2400

Before JEAN R. HOMERE, JON M. JURGOVAN, and
KARA L. SZPONDOWSKI, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Appellants identify the real party in interest as International Business Machines. App. Br. 2.

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–9, 11–23, and 25–27, which constitute all of the claims pending in this appeal. Claims App'x. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellants' Invention

Appellants invented a network information system (NIS- 410) for providing authorized clients (445) with secured access to requested objects (497) stored in a library (465) on behalf of a tenant (415). Spec. ¶¶ 17, 65, Fig. 4. In particular, upon receiving the client's request to access an instance of an object, a security processor (485) stored within the system memory (28) compares a security code in the client's request to security map (490) data provided by the tenant (415) to determine whether the requested access is authorized by the tenant (415). *Id.* If the comparison results in a match, the request is granted. Otherwise, the security processor (485) denies the request. *Id.* at ¶ 75.

Illustrative Claim

Independent claim 1 is illustrative, and read as follows:

1. A method, comprising:

passing an instance of an object, invoked by a user, to a memory device within a system memory at a hardware layer of a network information system, the object being one of a plurality of objects hosted for a tenant of a network information service;

determining, by a processing unit within the system memory, that storage of the object in the memory device is

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authorized by the tenant based on a security map provided by the tenant and accessible by the processing unit within system memory; and

preventing, by the processing unit, storage of the instance in the memory device based on the result of the determining.

Prior Art Relied Upon

Masurkar	US 7,730,523 B1	June 1, 2010
Harris et al. (“Harris”)	US 8,180,986 B2	May 15, 2012
Barck et al. (“Barck”)	US 8,261,091 B2	Sept. 4, 2012

Rejections on Appeal

Claims 1–9, 11–23, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Masurkar and Barck.

Claims 26 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Masurkar, Barck, and Harris.

ANALYSIS

We consider Appellants’ arguments *seriatim* as they are presented in the Appeal Brief, pages 5–30, and the Reply Brief, pages 2–24.² We have reviewed the Examiner’s rejection in light of Appellants’ arguments. We are unpersuaded by Appellants’ contentions. Except as indicated

² Rather than reiterate the arguments of Appellants and the Examiner, we refer to the Appeal Brief (filed November 21, 2014), the Reply Brief (filed June 29, 2015), and the Answer (mailed April 28, 2015) for the respective details. We have considered in this decision only those arguments Appellants actually raised in the Briefs. Any other arguments Appellants could have made but chose not to make in the Briefs are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

hereinbelow, we adopt as our own the findings and reasons set forth in the Examiner's Answer in response to Appellants' Appeal Brief, and in the Final Action. *See* Ans. 2–13; Final Act. 2–16. However, we highlight and address specific arguments and findings for emphasis as follows.

Appellants argue the proposed combination of Masurkar and Barck does not render claim 1 unpatentable. App. Br. 5–13; Reply Br. 2–10. First, Appellants argue that, as admitted by the Examiner, Masurkar does not teach “determining, by a processing unit within the system memory, that storage of the object in the memory device is authorized by a tenant based on a security map provided by the tenant and accessible by the processing unit within system memory”, and “preventing by the processing unit storage of the instance in the memory device based on the result of the determining.” App. Br. 7. Further, Appellants argue although Barck discloses a security processor within a memory for securely performing functions on secure tokens for an external processor, Barck does not cure the noted deficiencies in Masurkar because Barck does not disclose a tenant, let alone a tenant providing a security map to make such a determination. App. Br. 7–9 (citing Barck Abstr., 2:54–55, 5:8–22). These arguments are not persuasive.

As correctly noted by the Examiner, Appellants' arguments are tantamount to an individual attack against the Masurkar and Barck references.³ Ans. 2–4. In particular, the Examiner relies upon Masurkar's

³ One cannot show non-obviousness by attacking the references individually where the rejections are based on combinations of references. *In re Merck*

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teaching of a security map (containing UserID, Password, Business Unit ID, roles and privileges for all companies sharing resources inside the Customer Applications Operations Center (“CAOC”)) provided by a database to an application web server to determine whether a client’s access request to an object should be granted, as well as to determine the client’s access rights associated with the object. *Id.* (citing Masurkar 10:55–11:2, tables 1 and 2). Further, the Examiner relies upon Barck’s teaching of a security processor within a system memory wherein the processor utilizes a client’s token in determining whether the client is authorized to access a requested object, as well as the extent of the client’s access. *Id.* (citing Barck 4:17–37). We agree with the Examiner that the incorporation of the cited Barck’s teaching into Masurkar’s web server would predictably result in a centralized security processor within a system memory that compares a user’s token with information on a security map provided by a tenant database to thereby determine whether to grant a client’s access request to an object, as well as the limitations associated with the grant of access. Ans. 4.

