

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOCHEN HALLER

Appeal 2012–010373
Application 11/636,667
Technology Center 3600

Before HUBERT C. LORIN, ANTON W. FETTING, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.
FETTING, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE¹

Jochen Haller (Appellant) seeks review under 35 U.S.C. § 134 of a final rejection of claims 1–10, which along with claims 11–20 withdrawn from consideration, are the only claims pending in the application on appeal. An oral hearing was held December 16, 2014. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

¹ Our decision will make reference to the Appellant’s Appeal Brief (“App. Br.,” filed April 20, 2012) and Reply Brief (“Reply Br.,” filed July 3, 2012), and the Examiner’s Answer (“Ans.,” mailed May 9, 2012).

The Appellant invented a way to create secure process execution environments (Specification para 1).

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

1. A system including instructions recorded on a computer readable medium and executable by at least one processor, the system comprising:

[0.1] an application server configured to provide an execution environment;

and

[0.2] a process execution engine configured to execute a process model within the execution environment,

[0.3] the process execution engine including

[1] an operational component

configured to perform

an operation of the process model

and

based on a security policy

which describes an allowable number and order

of security services of a plurality of security services

executing within the process execution engine,

and

[2] a security provider

configured to determine,

based on the operation and on the security policy,

a parameterization of a selected number and order of the allowable number and order of security services,

and

configured to secure the operational component according to the parameterization.

The Examiner relies upon the following prior art:

Organ US 7,047,463 B1 May 16, 2006

Patrick US 2006/0136555 A1 Jun. 22, 2006

Claims 1–10 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 1–10 stand rejected under 35 U.S.C. § 112, first paragraph, as lacking a supporting written description within the original disclosure.

Claims 1–10 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention.

Claims 1–10 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Patrick and Organ.

ISSUES

The issues of statutory subject matter turn primarily on whether the claims are directed to more than software per se. The issues of written description turn primarily on the meaning of the phrase “a number of.” The issues of indefiniteness turn primarily on whether the output of the second limitation in claim 1 is the same as the input of the first limitation. A new issue of indefiniteness is introduced regarding whether the first limitation of

claim 1 can be grammatically construed. The issues of obviousness turn primarily on whether the login security process extends beyond login.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to the Prior Art

Patrick

01. Patrick is directed to middleware for services and, more particularly, to a switching fabric having message processing capabilities through which clients and services can communicate. Patrick para 32.

Organ

02. Organ is directed to automated multisite testing by reconverging test flow execution sub-paths in a test sequence, and the assignment of priority values for testing operations in a test flow. Organ 1:9–14.

ANALYSIS

Claims 1–10 rejected under 35 U.S.C. § 101 as directed to non–statutory subject matter

We are persuaded by the Appellant's argument that the claims are directed to more than software per se because the claims recite a computer readable medium.

Claims 1–10 rejected under 35 U.S.C. § 112, first paragraph, as lacking a supporting written description within the original disclosure

We are persuaded by the Appellant's argument that the instantiation described in the Specification provides sufficient support for the recited parameterization, and that the recited phrase “selected number . . . of security services” means a selection of several security services, as the phrase “a number of . . .” is an idiomatic synonym for several.

Claims 1–10 rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention

We are persuaded by the Appellant's argument that the output of the recited security provider is not the input to the recited operational component, but is instead a parameterization. The arguments for the rejections based on the phrase “selected number” are persuasive for the same reasons as in the written description rejection analysis *supra*.

Claims 1–10 rejected under 35 U.S.C. § 103(a) as unpatentable over Patrick and Organ

We are persuaded by the Appellant's argument that Patrick's user name and password do not form a security policy that is further used as recited in

the claims, viz. a parameterization of a selected number and order of the allowable number and order of security services.

CONCLUSIONS OF LAW

The rejection of claims 1–10 under 35 U.S.C. § 101 as directed to non-statutory subject matter is improper.

The rejection of claims 1–10 under 35 U.S.C. § 112, first paragraph, as lacking a supporting written description within the original disclosure is improper.

The rejection of claims 1–10 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention is improper.

The rejection of claims 1–10 under 35 U.S.C. § 103(a) as unpatentable over Patrick and Organ is improper.

NEW GROUND OF REJECTION

The following new ground of rejection is entered pursuant to 37 C.F.R. § 41.50(b). Claims 1–10 are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention. The inclusion of the word “and” following the phrase “an operation of the process model” in limitation [1] of claim 1 renders limitation [1] grammatically incomprehensible. Appellant admitted in the oral hearing that the word should be deleted. See Transcript of Oral Hearing page 4.

DECISION

The rejection of claims 1–10 is reversed.

The following new ground of rejection is entered pursuant to 37 C.F.R. § 41.50(b). Claims 1–10 are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention.

This Decision contains a new rejection within the meaning of 37 C.F.R. § 41.50(b) (2011).

Our decision is not a final agency action.

37 C.F.R. § 41.50(b) 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 rejection:

- (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. . . .

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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) (2011).

REVERSED; 41.50(b)

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