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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* NEIL MC ERLEAN, TUNA AKSOY, NICK BURCH,  
MICHAEL FARMAN, PAUL HOLMES-HIGGIN, JOHN NEWTON,  
BRAIN REMMINGTON, MARK ROGERS, JAN VONKA, and  
DAVID WEBSTER

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Appeal 2019-000583  
Application 14/170,364  
Technology Center 2100

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BEFORE DENISE M. POTHIER, CARL L. SILVERMAN, and  
JAMES W. DEJMEK, *Administrative Patent Judges*.

SILVERMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant<sup>1</sup> appeals under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–23, which constitute all pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

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<sup>1</sup> Throughout this Decision, we use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42 (2018). Appellant identifies Alfresco Software, Inc., as the real party in interest. Appeal. Br. 3.

## STATEMENT OF THE CASE

The invention relates to content management systems. Abstract; Spec. ¶¶ 2, 6–8, Figs. 1, 5. Claim 1 reproduced below, is illustrative of the subject matter on appeal (emphasis added):

1. A computer program product comprising a non-transitory machine-readable medium storing instructions that, when executed by at least one programmable processor, cause the at least one programmable processor to perform operations of a first installation of a content management system, the operations comprising:

establishing authentication between a first repository managed by the first installation and a second repository managed by a second installation of the content management system, *(L1) the first installation being protected by a firewall preventing access to the first repository by an external user;*

*(L2) linking a content item maintained by the first repository with a copy of the content item maintained by the second repository such that the copy of the content item is accessible by an external user subject to one or more access controls enforceable by the second installation, the copy comprising both content of the content item and a set of metadata in common with the content item at the first repository; and*

*(L3) synchronizing the set of metadata between the copy of the content item and the content item in the first repository, the synchronizing occurring via a push to the second installation of changes to the content item at the first repository for writing to the copy of the content item at the second repository, and via a pull to the first installation of changes to the copy of the content item at the second repository for writing to the content item at the first repository, the first installation initiating both the push and the pull.*

Appeal Br. 18. (Claims Appendix). (L1), (L2), and (L3) added and also referred to as “disputed limitations.”

## REFERENCES

### Prior art relied upon by the Examiner:

Name	Reference	Date
Hugh	US 2003/0227487 A1	Dec. 11, 2003
Storm	US 2013/0097687 A1	Apr. 18, 2013

## THE REJECTIONS

Claims 1–11, 14–18, and 21–23 are rejected under 35 U.S.C. § 102(a)(1) as being anticipated by Hugh. Final Act. 11–17.

Claims 12, 13, 19, and 20 are rejected under 35 U.S.C. § 103 as being unpatentable over Hugh and Storm. Final Act. 18–20.

## ANALYSIS

### *The § 102 rejection of claims 1–11, 14–18, and 21–23*

Appellant argues the Examiner errs in finding Hugh discloses independent claim 1 disputed limitations (L1, (L2), and (L3) as required for anticipation. Appeal Br. 10–15; Reply Br. 4–12. Appellant additionally argues the Examiner errs in finding Hugh anticipates claim 1 by selecting elements from many different Hugh embodiments. Appeal Br. 15–16; Reply Br. 13–14.

Regarding disputed limitation (L1) “the first installation protected by a firewall preventing access to the first repository by an external user,” the Examiner finds Hugh discloses client servers and a Brain (remote) server, and the Brain (remote) server is protected by a firewall and requires authentication to access. Final Act. 12 (citing Hugh ¶¶ 980, 997). In the Answer, the Examiner additionally refers to Hugh, paragraphs 1021, 1043, and 1045. Answer 11. In particular, the Examiner finds paragraph 1021

discloses the use of a firewall within the Brain system that may limit communication but allows certain email ports. *Id.* at 10–11. The Examiner refers to paragraph 1043 as disclosing firewall restrictions that prohibit direct connections between the Brain server and remote locations. The Examiner finds paragraph 1045 provides further support in that both the Brain client and the Brain server have firewall and security protections in which an email communication method was preventing threats. *Id.* at 11. The Examiner then concludes that “Hugh discloses a firewall at a first repository that prevents communication from other/remote repositories.” *Id.*

Appellant argues the Hugh portions cited (Hugh paragraphs 980, 997) by the Examiner in the Final Action merely indicate that firewalls have exceptions and that is not the same as the claimed firewall of disputed limitation (L1). Appeal Br. 11. In the Reply Brief, Appellant argues the Examiner’s reference in the Answer to additional Hugh paragraphs 1021, 1043, and 1045 as teaching the claimed firewall is a new ground of rejection that should not be considered. Reply Br. 4. Appellant then additionally argues that none of the newly cited paragraphs of Hugh discloses the claimed firewall. *Id.* at 5. According to Appellant, Hugh paragraphs 1043 and 1045 are generally directed to email content synchronization and avoiding “same contact” conflict, and there is no disclosure of providing a firewall or protection. *Id.* Appellant argues paragraph 1021 of Hugh also does not disclose a firewall that protects the claimed first repository as recited in disputed limitation (L1). *Id.* Appellant additionally argues paragraph 1021 of Hugh seems to teach away because, in contrast to the disputed limitation, Hugh suggests a firewall that fails to protect the server

when a direct connection is established for the purpose of synchronization.  
*Id.* at 5.

We are persuaded by Appellant’s arguments that the Examiner has not presented sufficient evidence to establish a prima facie case of anticipation. In our analysis below, we highlight and address specific findings and arguments for emphasis.

A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described in a single prior art reference, and arranged as required by the claim. *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

During prosecution, claims must be given their broadest reasonable interpretation when reading claim language in light of the Specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). Although we interpret claims broadly but reasonably in light of the Specification, we nonetheless must not import limitations from the Specification into the claims. *See In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993). Our reviewing court states that “the words of a claim ‘are generally given their ordinary and customary meaning.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (citations omitted).

Regarding disputed limitation (L1), Hugh provides a high level reference to firewalls, but no clear disclosure of “first installation being protected by a firewall preventing access to the first repository by an external user.” Initially, we note that the Specification states “[t]he term firewall is generally used throughout this disclosure to refer to network security controls, features, functionality, etc. that restrict access to users

outside of the firewall to content retained on one or more repositories inside of that firewall.” Spec. ¶ 21. Also, it is helpful to refer to Figure 1, which illustrates a firewall. *See also* Spec. ¶ 25 (element 110).

For example, cited paragraph 980 of Hugh does not utilize the term “firewall” nor suggest a firewall. Cited paragraph 997 of Hugh states “most firewall’s have exceptions that permit ports in the firewall for email,” but provides no disclosure of the placement and function of the firewall as recited in disputed limitation (L1). The Examiner’s reliance on additional Hugh paragraphs 1021, 1043, and 1045 also does not provide clear disclosure of disputed limitation (L1). For example, paragraph 1043 does not utilize the term “firewall” nor suggest a firewall. Paragraph 1045 does not utilize the term “firewall” as the paragraph states in its entirety: “Now an example of same-content conflict will be explored.” Hugh’s paragraph 1021 utilizes the term “firewall” without discussion of the placement and function recited in disputed limitation (L1). In particular, paragraph 1021 describes synchronization of email communication between a Brain client and server and, in that context, “avoiding the firewall and security threats to Brain Client and Brain Server that could be caused by requiring a direct connection.”

Applying a broad and reasonable interpretation, Hugh does not disclose disputed limitation (L1) as required for anticipation. In particular, on the record before us, the Examiner does not sufficiently show that the firewall is described and arranged as required by the disputed limitation.

We also are not persuaded by Appellant’s argument that the Examiner’s findings regarding the additional Hugh paragraphs should not be considered. Insofar as Appellant protests a failure to designate a new ground

of rejection, it is presented to an inappropriate entity. The *Manual of Patent Examining Procedure (MPEP)* explains that 37 C.F.R. § 41.40 provides the “exclusive procedure” for requesting review of a failure to designate a new ground of rejection, i.e., through a petition to the Director under 37 C.F.R. § 1.181. *MPEP* § 1207.03(b) (9th ed. Rev. 07.2015 Nov. 2015). The *MPEP* also explains that “[t]his procedure should be used if an appellant feels an answer includes a new ground of rejection that has not been designated as such and wishes to reopen prosecution . . . .” *Id.* Upon review of the record, we fail to find that Appellant has submitted a petition to the Director. The “[f]ailure of [an] appellant to timely file such a petition will constitute a waiver of any arguments that a rejection must be designated as a new ground of rejection.” 37 C.F.R. § 41.40(a).

We now refer to disputed limitation (L2):

linking a content item maintained by the first repository with a copy of the content item maintained by the second repository such that the copy of the content item is accessible by an external user subject to one or more access controls enforceable by the second installation, the copy comprising both content of the content item and a set of metadata in common with the content item at the first repository.

The Examiner finds Hugh discloses linking of content between disparate data repositories and the Brain server. Final Act. 12 (citing Hugh ¶ 842). The Examiner finds Hugh discloses data and associated information about the data (metadata). *Id.* (citing Hugh ¶¶ 842–845).

