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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STEFANO BORGHETTI, GIANLUCA DELLA
CORTE, LEONIDA GIANFAGNA, ALESSANDRO HAAG,
and ANTONIO SGRO

Appeal 2012-009388
Application 12/348,389
Technology Center 2400

Before CARL W. WHITEHEAD JR., MICHAEL J. STRAUSS, and
DANIEL J. GALLIGAN, *Administrative Patent Judges*.

STRAUSS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

THE INVENTION

The claims are directed to a secure system access without password sharing. Abst. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A method, in a client associated with a requesting user, for performing secure system access, the method comprising:
 - selecting an entry for a shared system in a system information database, wherein the entry comprises an identifier of a host, a protocol, an identifier of an owner, and a credential;
 - sending an access request to a client associated with the owner; and
 - responsive to the owner authorizing access to the shared system by the requesting user, opening a session with the host using the protocol and the credential from the system information database.

REFERENCES

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

Vinberg	US 2003/0018771 A1	Jan. 23, 2003
Chebolu	US 2005/0060412 A1	Mar. 17, 2005
Brickell	US 7,073,195	July 4, 2006
Hoghaug	US 2007/0101155 A1	May 3, 2007

REJECTIONS¹

The Examiner made the following rejections:

Claims 9–16 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Ans. 5.

Claims 1, 2, 4, 7–10, 12, 15–18, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brickell and Chebolu. Ans. 6–12.

Claims 3, 11, and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brickell, Chebolu, and Hoghaug. Ans. 12–14.

Claims 5, 6, 13, and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brickell, Chebolu, and Vinberg. Ans. 14–17.

APPELLANTS' CONTENTIONS

- 1) In connection with the rejections under 35 U.S.C. § 101, Appellants contend a storage media as recited by claim 9 must be non-transitory and cannot be interpreted to be a disembodied signal which, by itself, cannot store a computer readable program. App. Br. 6–7.
- 2) In connection with the rejection of claim 1 under 35 U.S.C. § 103(a):
 - a) Brickell's delegate does not select an entry for a shared system in a system information database as required by claim 1. App. Br. 9.

¹ In connection with the rejections under 35 U.S.C. § 103(a), Appellants argue the rejection of claims 1, 3, and 5. Separate patentability is not argued for claims 2, 4, and 6–20. Therefore, based on Appellants' arguments, we decide the appeal of the rejection under 35 U.S.C. § 103(a) of claims 1, 2, 4, 7–10, 12, 15–18, and 20 based on claim 1 alone, the rejection of claims 3, 11, and 19 based on claims 3 alone, and the rejection of claims 5, 6, 13, and 14 based on claims 5 alone. *See* 37 C.F.R. § 41.37(c)(1)(vii).

- b) Brickell’s delegate sends an access request to the relying party, not to a client associated with the owner of a shared system as required by claim 1. *Id.*
 - c) Contrary to the Examiner’s finding, “Brickell provides no teaching whatsoever of the delegator being the owner of the shared system [as required by claim 1].” *Id.*
 - d) Brickell is silent concerning sessions and protocols and fails to teach opening a session as required by claim 1. App. Br. 11–12.
 - e) Because Brickell does not teach the requestor is requesting access to a shared system owned by an owner, it further fails to teach sending an access request to a client associated with the owner as required by claim 1. App. Br. 13.
 - f) Chebolu does not cure the deficiency of Brickell, also failing to teach opening a session as required by claim 1. *Id.*
- 3) Modifying the combined teachings of Brickell and Chebolu, neither of which teaches a multiple user desktop system, to incorporate the dummy user of Hoghaug as required by claim 3 is improper because “[t]here is no problem in the Brickell or Chebolu teachings for which the teachings of Hoghaug would be a solution.” App. Br. 14.
- 4) Modifying the teachings of Brickell and Chebolu to incorporate Vinberg’s teaching of an escalation list of users authorized to grant access to the shared system as required by claim 5 is improper because the Examiner fails to provide sufficient support for making the combination. App. Br. 15.

ISSUES ON APPEAL

Based on Appellants' arguments in the Appeal Brief (App. Br. 5–16) and Reply Brief (Reply Br. 2–5), the issues presented on appeal are:

Whether the Examiner erred in concluding the computer storage medium of claim 9 includes transitory signals and, therefore, subject matter excluded from patentability under 35 U.S.C. § 101.

