UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/768,475	04/27/2010	William Bittles	GB920080305US1 8152-0103	5684

73109 7590 01/28/2019

Cuenot, Forsythe & Kim, LLC
20283 State Road 7
Ste. 300
Boca Raton, FL 33498

EXAMINER	
PATEL, DHAIRYA A	

ART UNIT	PAPER NUMBER
2453	

NOTIFICATION DATE	DELIVERY MODE
01/28/2019	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ibmptomail@iplawpro.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte WILLIAM BITTLES, DAVID GRANSHAW, and JOHN BRIAN PICKERING

Appeal 2017-007615
Application 12/768,475
Technology Center 2400

Before ELENI MANTIS MERCADER, JESSICA C. KAISER, and JOSEPH P. LENTIVECH, *Administrative Patent Judges*.

LENTIVECH, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellants[1] appeal from the Examiner's decision to reject claims 1, 2, 4, 5, and 16–31. Claims 3 and 6–15 have been canceled. *See* App. Br. 21–22, Claims Appendix. We have jurisdiction over the pending claims under 35 U.S.C. § 6(b).

We affirm-in-part.

---

[1] According to Appellants, the real party in interest is IBM Corporation. App. Br. 1.

RELATED APPEALS

The present application was the subject of Appeal No. 2013-005442, mailed August 5, 2015 (the "'442 Decision"), in which a panel of this Board affirmed the Examiner's rejection of claims 1–10 under 35 U.S.C. § 101; affirmed the Examiner's rejection of claims 7–9 under 35 U.S.C. § 103(a); and reversed the Examiner's rejection of claims 1–6 and 10–15 under 35 U.S.C. § 103(a).

STATEMENT OF THE CASE

Appellants' Invention

Appellants' invention generally relates to "a method of operating a communication system, and to the system itself. The method and system allow dynamic switching of message formats." Spec. ¶ 1. Claims 1 and 2, which are illustrative, read as follows:

> 1. A method of operating a computer hardware device within a client-server system, comprising:
>
> receiving, from a client, messages in a first format that includes data and descriptive tags;
>
> initiating, after receipt of the message and with the client, a negotiation to determine whether the client accepts message format switching;
>
> receiving, from the client, an indication that the client accepts message format switching; and
>
> transmitting, to the client after receiving the indication, an instruction to transmit messages in a second format.
>
> 2. The method of claim 1, wherein
>
> a message workload from the client is monitored; and

> the negotiation is initiated based upon a determination that a switch to a different message format would be more efficient given the message workload from the client.

Rejections

Claims 1, 5, 16–19, 22–26, and 29–31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Abjanic et al. (US 7,162,542 B2; issued Jan. 9, 2007) ("Abjanic") and Feingold et al. (US 2008/0168469 A1; published July 10, 2008) ("Feingold"). Final Act. 2–7.

Claims 2, 4, 20, 21, 27, and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Abjanic, Feingold, Giffin et al. (US 2009/0089417 A1; published Apr. 2, 2009) ("Giffin"), and Gerdes et al. (US 2007/0189159 A1; published Aug. 16, 2007) ("Gerdes"). Final Act. 7–10.

ANALYSIS

Claim 1

ISSUE 1

Did the Examiner err in finding that the combination of Abjanic and Feingold teaches or suggests "initiating, after receipt of the message and with the client, a negotiation to determine whether the client accepts message format switching," as recited in claim 1?

Appellants argue:

> Abjanic does not teach that a determination is not made as to whether the client accepts message format switching (i.e., corresponding to the claimed "to determine whether the client accepts message format switching"). Instead, the Examiner's cited passages refer to the actual operation of transforming data from one format to another format.

App. Br. 10.

