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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JAMES R. BOWES and JUSTIN HARRIS

Appeal 2018-007223
Application 13/034,115
Technology Center 2400

Before CARL W. WHITEHEAD JR, DAVID M. KOHUT, and
IRVIN E. BRANCH, Administrative Patent Judges.

BRANCH, Administrative Patent Judge.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–4, 9–12, 17, 21–25, 28, 33, 35, and 36, which are all of the pending claims. Appeal Br. 18; Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use “Appellant” to reference the applicant as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as “Red Hat Inc.” Appeal Br. 3.

STATEMENT OF THE CASE

APPELLANT'S INVENTION

Appellant's invention relates to third party management of software product subscriptions. Spec. ¶¶ 1–3, 12–13. Claim 1, reproduced below, is illustrative of the claimed subject matter.

1. A method comprising:

determining, by a processing device, entitlements configuration data for a computing system to configure registered entities with a product in view of a client configuration data, wherein the entitlements configuration data comprising a product entitlement authorizing consumption by the computing system of a product associated with a plurality of product assets, wherein the determining comprises:

identifying an extension point associated with a vendor of the product, wherein the extension point represents a point in the entitlements configuration data to add extensions data to extend distribution of the product as reflective of subscription data associated with the computing system, wherein the extensions data further comprises extension information to define extended procedures for authenticating an identity of a server for consuming the product; and

updating the entitlements configuration data in view of the extension point; and

configuring, by the processing device over a first network to a second network, a server computing system with the entitlements configuration data to configure a registered entity within the second network associated with the server computing system.

Appeal Br., Claims Appendix.

REJECTIONS

Claim 36 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Final Act. 3.

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Claims 1, 9, 17, 33, and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Misra (US 2005/0102240; May 12, 2005), Cognigni (US 2009/0249327; Oct. 1, 2009), and Desai (US 2011/0321178; Dec. 29, 2011). Final Act. 4–6.

Claims 3, 11, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Misra, Cognigni, Desai, and Chan (US 2009/0177698; July 9, 2009). Final Act. 7.

Claims 2, 10, 21, and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Misra, Cognigni, Desai, and Coley (US 2007/0198429 A1; Aug. 23, 2007). Final Act. 8.

Claims 4, 12, and 23–25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Misra, Cognigni, Desai, and Official Notice. Final Act. 9.

Claim 28 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Misra, Cognigni, Desai, and Hudson (US 2002/0059499; May 16, 2002). Final Act. 10.

We review the appealed rejections for error based upon the issues identified by Appellant, and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential). We have only those arguments Appellant actually raised in the Briefs. Any other arguments Appellant 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)(iv).

OPINION

We have reviewed the Examiner’s rejections in light of Appellant’s arguments. To the extent consistent with our analysis herein, we adopt as our own the findings and reasons set forth by the Examiner in (1) the action from which this appeal is taken (Final Act. 3–107) and (2) the Examiner’s

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Answer in response to Appellant’s Appeal Brief (Ans. 4–10) and concur with the conclusions reached by the Examiner. We highlight the following for emphasis.

35 U.S.C. § 112, ¶ 1, REJECTION OF CLAIM 36

Claim 36 depends from claim 1 and adds: “wherein the extensions data further comprises event publishing extension information to define procedures for publishing events related to the consumption of the product by the server.” The Examiner finds a lack of written description support for claim 36 because the Specification does not describe “procedures for publishing events[,] let alone procedures for publishing events related to the consumption of the product by the server.” Ans. 4.

Appellant contends that the Specification discloses the claimed subject matter at paragraphs 17–21, 23, 25, and 29 by disclosing product asset management (PAM) that tracks a licensee’s consumption of software (*see e.g.*, Spec. ¶ 18) and publishes events per event publishing data (*see e.g.*, *id.* ¶ 29). Appeal Br. 8–9; Reply Br. 4–5.