Whether the Examiner erred in finding the combination of Brickell and Chebolu teaches or suggests the disputed limitations of claim 1.

Whether the Examiner erred in combining the teachings of Brickell and Chebolu with the teachings of (i) Hoghaug in rejecting claim 3, or (ii) Vinberg in rejecting claim 5.

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellants' arguments that the Examiner has erred. We disagree with Appellants' conclusions. We adopt as our own (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken (Ans. 5–17) and (2) the reasons set forth by the Examiner in the Examiner's Answer in response to Appellants' Appeal Brief (Ans. 17–26) and concur with the conclusions reached by the Examiner. We highlight the following for emphasis.

35 U.S.C. §101 Rejection of Claims 9–16

Claim 9 is directed to “[a] computer program product comprising a computer storage medium having computer readable program stored thereon” The Examiner rejected claims 9–16 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Ans. 5. The Examiner finds

“a ‘computer storage medium’ as claimed is commonly used in the art in such a way that includes transitory media and thus any redefinition of the term as used by the applicant must be made explicit in the specification.” *Id.* Appellants contend, although a computer *usable* medium or computer *readable* medium includes propagation media, their Specification distinguishes those media from *recordable* media, which Appellants equate to the claimed storage media, thereby excluding propagation media. App. Br. 6. Appellants argue, because one skilled in the art would understand storage requires preservation of that which is stored while transitory means not persistent or of brief duration, a storage medium which *stores* a computer readable program for preservation or later use must be non-transitory. *Id.*

We are unpersuaded. “[T]hose of ordinary skill in the art would understand the claim term ‘machine-readable storage medium’ would include signals *per se.*” *Ex parte Mewherter*, 107 USPQ2d 1857, 1862 (PTAB 2013) (precedential-in-part) (machine-readable storage medium non-statutory where Specification silent as to meaning). Appellants’ argument that, in *In re Nuijten*, the rejection of claim 15 reciting “[a] storage medium having stored thereon a signal . . .” was reversed by the Board is not persuasive. The decision of the Board in *Nuijten* was non-precedential and the issue of whether claim 15 included non-statutory subject matter was not before or considered by the Federal Circuit. Instead, what *is* controlling in the instant appeal is the precedential opinion of the Board in *Mewherter* concluding the addition of the term “storage” standing alone does not exclude transitory media thereby converting a non-statutory claim into a statutory claim.

Furthermore, we add in passing, we disagree with Appellants' argument that a signal cannot store a computer readable program (App. Br. 7), directing Appellants' attention to circulating memory.² In such devices, data is stored by repeatedly transmitting, receiving, refreshing, and retransmitting a transitory signal so that the recirculated signal stores the data including any computer program represented by the data.

For the reasons *supra*, and in the absence of any restrictive language or definition in the Specification of the disputed "computer storage medium," we agree with the Examiner claim 9 is directed to non-statutory subject matter. Accordingly, we sustain the rejection of claim 9 and, for the same reasons, the rejection of dependent claims 10–16 under 35 U.S.C. § 101.³

² A digital computer device that uses a delay line to store information in the form of a pattern of pulses in a train; the output pulses are detected electronically, amplified, reshaped, and reinserted in the delay line at the beginning. Also known as delay-line memory; delay-line storage; circulating storage. *McGraw-Hill Dictionary of Electrical and Computer Engineering*, 90. New York: McGraw-Hill, 2004.

³ We add in passing and without reliance in our affirmance of the appealed rejection under 35 U.S.C. § 101, Appellants' Specification further describes "computer-usable or computer-readable medium" includes "*paper* or another suitable medium *upon which the program is printed*, as the program can be electronically captured, via, for instance, optical scanning of the paper or other medium, then compiled, interpreted, or otherwise processed in a suitable manner, if necessary, and then stored in a computer memory." Spec. ¶ 41 (emphasis added). Although the computer-readable program of claim 9 causes a computing device to implement a method when executed, the program must first at least be scanned and stored for execution before the code is executed. *Id.* Thus, the program is mere nonfunctional descriptive material (i.e., the program is not functional until scanned and stored for execution). See *Ex parte Shealy*, Appeal No. 2006-1601, slip op. at 39, available at <http://www.uspto.gov/sites/default/files/ip/boards/bpai/decisions/inform/fd0>

35 U.S.C. §103 Rejections

In connection with contention 2(a) Appellants argue Brickell’s “delegate does not select an entry for a shared system . . . in a system information database,” as required by claim 1. App. Br. 9. The Examiner responds by finding the disputed limitation is taught by Brickell’s delegate registering with the DCSP. Ans. 6, 23.