Additionally, we note Appellants argue for the first time in the Reply Brief that Masurkar discloses a security map (table 1 and 2) for authentication and authorization service at the upper level portal layer, as opposed to the lower hardware level layer recited in the claim. Reply Br. 5–7. Because Appellants’ belated arguments presented in the Reply Brief are not in response to new evidence or arguments proffered by the Examiner in

& Co., 800 F.2d 1091, 1097 (Fed. Cir. 1986). *See also In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

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the Answer, those arguments are waived absent a showing of good cause for their late consideration. 37 C.F.R. § 41.41(b)(2). In particular, we find no justification on this record as to why Appellants could not have raised earlier the arguments that the cited arguments. We have held that new arguments in the Reply Brief are inappropriate and will not be considered. *See Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (informative) (“[T]he reply brief [is not] 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.”).

Second, Appellants argue incorporating Masurkar’s application web server into Barck’s memory module would render Masurkar unsatisfactory for its intended purpose of providing a “high level process for . . . inter-network authentication.” App. Br. 12. Accordingly, Appellants submit that Barck’s security processor would be repurposed to function as an application web server. *Id.* These arguments are not persuasive.

At the outset, we note Appellants have mischaracterized the proposed combination of Masurkar and Barck. As noted above, the Examiner proposes to incorporate Barck’s security processor into Masurkar’s server, and not the other way around. Therefore, the argument that the processor would be repurposed as a web server is misplaced. Next, we remind Appellants the argument that a proposed combination of references would render one of the references unsuitable for its intended purpose or would change its principle of operation is a teaching away argument. *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984) (The court

concluded that in effect, “French teaches away from the board’s proposed modification” because “if the French apparatus were turned upside down, it would be rendered inoperable for its intended purpose”). The Federal Circuit has held “[a] reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Kahn*, 441 F.3d 977, 990 (Fed. Cir. 2006) (quoting *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)).⁴ In this case, upon being incorporated into Masurkar’s web server, Barck’s processor would continue performing its original functions of authenticating clients, and authorizing access requests as prescribed by the security map. Likewise, Masurkar’s web server would continue performing its same functions, while being enhanced by the assistance of the security processor. We thus find nothing on this record that discourages, criticizes or otherwise discredits enhancing Masurkar’s web server as proposed by the Examiner. For at least the aforementioned reasons, we are not persuaded or error in the Examiner’s rejection of claim 1.

⁴ “If references taken in combination would produce a ‘seemingly inoperative device,’ . . . such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness.” *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1354 (Fed. Cir. 2001) (citation omitted); *see also In re ICON Health & Fitness, Inc.*, 496 F.3d 1374, 1382 (Fed. Cir. 2007) (“a reference teaches away from a combination when using it in that combination would produce an inoperative result,” but the obviousness analysis must account for “modifications that one skilled in the art would make to a device borrowed from the prior art”).

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Regarding the rejections of claims 2–9, 11–23, and 25–27, to the extent Appellants either did not present separate patentability arguments or reiterated substantially the same arguments as those previously discussed for patentability of claim 1 above, claims 2–9, 11–23, and 25–27 fall therewith. *See* 37 C.F.R. § 41.37(c)(1)(iv). Further, to the extent Appellants raised additional arguments for patentability of these claims (App. Br. 13–30), we find that the Examiner has rebutted in the Answer each and every one of those arguments by a preponderance of the evidence. Ans. 4–14. We adopt the Examiner’s findings and underlying reasoning, which we incorporate herein by reference. Because Appellants have failed to persuasively rebut the Examiner’s findings regarding the rejections of claims 2–9, 11–23, and 25–27, Appellants have failed to show error in the Examiner’s rejection of these claims.

DECISION

We affirm the Examiner’s obviousness rejections of claims 1–9, 11–23, and 25–27.

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