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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ALAN F. BABICH, MIKE A. MARIN, and MIMI P. VO

Appeal 2017-000669
Application 13/655,004¹
Technology Center 3600

Before ANTON W. FETTING, MICHAEL C. ASTORINO, and
BRUCE T. WIEDER, *Administrative Patent Judges*.

WIEDER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 1, 2, 5–10, 13–18, and 21–24. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

CLAIMED SUBJECT MATTER

Appellants' invention relates "to use of proxy objects for integration between a content management system and a case management system."
(Spec. ¶ 1.)

¹ According to Appellants, the real party in interest is International Business Machines Corporation. (Appeal Br. 3.)

Claims 1, 9, and 17 are the independent claims on appeal. Claim 1 is illustrative. It recites:

1. A method comprising:
 - designating, by a processor of a computer, a first content management system to store proxy objects for root case instance folders, real objects for documents, and real objects for other folders in a first folder sub-hierarchy;
 - designating, by the processor of the computer, a second content management system to store real objects for the root case instance folders, proxy objects for the documents, and proxy objects for the other folders in a second folder sub-hierarchy;
 - in response to receiving a first operation to modify one of 1) a real object for a document among the real objects for the documents and 2) a real object for a folder among the real objects for the other folders, having the first content management system to process the first operation; and
 - in response to receiving a second operation to modify a real object for a root case instance folder among the real objects for the root case instance folders, having the second content management system to process the second operation.

REJECTIONS

Claims 1, 2, 6, 7, 9, 10, 14, 15, 17, 18, 22, and 23 are provisionally rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1–24 of copending Application No. 14/060,091 (hereinafter “the ’091 application”).

Claims 8, 16, and 24 are provisionally rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1–24 of the ’091 application, and Peter Mell & Timothy Grance, *The NIST Definition of Cloud Computing (Draft)*, NIST Special Pub. 800-145 (Draft) (Jan. 2011) (hereinafter “Mell”).

Claims 1, 2, 5–10, 13–18, and 21–24 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 1, 5, 9, 13, 17, and 21 are rejected under 35 U.S.C. § 102(b) as anticipated by Cramer (US 5,946,685, iss. Aug. 31, 1999).

Claims 2, 6, 7, 10, 14, 15, 18, 22, and 23 are rejected under 35 U.S.C. § 103(a) as unpatentable in view of Cramer and Johnson (US 2006/0085412 A1, pub. Apr. 20, 2006).

Claims 8, 16, and 24 are rejected under 35 U.S.C. § 103(a) as unpatentable in view of Cramer and Mell.

ANALYSIS

*The provisional double patenting rejections
of claims 1, 2, 6, 7, 9, 10, 14, 15, 17, 18, 22, and 23*

Claims 1, 2, 6, 7, 9, 10, 14, 15, 17, 18, 22, and 23 are provisionally rejected on the ground of nonstatutory double patenting in view of the '091 application. (Final Action 4.) In particular, independent claims 1, 9, and 17 of the present application are rejected in view of claims 1, 17, and 9 of the '091 application.

Although the '091 Application refers to a case management system and external content repository rather than a first content management system and second content management system, the Examiner asserts that each of the above elements is merely a computer system programmed to perform and respond to remote procedure calls to add, modify, update, link, and delete content. As such, it would have been obvious to a person having ordinary skill in the art at the time of the invention to refer to the programmed computers by any designated title as this would not have affected or impacted the functionality performed by the computer

(*Id.* at 6.)

Appellants argue that “the claims of the present application recite . . . designating a first content management system . . . and recite designating a second content management system. . . . In contrast, the claims of the [’091 application] recite . . . detecting a case creation event . . . to cause creation of a case within the case management system.” (Appeal Br. 19.) Specifically, Appellants argue:

The rejection further alleges that a “case management system” is equivalent to a “content management system.” (Final Office Action dated August 25, 2015, page 5). However, Appellant teaches that these two types of systems are distinct and different systems that perform distinct and different functions (e.g., one manages cases, and the other manages “content” that may be associated with the cases).

