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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JAMES D. JAMISON and CHARLES C. SNOW

Appeal 2019-000598
Application 14/536,170
Technology Center 3600

Before BRADLEY W. BAUMEISTER, MIRIAM L. QUINN, and
RUSSELL E. CASS, *Administrative Patent Judges*.

QUINN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from a final rejection of claims 1–2 and 5–20, which constitute all the claims pending in this application.² *See* Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as International Business Machines Corporation. Appeal Br. 1.

² Claims 3 and 4 have been cancelled. Final Act. 2.

CLAIMED SUBJECT MATTER

The claims are directed to calculating customer experience based on product performance. Spec. ¶ 1. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A customer lifetime benefit (CLB) system, comprising:

a communication system that provides a communication link to a plurality of CLB compatible products;

an event processor that detects and processes events occurring on the plurality of CLB compatible products;

a response engine that determines an appropriate action from a set of possible actions to take in response to event data detected on a CLB compatible product, wherein the set of possible actions includes triggering a corrective action on the CLB compatible product;

a policy and security orchestrator for determining whether the appropriate action is consistent with a set of policies associated with the CLB compatible product; and

a lifecycle benefits analyzer that calculates a CLB metric based on operational compliance data of the CLB compatible product and resolution data resulting from corrective actions taken by the response engine, wherein the operational compliance data and the resolution data are generated by the CLB compatible product,

wherein the operational compliance data is calculated based on a comparison of collected event data against product design specifications, and wherein the resolution data is calculated based on a success or failure of a corrective action.

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Vaccarelli	US 2003/0163380 A1	Aug. 28, 2003
Bieda	US 2003/0171897 A1	Sept. 11, 2003
Brodie	US 2009/0182591 A1	July 16, 2009
Herrod	US 2010/0131792 A1	May 27, 2010
Monk	US 2013/0204785 A1	Aug. 8, 2013
Goyal	US 2014/0278798 A1	Sept. 18, 2014

REJECTIONS

Claims 8–20 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Final Act. 3.

Claims 1, 5, and 7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Herrod, Brodie, and Bieda. *Id.* at 4–10.

Claim 2 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Herrod, Brodie, Bieda, and Monk. *Id.* at 11.

Claim 6 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Herrod, Brodie, Bieda, and Vaccarelli. *Id.* at 12–14.

Claims 8, 11, 14, 15, and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Herrod, Brodie, and Goyal. *Id.* at 14–25.

Claims 10, 12, 17, and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Herrod, Brodie, Goyal, and Bieda. *Id.* at 25–29.

Claims 9 and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Herrod, Brodie, Goyal, and Monk. *Id.* at 29–31.

Claims 13 and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Herrod, Brodie, Goyal, and Vaccarelli. *Id.* at 31–35.

OPINION

This appeal presents two issues:

- 1) Did the Examiner err in determining that Appellant's originally filed Specification provides insufficient support under the first paragraph of § 112(a) for the limitation "sending a product promotion to the customers of the CLB compatible products based on the CLB metric," as recited in independent claims 8 and 15?
- 2) Did the Examiner err in determining that the combination of Herrod and Brodie teaches limitations involving the "resolution data," recited in all independent claims 1, 8, and 15?

Having reviewed the Examiner's rejections in light of Appellant's arguments, as presented in the Appeal Brief and Reply Brief, we are not persuaded that the Examiner has erred as Appellant alleges. We discuss each issue in turn.

1. Written Description Rejection

Claims 8 and 15 recite "sending a product promotion to the customers of the CLB compatible products based on the CLB metric." Claim App. 12, 14. The Examiner finds that the Specification does not disclose sending a product promotion to the customers of the CLB compatible product *based on the CLB metric*. Final Act. 3.

Appellant submits that the claim language complies with the written description requirement because paragraphs 14, 15, and 29 support the limitation. Appeal Br. 5. For instance, Appellant focuses on the disclosure at paragraph 15, which states that "[i]n one embodiment, a promotion is defined to be any offer, discount, incentive or similar activity *that is made available* to buyers of the product to address potential customer satisfaction

issues or inconveniences because of product performance non-compliance.” *Id.* (emphasis in original). In Reply, Appellant further relies on step 19 of Figure 3, and further argues that the disclosure shows that “an action (e.g., promotion) is taken based on the determined CLB metric.” Reply 2. We are not persuaded by Appellant’s argument that the written description supports the claim language.

