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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ASHLEY THOMAS NAELON and
KENNETH SCOTT WIGGINS

Appeal 2010-003102
Application 11/427,129
Technology Center 2100

Before DENISE M. POTHIER, JEFFREY S. SMITH, and
STANLEY M. WEINBERG, *Administrative Patent Judges*.

WEINBERG, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-25. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Claims 1, 6, 9-14, 20, 21, and 23-25 stand rejected under 35 U.S.C. § 103(a) as obvious over Mikurak (US 2006/0178918 A1; published Aug. 10, 2006) in view of Tracy (US 2003/0050718 A1; published March 13, 2003) and further in view of Blom (US 2007/0230707 A1; published Oct. 4, 2007).¹

Claims 2 and 8 stand rejected under 35 U.S.C. § 103(a) as obvious over Mikurak, Tracy, and Blom and further in view of Berry (US 2005/0240446 A1; published Oct. 27, 2005).

Claims 3 and 7 stand rejected under 35 U.S.C. § 103(a) as obvious over Mikurak, Tracy, and Blom and further in view of Willey (US 2006/0212386 A1; published Sept. 21, 2006).

Claims 4, 5, 15, 16, and 22 stand rejected under 35 U.S.C. § 103(a) as obvious over Mikurak, Tracy, and Blom, and further in view of Reinhardt (US 5,673,006; issued Sept. 30, 1997).

Claims 17 and 18 stand rejected under 35 U.S.C. § 103(a) as obvious over Mikurak, Tracy, and Blom and further in view of Ben-Salha (US 2008/0029242 A1; published Feb. 7, 2008).

Claim 19 stands rejected under 35 U.S.C. § 103(a) as obvious over Mikurak, Tracy, Blom, Reinhardt, and Ben-Salha.

Claim 25 also stands rejected under 35 U.S.C. §101 for being directed to non-statutory subject matter.

¹ Throughout this opinion, we refer (1) to the Appeal Brief filed June 9, 2006; and (2) the Examiner's Answer mailed September 25, 2009.

STATEMENT OF THE CASE

Appellants' invention is a system and method for developing standards and related procedures for an organization. The standards and procedures are scored and compared to threshold scores. Each standard is linked to the rule on which it is based and each procedure is linked to the standard it supports. Spec. ¶ 0005.

Independent claim 1 is illustrative with key disputed limitations emphasized:

1. A standard and procedure rationalization system for rationalizing a proposed standard and a proposed procedure, wherein the standard *relates to one or more actions* required to be enforced by an organization based on a rule applicable to the organization, the system comprising:
 - a computer-readable medium having computer-readable instructions embodied therein;
 - a processor configured to execute the computer-readable instructions stored on the computer-readable medium, said computer-readable instructions comprising:
 - a module for *scoring the proposed standard*;
 - a module for *scoring the proposed procedure*; and
 - a module linking the proposed standard to the rule and linking the proposed procedure to the proposed standard; and
 - a memory device operatively connected to the processor and comprising a *database configured for storing the at least one standard and the at least one procedure such that the standard and procedure are linked to one another*.

THE OBVIOUSNESS REJECTION OVER MIKURAK, TRACY, AND BLOM

The Examiner finds that Mikurak teaches every recited feature of representative claim 1 except for a module for scoring the proposed standard; a module for scoring the proposed procedure; a module linking the

proposed standard to the rule and linking the proposed procedure to the proposed standard; and a database configured for storing the at least one standard and the at least one procedure such that the standard and procedure are linked to one another. Ans. 5:6-11. The Examiner finds that the secondary references teach the features that Mikurak does not teach and that it would have been obvious to combine the references to obtain the claimed device. Ans. 5-6.

Appellants contend that Mikurak does not disclose a proposed standard that relates to one or more actions required to be enforced by an organization (Br. 7:2-24); and that the other references do not teach the features that are missing in Mikurak. Br. 7:27-9:16.

ISSUES

Under § 103, does the combination of Mikurak, Tracy, and Blom teach all of the features recited in claim 1?