(*Id.*)

The Examiner answers that “[t]here is no explanation in Appellant’s [sic] brief regarding why the difference between ‘cases’ and ‘content’ amounts to a technical, patentable distinction, rather than a purely semantic one.” (Answer 65.)

Appellants’ Specification discloses that “[c]ontent management systems manage objects (such as documents, folders, or other types of objects)” (Spec. ¶ 2), that “[p]rocess management systems manage workflow processes and may use a content management system to store and retrieve objects, as well as, to maintain workflow queues” (*id.* ¶ 3), and that “[a] case management system uses both a process management system and a content management system in order to facilitate the processing of cases . . . by human case workers” (*id.* ¶4). Thus, Appellants’ argument relates to the

type of information, e.g., documents or workflow, being managed by the system.

“Obviousness-type double patenting . . . requires rejection of an application claim when the claimed subject matter is not patentably distinct from the subject matter claimed in a commonly owned patent.” *In re Berg*, 140 F.3d 1428, 1431 (Fed. Cir. 1998). “Generally, a ‘one-way’ test has been applied to determine obviousness-type double patenting. Under that test, the examiner asks whether the application claims are obvious over the patent claims.” *Id.* at 1432. Here, we agree with the Examiner. Appellants have not persuasively argued *why* the Examiner erred in determining that the claims of the present application would have been obvious over the claims of the ’091 application. Specifically, Appellants have not persuasively argued that the asserted difference in the type of information at issue in a “content management system” and in a “case management system” shows that the subject matter of claim 1 of the present application is patentably distinct from the subject matter of claim 1 of the ’091 application.

Therefore, Appellants have not persuasively shown that the Examiner erred in provisionally rejecting claim 1 on the ground of double patenting. Because Appellants do not separately argue claims 2, 6, 7, 9, 10, 14, 15, 17, 18, 22, and 23, these claims fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The provisional double patenting rejection of claims 8, 16, and 24

Claims 8, 16, and 24 are provisionally rejected on the ground of nonstatutory double patenting in view of the ’091 application and Mell. (Final Action 9.) Appellants do not present any arguments in response.

Therefore, we summarily affirm the provisional rejection of claims 8, 16, and 24 on the ground of nonstatutory double patenting.

The § 101 rejection

“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101. Section 101, however, “contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)).

Alice applies a two-step framework, earlier set out in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice*, 134 S. Ct. at 2355.

Under the two-step framework, it must first be determined if “the claims at issue are directed to a patent-ineligible concept.” *Id.* If the claims are determined to be directed to a patent-ineligible concept, then the second step of the framework is applied to determine if “the elements of the claim . . . contain[] an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Id.* at 2357 (citing *Mayo*, 566 U.S. at 72–73, 79).

As an initial matter, we note that all claims are argued together. Therefore, the claims will stand or fall together. *See* 37 C.F.R. § 41.37(c)(1)(iv). We select claim 1 as representative.

With regard to step one of the *Alice* framework, the Examiner determines that the claims are directed to “the abstract idea of managing data by executing predefined tasks according to rules, with the intended use or purpose of data redundancy or synchronization between multiple computers.” (Final Action 12; *see also id.* at 14.)

Appellants disagree and argue that the claims are “directed to real-time processing and partitioning of responsibility between different devices, where specifically as claimed each content management system processes different operations to modify the respective different real objects stored at the respective devices.” (Appeal Br. 23–24.)

Under step one of the *Alice* framework, we “look at the ‘focus of the claimed advance over the prior art’ to determine if the claim’s ‘character as a whole’ is directed to excluded subject matter.” *Affinity Labs of Texas, LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016) (quoting *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016)). Moreover, because the focus of the analysis is on the claim as a whole, a claim may incorporate multiple abstract ideas, but that “does not render the claim non-abstract.” *RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1327 (Fed. Cir. 2017).

The Specification provides evidence as to what the claimed invention is directed. In this case, the Specification discloses that the claimed invention relates “to use of proxy objects for integration between a content management system and a case management system.” (Spec. ¶ 1.) Claim 1

recites “[a] method comprising: designating . . . a first content management system to store proxy objects . . . and real objects,” “designating . . . a second content management system to store real objects . . . and proxy objects,” “in response to receiving a first operation to modify one of” the real objects stored in the first management system, “having the first . . . management system to process the first operation,” “and in response to receiving a second operation to modify one of” the real objects stored in the second management system, “having the second . . . management system to process the second operation.”