As the Examiner points out, and we agree, the Specification “does not indicate anywhere that sending a product promotion to customers of the CLB compatible products is based on the CLB metric.” Ans. 4. Paragraph 15 does specify that a promotion is made available to buyers of the product, thus disclosing the sending of promotions. Spec. ¶ 15. But paragraph 15 also states that the CLB metric is determined based on the *impact* of the promotions acceptance rate. *Id.* Thus, although the CLB system may take a corrective action, such as sending a promotion, paragraph 15, at best, explains that the CLB system sends the promotion, and, based on the acceptance rate of the sent promotion, a CLB metric is determined. Paragraph 15, however, does not support the inverse proposition—that based on the CLB metric, the system sends a promotion as a corrective action.

Paragraphs 14 and 29 are in accord. For instance, paragraph 29 discloses that the CLB metric is the product of Product Benefit (PB) and Resolution Quality (RQ), where RQ is a function of “correction action resolution results that can be detected by the CLB system or supplied to the CLB system [.]” *Id.* ¶ 29. That is, the CLB metric is calculated based on the *results* of a corrective action, one of which may be a promotion. Paragraph 29 does not support the notion that the promotion is sent *based on*

the CLB metric. It is, rather, the opposite. The CLB metric is based on the promotion *results*.

Appellant's reliance on S19 of Figure 3 fares no better. Figure 3 shows that a promotion is indeed a corrective action. *Id.* Fig. 3 (showing step S16 as determining whether the event is a corrective action event, followed by determining the response at step S18, and finally taking the corrective action at step S19). More importantly, however, Figure 3 shows that the CLB metric calculation is not performed in the branch of corrective action determination. Rather, the CLB metric is derived *after* the system evaluates the resolution of the event. *Id.* (showing at step S21 a resolution completion evaluation and at S22 the CLB calculation). In sum, the embodiments Appellant identifies show that a promotion is a corrective action, but do not show that the sending of a corrective action is not *based on the CLB metric*.

Accordingly, we find that the Examiner did not err in rejecting claims 8–20 as failing to comply with the written description requirement.

2. Obviousness Rejection

Appellant argues that the Examiner's rejection of claims 1, 8, and 15 on the basis of Herrod and Brodie (at a minimum) is in error because Brodie does not teach certain limitations concerning the recited "results data" and that the Examiner's motivation for combining Herrod and Brodie are flawed. Appeal Br. 6–8. We address each argument in turn.

Appellant's Arguments Based on Brodie

Appellant focuses its arguments on the language of claim 1, and, thus our analysis below also focuses on that claim. *Id.* at 2. The Examiner finds that Herrod teaches most of the limitations of claim 1, except that Brodie

teaches the following: lifecycle benefits analyzer that calculates a CLB metric based on operational compliance data of the CLB compatible product and resolution data resulting from corrective actions taken by the response engine. Final Act. 6–8. With respect to the “resolution data,” the Examiner finds that Herrod also teaches the limitations “wherein the resolution data is calculated based on a success or failure of a corrective action” (*id.* at 6). We understand the rejection, therefore, to apply a combination of teachings from Herrod and Brodie, where Brodie’s teachings contribute the disclosure of the CLB metric calculation, and Herrod further contributes the required “resolution data.”

Appellant argues that Brodie’s calculation fails to teach the recited CLB metric calculation because Brodie’s metric is based on a “possible resolution,” rather than an “already executed corrective action.” Appeal Br. 6–7. The argument is not persuasive.

The rejection is not based on Brodie’s metric calculation alone. The Examiner also relies on Herrod’s teachings of a “problem resolution report” that the system generates to inform management personnel that the mobile device problem is resolved. Ans. 6 (citing Herrod ¶ 41); *see also* Ans. 5–6 (interpreting Herrod’s workflow generator, which determines corrective actions and generates the workflow to resolve the problem, as teaching the claim’s “response engine” that takes the corrective action), 8 (“The Herrod reference discloses resolution data taken by a response engine[,] and the Brodie reference discloses calculating CLB metric using resolution data.”). Paragraph 41 of Herrod states that the problem resolution report is part of the workflow report component, which generates reports for later review and

analysis to investigate systemic problems and to improve the overall efficiency of the enterprise mobile device architecture. Herrod ¶ 41.

