UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/259,218	10/26/2005	Curtis C. Ballard	82211222	4513

22879 7590 03/07/2013
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
3404 E. Harmony Road
Mail Stop 35
FORT COLLINS, CO 80528

EXAMINER
HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
3685	

NOTIFICATION DATE	DELIVERY MODE
03/07/2013	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JERRY.SHORMA@HP.COM
ipa.mail@hp.com
brandon.serwan@hp.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CURTIS C. BALLARD, KELLY J. REASONER, and MIKE P. FLEISCHMANN

Appeal 2011-006817
Application 11/259,218
Technology Center 3600

Before: ANTON W. FETTING, BIBHU R. MOHANTY, and MICHAEL W. KIM, *Administrative Patent Judges*.

KIM, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 1-3, 11-13, and 16-23[1]. We have jurisdiction to review the case under 35 U.S.C. §§ 134 and 6.

The invention relates generally to methods for managing removable media (Spec., Abstract).

Claim 1, reproduced below, is further illustrative of the claimed subject matter.

> 1. Storage apparatus for managing removable media, comprising:
>
> a controller configured to robotically manage the removable media and to monitor a licensed storage capacity of the storage apparatus; and
>
> a user interface coupled to the controller;
>
> wherein in response to the controller detecting that usage of a storage capacity of the storage apparatus has reached a predetermined level of the licensed storage capacity, the controller is configured to cause the user interface to display a prompt to acquire additional licensed storage capacity, and
>
> wherein if a request responsive to the prompt is received at the user interface to acquire the additional licensed storage capacity, the controller is configured to take action to authorize usage of previously unlicensed storage capacity in the storage apparatus as the additional licensed storage capacity.

THE REJECTIONS

The Examiner has rejected:

claims 11-13, 22, and 23 under 35 U.S.C. § 101 as being directed to non-statutory subject matter;

---

[1] Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed June 30, 2010) and Reply Brief ("Reply Br.," filed December 14, 2010), and the Examiner's Answer ("Ans.," mailed October 15, 2010).

claims 1-3, 11-13, and 16-23 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement;

claims 1-3 and 16-18 under 35 U.S.C. § 112, second paragraph, as being indefinite[2];

claims 1, 3, 11-13, 16, 18, 19, 21, and 22 under 35 U.S.C. § 103(a) as being unpatentable over Bruynsteen (US 6,658,663 B1, iss. Dec. 2, 2003) and Microsoft, *Description of the Low Disk Space Notification in Windows XP* (June 2, 2003)[3] (hereafter "Microsoft"); and

claims 17, 20, and 23 under 35 U.S.C. § 103(a) as unpatentable over Bruynsteen and Crawford (US 2006/0074765 A1, pub. Apr. 6, 2006).

We AFFIRM. We enter a NEW GROUND OF REJECTION pursuant to our authority under 37 C.F.R. § 41.50(b).

ISSUES

Did the Examiner err in asserting that claims 11-13, 22, and 23 fail to recite statutory subject matter under 35 U.S.C. § 101?

Did the Examiner err in asserting that claims 1-3, 11-13, and 16-23 fail to comply with the written description requirement of 35 U.S.C. § 112, first paragraph?

Did the Examiner err in asserting that claims 1-3 and 16-18 fail to comply with the definiteness requirement of 35 U.S.C. § 112, second paragraph?

---

[2] The rejection of claims 19-21 on these grounds is withdrawn (Ans. 15).
[3] Found at: http://support.microsoft.com/kb/285107 (last viewed Feb. 26, 2013).

Did the Examiner err in asserting that a combination of Bruynsteen and Microsoft renders obvious "wherein if a request responsive to the prompt is received at the user interface to acquire the additional licensed storage capacity, the controller is configured to take action to authorize usage of previously unlicensed storage capacity in the storage apparatus as the additional licensed storage capacity," as recited in independent claim 1?

Did the Examiner err in asserting that a combination of Bruynsteen, Microsoft, and Crawford renders obvious "configuring the controller to further receive an activation key from the authorization source to authorize usage of the additional licensed storage capacity, wherein the activation key is responsive to the order," as recited in dependent claim 23?

FINDINGS OF FACT

Specification

FF1. The Specification does not provide a lexicographic definition of "configured."

FF2. After the prompt 31 is displayed, a user may choose to order additional capacity directly from the available additional, but yet unlicensed, capacity in the tape library 10. After choosing to make the order, such as by selecting a "YES" button or icon, a user configurable capacity threshold 33 is displayed, and the user may select 34 or enter 34 the amount of additional capacity to be purchase. This may be done by typing in the capacity increase amount, or selecting an amount from a pull-down menu, or other similar action, for example. Once the additional capacity to be purchased is entered 34 or selected 34, the user is prompted for a password 35. After the password 35 is entered, a request (order) is transmitted, such as by way of

the component 22 (interface manager 22), to the licensee or manufacturer, such as to an appropriate order desk at the licensee or manufacturer, for example. The request (order) is automatically processed at the licensee or manufacturer, such as by automatically logging into a key generation system at the licensee or manufacturer. A license and an activation key are automatically generated and transmitted from the licensee or manufacturer back to the tape library 10 in real time to authorize usage of the additional licensed capacity (paras. [00026], [00038]).