Although we and the Examiner describe, at different levels of abstraction, to what the claims are directed, it is recognized that “[a]n abstract idea can generally be described at different levels of abstraction.” *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240 (Fed. Cir. 2016). In this case, that does not “impact the patentability analysis.” *See id.* at 1241. Moreover, in this case, as in *Alice*, we need not labor to delimit the precise contours of the “abstract ideas” category. It is enough to recognize that there is no meaningful distinction in the level of abstraction between the concept of using proxy objects to integrate between two systems, and creating shadow records held independently by separate institutions, adjusting shadow records as transactions are made, and issuing related instructions, which the Court determined amount[s] to nothing more than “electronic record keeping—one of the most basic functions of a computer.” *Alice*, 134 S. Ct. at 2359; *see also id.* at 2352 n.2. Therefore, we are not persuaded that the Examiner erred in determining that the claims are directed to an abstract idea, i.e., “the abstract idea of managing data by executing predefined tasks according to rules, with the intended use or purpose of data

redundancy or synchronization between multiple computers.” (See Final Action 12; *see also id.* at 14.)

Nonetheless, Appellants argue that “Appellant’s [sic] claimed subject matter is not directed to an abstract idea to the exclusion of others.” (Appeal Br. 22.) We understand this to be an argument rooted in a concern for preemption, i.e., that the claims are patent-eligible because they do not preempt every application of the abstract idea. We do not find this argument persuasive of error. Preemption is not a separate test.

To be clear, the proper focus is not preemption *per se*, for some measure of preemption is intrinsic in the statutory right granted with every patent to exclude competitors, for a limited time, from practicing the claimed invention. *See* 35 U.S.C. § 154. Rather, the animating concern is that claims should not be coextensive with a natural law, natural phenomenon, or abstract idea; a patent-eligible claim must include one or more substantive limitations that, in the words of the Supreme Court, add “significantly more” to the basic principle, with the result that the claim covers significantly *less*. *See Mayo* 132 S. Ct. at 1294 [566 U.S. at 72–73].

CLS Bank Int’l v. Alice Corp. Pty. Ltd., 717 F.3d 1269, 1281 (Fed. Cir. 2013) (Lourie, J., concurring), *aff’d*, 134 S. Ct. 2347 (2014). Moreover, “[w]here a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, as they are in this case, preemption concerns are fully addressed and made moot.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015). In other words, “preemption may signal patent ineligible subject matter, [but] the absence of complete preemption does not demonstrate patent eligibility.” *Id.*

We now look to step two of the *Alice* framework which has been described “as a search for an ‘ “inventive concept” ’—*i.e.*, an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Alice*, 134 S. Ct. at 2355 (citing *Mayo*, 566 U.S. at 72–73).

The Examiner determines that “none of the claim limitations recite any improvement to another technology or technical field [or] an improvement to the functioning of the computer itself.” (Final Action 14.)

Appellants disagree and argue that “Appellant [sic] improves computing technology itself by improving partitioning of responsibility between two content management systems, as claimed.” (Appeal Br. 22.) Specifically, Appellants argue that the claims “amount to significantly more than the alleged exception, by specifically reciting that the claimed programmed processor/process performs real-time processing by having operations to modify the respective real objects managed by the different content repositories processed by the respective different content repositories.” (*Id.* at 23.)

As an initial matter, we note that claim 1 does not recite performing “real-time processing.” Claim 1 is silent on the temporal relation between, e.g., “receiving a first operation” and “process[ing] the first operation.” Therefore, we do not find the argument persuasive of error.

With regard to Appellants’ more general argument that the claimed invention “improves computing technology itself by improving partitioning of responsibility between two content management systems” (*id.* at 22), we are not persuaded of error. Appellants do not point to anything in the Specification or elsewhere to support the attorney argument that the claimed

method “improves computer technology.” Instead, Appellants’ argument appears to be based on the assertion that “[t]here has not been shown a previous or conventional approach to solving this technological real-time problem of partitioned responsibility.” (*Id.* at 21.)