ANALYSIS

THE STANDARD RELATES TO ONE OR MORE ACTIONS REQUIRED TO BE ENFORCED BY AN ORGANIZATION

Although Appellants agree that Mikurak teaches security standards and that procedures should be developed and implemented, they contend that Mikurak does not teach a standard that “relates to one or more actions required to be enforced by an organization based on a rule applicable to the organization,” with particular emphasis on the required implementation of the standard. Br. 7:17-23.

Because the referenced recitation is in claim 1's preamble and does not appear elsewhere in claim 1, the recitation concerning the standard relating to one or more actions required to be enforced by an organization is entitled to little weight because it recites an intended use. *See In re Otto*, 312 F.2d 937, 938 (CCPA 1963). In *Otto*, the claims were directed to a core member for hair curlers and a process of making a core member for hair curlers. The Court held that the intended use of hair curling was of no significance to the structure and process of making. *See also Catalina Marketing Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002). In *Catalina Marketing*, the Court stated that "a preamble limits the invention if it recites essential structure or steps" and that the preamble limits claim scope when the preamble is essential to understand limitations or terms in the claim body.

Here, the claim is directed to a standard and a system (including modules, memory, and database) for rationalizing the standard. The intended use of the standard (actions required to be enforced) is of no significance to the claimed standard and system because the body of the claim does not act on the actions required to be enforced, such that the preambular limitation to the "actions" is essential to understanding the recitations in the claim body. In addition, deletion of the disputed limitation would not affect the claimed structure. We therefore conclude that the disputed phrase merely recites an intended use and that Mikurak is capable of having a standard that relates to an action required to be enforced by an organization.

In any event, the Examiner finds that Mikurak ¶ 2583 teaches this limitation. Ans. 19-20, Argument III. Appellants do not respond or rebut

this finding. We find that the Examiner's finding is reasonable and we agree with the Examiner.

MODULE FOR SCORING THE PROPOSED STANDARD

The Examiner finds that Mikurak teaches standards, that Tracy teaches scoring a proposed standard, and that it would have been obvious to combine the Tracy teaching in the Mikurak system because it would allow enhancement of fine tuning the system. (Ans. 5:12-13, 17-19, and Ans. 19-20, Arguments II and IV). Appellants agree that Tracy teaches a predefined standard, but contends that Tracy does not teach scoring the standard or scoring the specific features as arranged and recited in the claim. Br. 8:1-5. Appellants' argument is not persuasive because one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

MODULE FOR SCORING THE PROPOSED PROCEDURE

The Examiner finds that the combination of Tracy and Blom teach this limitation and that it would have been obvious to combine the Blom teaching in the Mikurak system because it would allow for improvement of the invention by incorporating proposed procedures. Ans. 6, 22-23, Arguments VII and VIII. Appellants' arguments (Br. 9:1-16) are not persuasive because they have argued the references individually, rather than arguing the combination relied upon by the Examiner. *Keller, supra; Merck, supra.*

A DATABASE CONFIGURED FOR STORING THE AT LEAST ONE STANDARD AND THE AT LEAST ONE PROCEDURE SUCH THAT THE STANDARD AND PROCEDURE ARE LINKED TO ONE ANOTHER

The Examiner finds that the combination of Mikurak and Tracy teach this limitation and that it would have been obvious to combine the Tracy teaching in the Mikurak system because it would allow enhancement of fine tuning the system. Ans. 5:12-19 and Ans. 20-22, Arguments V and VI. Appellants contend that Mikurak paragraph 1184 does not teach linking a proposed standard and a proposed procedure. Br. 8:17-25. The Examiner, however, finds that this limitation is taught by paragraph 1184's discussion of matching. Ans. 22:1-2. Appellants do not respond to the Examiner's finding. In addition, Appellants argue the references individually, rather than arguing the combination relied upon by the Examiner. Br. 8:8-10-13, 24-26. *Keller, supra; Merck, supra*. Consequently, Appellants' arguments are not persuasive.

We are therefore not persuaded that the Examiner erred in rejecting (1) representative claim 1; (2) independent claims 9 and 25 for similar reasons; and (3) claims 6, 10-14, 20, 21, 23, and 24 not separately argued with particularity.