ANALYSIS

Statutory Subject Matter

We are not persuaded the Examiner erred in asserting that claims 11-13, 22, and 23 fail to recite statutory subject matter under 35 U.S.C. § 101 (App. Br. 6-8; Reply Br. 1-3). Independent claim 11 repeatedly recites "configuring a controller." The Specification does not provide a lexicographic definition of "configured." Accordingly, under a broadest reasonable construction, we define "configuring a controller" as "to store instructions on a controller." The only other step recited by independent claim 11 is "coupling a user interface to the controller." Both the "configuring" and "coupling" constitute insignificant post-solution activity. The Supreme Court in *Bilski* approvingly cited *Parker v. Flook*, 437 U.S. 584 (1978), stating that *Flook* stands for "the proposition that the prohibition against patenting abstract ideas 'cannot be circumvented by… adding 'insignificant post-solution activity.'" *Bilski v. Kappos*, 130 S.Ct. 3218, 3230 (2010). The mere storing of data on a controller, or coupling a user interface to that controller, is just such an extra-solution activity insignificant

to the core of the invention, and thus is disfavored by *Bilski* and *Flook*. To hold otherwise would allow Appellants to easily circumvent the unpatentability of abstract ideas by merely storing it on a controller, or by coupling a user interface, rendering superfluous the prohibition against patenting abstract ideas.

As our rationale differs from that set forth by the Examiner, we denominate our affirmance a NEW GROUND OF REJECTION pursuant to our authority under 37 C.F.R. § 41.50(b).

Written Description Requirement

We are persuaded the Examiner erred in asserting that claims 1-3, 11-13, and 16-23 fail to comply with the written description requirement of 35 U.S.C. § 112, first paragraph (App. Br. 9-11; Reply Br. 3-5). The Examiner asserts that the Specification does not provide adequate written description support for "the controller is configured to take action to authorize usage of previously unlicensed storage capacity in the storage apparatus as the additional licensed storage capacity," as recited in independent claim 1, because paragraphs [0038] and [0043] of the Specification disclose that it is the license and activation key generated by the key generation system at the licensee or manufacturer that actually authorizes the usage of the additional storage capacity (Ans. 17-18). However, independent claim 1 recites that "the controller is configured to *take action to* authorize usage" (emphasis added). Contrary to the Examiner's assertion, it does not recite that the action itself will "directly" result in authorizing the usage. The Specification discloses sending a request (order) which eventually results in the authorized usage (FF1). Thus, we are persuaded the Examiner's rationale for rejecting

independent claim 1 on these grounds is incorrect.

Independent claim 19 recites "a controller configured to… in response to detecting that the storage system has reached the predetermined level of the licensed storage capacity, cause a request to be sent to an authorization source to request additional licensed storage capacity to be made available in the storage system." For the same reasons as set forth above, we also do not sustain the rejection of independent claim 19 on these grounds.

In rejecting claims 16, 17, and 19-23 on these grounds, the Examiner asserts

> the claims are directed to a controller for robotically managing and issuing request. The most relevant disclosure is ¶[¶] 17-20 of the Specification. However, the disclosure describes two different controllers an interface controller 21 and a library controller 17. As these are distinct components, there is insufficient support to convey that Applicant had possession of the invention as claimed

(Ans. 18). However, while the disclosure of two separate controllers may be grounds for an indefiniteness rejection, the Examiner has not shown that they support an adequate basis for a written description rejection.

Indefiniteness Rejection

We are persuaded the Examiner erred in asserting that claims 1-3 and 16-18 fail to comply with the definiteness requirement of 35 U.S.C. § 112, second paragraph (Ans. 11-13). The Examiner asserts that claims 1 and 2 are impermissibly directed to both an apparatus and a process (Ans. 18-19). However, claims 1 and 2 are both directed to apparatuses that include components that are configured to perform certain functions. Such functional claiming is permissible in an apparatus claim and does not

constitute a process claim.