However, even if the claimed techniques are “[g]roundbreaking, innovative, or even brilliant,” that is not enough for patent eligibility. *Ass’n for Molecular Pathology*, 569 U.S. at 591. “The ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.” *Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981).

Therefore, we are not persuaded that the Examiner erred in rejecting claim 1 under § 101. Claims 2, 5–10, 13–18, and 21–24 fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The § 102(b) rejection of claims 1, 5, 9, 13, 17, and 21

Cramer discloses a “global mount mechanism [that] mounts a new file system resource into the global name space in a coherent manner such that the new file system resource is mounted at the same mount point concurrently in each node.” (Cramer, Abstract.) Figure 8D of Cramer is shown below:

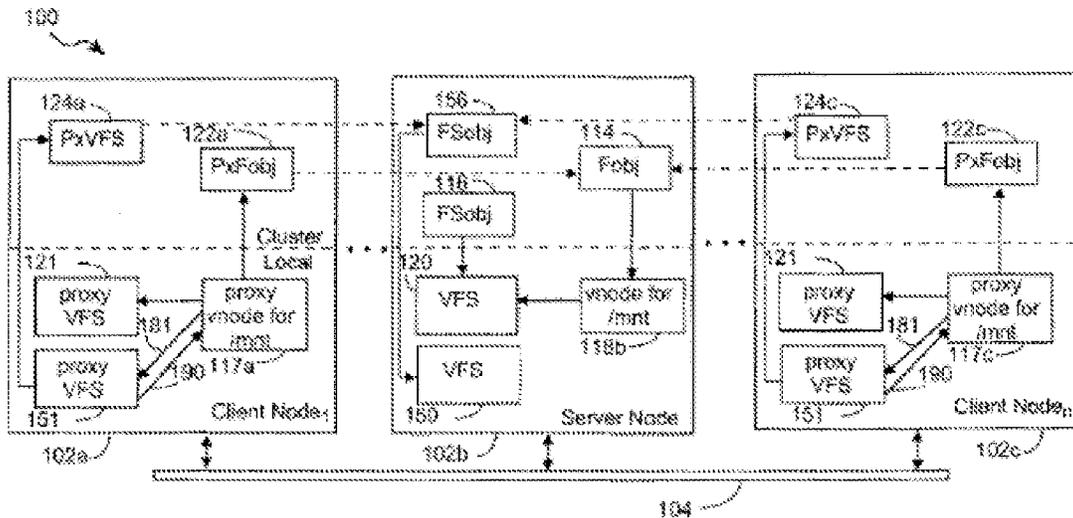


FIGURE 8D

Figure 8D illustrates an example of the steps used by a global mount mechanism to mount a new file system resource into a global name space. (*Id.* at col. 3, ll. 3–4 and col. 2, ll. 65–67.)

Cramer also discloses that

[i]n the case where the client and server computer are the same node, the client node **102a** will have a file system object (FSobj) **116** and a file object (Fobj) **114** for a file system resource when the client node **102a** is acting as the sever [sic] for the file system resource and will have proxy data structures when the client node **102a** is acting as a client for the resource. The proxy file object **122** contains an object reference to the associated file object **114** and the proxy file system object **122** contains an object reference to the associated file system object **116**.

(*Id.* at col. 4, ll. 1–10.)

The Examiner finds:

Because Cramer (as cited above) discloses that each node can act as either a client or server depending on the file system

resource, and that a node can be a client (with respect to proxy objects) and server (with respect to real objects) simultaneously, a person having ordinary skill in the art would recognize that the system shown in Figure 8D may have an alternate configuration. In the alternate configuration, proxy VFS 151 in node 102a (i.e., “Client Node₁”) could be swapped with VFS 150 in node 102b (i.e., “Server Node”) making node 102a the server node for VFS 150 and node 102b the client node for corresponding proxy VFS 151.