Appellant does not persuasively explain, however, the relevance of the cited paragraphs to “procedures for publishing events.” *See* Reply Br. 3–6; *id.* at 5 (“Based on the above description in paragraphs of the specification, a person skilled in the art would understand the functional steps utilized to implement ‘the extensions data that comprises event publishing extension information to define procedures for publishing events related to the consumption of the product by the server.’”). We are, therefore, unpersuaded of written description support for the claimed “publishing procedures” *See Pandrol USA LP v. Airboss Railway Products Inc.*, 424 F.3d 1161, 1165 (Fed. Cir. 2005) (A written description shows possession of the claim’s full scope.).

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For the foregoing reasons, we sustain the rejection of claim 36 under 35 U.S.C. § 112, first paragraph.

35 U.S.C. § 103(a) REJECTION OF CLAIMS 1, 9, AND 17
OVER MISRA, COGNIGNI, AND DESAI

Appellant argues claims 1, 9, and 17 as a group for this rejection. Appeal Br. 10 (heading). We select claim 1 as representative. 37 C.F.R. § 41.37(c)(1)(iv). We are unpersuaded of error in this rejection of claim 1.

Appellant contends the Examiner incorrectly cites Desai as teaching the claimed “extensions data to extend distribution of the product by the computing system as reflective of subscription data associated with the computing system.” Appeal Br. 10–12. Specifically, Appellant contends Desai’s cited extensions are gateways that connect a network’s centralized application to endpoints, but the gateways do not distribute the application and therefore do not “extend distribution of the product” as claimed. *Id.* at 12 (citing Desai ¶¶ 24, 43).

The Examiner responds that Desai’s system assigns an extension to grant an endpoint use of a licensed application. Ans. 6 (citing Desai ¶¶ 1, 8, 19–20, 22, 40, 42–43). The Examiner thus views this “extension assignment” as a distribution of software. *Id.* (quoting Desai *abst.*).

We are unpersuaded of error. Because the extension assignment permits an endpoint to log into an application (*see e.g.*, Desai ¶ 22), we conclude the Examiner reasonably relies on the assignment as a distribution of software. *See also* Spec. ¶ 42 (describing a “distributed” product as an assigned entitlement to software). Appellant does not adequately explain how such an extension assignment does not amount to distribution of software.

With respect to the same claim limitation (above), Appellant also contends Desai’s extensions comply with business rules that concern an endpoint’s location, but the rules do not concern “subscription data” and therefore do not “extend . . . the product . . . reflective of subscription data” as claimed. Appeal Br. 13. The Examiner responds that Desai’s business rules enforce licensing rules, which constitute “subscription data.” Ans. 6–7 (citing Desai ¶ 42).

We are unpersuaded of error. Because Desai’s business rules for extension “may enforce or facilitate licensing rules” (Desai ¶ 42), we conclude the Examiner reasonably relies on the rules as “subscription data” (licensing rules). Appellant does not adequately explain how such rules for enforcing licenses do not amount to subscription data.

Appellant also contends the Examiner presents a conclusory rationale for adding the relied-upon teachings of Desai to those of Misra and Cognigni. Appeal Br. 14–15. Appellant further contends the rationale is premised upon adding software assignment and licensing features that are not claimed. *Id.* at 15.

The Examiner responds with the following clarification of the rationale.

Desai’s technology would allow for dynamic extension assignment which is an improvement over the static assignment referenced in paragraph one of Desai. Additionally, Desai’s technology would add the benefit of efficient license tracking through the application of business rules applied to the dynamic pool of extensions.

Ans. 9; *see also* Final Act. 6 (citing Desai ¶ 8 in support of the rationale).

The response also explains that Misra, Cognigni, and Desai are each concerned with providing licensed software to endpoints. *Id.*

Appellant replies that the Examiner’s response neither: addresses the argument that claim 1 does not recite a product assignment or licensing; nor relates the above rationale to Misra and Cognigni. Reply Br. 7–8.

We are unpersuaded of error. The Examiner shows the references concern similar technologies and objectives, such that the combined features would be viewed as compatible with one another. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) (“[I]f a technique . . . would improve similar devices in the same way, using the technique is obvious.”). Further, the Examiner shows Desai’s added teachings would be viewed as conferring a benefit. *See id.* at 424 (“The proper question [is] whether a pedal designer of ordinary skill . . . would have seen a benefit to [the combination].”); *see also* Desai ¶ 8 (explaining that Desai’s added feature—its means of extension assignment—allow extensions to be dynamically assigned). These are not conclusory assertions of obviousness, as argued, but rather articulated reasons and rational underpinnings for the addition of Desai’s teachings. *See KSR*, 550 U.S. at 417 (contrasting “conclusory statements” and “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”).