Consequently, the rejection of claim 1 is not based on solely the Brodie metric calculation involving a determined resolution that is not yet implemented. The rejection also includes the teachings of Herrod's implemented resolution results as the results data that would be combined with the teaching of Brodie's metric calculation. Ans. 8; *see also* Appeal Br. 7 (pointing out the Examiner's reliance on Herrod "taking corrective action, [and] therefore the combination teaches allegedly the CLB metric based on 'resolution data resulting from corrective actions taken by the response engine.'"). "Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references." *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (citing *In re Keller*, 642 F.2d 413, 425 (CCPA 1981)). Appellant's arguments that focus on Brodie alone, therefore, do not persuade us that the Examiner erred.

Motivation to Combine Teachings

Appellant next argues that "the Examiner has not provided any motivation for modifying the metric calculated in Brodie to be based off data from Herrod's corrective action in order to modify Herrod to include 'a lifecycle benefits analyzer that calculates a CLB metric.'" *Id.* at 7.

Appellant explains that Brodie's calculation is not based on resolution data resulting from corrective actions *taken* by a response engine, and, that modifying "Brodie's metric to be calculated based on Herrod's corrective actions would frustrate the purpose of the calculation." *Id.* at 7–8.

Specifically, Appellant argues that "Brodie's metric is used to determine

resolution or corrective action that *should* be taken.” *Id.* at 8. Thus, “modifying the metric to be based off of the corrective action having already been taken [as taught in Herrod] would frustrate the purpose of the calculation.” *Id.*

The Examiner responds that a person of ordinary skill in the art would have combined the teachings to “better examine failure and resolution effects.” Ans. 8 (citing Brodie ¶ 8). Furthermore, the Examiner states that “the claimed invention is merely a combination of old elements in a similar field of endeavor and, in the combination, each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that, given the existing technical ability to combine elements as evidenced by Brodie, the results of the combination were predictable.” *Id.* (citing MPEP § 2143(A)).

We do not find error in the Examiner’s provided motivation to combine. Brodie states an advantage of examining failures and providing the most optimized resolution. Brodie ¶ 8. As stated above, the Examiner finds that the same advantage (to better examine failures and resolution effects) would have motivated a person of ordinary skill in the art to use the Brodie metric with Herrod’s teachings. Herrod similarly describes its desire to provide resolution reports to management to investigate systemic problems and to improve the overall efficiency of the enterprise mobile device architecture. Herrod ¶ 41 (*cited in* Ans. 6).

In the combination, Brodie’s metric calculation provides the added benefit of examining failures using Herrod’s resolution reports. This added benefit of Brodie advances the object of Herrod, which is to investigate systemic problems and to improve the efficiency of the system. Thus, one of

ordinary skill would have been motivated to apply Brodie’s metric calculation to enhance the benefit articulated by Herrod. Indeed, if Brodie’s metric provides a more optimized resolution to deploy, and Herrod provides the results of such a resolution, a metric that takes these resolutions into consideration would better inform a system administrator whether the optimized resolutions are indeed a more efficient resolution to systemic problems, as Herrod confirms.

Consequently, we are not persuaded by Appellant’s argument that the Examiner provides no reasonable motivation to combine the teachings of Herrod and Brodie with respect to claims 1, 8, and 15.^{3, 4}

CONCLUSION

The Examiner’s rejections of all pending claims are affirmed.

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed
8–20	112(a)	First, Paragraph: Written Description Requirement	8–20	
1, 5, 7	103(a)	Herrod, Brodie, Bieda	1, 5, 7	
2	103(a)	Herrod, Brodie, Bieda, Monk	2	
6	103(a)	Herrod, Brodie, Bieda, Vaccarelli	6	

³ Appellant does not argue separately claims 8 and 15, or any other claim for that matter. Appeal Br. 8. Therefore, all claims rise and fall in accordance with our determination concerning claim 1. 37 C.F.R. § 41.37(c)(1)(iv).

⁴ In the event further prosecution is warranted, the Examiner should consider whether the claims recite patent-eligible subject matter pursuant to the 2019 Revised Patent Subject Matter Eligibility Guidance. 84 Fed. Reg. 50.

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed
8, 11, 14, 15, 18	103(a)	Herrod, Brodie, Goyal	8, 11, 14, 15, 18	
10, 12, 17, 19	103(a)	Herrod, Brodie, Goyal, Bieda	10, 12, 17, 19	
9, 16	103(a)	Herrod, Brodie, Goyal, Monk	9, 16	
13, 20	103(a)	Herrod, Brodie, Goyal, Vaccarelli	13 20	
Overall Outcome:			1, 2, 5–20	

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