We agree with the Examiner. The disputed limitation requires selecting an entry for a shared system in a system information database, e.g., in Brickell’s DSCP. Appellants do not explain why this finding of the Examiner is erroneous, i.e., why the limitation is not taught by Brickell’s delegate communicating with the DCSP to register, access, and update, its information in the DCSP. Therefore, Appellants’ argument is unpersuasive of Examiner error. Furthermore, although Appellants argue Brickell’s delegate does not select an entry (App. Br. 9), the disputed selecting step of

61601.pdf (BPAI Apr. 23, 2007) (informative) (logic on paper that must be scanned, compiled, and interpreted is not functional). Moreover, we are unable to discern any novel or nonobvious manner in which the program is related to the paper on which it may be printed, further evincing the program is mere nonfunctional descriptive material. *See In re Miller*, 418 F.2d 1392, 1396 (CCPA 1969); *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983). Accordingly, claim 9 represents mere printed matter—an abstraction that by itself does not perform a function. *See Ex Parte Shealy*, Appeal No. 2006-1601 at 39. That is, a computer storage medium including paper adds nothing of substance to the underlying abstraction of printed matter, thus suggesting claim 9 may be patent ineligible under 35 U.S.C. § 101. *See Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S.Ct. 2347, 2360 (2014) (system and media claims that add nothing to an underlying abstract idea are also patent ineligible). Therefore, should prosecution be continued, the Examiner may wish to consider whether claims 9-16 are directed to non-statutory subject matter for this additional reason.

claim 1 makes no mention of a delegate or any other actor performing the step. Thus, Appellants' argument is not commensurate with the scope of the claim. Therefore, for the reasons *supra*, Appellants' contention 2(a) is unpersuasive.

In connection with contention 2(b) Appellants argue, according to Brickell, “[o]nce the delegator/delegate relationship is registered, the delegator [(i.e., owner)] is not involved” so that, rather than sending an access request to an owner, Brickell teaches sending a request to a relying party. App. Br. 9. The Examiner responds by explaining the rejection relies on Chebolu, not Brickell, for teaching the disputed sending step of claim 1. Ans. 23. Therefore, because Appellants' argument does not address the findings of the Examiner, i.e., the teachings of Chebolu rather than the argued teachings of Bickell, contention 2(b) is unpersuasive of Examiner error.

We also find contention 2(c) unpersuasive of Examiner error because, as found by the Examiner, claim 1 has no requirement for the delegator to be the owner of the shared system. *See* Ans. 23 and App. Br. 9–10. Arguments that are not commensurate in scope with the claims are not persuasive of error. Furthermore, as explained by the Examiner, under a broad but reasonable interpretation of the term *owner*, “Brickell's delegator *owns* the service because he provides authority as to who may or may not access this service over the shared system.” Ans. 23 (emphasis added.)

Appellants' contention 2(d) is unsupported by sufficient evidence or technical reasoning explaining why the Examiner's findings are erroneous and is, therefore, also unpersuasive of Examiner error. In particular, Appellants fail to explain why Brickell's service response by the relying

party 230 to delegate 210b where the relying party verifies the conditions and credentials in order to provide service fails to teach or suggest opening a session with the host. *See* Ans. 6–7, 23–24.

In connection with contention 2(e) Appellants argue “because Brickell does not teach the requestor is requesting access to a shared system owned by the owner such that the owner authorizes or denies the access,” it fails to teach or suggest sending an access request to a client associated with the owner as required by claim 1. App. Br. 13. We find this contention unpersuasive of error for the reasons *supra* in connection with Appellants’ contention 2(c). We further agree with the Examiner Appellants’ contention is unpersuasive because “Brickell’s delegate requests access to a service owned by a delegator such that the delegator authorizes or denies access to the service, via establishment of a delegator/delegate relationship in the DCSP.” Ans. 24. Furthermore, Appellants’ argument is further deficient because it fails to address the Examiner’s finding that Chebolu teaches the step of sending an access request as required by claim 1. *See* Ans. 7.