According to Appellants, Feingold teaches "Application 1 sends the original request to Application 2 along with a propagation information package that describes what protocols Application 1 accepts." App. Br. 12. Appellants argue

> at the time that Application 2 receives the propagation information package, which is sent along with the original request, Application 2 already knows that Application 1 accepts message format switching because the *existence of the propagation information package sent by Application 1 establishes that Application 1 accepts message format switching.*

App. Br. 12. Appellants further argue "[s]ince Application 2 already knows that Application 1 accepts message format switching as a result of the message being received, there is no need to perform 'a negotiation to determine whether the client accepts message format switching' after receipt of the message," as required by claim 1. App. Br. 12. Appellants argue:

> To the extent that a "negotiation" is performed between Application 2 and Application 1, this negotiation involves "Transaction Manager 2 108 select[ing] a protocol and communicates with Transaction Manager 1 106 (arrow 5)" and "Transaction Manager 1 106 receives a selection of one of the supported communication protocols from Transaction Manager 2 108." Accordingly, the interactions between the Transaction Manager 1 106 and Transaction Manager 2 108 (as proxies for the Application 1 102 and Application 2 104) are not "to determine whether the client accepts message format switching," as claimed.

App. Br. 12–13.

Appellants also argue Feingold's teaching that either of the transaction managers may initiate a re-negotiation of the communication protocol (Feingold ¶ 39) is a negotiation regarding which communication

protocol to use and not a negotiation to determine whether the client accepts message format switching. App. Br. 13.

Nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *See In re Merck & Co. Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Here, the Examiner relies upon the combination of Abjanic and Feingold for teaching or suggesting the disputed limitation. Final Act. 4–5 (citing Abjanic 11:6–64, 12:30–45; Feingold ¶¶ 19, 20, 23, 29, 30, 35–37, 39, 40, 44); *see also* Ans. 3–5. In particular, the Examiner finds Abjanic teaches:

> [A] first node may issue a request over the network or internet that is received by the second node (initiating with the client). The second node may send a response back to the first node. Both the request and response may typically be routed over the network and transforming switch, and the request and the response may both include data that may be transformed (relating to message format switching). The transforming switch receives the message provided in one or more packets, determines if the data within the packets need to be transformed, performs transformation that is required and forwards the message (relating to message format switching).

Final Act. 3 (citing Abjanic 11:6–44; 12:30–45); *see also* Ans. 3–4. The Examiner finds Feingold teaches initiating, after receipt of a message and with a client, a negotiation with the client to determine whether the client accepts message format switching. Ans. 4–5 (citing Feingold ¶¶ 19, 20, 23, 29, 30, 35–37, 39, 40, 44). The Examiner finds it would have been obvious to one of ordinary skill in the art at the time Appellants' invention was made "to implement Feingold's teaching in Abjanic's teaching to come up with initiating a negotiation and receiving an indication relating to format switching." Final Act. 6; *see also* Ans. 6. Appellants' arguments fail to

persuasively address the combined teachings of the references and, therefore, are unpersuasive of error.

ISSUE 2

Did the Examiner err in finding that the combination of Abjanic and Feingold teaches or suggests "transmitting, to the client after receiving the indication, an instruction to transmit messages in a second format," as recited in claim 1?

According to Appellants, Feingold teaches "Transaction Manager 2 initiates communication with Transaction Manager 1 to indicate that Application 2 has selected one of the protocols already forwarded (by Application 1) to Application 2." App. Br. 14. Appellants argue:

> The limitations at issue are "transmitting, to the client after receiving the indication, an instruction to transmit messages in a second format." The Examiner's analysis necessarily requires that Application 1 be the client that sends the original request and Application 2 be the receiver of the request. Based upon this interpretation, the claimed "transmitting" would have to refer to a message (i.e., instruction) sent from Application 2 to Application 1. The only message (see Figure 1 of Feingold) that could correspond to this is arrow 6. However, arrow 6 refers to "Application 2 104 completes the designated operations in the transaction and sends the status and/or results to Application 1 102." This does not involve "an instruction to transmit messages in a second format."

App. Br. 14. Appellants further argue "the claimed invention contemplates message format switching being performed by the client *that sends the request* whereas Feingold contemplates message format selection by the application *that receives the request*." App. Br. 15.

The Examiner finds Feingold teaches that the first transaction manager receives a protocol request from the second transaction manager. Ans. 6; *see also* Feingold ¶ 37. The Examiner finds "[t]he protocol request is a request for the first transaction manager to communicate with the second transaction manager via a selected communication protocol (transmitting to the client an instruction to transmit message of a second format)." Ans. 6. Thus, contrary to Appellants' arguments, the Examiner relies upon the message represented by arrow 5 in Figure 1 of Feingold, along with the associated description of that message, for teaching or suggesting the disputed limitation. *See* Ans. 6. Appellants' arguments fail to address these findings of the Examiner and, therefore, are unpersuasive of error.