Obviousness Rejection of Independent Claim 1

We are not persuaded the Examiner erred in asserting that a combination of Bruynsteen and Microsoft renders obvious "wherein if a request responsive to the prompt is received at the user interface to acquire the additional licensed storage capacity, the controller is configured to take action to authorize usage of previously unlicensed storage capacity in the storage apparatus as the additional licensed storage capacity," as recited in independent claim 1 (App. Br. 13-18; Reply Br. 5). Appellants assert that the Examiner concedes that Bruynsteen does not disclose the aforementioned aspect of independent claim 1, and then asserts that Microsoft only discloses prompting a user to delete old and unnecessary files in previously authorized storage space, and not previously unlicensed storage space, as recited in independent claim 1. However, Appellants' characterization of the Examiner's position is not accurate. The Examiner does cite Bruynsteen for disclosing "authorizing previously unlicensed storage capacity in the storage apparatus as the additional license storage capacity" (Ans. 10, 20), but then admits that Bruynsteen does not disclose the prompting aspect of independent claim 1. For the prompting aspect, *and the prompting aspect alone*, the Examiner cites Microsoft (Ans. 10, 20). These disclosures of Bruynsteen and Microsoft are then combined to teach or suggest the "wherein" clauses of independent claim 1.

Appellants assert that

> [s]ince Microsoft specifically teaches that **existing** storage capacity (currently occupied by old or unnecessary files) be re-used, the solution proposed by Microsoft would

> have led a person of ordinary skill in the art away from the claimed subject matter, which recites that the controller is configured to take action to authorize usage of previously **unlicensed** storage capacity in the storage apparatus as the additional licensed storage capacity. The solution of Microsoft is the reuse of existing storage capacity, and thus, a person of ordinary skill in the art would not have been led to a solution that involves authorizing usage of previously unlicensed storage capacity as the additional licensed storage capacity. Therefore, a person of ordinary skill in the art would have found no reason to combine the teachings of Microsoft with Bruynsteen to achieve the claimed subject matter.

(App. Br. 17; emphasis original). We disagree. The Examiner has added the prompt system of Microsoft to the system of Bruynsteen which authorizes usage of previously unlicensed storage capacity. Thus, the deletion of old or unnecessary files in the existing storage capacity of Microsoft does not come into play. Moreover, even if such an issue did come into play, we are not persuaded that one of ordinary skill would have been unable to replace the deletion of old or unnecessary files in the existing storage capacity of Microsoft with the authorization of usage of the previously unlicensed storage capacity of Bruynsteen, as set forth by the Examiner.

Appellants set forth similar arguments for the corresponding aspects of independent claims 11 and 19 (App. Br. 18-21). We find those arguments unpersuasive for the same reasons set forth above with respect to independent claim 1.

Obviousness Rejection of Dependent Claim 23

We are not persuaded the Examiner erred in asserting that a combination of Bruynsteen, Microsoft, and Crawford renders obvious "configuring the controller to further receive an activation key from the

authorization source to authorize usage of the additional licensed storage capacity, wherein the activation key is responsive to the order," as recited in dependent claim 23 (App. Br. 21-22). Appellants assert that

> Crawford relates to receiving an activation confirmation from a host computer that includes receiving an activation key code, for the purpose of performing a wireless network access. Crawford has nothing to do with the claimed subject matter, which relates to receiving an activation key from the authorization source to authorize **a usage of the additional licensed storage capacity**, where the activation key is responsive to the order that is sent to an authorization source to acquire the additional licensed storage capacity.

(App. Br. 21). However, Bruynsteen is cited for disclosing "receive a confirmation from the authorization source to authorized usage of the additional licensed capacity (i.e. awaits a confirmation that adjustment is successfully complete, see Bruynsteen, Column 4, Lines 32-41)" (Ans. 10, 14, 20), to which the Examiner has added the activation key code of Crawford (Ans. 14). It is thus immaterial that Crawford's activation key code is for wireless network access, as the Examiner has replaced this wireless network access with the authorization of usage of the previously unlicensed storage capacity of Bruynsteen. *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (the argument that a single reference alone does not disclose the recited claimed steps is not persuasive because nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures); *In re Keller*, 642 F.2d 413, 426 (CCPA 1981) ("one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references").

Appellants set forth similar arguments for the corresponding aspects

of dependent claims 17 and 20 (App. Br. 22). We find those arguments unpersuasive for the same reasons set forth above with respect to dependent claim 23.

DECISION

The decision of the Examiner to reject claims 11-13, 22, and 23 under 35 U.S.C. § 101 is AFFIRMED.

The decision of the Examiner to reject claims 1-3, 11-13, and 16-23 under 35 U.S.C. § 112, first paragraph, is REVERSED.

The decision of the Examiner to reject claims 1-3 and 16-18 under 35 U.S.C. § 112, second paragraph, is REVERSED.

The decision of the Examiner to reject claims 1-3, 11-13, and 16-23 under 35 U.S.C. § 103(a) is AFFIRMED.

This decision also contains a NEW GROUND OF REJECTION for claims 11-13, 22, and 23 pursuant to 37 C.F.R. § 41.50(b), which provides "[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 Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options *with respect to the new ground of rejection* to avoid termination of the appeal 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 § 41.52 by the Board upon the same record. . . .

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)

mls