In connection with contention 2(f) Appellants argue Chebolu fails to teach opening a session as required by claim 1. App. Br. 13. This argument is unpersuasive of error because, as found by the Examiner, “Chebolu was not cited as disclosing this limitation.” Ans. 24. Therefore, because Appellants’ argument fails to address the Examiner’s findings, the contention is unpersuasive.

For the reasons *supra* Appellants’ contentions 2(a) – 2(f) are unpersuasive of error in connection with the rejection of claim 1. Therefore we sustain the rejection of independent claim 1 and, for the same reasons, the rejection of independent claims 9 and 17 under 35 U.S.C. § 103(a) over

Brickell and Chebolu together with the rejection of dependent claims 2, 4, 7, 8, 10, 12, 15, 16, 18, and 20 which were not separately argued.

In connection with contention 3 Appellants argue, “because Hoghaug is specific to multiple user desktop systems” and “[n]either Brickell nor Chebolu teaches a multiple user desktop system,” modifying the combined teachings of Brickell and Chebolu to incorporate Hoghaug’s dummy user is improper. App. Br. 14. The Examiner responds by finding Hoghaug is in the same field of endeavor as Brickell and Chebolu and the combination would have been obvious because:

One of ordinary skill in the art would have recognized the benefit that utilizing a dummy user in this way would help overcome prior art problems and provide for efficient security for multiple user and intermittent users, authenticated access to computers, kiosks, network access points, network resources, databases, applications, and the like.

Ans. 13. The Examiner further finds, contrary to Appellants’ argument, the teachings of Hoghaug are not limited to multiple user desktop systems and, instead, “Hoghaug addresses problems that are relevant to all systems that control access to resources based on credentials of a requesting user.” Ans. 25.

We agree with the Examiner. Appellants provide insufficient evidence or technical reasoning explaining why, because Hoghaug is directed to multiuser systems “[t]here is no problem in the Brickell or Chebolu teachings for which the teachings of Hoghaug would be a solution.” *See* App. Br. 14. Instead, we find the Examiner has articulated reasoning with rational underpinnings sufficient to justify the legal conclusion of obviousness. Therefore, Appellants’ assertion that the references were improperly combined is not persuasive of error and accordingly, the

Examiner has properly relied upon the combination of Brickell, Chebolu, and Hoghaug in formulating the disputed rejection. For the reasons *supra*, we are also not persuaded the rejection is improper for failure of the combination to teach or suggest the disputed steps of claim 1 from which claim 3 depends. *See* App. Br. 15.

Because Appellants' have failed to provide sufficient evidence or reasoning explaining why the Examiner's rejection of claim 3 is improper or deficient, Appellants' arguments are unpersuasive of Examiner error. Accordingly, we sustain the rejection of claim 3 and for the same reasons, the rejection of claims 11 and 19 under 35 U.S.C. § 103(a) over Brickell, Chebolu, and Hoghaug.

We are also not persuaded of error by Appellants' contention 4 arguing the combination of Brickell, Chebolu, and Vinberg is improper. App. Br. 15. Contrary to Appellants' argument, the Examiner has explained why one skilled in the art would have made the proposed modification, i.e., because "[o]ne of ordinary skill in the art would have recognized the benefit that proactively determining notification paths would help operators in being properly notified of events or other information." Ans. 15, 26. Appellants' further contention the combination of Brickell, Chebolu, and Vinberg is deficient for failure to teach the disputed limitations of the respective base claims is unpersuasive for the reasons *supra*. Therefore we sustain the rejection of claim 5 and, for the same reasons, the rejection of claims 6, 13, and 14 under 35 U.S.C. § 103(a) over Brickell, Chebolu, and Vinberg.

CONCLUSIONS

The Examiner did not err in concluding the computer storage medium of claim 9 includes transitory signals and, therefore, is subject matter excluded from patentability under 35 U.S.C. § 101.

The Examiner did not err in finding the combination of Brickell and Chebolu teaches or suggests the disputed limitations of claim 1.

The Examiner did not err in combining the teachings of Brickell and Chebolu with the teachings of (i) Hoghaug in rejecting claim 3, and (ii) Vinberg in rejecting claim 5.

DECISION

The Examiner's decision to reject claims 1–20 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