(Final Action 20.) In view of the above, “[t]he Examiner . . . create[s] for reference a simplified alternate of Figure 8D below to represent this alternate state of the system . . . :”

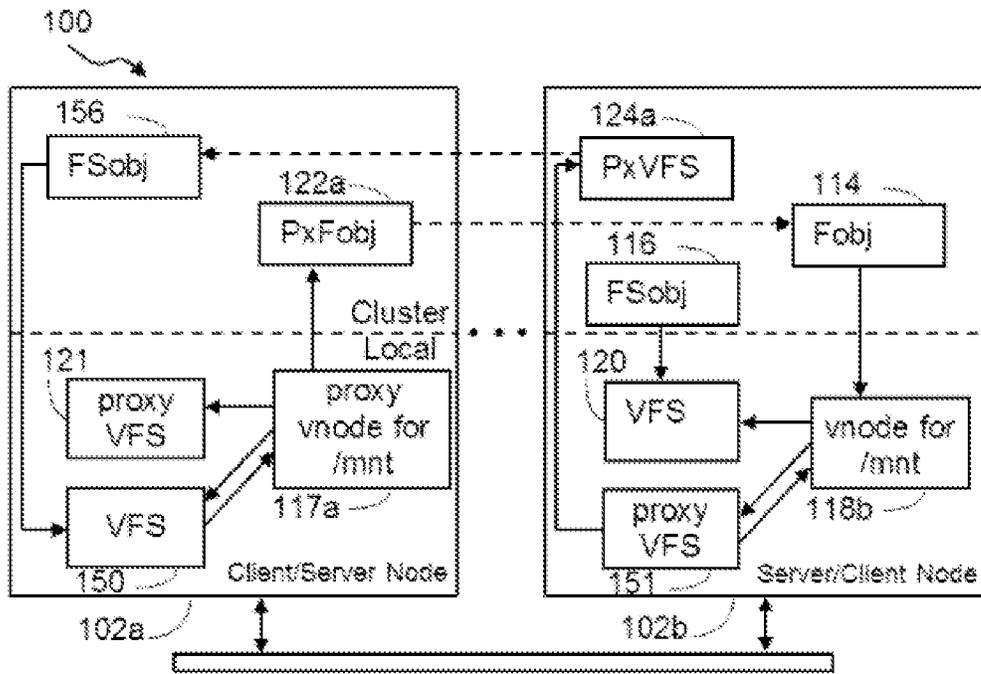


FIGURE 8D ALTERNATE

(*Id.* at 21.)² In the Examiner-created Figure 8D Alternate, node 102a stores “proxy ‘vnode for /mnt’ to access proxy VFS 121 and proxy file object ‘PxFobj’ 122a (i.e., proxy objects for the documents and proxy objects for the other folders) in the cluster/local hierarchy of node 102a.” (*Id.*)

Appellants disagree and argue that “the principle elements (e.g., vnode, VFS, and FSobj) are always correlated on the same node, and that node is always the server node that serves the respective principle file system elements within the global namespace.” (Appeal Br. 34.)

Additionally, Appellants argue that the cited portion of Cramer, i.e., column 4, lines 1–10,

confirms . . . that when a node is acting as both a client node and a server node, the node “will have” (required in the citation twice) each of the respective sets of “data structures,” and that these data structures must be present and must be used to operate as the respective node type (server or client) within the global name space.

(*Id.* at 35.) Thus, Appellants further argue,

as disclosed within the Cramer reference, to function as a client node, the respective node must have the “proxy data structures” (all of them - the “proxy” VFS element, the “proxy” FSobj, and the “proxy” vnode) working in conjunction with one another for a given “resource” to support client-based access to that particular resource. Further, to function as a server node, the respective node must have the principle data structures (all of them - the VFS, the FSobj, and the vnode - not proxy elements) working in conjunction with one another for a given “resource” to support server-based access to the particular resources.

² “VFS” refers to a virtual file system mechanism and “vnode” refers to a virtual file system node. (See Cramer, col. 2, ll. 16–22.)

