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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------------|------------------|
| 14/053,260 | 10/14/2013 | Gerard Cunningham | GB920120116US2 8152-0233 | 1670 |
| 112978 | 7590 | 02/27/2020 | EXAMINER | |
| Cuenot, Forsythe & Kim, LLC 20283 State Road 7, Suite 300 Boca Raton, FL 33498 | | | MCLEOD, MARSHALL M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2454 | |
| | | | NOTIFICATION DATE | DELIVERY MODE |
| | | | 02/27/2020 | ELECTRONIC |

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GERARD CUNNINGHAM, ELAINE HANLEY,
RONAN M. O'SUILLEABHAIN, and FRED RAGUILLAT

Appeal 2019-004948
Application 14/053,260
Technology Center 2400

Before JAMES R. HUGHES, ERIC S. FRAHM, and
MATTHEW J. McNEILL, *Administrative Patent Judges*.

FRAHM, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ appeals under 35 U.S.C. § 134 from a rejection of claims 26–35. Claims 1–25 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b). We affirm in part.

DISCLOSED AND CLAIMED INVENTION

The invention relates to “[r]eal time collaboration involv[ing] use of the Internet and presence technology for people to communicate amongst themselves” (Spec. ¶ 1), and more particularly to a method for generating a user unavailability alert in a collaborative environment, for example, an environment where users collaborate using a communication network. *See* Spec. ¶¶ 2, 18; Figs. 1–3; claim 26. According to Appellant:

Aspects of a collaborative environment may include, but are not limited to, electronic mail (email), text messaging, instant messaging (IM), telephone calls, telephone conferences, video conferences, web conferences, social media (e.g., via social networking sites), calendaring applications, and/or the like. *Within a collaborative environment, a user 105 may participate in one or more collaborative sessions.* Each collaborative session may include user participation in one or more aspects of the collaborative environment. Further, each collaborative session can pertain to a particular subject, for example a project. One or more users can be assigned actions (e.g., tasks) pertaining to the particular subject. Further, *one or more participants may be assigned responsibility for monitoring the progress of other participants on assigned actions (e.g., pending actions), or may otherwise be impacted by the progress of other participants on assigned actions.*

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. “The word ‘applicant’ when used in this title refers to the inventor or all of the joint inventors, or to the person applying for a patent as provided in §§ 1.43, 1.45, or 1.46.” 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as IBM Corporation. Appeal Br. 1.

Spec. ¶ 18 (emphases added). More specifically, the system allows a user to select a control that indicates the user's unavailability, and if participants in collaborative sessions may be impacted by the user's unavailability, the system generates and sends a message to the impacted participants indicating the user's unavailability. Spec. ¶¶ 23, 29–30. Claim 26, reproduced below with bracketed lettering and emphases added, is illustrative of the claimed subject matter:

26. A computer-implemented method of generating a user unavailability alert in a collaborative environment, comprising:
receiving, from a user, a user input indicating an unavailability of the user;
[A] identifying, responsive to the user input, *a collaborative session* in which the user participated;
[B] identifying a pending action to be performed by the user within the identified collaborative session;
[C] *determining a completion time* for the identified pending action and a second participant of the collaborative session; and
sending, based upon the user input indicating the unavailability of the user and the completion time, a first message to the second participant.

Appeal Br. 18, Claims Appendix (bracketed lettering and emphases added).

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

| | | |
|---------|--------------------|----------------|
| Hatoun | US 2006/0069599 A1 | Mar. 30, 2006 |
| Chakra | US 2009/0319926 A1 | Dec. 24, 2009 |
| Norwood | US 2010/0250322 A1 | Sept. 30, 2010 |
| Caligor | US 2012/0239451 A1 | Sept. 20, 2012 |

REJECTIONS

The Examiner made the following rejections:

Claims 26–30, 32, and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chakra and Hatoun. Final Act. 2–6.

Claims 31 and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chakra, Hatoun, and Caligor. Final Act. 6–8.

Claim 35 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Chakra, Hatoun, and Norwood. Final Act. 8–9.

ISSUES

Based on Appellant’s arguments in the Appeal Brief (Appeal Br. 4–16) and the Reply Brief (Reply Br. 2–9),² the following principal issues are presented on appeal:

(1) Did the Examiner err in rejecting claims 26 and 30–35 under 35 U.S.C. § 103(a) as being unpatentable over the base combination of Chakra and Hatoun, because (a) Hatoun fails to teach or suggest identifying “a collaborative session” and “a pending action to be performed” therein, and “determining a completion time,” as recited in limitations A, B, and C of representative claim 26; and/or (b) there is not proper motivation to combine Chakra and Hatoun?