Appellant argues Hugh’s accessing a repository that contains a list of links is not the same as disputed limitation (L2). Appeal Br. 11–12.

According to Appellant:



However, accessing a repository that contains a list of links is not the same as “linking a content item maintained by the first repository” with “a copy of the content item” that is “maintained by the second repository” and that a result of this linking is that “the copy of the content item is accessible by an external user subject to one or more access controls enforceable by the second installation.” In other words, the “linking” recited in Claim 1 relates to a content item maintained by the first repository (protected by a firewall and managed by the first installation of the CMS) being linked with a copy of that content item maintained by the second repository managed by the second installation of the CMS.

*Id.*

Similar to our discussion regarding disputed limitation (L1) *supra*, the Examiner does not sufficiently show that Hugh’s paragraphs 842–845 description of a “list of links” disclose a copy of the content item as recited in the disputed limitation. In particular, the Examiner does not show Hugh discloses disputed limitation (L2) described and arranged as required for anticipation. We agree with Appellant that Hugh’s “list of links” does not sufficiently disclose “linking a content item maintained by the first repository with a copy of the content item maintained by the second repository such that the copy of the content item is accessible by an external user subject to one or more access controls enforceable by the second installation.”

Independent claims 16, 22, and 23 include limitations similar to claim 1. The rejection of these claims suffers from similar issues to those noted above for claim 1.

Dependent claims 2–11, 14, 15, 17, 18, and 21 depend from claims 1 and 16. The rejection of these claims suffers from similar issues to those noted above for claims 1 and 16.

In view of the above, we do not sustain the anticipation<sup>2</sup> rejection of representative claim 1, and claims 2–11, 14–18, and 21–23.

*The § 103 rejection of dependent claims 12, 13, 19, and 20*

Dependent claim 12 recites “A computer program product as in Claim 1, wherein the first repository comprises an on-premise repository protected from access by external users by a firewall, and the second repository comprises a cloud-based tenant repository outside of the firewall.”

The Examiner finds that Hugh *discloses* the limitations of claim 1 but does not explicitly disclose the limitations of dependent claim 12 (emphasis added). Final Act. 19. The Examiner finds Storm teaches an on-premises server and a cloud server. *Id.* (citing Storm ¶ 48). The Examiner concludes “it would have been obvious to one of ordinary skill in the art to modify Hugh's disclosure of synchronizing data between repositories and Storm's use of on-premise and cloud servers in order to provide secure content sharing and synchronization with cloud capable software delivery and execution.” *Id.*

Appellant does not expressly address the § 103 rejection. Appeal Br. 16. Instead, Appellant argues claims 2–15 and 17–21 are allowable based on dependency, “the reasons discussed above” regarding representative claim 1, and unidentified additional features of the dependent claims. *Id.*

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<sup>2</sup> On the record before us, the rejection of independent claim 1 is under § 102, not § 103. We render no opinion whether Hugh's teachings suggest the limitations in claim 1. Although the Board is authorized to reject claims under 37 C.F.R. § 41.50(b), no inference should be drawn when the Board elects not to do so. *See* Manual of Patent Examining Procedure (MPEP) § 1213.02.

As stated by the Supreme Court, the Examiner's obviousness rejection must be based on:

[S]ome articulated reasoning with some rational underpinning to support the legal conclusion of obviousness . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

*KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Although we agree with the Examiner's unrebutted findings that Storm teaches the dependent claim 12 (and claim 19) limitations, the Examiner provides no additional reasoning why Hugh teaches the claim 1 limitations under § 103. Similarly, we agree with the Examiner's unrebutted finding that Storm teaches the dependent claims 13 and 20 limitations but that the Examiner provides no additional reasoning why Hugh teaches the claim 1 limitations under § 103. Furthermore, the Examiner has not relied on Storm to cure the noted deficiencies in Hugh. *See* Final Act. 19–20.

Thus, the Examiner does not provide sufficient “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” for claims 12, 13, 19, and 20. *See In re Kahn*, 441 F.3d at 988.

In view of the above, we do not sustain the obviousness rejection of claims 12 and 13, which depend from claim 1, and the obviousness rejection of dependent claims 19 and 20, which depend from independent claim 16.

## CONCLUSION

In summary:

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<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1-11, 14-18, 21-23	102	Hugh		1-11, 14-18, 21-23
12, 13, 19, 20	103	Storm		12, 13, 19, 20
<b>Overall Outcome</b>				1-23

REVERSED