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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* ANAND RAGHUNATHAN, SRIVATHS RAVI,  
NACHIKETH POTLAPALLY, SRIMAT CHAKRADHAR,  
and MURUGAN SANKARADAS

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Appeal 2010-001542  
Application 10/259,569<sup>1</sup>  
Technology Center 2400

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Before CAROLYN D. THOMAS, CARL W. WHITEHEAD JR., and  
ANDREW J. DILLON, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> The real party in interest is NEC Corporation.

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1-30, which are all the claims pending in the application. We have jurisdiction over the appeal under 35 U.S.C. § 6(b). We also use our authority under 37 C.F.R. § 41.50(b) to enter a new ground of rejection of claims 1-9, 15-23, and 26-30.

We AFFIRM.

The present invention relates generally to efficiently executing security protocols. *See* Abstract.

Claim 1 is illustrative:

1. A programmable security processor for efficient execution of security protocols, wherein the instruction set of the processor is enhanced to contain at least one instruction that is used to improve the efficiency of a public-key cryptographic algorithm, and at least one instruction that is used to improve the efficiency of a private-key cryptographic algorithm,

wherein the security processor is a processor that is dedicated to perform security related functions and performs no other functions.

Appellants appeal the following rejections:

R1. Claims 1-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Burke (*Architectural Support for Fast Symmetric-Key Cryptography*, Operating System Review, Vol. 34, No. 5, pp. 178-89, A.C.M., Dec. 2000) and Ekner (US Patent Pub. 2006/0190518 A1, Aug. 24, 2006);

R2. Claims 10-16, 18, and 22-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Killian (US 6,477,683 B1, Nov. 5,

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2002) and Burke; and

R3. Claims 17 and 19-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Killian, Burke, and Pinder (US 6,424,717 B1, July 23, 2002).

### Claim Groupings

Based on Appellants' arguments in the Appeal Brief, we will decide the appeal on the basis of claims as set forth below. *See* 37 C.F.R. 41.37(c)(1)(iv).

### ANALYSIS

#### *Claims 1-9, 15-23, and 26-30*

**Issue:** Did the Examiner err in finding that the cited art, specifically Burke, teaches and/or suggests a “security processor . . . that is dedicated to perform security related functions and performs no other functions,” as set forth in claim 1?

Appellants contend that “Burke does not suggest a security processor that is dedicated to performing security functions and does not perform any other functions” (App. Br. 10).

The Examiner found that “Burke further discloses ‘we are now exploring the implications of a design where the **primary purpose of the processor is cryptographic processing**’” (Ans. 13).

Specifically, Burke discloses that “[w]e are now exploring the implications of a design where the primary purpose of processor is cryptographic processing. . . . but it need not support the generality of all

programs.” (p.189.) In other words, Burke merely discloses a primary purpose of the processor, i.e., cryptographic. However, the Examiner has not established, and we do not find, where Burke discloses a processor “dedicated to perform security related functions and performs no other functions,” as required by claim 1 (emphasis added), as Burke merely discloses a primary focus of its processor, yet also discloses that the processor can support general programs.

Simply asserting that Burke discloses “a security processor that is dedicated to performing security functions” (*see* Ans. 13) does not amount to a finding supportive of the Examiner’s obviousness conclusion that Burke’s processor performs no other function. We agree with Appellants that “denoting something as ‘primary’ as opposed to denoting it as ‘sole’ or ‘dedicate[d]’ clearly indicates that Burke contemplates other ‘secondary’ uses other than security processing” (*see* Reply Br. 5).

We are therefore constrained by the record before us to find that the Examiner erred in rejecting independent claim 1 (and dependent claims 2-9), independent claim 15 (and dependent claims 16-23), and independent claim 26 (and dependent claims 27-30) which all contain this limitation.

Since we agree with at least one of the arguments advanced by Appellants, we need not reach the merits of Appellants’ other arguments regarding these claims. It follows that Appellants have shown that the Examiner erred in finding that Burke alone or in combination with either Ekner, Killian, and/or Pinder renders claims 1-9, 15-23, and 26-30 unpatentable.