² Notably, Appellant does not present any arguments as to the rejection of claim 35. Therefore, we summarily sustain the Examiner’s rejection of claim 35, and do not discuss this rejection further herein, except for our conclusion. Appellants rely on the arguments presented as to claim 26 as to the patentability of claims 31 and 34, and state that these claims stand/fall with claim 26 (Appeal Br. 14–15). Therefore, we decide the outcome of the rejection of claims 31 and 34 on the same basis as provided for claim 26.

(2) Did the Examiner err in rejecting dependent claim 27 under 35 U.S.C. § 103(a) as being unpatentable over the base combination of Chakra and Hatoun, because Hatoun fails to teach or suggest identifying the pending action by analyzing “collaborative media” associated with the collaborative session, as recited in claim 27?

(3) Did the Examiner err in rejecting dependent claim 28 under 35 U.S.C. § 103(a) as being unpatentable over the base combination of Chakra and Hatoun, because Hatoun fails to teach or suggest sending the first message to the second participant “based upon an analysis that concludes that the unavailability of the user impacts and second participant,” as recited in claim 28?

(4) Did the Examiner err in rejecting dependent claim 29 under 35 U.S.C. § 103(a) as being unpatentable over the base combination of Chakra and Hatoun, because Hatoun fails to teach or suggest “wherein the determining the completion time includes an amount of work already performed by the user on the identified pending action,” as recited in claim 29?

ANALYSIS

Obviousness Rejection of Representative Claim 26

We have reviewed the Examiner’s rejection of claim 26 (Final Act. 2–3) in light of Appellant’s arguments (Appeal Br. 4–11; Reply Br. 2–6) that the Examiner has erred, as well as the Examiner’s response to Appellant’s arguments in the Appeal Brief (Ans. 3–6). Appellant’s arguments are not persuasive of error. With regard to representative claim 26, we agree with and adopt as our own the Examiner’s findings of facts and conclusions as set

forth in the Final Rejection (Final Act. 2–3) and Answer (Ans. 3–6). We provide the following explanation for emphasis.

Appellant has not shown the Examiner erred in rejecting claim 26 under 35 U.S.C. § 103(a) as being unpatentable over the base combination of Chakra and Hatoun, because Hatoun teaches or suggests identifying “a collaborative session” and “a pending action to be performed” therein, and “determining a completion time,” as recited in limitations A, B, and C of claim 26.

We agree with the Examiner that Hatoun teaches (i) identifying a collaborative session based on a user’s input (*see* Final Act. 3 citing Hatoun ¶ 48); (ii) identifying a pending action to be performed in a collaborative session (*see* Final Act. 3 citing Hatoun ¶ 48); and (iii) determining a due date (i.e., a completion time) for the identified pending action or task (*see* Final Act. 3 and Ans. 4 citing Hatoun ¶¶ 38, 45), as recited in limitations A, B, and C of claim 26. We also agree with the Examiner’s determination (*see* Ans. 3–4) that the *combination* of Chakra and Hatoun teaches or suggests determining a completion time, because Hatoun’s use of a due date for task completion and percent complete information taken with Chakra’s event report 137 and completion task indicator with event specific data 136 (*see* Chakra ¶ 26) would predictably yield determining a completion time.

With regard to the motivation to combine Chakra and Hatoun, we agree with the Examiner’s rationale for making the combination set forth at page 3 of the Final Rejection:

It would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the collaborative systems of Chakra with the collaborative application teachings of Hatoun. By modifying the collaborative calendar application

disclosed at paragraph [0023] of Chakra [t]o further include the ability to track workflow (i.e. task/workload status) (Hatoun; Paragraph [0003]). In order to better provide project managers, managers and users detailed task/workload status (Hatoun; Paragraph [0003]) and to improve and/or add workflow capabilities to applications (Hatoun; Paragraph [0008]).

Final Act. 3; and at pages 4 through 6 of the Answer:

Hatoun discloses in paragraph [0023], a ‘Due Date’; please also see Hatoun Figure 6, item 440, which shows the Due Date, including the time. The examiner further states that Hatoun in paragraph [0023] discloses in part that ‘ ... The Due Date function returns the date that a task is due for completion ... ‘. As such, it would have been obvious to a person having ordinary skill in the art to modify Chakra’s ‘completion status indicator’ as disclosed in Chakra paragraph [0026] to further include a date and time of completion as disclosed in Hatoun paragraph [0023]; Figure 6, item 440. A person having ordinary skill in the art would find it obvious to modify Chakra’s ‘completion status indicator’ which one of ordinary skill in the art would know that an ‘status indicator’ could be any piece of data for providing information on any task. Thus, modifying Chakra’s ‘completion status indicator’ to include a date and time would have been obvious to one of ordinary skill in the art when viewing Chakra in light of Hatoun’s Due Date indicator/field as disclosed in Hatoun Figure 6, item 440.