Appellant does not persuasively rebut the Examiner’s reasoning and underpinnings. Appellant rather contends claim 1 does not recite a software product’s assignment or licensing. Appeal Br. 15; Reply Br. 7–8. Even assuming Appellant is correct, the claim limitations are irrelevant to whether the combination of prior art is obvious (and rather relevant to whether the combination reaches those limitations and, possibly, to whether the claimed invention and references are analogous art). Further, Appellant is incorrect in that the Examiner shows (and Appellant does not persuasively rebut) the claimed “extend[ing] distribution of the product . . . reflective of

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subscription data” reads on a software product’s assignment based on its licensing. *See supra* 5–6.

Appellant also contends the Examiner does not relate the above rationale to Misra and Cognigni. Reply Br. 7–8. However, the Examiner explains the rationale and explains how *each reference* concerns a system’s provision of licensed software to endpoints. Ans. 9.

For the foregoing reasons, we sustain the rejection of claims 1, 9, and 17 under 35 U.S.C. § 103(a).

35 U.S.C. § 103(a) REJECTION OF 4, 12, AND 23–25
OVER MISRA, COGNIGNI, DESAI, AND OFFICIAL NOTICE

Appellant contends the Examiner relies on official notice, for each of claims 4, 12, and 23–25, but fails to substantiate the notice on the record. Appeal Br. 16. We are unpersuaded for each of two reasons.

First, as the Examiner responds, “documentary evidence has been provided previously in the . . . office action of 11/12/2015.” Ans. 10; *see also* Non-Final Act., mailed Nov. 12, 2015, 3–4. Appellant does not address the documentary evidence, nor even address the Examiner’s above response. *See* Reply Br. 3 *et seq.* (replies to the Answer do not address claims 4, 12, and 23–25).

Second, Appellant does not address the Examiner’s prior response that: “Applicant has failed to adequately traverse the findings of Official Notice . . . [by] stating why the noticed fact is not considered to be common knowledge or well-known in the art. . . . MPEP [§] 2144.03[.]C.” Non-Final Act. 3. “If . . . [an] applicant’s traverse is not adequate,” as here, “the art statement is taken to be admitted prior art.” MPEP § 2144.03.C. We therefore take the official notice as admitted prior art. *See also In re Gunther*, 125 F.2d 1020, 1023 (CCPA 1942) (“[T]he examiner stated that it

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was well known in the art to use dry or superheated steam[.] This statement was not challenged[.] . . . [W]e must accept such statement of the examiner as correct.”).

For the foregoing reasons, we sustain the rejection of claims 4, 12, and 23–25 under 35 U.S.C. § 103(a).

REMAINING 35 U.S.C. § 103(a) REJECTIONS

Appellant does not present separate arguments for the rejections of claims 2, 3, 10, 11, 21, 22, 28, and 34 under 35 U.S.C. § 103(a). We accordingly sustain those rejections.

OVERALL CONCLUSION

We affirm the Examiner’s decision to reject claims 1–4, 9–12, 17, 21–25, 28, 33, 35, and 36.

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed
36	§ 112	¶ 1 (Written Description)	36	
1, 9, 17, 33, 35	§ 103(a)	Misra, Cognigni, Desai	1, 9, 17, 33, 35	
3, 11, 22		Misra, Cognigni, Desai, Chan	3, 11, 22	
2, 10, 21, 34	§ 103(a)	Misra, Cognigni, Desai, Coley	2, 10, 21, 34	
4, 12, 23–25	§ 103(a)	Misra, Cognigni, Desai, Official Notice	4, 12, 23–25	
28	§ 103(a)	Misra, Cognigni, Desai, Hudson	28	
Overall Outcome			1–4, 9–12, 17, 21–25, 28, 33, 35, 36	

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TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this Appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED