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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* JAMES L. WOOLDRIDGE and JAMES J. BOZEK

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Appeal 2010-001719  
Application 10/971,256  
Technology Center 2100

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*Before* CARL W. WHITEHEAD, JR., ERIC S. FRAHM, and  
ANDREW J. DILLON, *Administrative Patent Judges*.

DILLON, *Administrative Patent Judge*.

#### DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejections of claims 1-15. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

#### STATEMENT OF THE CASE

The present invention is directed to a method of installing more than a typically needed amount of resource within a computer system and then licensing a fractional amount of the resource to the system on an as-needed basis. Spec., p. 15, l. 13 – p. 16, l. 13.

Claim 1 is illustrative, with key disputed limitations emphasized:

1. A method comprising:

conducting an inventory of resources of a computer system, *the resources being processors installed within the computer system*, wherein the inventory is conducted by generating a directory of the resources installed within the computer system, the directory stored in a secure storage of the computer system;

determining which of the resources of the computer system are licensed for usage by parsing the directory;

*permitting utilization of the resources of the computer system that are licensed for usage; and,*

*preventing utilization of other resources of the computer system that are not licensed for usage.*

The Examiner relies on the following references as evidence of unpatentability:

Ross	US 5,553,143	Sept. 3, 1996
Matsuzuki	US Pat. Pub. 2002/0019977 A1	Feb. 14, 2002
Gold	US Pat. Pub. 2002/0188704 A1	Dec. 12, 2002
Foster	US 6,832,358 B2	Dec. 14, 2004
Wang	US 6,889,212 B1	May 3, 2005

### THE REJECTIONS

The Examiner rejected claims 1 and 3-6 under 35 U.S.C. § 103(a) as unpatentable over Gold, Ross, and Foster. Ans. 7-10.<sup>1</sup>

The Examiner rejected claim 2 under § 103(a) as unpatentable over Gold, Ross, Foster, and Wang. *Id.* at 10-11.

The Examiner rejected claims 7 and 8 under § 103(a) as unpatentable over Gold, Ross, Foster, and Matsuzuki. *Id.* at 11-12.

The Examiner rejected claims 9-11 under § 103(a) as unpatentable over Gold and Foster. *Id.* at 4-7.

The Examiner rejected claims 12-15 under § 103(a) as unpatentable over Gold, Foster, and Matsuzuki. *Id.* at 14-19.

### ISSUE

Based upon our review of the record, the arguments proffered by Appellants, and the findings of the Examiner, we address the following issue:

Under § 103, has the Examiner erred in determining that Gold and Foster suggest the claimed licensing of a fractional amount of preinstalled processors?

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<sup>1</sup> Throughout this opinion, we refer to the Appeal Brief filed April 26, 2009 (“App. Br.”), the Examiner’s Answer mailed July 1, 2009 (“Ans.”), and the Reply Brief mailed August 29, 2009.

## ANALYSIS

### *Claims 1-8*

Independent claim 1 stands rejected as obvious over Gold, Ross, and Foster. The Examiner found that Gold teaches all features of claim 1, with two exceptions. App. Br. 7-8. As to the first exception, which is not at issue, the Examiner found that Gold does not generate a directory of installed resources, but determined this feature would have been obvious in view of Ross. *Id.* at 8-9.<sup>2</sup> As to the second exception, which is at issue, the Examiner found that Gold fractionally licenses preinstalled memory, not processors, but determined this feature would have been obvious in view of Foster.

More particularly, the Examiner determined the at-issue feature would have been obvious in view of Foster's licensing of preinstalled software to a processor. Ans. 9 and 20. Appellants argue that Foster's assigning of a license to a processor does not in turn suggest licensing of a processor itself. App. Br. 6. Appellants explain the difference as follows:

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<sup>2</sup> We note the rejection of claim 1 cites Ross as suggesting the claimed step of "conducting an inventory ... processors installed within the computer system ... *by generating a directory* ... stored in a secure storage" (emphasis added). In light of the rejection of claim 9, we have concluded that the rejection of claim 1 more particularly relies on Ross as suggesting the emphasized feature of generating a directory. Though claim 9 recites "conducting an inventory of ... processors [and] ... storing the inventory ... within a secure location," which is similar to the above inventory step of claim 1 *but omits the feature generating a directory*, the rejection of claim 9 cites only Gold's storing of "license key data" – not Ross – as teaching this feature. Ans. 5 (citing Gold, ¶ [0061]). We make no determination of whether Gold's storing of license key data teaches or suggests the inventory step of claim 1. *See* Gold, ¶ [0085] (describing the license key data).