Accordingly, we will sustain the Examiner's rejection of claims 1, 6, 9-14, 20, 21, and 23-25.

THE REMAINING ART REJECTIONS

Claims 2-5, 7, 8, 15-19, and 22

We will also sustain the rejections of claims 2-5, 7, 8, 15-19, and 22 which have been rejected as obvious over Mikurak, Tracy, Blom, and various additional references because the references have been argued

individually and the claims have not been argued separately with particularity. Br. 9-11.

THE § 101 REJECTION OF INDEPENDENT CLAIM 25

The Examiner concludes that because claim 25 does not recite any hardware components, claim 25 is software per se. Ans. 4. Alternatively, the Examiner concludes that Appellants' Specification states that propagation discussed in paragraph 31 of the disclosure is not limited to a computer medium. Ans. 19.

Appellants argue that claim 25 uses permissible means-plus-function language to recite the structure of their apparatus and that their Specification describes various structures for performing the functions recited in claim 25, including hardware. Br. 6.

Independent claim 25 recites, in pertinent part, an apparatus comprising means for scoring a proposed standard, means for mapping a proposed procedure to the proposed standard, means for scoring the proposed procedure, and means for linking the proposed standard to a rule and linking the proposed procedure to the proposed standard. We find that 35 U.S.C. § 112, ¶ 6 has been invoked with respect to claim 25. *See Biomedino L.L.C. v. Waters Techs. Corp.*, 490 F.3d 946, 950 (Fed. Cir. 2007). As such, the means-plus-function limitations in claim 25 must be construed by “look[ing] to the specification and interpret[ing] that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure.” *In re Donaldson Co., Inc.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994) (en banc).

Claim 1 recites these same “means for” recitations as modules. Appellants describe that the term, “module,” can correspond to a software application. *See* Spec. ¶ 0028. Similarly, we find that these “means for” limitations in claim 25 can broadly, but reasonably correspond to modules or are software application. Notably, claim 25 recites an “apparatus” or some structure that comprises the “means for” limitations. Yet, in light of the disclosure, the breadth of the term, “apparatus” includes a computer usable or readable storage medium including program instructions (i.e., the “means for” limitations.”

For example, the Specification discloses that

a computer program which implements parts of the invention through the use of a system like that illustrated in Fig. 1 can take the form of a computer program . . . residing on a . . . computer readable storage medium . . . The medium may also be a stream of information being retrieved when the computer program product is “downloaded” through the Internet. . . The computer-usable or computer-readable medium may be, for example but not limited to, an electronic, magnetic, optical, electromagnetic, infrared, or semiconductor system, apparatus, device, or propagation medium.

Spec. ¶ 0031. This paragraph of the Specification describes these implementations in the alternative. Thus, the stream of information as well as the electronic, magnetic, optical, electromagnetic, and infrared propagation medium are all alternatives to computer hardware. The clear import of this discussion is that the invention, including the broadly recited, “apparatus,” can exist solely as signals, which are not patentable subject matter under § 101. *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007). Reading independent claim 25 in light of the Specification, the recited “apparatus” encompasses a signal that performs the recited operations.

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Therefore, when read in light of the Specification, claim 25 includes both statutory subject matter (means-plus-function limitations stored on a diskette) and non-statutory subject matter (means-plus-function limitations conveyed by a signal).

According to USPTO guidelines, such claims must be amended to recite solely statutory subject matter. *See Subject Matter Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010); *see also* Manual of Patent Examining Procedure (“MPEP”) § 2106(IV)(C)(2)(2)(a), Rev. 6, Sept. 2007 (“[A] claim that can be read so broadly as to include statutory and nonstatutory subject matter must be amended to limit the claim to a practical application.”)

For the foregoing reasons, independent claim 25 does not recite statutory subject matter under 35 U.S.C. § 101.

Accordingly, we will sustain the Examiner’s § 101 rejection of independent claim 25.

CONCLUSION

Under § 103, the Examiner did not err in rejecting claims 1-25 and the Examiner did not err in also rejecting claim 25 under § 101.

DECISION

The Examiner’s decision rejecting claims 1-25 is affirmed.

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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)(1). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2010).

AFFIRMED

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