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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte COLIN SIDI, STEPHEN S. HASKELL, ABHIJIT NAIK, and
DEEPAK RATHI

Appeal 2019-000920
Application 13/787,124¹
Technology Center 2400

Before ALLEN R. MacDONALD, JON M. JURGOVAN, and
KEVIN C. TROCK, *Administrative Patent Judges*.

JURGOVAN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

On August 11, 2020, Appellant filed a Request for Rehearing under 37 C.F.R. § 41.52 following our Decision on Appeal mailed June 16, 2020. In the Decision, we affirmed the Examiner’s rejection of claims 1–9 and 21–23 under 35 U.S.C. § 103. We have jurisdiction under 35 U.S.C. § 6(b).

We have considered Appellant’s arguments in the Request for Rehearing, but we are not persuaded any points were misapprehended or overlooked by the Board in issuing the Decision. We have provided herein

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. According to Appellant, the real party in interest is W. W. Grainger, Inc. Appeal Br. 2.

additional explanations, but we decline to change our Decision in view of Appellant's arguments.

ANALYSIS

Appellant requests rehearing for the following reasons: (1) the Office allegedly did not meet its burden of showing that all claimed elements are expressly or inherently described in the prior art (Req. Reh'g 2–5); (2) the Board allegedly made new findings and adopted different reasoning from the Examiner to create an undesignated new ground of rejection (*id.* at 1–2, 7–8) that (3) impermissibly distilled the claimed invention down to its “gist” or “thrust” (*id.* at 2, 5–6) and (4) misapplied or misapprehended the law of obviousness (*id.* at 2, 4–7). We address Appellant's arguments below.

Burden Argument

The Examiner has the burden of establishing a *prima facie* case of obviousness under *Graham v. John Deere*, 383 U.S. 1 (1966). *In re Brandt*, 886 F.3d 1171, 1175–76 (Fed. Cir. 2018); *In re Bell*, 991 F.2d 781, 783 (Fed. Cir. 1993); *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. *In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). Once a *prima facie* case is established, the burden shifts to applicant to come forward with rebuttal evidence or argument to overcome the *prima facie* case. *Brandt*, 886 F.3d at 1176; *Bell*, 991 F.2d at 783–784; *Rijckaert*, 9 F.3d at 1532; *Oetiker*, 977 F.2d at 1445.

An examiner approaches the question of obviousness through underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) where present, objective evidence of nonobviousness. *Graham*, 383 U.S. at 17–18; MPEP §§ 2141–2145.

In the case before us, the Examiner met the requirements for a *prima facie* case of obviousness.² Final Act. 4–13. The Examiner considered the scope and content of the prior art, and cited teachings of each reference in correspondence with each claim limitation. *Id.* The Examiner identified differences between the subject matter and prior art, explaining what each reference did and did not teach or suggest in correspondence with the claim limitations, identified where a missing limitation could be found in another reference, and provided reasons why a person of ordinary skill in the art would have considered it beneficial to combine the references with reasonable expectation of success in arriving at the claimed invention. *Id.* The prior art references themselves may be considered representative of the level of ordinary skill in the art. *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (citing *Litton Indus. Prods., Inc. v. Solid States Sys. Corp.*, 755 F.2d 158 (Fed. Cir. 1985); *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 963 (Fed. Cir. 1986)). Appellant provided no objective evidence of nonobviousness. The Final Office Action was thus

² An example of the thoroughness of the Examiner’s rejection is shown for claim 1 where the Examiner cites Saghier 2:30–32, 2:56–57, 4:44–46, 4:66–67, 5:6–14, 6:17–18, 6:31–34, 8:54–62; Peles ¶¶ 3, 10, 25, 32; and Williams ¶¶ 136, 147, Fig. 11. Final Act. 5–7; *see also* Ans. 3–7.

sufficient to notify Appellant of the reasons for the Examiner's rejection, together with such information and references as may be useful in judging the propriety of continuing prosecution of the application. *See* 35 U.S.C. § 132; 37 C.F.R. § 1.104(a)(2).

Accordingly, the Examiner presented a *prima facie* case of obviousness despite Appellant's repeated assertions to the contrary. Req. Reh'g 5-7; Reply Br. 2, 4-6, 9, 11; Appeal Br. 9, 11. The burden of coming forward with evidence to rebut the Examiner's case thus shifted to Appellant. Instead of attempting to rebut the Examiner's *prima facie* case of obviousness, however, Appellant merely insists a *prima facie* case was never made, and argues that certain underlined text is missing from the cited references without explaining *why* this may be so. As we noted in our Decision, merely quoting and emphasizing certain claim language and asserting it is not described by a prior art reference is insufficient to constitute an argument. *See* Dec. 4; 37 C.F.R. § 41.37(c)(1)(iv) ("The arguments shall explain *why* the examiner erred as to each ground of rejection contested by appellant." (emphasis added)).