*Claims 10-12*

**Issue 2:** Did the Examiner err in finding that Killian teaches and/or discloses a layered software library, as set forth in claim 10?

Appellants contend that “these passages [in Killian] do not suggest a layered software library for efficient execution of security protocols” (App. Br. 13).

The Examiner found that “Killian discloses the layered software library” (Ans. 16).

Specifically, Killian discloses that “the preferred embodiment of this invention groups the software to perform those tasks into a separate software library” (col. 28, ll. 17-19). In other words, Killian teaches generating a software library for performing the tasks. While Appellants contend that Killian do not suggest a layered software library for efficient execution of security protocols (*see* App. Br. 13), we note that such a contention merely amounts to an “intended use” of the software library.

However, an intended use of a claimed device does not limit the scope of the claim. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997) (product claim’s intended use recitations not given patentable weight); *see also Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003) (“An intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates.”). Although “[s]uch statements often . . . appear in the claim’s preamble,” *In re Stencel*, 828 F.2d 751, 754 (Fed. Cir. 1987), a statement of intended use or purpose can appear elsewhere in a claim. *Id.*

Here, the recited “for efficient execution of security protocols” does no more than define a context in which the invention operates. Therefore, such a statement will not be given any patentable weight. Moreover, arguments not made are waived. *See* 37 C.F.R. § 41.37(c)(1)(vii). *Cf. In re Baxter Travenol Labs.*, 952 F.2d 388, 391 (Fed. Cir. 1991) (“It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art.”)

Based on the record before us, we find no error in the Examiner’s obviousness rejection of claim 10, and claims 11 and 12, essentially for the reasons indicated by the Examiner.

*Claims 13, 14, 24, and 25*

On this record, we find Appellants have failed to present *substantive* arguments and supporting *evidence* persuasive of Examiner error regarding the aforementioned claims. *See In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011)(“we hold that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.”). Here, Appellants merely rely on the arguments made for claims 1 and 10 (*see* App. Br. 13), however, such argued limitations are not found in the above-noted claims.

As such, Appellants present no arguments pertaining to the Examiner’s obviousness rejections of claims 13, 14, 24, and 25. Accordingly, we summarily sustain these rejections. *See* Manual of Patent Examining Procedure (MPEP) § 1205.02, 8th ed., Rev. 8, July 2010 (“If a

ground of rejection stated by the examiner is not addressed in the appellant's brief, that ground of rejection will be summarily sustained by the Board.”).

*New Ground of Rejection of Claims 1-9, 15-23, and 26-30  
Under 35 U.S.C. § 112, first paragraph*

Under 35 U.S.C. § 112, the specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement. If a claim is amended to include subject matter, limitations, or terminology not present in the application as filed, involving a departure from, addition to, or deletion from the disclosure of the application as filed, the examiner should conclude that the claimed subject matter is not described in that application. This conclusion will result in the rejection of the claims affected under 35 U.S.C. § 112, first paragraph - description requirement, or denial of the benefit of the filing date of a previously filed application, as appropriate.

Claims 1-9, 15-23, and 26-30 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the claims contains subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had

possession of the claimed invention. The limitation “dedicated to perform security related functions and performs no other functions” in all independent claims 1, 15, and 26 does not find express or implied support in the original Specification, particularly in paragraph [0053] as highlighted by Appellants (*see* App. Br. 6).

*37 C.F.R. § 41.50(b)*

37 C.F.R. § 41.50(b) provides that, “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellants, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 C.F.R. § 1.197 (b) as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner ...

(2) Request rehearing. Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record ...

DECISION

We reverse the Examiner’s § 103 rejections of claims 1-9, 15-23, and 26-30.

We affirm the Examiner’s § 103 rejection of claims 10-14, 24, and 25.

Since we have entered a new ground of rejection against claims 1-9, 15-23, and 26-30 under 35 U.S.C. § 112, first paragraph, our decision is not a final agency action.

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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  
37 C.F.R. § 41.50(b)

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