ISSUE 3

Is the combination of Abjanic and Feingold proper?

Appellants contend the combination of Abjanic and Feingold is improper because the Examiner fails to provide a rational underpinning to support the conclusion of obviousness. App. Br. 15. Appellants argue "the Examiner's 'motivation' is already achieved by Abjanic alone" because "Abjanic already provides the ability to establish communication 'between the client and the server in a format which is supported/compatible by both client and server.'" App. Br. 15, 16; *see also* Reply Br. 5.

We are not persuaded. Although Abjanic teaches transforming messages generally (Abjanic 11:6–44), we disagree that this teaching precludes the Examiner's reasoning from having rational underpinning as Appellants argue. Instead, we find the Examiner's reasoning has rational underpinning (i.e., so that communication can be established between the

client and the server in a format which is supported by both client and server (and determined by Feingold's handshake/negotiation)).

For the foregoing reasons, we do not sustain the Examiner's rejection of claim 1; and claims 4, 5, and 16–31, which are not separately argued with particularity. *See* App. Br. 8, 16.[2]

Claim 2

ISSUE 4

Did the Examiner err by finding the combination of Abjanic, Feingold, Giffin, and Gerdes teaches or suggests "a message workload from the client is monitored," as recited in claim 2?

Regarding the disputed limitation, the Examiner finds Giffin teaches that "the collector receives all the incoming requests/messages at the incoming load balancer which handles all the traffic relating to all incoming requests which creates alerts, and the user viewing alerts an HTTP load balancer is implemented." Ans. 9 (citing Giffin ¶ 55). The Examiner further finds "that the user is viewing alerts which is workload from a client therefore, the load balance has to be implemented." *Id.* Additionally, the Examiner finds "monitoring of screen names of the user for messages is a message workload from a client because in this case the client is the user and

[2] Although Appellants state that claims 4, 20, 21, 27, and 28 stand or fall together with claim 2 (App. Br. 16), these claims do not depend from claim 2 (*see* App. Br. 21–24 (Claims Appendix)). As such, Appellants' arguments with respect to claim 2 are not determinative as to the patentability of claims 4, 20, 21, 27, and 28.

message workload is all the messages related to the screen name of the user." *Id.*

Appellants argue Giffin's teaching of monitoring known screen names does not teach or suggest monitoring a message workload from a client, as required by claim 2. App. Br. 17. Appellants argue:

> The term "workload" is defined as "the amount of work or of working time expected or assigned" or "the amount of work performed or capable of being performed (as by a mechanical device) usually within a specific period." What the Examiner has identified refers to monitoring work product. The teaching of "monitoring known screen names" does not refer to the amount of work expected/performed/capable of being performed.

App. Br. 17 (citing *Merriam-Webster Dictionary* (available at http://www.merriam-webster.com/dictionary/workload) (last accessed Dec. 20, 2018)). Appellants further argue Giffin's load balancer does not monitor a message workload from a client but merely implements "a technique by which a load is balanced over a number of components (e.g., servers) that are capable of handling a portion of the load." Reply Br. 7.

We find Appellants' arguments persuasive. Based on the plain meaning of the terms, "a message workload from the client" refers to a workload (e.g., an amount of work to be performed) resulting from messages received from a client, which is consistent with Appellants' Specification. *See* Spec. ¶ 22. We agree with Appellants (Reply Br. 7) that Giffin teaches balancing a workload of the system irrespective of the client device from which the messages were received (*see* Giffin ¶¶ 55–57). The Examiner's findings fail to show how balancing a workload of a system, as taught by Giffin, teaches or suggests that the message workload from a client is

monitored, as required by claim 2. As such, we are constrained by the record to not sustain the Examiner's rejection of claim 2.

DECISION

We affirm the Examiner's rejection of claims 1, 4, 5, and 16–31 under 35 U.S.C. § 103(a).

We reverse the Examiner's rejection of claim 2 under 35 U.S.C. § 103(a).

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-IN-PART