For example, Appellant argues Saghier does not expressly or inherently describe the claimed "individual application response times resulting from user interactions with each one of a plurality of applications running on a network." Req. Reh'g 3. Appellant argues the reason *why* Saghier does not describe this limitation is "self-evident." *Id.* This is insufficient to constitute an argument.

Even assuming Appellant's underlining and bolding of claim limitations constitutes an argument, a request for rehearing is not an opportunity to rehash or reargue points merely because Appellant does not

agree with the result of the Board's decision. The proper course for an appellant dissatisfied with a Board decision is to seek judicial review. *See* 35 U.S.C. §§ 141, 145. We deny the Request for Rehearing for this reason. Even if we could consider Appellant's arguments, however, we would still find them unpersuasive for reasons stated below.

New Findings Argument

Appellant argues we made new findings and adopted different reasons from the Examiner's to create an undesignated new ground of rejection. Req. Reh'g 5. Specifically, Appellant asserts we made a new finding that "Saghier at least suggests performance data may include individual application response times for each of multiple applications" to support the Examiner's reliance on Saghier to teach or suggest the claim limitation discussed above. *Id.* (citing Dec. 6) (emphasis Appellant's). We disagree that this statement amounts to a new finding or reasoning.

Appellant's brief underlined two parts of the claim limitation: "[1] individual application response times resulting from user interactions [2] with each one of a plurality of applications running on a network." Appeal Br. 5. Our statement addressed the first underlined claim limitation [1] and merely restated the Examiner's finding with respect to that limitation. Dec. 6; Final Act. 5–7. The second underlined limitation [2] had been addressed previously in the Decision. Dec. 5. Accordingly, our statement does not amount to new findings or different reasons creating an undesignated new ground of rejection.

To show that our statement is not a new finding or reasoning, we look to the Examiner's rejection of claim 1 as an example. Final Act. 5–7. As the Examiner noted, Saghier teaches that "[t]he system includes a computer

operable to execute applications” and “to generate performance data on the applications.” Ans. 4 (citing Saghier 2:52–56). Saghier also indicates that a person of ordinary skill in the art would have understood that performance data may include response time. Saghier 1:58–60 (“these computers are always working to provide the *response time* as defined in contracted service level agreements” (emphasis added)). Saghier even *claims* “executing software to measure samples of performance of *one or more applications* in a computer” (emphasis added). Saghier 13:12–13 (claim 31). The plain meaning of these statements includes that response time is obtained for each individual application. Peles also teaches use of application response time to measure system performance in computer networks. Final Act. 6–7 (citing Peles ¶¶ 3, 25). Thus, as the Examiner noted, both Saghier and Peles teach the limitation of “individual application response times” notwithstanding Appellant’s argument to the contrary.

Saghier further teaches response times in connection “with each one of a plurality of applications running on a network.” Final Act. 5. Specifically, as the Examiner noted, Saghier teaches “[t]he system includes a computer operable to execute *applications*” and “[c]omputer **310** may be any computing device that operates in a standalone mode or *in a network.*” *Id.* (citing Saghier 6:16–17); Ans. 4 (citing Saghier 2:52–56) (emphases added). Also, Saghier’s background describes what a person of ordinary skill in the art would have known, that “[i]n today’s world, *numerous computers are dispersed throughout many networks* covering a *range of applications* and activities.” Saghier 1:56–58 (emphases added). Saghier also teaches transactions on a computer can be initiated by a user. *Id.* at 4:57–60. Considering Saghier’s teachings together, we agree with the

Examiner that a person of ordinary skill in the art would have understood Saghier to teach or at least suggest the claim limitation of “individual application response times resulting from user interactions with each one of a plurality of applications running on a network” (emphases Appellant’s).

Gist Argument

Appellant argues we impermissibly distilled the claimed element into its gist or thrust. Req. Reh’g. 2, 6. We disagree. As discussed above, our statement that “Saghier at least suggests performance data may include individual application response times for each of multiple applications” was to address the first part of the claim limitation emphasized by Appellant (“individual application response times”). Dec. 6. The second part emphasized by Appellant (“with each one of a plurality of applications running on a network”) had been addressed already on the previous page. Dec. 5. We agree with the Examiner that the references teach or suggest the entirety of the claim limitation, including the parts emphasized by Appellant. See Dec. 4–6; Final Act. 5–7.