Ans. 4–5. Finally, we agree with the Examiner that:

obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007).

Ans. 5–6.

The Supreme Court and our reviewing court, the Court of Appeals for the Federal Circuit, have repeatedly held that the motivation that a person of ordinary skill in the art would have had to combine prior art references need not be the same motivation that inspired the patent owner. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 420 (2007) (“[A]ny need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.”); *In re Kahn*, 441 F.3d 977, 989 (Fed. Cir. 2006) (“[T]he skilled artisan need not be motivated to combine [a prior art reference] for the same reason contemplated by the [inventor]”); *In re Beattie*, 974 F.2d 1309, 1312 (Fed. Cir. 1992) (“As long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not required that the references be combined for the reasons contemplated by the inventor.”); *In re Kronig*, 539 F.2d 1300, 1304 (CCPA 1976). “[T]he problem motivating the patentee may be only one of many addressed by the patent’s subject matter.” *KSR*, 550 U.S. at 420. Any motivation, “whether articulated in the references themselves or supported by evidence of the knowledge of a skilled artisan, is sufficient.” *Outdry Technologies Corp. v. Geox S.p.A.*, 859 F.3d 1364, 1370–71 (Fed Cir. 2017). In other words, some motivation to combine is necessary, but it does not have to be the same motivation cited by Appellants. This, the Examiner has provided.

In this light, Appellant’s contentions that (a) “the claimed invention does not entail providing ‘detailed task/workload status’ or ‘improv[ing] and/or add[ing] workflow capabilities to applications;”” and (b) in making the combination “the Examiner is relying upon teachings that have nothing to do with either (i) the claimed invention or (ii) the limitations that the Examiner is relying upon Hatoun to teach” are not persuasive.

In view of the foregoing, Appellant has not overcome the Examiner's prima facie case of obviousness with respect to independent claim 26. We are not persuaded the Examiner erred in rejecting claim 26. Accordingly, we sustain (i) the Examiner's rejection of independent claim 26, as well as corresponding dependent claims 30, 32, and 33 grouped therewith; and (ii) the Examiner's rejection of claim 35 not separately argued.

Obviousness Rejection of Dependent Claim 27

Claim 27 depends from claim 26, and recites, in pertinent part:

in response to the collaborative session being identified, collaboration media associated with the collaborative session is retrieved, and

the pending action is identified *based upon an analysis of the collaboration media.*

Appeal Br. 18, Claims Appendix (emphases added). Appellant's Specification states that "the term 'collaboration media' means any media generated during a collaboration session, for example, text, audio, video, images, slides, and so on." Spec. ¶ 25.

The Examiner relies upon paragraphs 45 and 48 as teaching or suggesting the limitations of claim 27 (*see* Final Act. 4; Ans. 6–7), determining that Hatoun's examination of workflows is equivalent to the recited analysis of collaboration media (*see* Ans. 6–7).

Paragraph 45 of Hatoun describes that "the workflow engine **140** *examines the workflow* being managed and executed by the workflow engine **140** to determine if there are any incomplete tasks" (Hatoun ¶ 45) (italicized emphasis added). And, paragraph 48 of Hatoun describes that "any *documents* associated with the incomplete task *are identified.*" Hatoun ¶ 48 (emphasis added). Thus, Hatoun does not teach *analyzing the collaborative*

media as claimed, where collaborative media is defined as “any media generated during a collaboration session, for example, text, audio, video, images, slides, and so on.” Spec. ¶ 25. At best, Hatoun teaches (i) identifying a document (*see* Hatoun Fig. 10B, step 720; ¶ 48); (ii) examining a workflow or incomplete task, and not a collaborative media (*see* Hatoun Fig. 10A; ¶ 45); and (iii) facilitating the filling out of a workflow task form (*see* Hatoun Fig. 10B, steps 730, 735, 740; ¶ 48).

In this light, we concur with Appellant’s assertions (*see* Appeal Br. 11–12; Reply Br. 6–7) that neither Hatoun, nor the combination of Chakra and Hatoun, shows or describes performing an “analysis of the collaboration media” as set forth in claim 27.