(Reply Br. 9.) “No commingling of the principle nodes and principle file system elements/resources with proxy nodes or proxy file system elements/resources is factually disclosed in the Cramer reference as cited.” (*Id.*) In other words, Appellants argue, because claims 1, 9, and 17 recite such comingling, i.e., “designating . . . a first content management system to store proxy objects for root case instance folders, real objects for documents, and real objects for other folders in a first folder sub-hierarchy” and “designating . . . a second content management system to store real objects for the root case instance folders, proxy objects for the documents, and proxy objects for the other folders in a second folder sub-hierarchy,” Cramer does not anticipate claims 1, 9, and 17.³

³ Appellants also argue:

As a threshold, this formal introduction of an alleged alternative configuration based upon speculation of the Examiner constitutes manufacturing of evidence. Further, based upon the technical facts regarding operation of the respective data structure stacks of the Cramer reference that are required to be interconnected within the global name space as cited, this formal introduction of an alternative configuration constitutes manufacturing of false evidence. Manufacture of false evidence by an administrative agent is a violation of the Administrative Procedure Act (APA). Use of false manufactured evidence to deprive Appellant of justified patent rights violates Due Process.

(Appeal Br. 37–38; *see also id.* at 32.) We do not find the Examiner’s determination that “a person having ordinary skill in the art would recognize that the system shown in Figure 8D may have an alternate configuration” (Final Action 20) or the revised Figure 8D (clearly labeled “Figure 8D Alternate”) illustrating such an alternate configuration, to be in any way “false evidence.” Nor do we find Appellants’ accusations of such to be helpful to us in understanding Appellants’ arguments. We remind Appellants and Appellants’ counsel that “Applicants and their attorneys or

“[A]n invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim.”

Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989).

If the prior art reference does not expressly set forth a particular element of the claim, that reference may still anticipate if that element is “inherent” in its disclosure. To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed.Cir.1991). “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Id.* at 1269, 948 F.2d 1264, 20 U.S.P.Q.2d at 1749 (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A.1981)).

In re Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999).

Here, the Examiner acknowledges that all of the claim limitations are not literally present and arranged as shown in the claim, i.e., “a person having ordinary skill in the art would recognize that the system shown in Figure 8D may have an alternate configuration.” (*See* Final Action 20.)

With regard to inherency, the Examiner finds that in the alternate configuration, “proxy VFS 151 in node 102a . . . *could be* swapped with VFS 150 in node 102b . . . making node 102a the server node for VFS 150 and node 102b the client node for corresponding proxy VFS 151.” (*Id.*, emphasis added.) Particularly in view of the disclosure in Cramer that

agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy.” 37 C.F.R. § 1.3.

“where the client and server computer are the same node, the client node 102a will have a file system object . . . and a file object . . . for a file system resource when the client node 102a is acting as the sever [sic] for the file system resource and will have proxy data structures when the client node 102a is acting as a client for the resource,” we find that the Examiner has not established that the proposed alternate configuration “is necessarily present in the thing described.” *See Continental Can Co.*, 948 F.2d at 128.

In view of the above, we will reverse the rejection of claim 1. Independent claims 9 and 17 contain similar language and for similar reasons we will reverse the rejection of claims 9 and 17, and dependent claims 5, 13, and 21.

The § 103(a) rejections of claims 2, 6–8, 10, 14–16, 18, and 22–24

In rejecting dependent claims 2, 6–8, 10, 14–16, 18, and 22–24 under § 103(a), the Examiner does not rely on the additional references to cure the deficiency noted above. Therefore, for the reasons discussed above, we will reverse the rejections of claims 2, 6–8, 10, 14–16, 18, and 22–24 under § 103(a).

DECISION

The Examiner’s provisional rejections of claims 1, 2, 6–10, 14–18, and 22–24 on the grounds of nonstatutory double patenting are affirmed.

The Examiner’s rejection of claims 1, 2, 5–10, 13–18, and 21–24 under 35 U.S.C. § 101 is affirmed.

The Examiner’s rejection of claims 1, 5, 9, 13, 17, and 21 under 35 U.S.C. § 102(b) is reversed.

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The Examiner's rejections of claims 2, 6–8, 10, 14–16, 18, and 22–24 under 35 U.S.C. § 103(a) are reversed.

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