Misapplied or Misapprehended Law Argument

Appellant argues that the alleged new finding “evidences that the Board misapprehended or misapplied the law.” Req. Reh’g 2. According to Appellant, the burden of demonstrating a *prima facie* case requires the Examiner to: “A) demonstrate that all of the **claimed elements** were **expressly or inherently described** in the prior art; and B) demonstrate that one skilled in the art could have combined such **described elements** by known methods with no change in their respective functions with the

combination yielding nothing more than predictable results.” Req. Reh’g 2.³ However, none of the cases that Appellant cites actually state the burden for a *prima facie* case in this way. *Id.* In fact, none of these cases relate to patent examination at all. *Id.*

The patent statute expressly requires consideration of differences between the claimed invention and the prior art. 35 U.S.C. § 103; *Graham*, 383 U.S. at 17–18. Under Appellant’s understanding of a *prima facie* case of obviousness, no differences would be possible because each claim element would have to be expressly or inherently described in the prior art. But cases like *Brandt, supra*, where the claimed range was close but did not overlap the prior art, show that a claim element can differ from the prior art, and yet still be found unpatentable as obvious. Appellant’s understanding of a *prima facie* case of obviousness also does not take into account that the general knowledge of a person of ordinary skill in the art can supply a missing claim element. *See Koninklijke Philips N.V. v. Google LLC*, 948 F.3d 1330 (Fed. Cir. 2020).

In addition, combining elements according to known methods is not the only way that teachings of different references can be combined. Other ways include simple substitution of one known element for another; use of known technique to improve similar devices in the same way; applying a

³ Appellant’s understanding of a *prima facie* case of obviousness may be misinterpreting case law which states “[t]o support the conclusion that the claimed [invention] is directed to obvious subject matter, either the reference[] must *expressly or impliedly suggest* the claimed [invention] or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (BPAI 1985) (emphasis added).

known technique to a known device; obvious to try; known work in one field prompting variations in another; and a teaching, suggestion or motivation to combine prior art to arrive at the claimed invention. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 415–421 (2007); MPEP § 2143.

Thus, we decline to apply Appellant's understanding of what is required for a *prima facie* case of obviousness. Instead, we reviewed the Examiner's rejection under the principles previously stated herein and found the Examiner's rejection sufficient to establish a *prima facie* case of obviousness.

Appellant takes issue with our statement “[i]n the obviousness analysis, however, it is not necessary that the combined references ‘expressly describe’ the claimed invention, only that they teach or suggest it.” Req. Reh’g 4 (citing Dec. 5 (citing *Keller*, 642 F.2d at 425 (CCPA 1981))). This is a correct statement of the law. As we stated earlier, a *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have *suggested* the claimed subject matter to a person of ordinary skill in the art. *Rinehart*, 531 F.2d at 1051; *Keller*, 642 F.2d at 425. Appellant’s approach that the references must expressly or inherently describe each claim element fails to consider the teachings of the references in combination and as a whole for what they would *suggest* to a person of ordinary skill in the art, as required in the obviousness analysis before the Office. The Final Office Action meets *Rinehart*’s standard for a *prima facie* case as the combined teachings of the references suggest the claimed subject matter. Appellant’s arguments (to the extent they could be considered such) fail to rebut the Examiner’s *prima facie* case of obviousness.

Appellant argues that *Keller* involved combining elements expressly described in references, and did not remove the burden placed on the Examiner. Req. Reh’g 4–5. None of the references in *Keller* expressly or inherently described Walsh’s digital timing to replace Keller’s or Berkovits’s analog-timed cardiac pacers, yet the court found the claims obvious over these combinations. In so doing, the court stated “the test is what the combined teachings of the references would have *suggested* to those of ordinary skill in the art” (emphasis added). *Keller*, 642 F.2d at 425.

DECISION

In view of the foregoing discussion, we deny Appellant’s request to make any changes in our Decision. Appellant has not identified any points the Board has misapprehended or overlooked.

The request for rehearing is denied.

Outcome of Decision on Rehearing:

Claims Rejected	35 U.S.C. §	References	Denied	Granted
1, 2, 6, 21–23	103	Saghier, Peles, Williams	1, 2, 6, 21–23	
7	103	Saghier, Peles, Williams, Breslin	7	
3–5, 8, 9	103	Saghier, Peles, Williams, Jones	3–5, 8, 9	
Overall Outcome			1–9, 21–23	

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Final Outcome of Appeal after Rehearing:

Claims Rejected	35 U.S.C. §	References	Affirmed	Reversed
1, 2, 6, 21-23	103	Saghier, Peles, Williams	1, 2, 6, 21-23	
7	103	Saghier, Peles, Williams, Breslin	7	
3-5, 8, 9	103	Saghier, Peles, Williams, Jones	3-5, 8, 9	
Overall Outcome			1-9, 21-23	

DENIED