Based on the foregoing, we find that the Examiner has not properly established factual determinations and articulated reasoning with a rational underpinning to support the legal conclusion of obviousness for dependent claim 27, resulting in a failure to establish a *prima facie* of obviousness.

Obviousness Rejection of Dependent Claim 28

We have reviewed the Examiner’s rejections (Final Act. 4; Ans. 7–8) in light of Appellant’s arguments in the briefs (*see* Appeal Br. 12–13; Reply Br. 7–8) that the Examiner has erred. We disagree with Appellant’s contentions. With regard to claim 28, we adopt as our own (1) the findings and reasons set forth by the Examiner in the Final Office Action from which this appeal is taken (Final Act. 4), and (2) the reasons set forth by the Examiner in the Examiner’s Answer (Ans. 7–8) in response to Appellant’s Appeal Brief. We concur with the conclusions reached by the Examiner. We agree with the Examiner’s findings that paragraphs 26 and 28, taken with paragraphs 38 and 47, of Hatoun, teach or suggest sending the first

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message to the second participant “based upon an analysis that concludes that the unavailability of the user impacts and second participant,” as recited in claim 28. *See* Final Act. 4; Ans. 7–8. Specifically, we agree with the Examiner’s rationale found at page 8 of the Answer, namely:

that viewing paragraph [0038] in light of cited paragraphs [0026] and [0028] it is clear to one of ordinary skill in the art that the *‘unavailability of the user impacts the second participant’* as disclosed in paragraph [0038] impacts **‘a document cannot be approved until a draft of the document is written’**. In other words if a user is unavailable to draft/write a document it impact a second person/participant's ability to approve said document.

Ans. 8; and “when Hatoun is viewed in context and the citations read in light of appellants limitation and contentions, Hatoun's paragraphs [0038] and [0047] [e.g., detecting and notifying a group of users of incomplete tasks] teach appellants limitation” (Ans. 8).

In view of the foregoing, we are not persuaded the Examiner erred in rejecting claim 28, and we sustain the Examiner’s rejection of independent claim 28.

Obviousness Rejection of Dependent Claim 29

We have reviewed the Examiner’s rejections (Final Act. 5; Ans. 9–10) in light of Appellant’s arguments in the briefs (Br. 13–14; Reply Br. 8–9) that the Examiner has erred. We disagree with Appellant’s contentions. With regard to claim 29, we adopt as our own (1) the findings and reasons set forth by the Examiner in the Final Office Action from which this appeal is taken (Final Act. 5), and (2) the reasons set forth by the Examiner in the Examiner’s Answer (Ans. 9–10) in response to Appellant’s Appeal Brief. We concur with the conclusions reached by the Examiner. And particularly,

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we agree with the Examiner's finding that Hatoun's Figure 4 (*see* Fig. 4, column name header 325 and data block 330; *see also* ¶ 30) and Figure 6 (*see* Fig. 6, name/data field pair 420; *see also* ¶ 32) "clearly show[] user percentages of work completed" (Ans. 9).

In view of the foregoing, we are not persuaded the Examiner erred in rejecting claim 29, and we sustain the Examiner's rejection of independent claim 29.

Obviousness Rejection of Dependent Claims 31 and 34

Appellant does not present specific arguments regarding the obviousness rejection of claims 31 and 34, but rather rely on the same arguments presented for claim 26. *See* App. Br. 14–15. Appellant's claim 26 arguments are not persuasive, as discussed above, and thus we sustain the rejections of claims 31 and 34 for the same reasons as claim 26.

Summary

Under 35 U.S.C. § 103(a), Appellant has not shown the Examiner erred in rejecting claims 26 and 28–35 over the base combination of Chakra and Hatoun. Under 35 U.S.C. § 103(a), Appellant has shown the Examiner erred in rejecting claim 27 over the combination of Chakra and Hatoun. For the above reasons, we affirm the Examiner's decision to reject claims 26 and 28–35, and we reverse the Examiner's decision to reject claim 27.

CONCLUSION

In summary:

| Claims Rejected | 35 U.S.C. § | References | Affirmed | Reversed |
|------------------------|--------------------|-------------------------|-----------------|-----------------|
| 26–30, 32, 33 | 103(a) | Chakra, Hatoun | 26–30, 32, 33 | 27 |
| 31, 34 | 103(a) | Chakra, Hatoun, Caligor | 31, 34 | |
| 35 | 103(a) | Chakra, Hatoun, Norwood | 35 | |
| Overall Outcome | | | 26, 28–35 | 27 |

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