[I]f a license is not checked out and assigned to a processor, there is no reason to believe that the processor cannot still be used for functionality other than the software tool. This is in contradistinction to the claimed invention, in which the processor is specifically licensed for usage, and if it is not currently licensed for usage, utilization of the processor is prevented.

App. Br. 7. We agree with Appellants insofar that there is a clear difference, as asserted above, between assigning a license to a processor and licensing a processor itself.

Nonetheless, the Examiner has established a *prima facie* case of obviousness. The claimed method fractionally licenses (*i.e.*, less than all of) the preinstalled processors. Gold and Foster fractionally license preinstalled memory and software, respectively. *See e.g.*, Gold, abstract; Foster, abstract.<sup>3</sup> The fractional licensing of most any other computer resource, including processors, would have been a predictable variation of fractionally licensing memory or software.

Predictable variations of the prior art are obvious unless their application is beyond the ordinary skill in the art. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007).<sup>4</sup> There is no evidence, before us,

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<sup>3</sup> We find that Foster preinstalls the software because Foster describes a software tool as being accessed and then licensed. Foster, col. 7, ll. 5-9. And, in any event, Appellants acknowledge the obviousness of preinstalling Foster's software. Reply Br. 2 (“[T]he prior art in combination suggests ... the computer program is installed on all 100 computers, but is licensed for use on only 20 computers at any given time.”).

<sup>4</sup> Though there is no requirement to show motivation for extending Gold's teaching to processors, we note that Gold presents Appellants' very own motivation for fractionally licensing preinstalled hardware. Gold

that a skilled artisan could not have fractionally licensed preinstalled processors in view of Gold and Foster. And to the contrary, Appellants' Specification indicates that various resources would have been understood as amenable to such licensing. *See e.g.*, Spec., 12:18-20 ("The resources 202 are depicted ... as including ... the memory 206 [and] ... the processors 208. As can be appreciated by those of ordinary skill within the art, the computer system 200 may have resources in addition to and/or in lieu of the memory 206 and the processors 208.").

For the foregoing reasons, we sustain the obviousness rejection of claim 1 over Gold, Ross, and Foster. As Appellants do not present separate bases of patentability for dependent claims 2-8, but rather rely on the arguments presented for claim 1 (App. Br. 4 and 8), we also sustain the obviousness rejections of: claims 3-6 over Gold, Ross, and Foster; claim 2 over Gold, Ross, Foster, and Wang; and claims 7 and 8 over Gold, Ross, Foster, and Matsuzuki.

#### *Claims 9-15*

Independent claim 9 stands rejected as obvious over Gold and Foster. There is one at-issue difference between claims 1 and 9. Particularly, claim

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particularly teaches that, via this business practice, "users can upgrade their computer entity after purchase without any hardware change, by simply typing in a new upgrade capacity license key obtainable from a vendor." Gold, ¶ [0062]. Similarly, Appellants teach that "embodiments of the invention provide for on-demand computing, so that an organization can obtain and pay for only the computer system resources it currently needs, without having to reconfigure or reboot its computer systems." Spec., p. 6, ll. 14-17.

9 requires that unlicensed processors be placed in a lowest power state, reciting:

for each resource of the resources of the computer system that is installed within the computer system but that is not currently available for usage due to the resource not currently being licensed, placing the processor in a lowest power state and preventing usage of the processor by the computer system[.]

The Examiner determined that the typical powering down of an unused processor to standby mode would result in powering down of an unlicensed (and thus unused) processor. Ans. 21 (citing Gold, ¶ [0058]).

Appellants argue:

Applicant is not contending that he has invented the capability of a processor to be put in a lowest power state, which the Examiner has indicated that Gold in view of Foster allegedly discloses[.] Rather, Applicant is contending that his inventive method, as particularly recited in claim 9, is that *for each resource that is not currently available for usage due to the resource not currently being licensed*, the processor is placed in a lowest power state and is prevented from being used.

App. Br. 10.

Appellants' argument is not persuasive. Claim 9 does not require powering down of an unlicensed processor to prevent its unauthorized use. Claim 9 merely requires powering down and preventing use of an unlicensed processor. In other words, there is no required cause and effect. Thus, the powering down and prevention of use may have no relationship. The powering down may affect the prevention of use, in accord with Appellants'

argument. Or, the prevention of use may affect the powering down, in accord with the Examiner's reasoning.

For the foregoing reasons, we sustain the obviousness rejection of claim 9 over Gold and Foster. As Appellants do not present separate bases of patentability for dependent claims 10-15, but rather rely on the arguments presented for claim 9 (App. Br. 8 and 12), we also sustain the obviousness rejections of: claims 10-11 over Gold and Foster; and claims 12-15 over Gold, Foster, and Matsuzuki.

**ORDER**

The Examiner's decision rejecting claims 1-15 is affirmed.

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**

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