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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
Row 1: 13/239,260, 09/21/2011, Craig S. Etchegoyen, UN-NP-SU-068 (Large), 1398

96051 7590 11/30/2016
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EXAMINER

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ART UNIT PAPER NUMBER

3685

NOTIFICATION DATE DELIVERY MODE

11/30/2016

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CRAIG S. ETCHEGOYEN

Appeal 2015-001206¹
Application 13/239,260
Technology Center 3600

Before MICHAEL W. KIM, PHILIP J. HOFFMANN, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

KIM, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

This is an appeal from the final rejection of claims 1–16. We have jurisdiction to review the case under 35 U.S.C. §§ 134 and 6.

The invention relates generally to a system for auditing software licenses. Spec., para. 2.

¹ The Appellant identifies Uniloc USA, Inc. and Microsoft Corporation as the real parties in interest. Appeal Br. 3.

Claim 1 is illustrative:

Claim 1. A system for auditing software usage on multiple network devices, comprising:

- a communication module;

- an audit database accessible by the communication module, the audit database storing audit numbers for the multiple network devices, each audit number derived from a software identifier identifying the software and from a device identifier, each software identifier representing a particular licensing instance of the software and number of seats licensed for the instance, each device identifier being generated from a combination of user-configurable and non-user-configurable machine parameters and identifying a particular one of the multiple network devices, each audit number representing an activation of the software;

- a display module;

- at least one processor in operative communication with the communication module and the display module; and

- a memory in operative communication with the at least one processor and comprising executable code for the at least one processor to:

- instruct the communication module to access the database;

- read the audit numbers;

- sort the audit numbers according to at least one of activated license seats and unactivated license seats;

- read a number of seats licensed for each software identifier; and

- instruct the display module to display licensed seats versus activations according to the sorted audit numbers.

Claims 1–16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wesinger (US 2006/0265337 A1, pub. Nov. 23, 2006), Gorman (US 2002/0143780 A1, pub. Oct. 3, 2002), and Omshehe (US 2002/0069172 A1, pub. June 6, 2002).

We REVERSE.

ANALYSIS

Each of independent claims 1 and 9 recites an “audit number derived from a software identifier . . . , each software identifier representing a . . . number of seats licensed for the instance.” We are persuaded by Appellant’s arguments that the portions of Wesinger cited by the Examiner do not disclose the claimed software identifier. App. Br. 17–18. More specifically, while Wesinger discloses implementing fixed and floating licenses with an authorized number of seats (e.g., Wesinger ¶ 0012), the Examiner has not explained adequately how any number of seats associated with these fixed and floating licenses is incorporated into any audit number, as required by each of independent claims 1 and 9.

Furthermore, we are persuaded by Appellant’s argument that the Examiner erred in asserting that the claimed “audit number” is non-functional descriptive material that is not entitled to patentable weight. Reply Br. 7–9. In making a determination regarding non-functional descriptive material, one relevant part of the inquiry is whether there is a “functional relationship” between the process and the descriptive material. MPEP § 2111.05 (citing *In re Kao*, 639 F.3d 1057, 1072–74 (Fed. Cir. 2011); *King Pharmaceuticals Inc. v. Eon Labs, Inc.*, 616 F.3d 1267, 1278 (Fed. Cir. 2010)). In the case of independent claims 1 and 9, we are persuaded that there is such a functional relationship, in that the claimed “audit number” is explicitly used in the processes of reading, sorting, determining the number of seats licensed, and displaying a comparison of licensed seats to activations, later recited in each of independent claims 1 and 9. Accordingly, because there is a functional relationship between the claimed “audit number” and underlying processes of independent claims 1

Appeal 2015-001206
Application 13/239,260

and 9, we are persuaded that the claimed “audit number” cannot be considered non-functional descriptive material.

For these reasons, we do not sustain the rejection of independent claims 1 and 9, or claims 2–8 and 10–16 dependent respectively therefrom.

DECISION

We REVERSE the rejection of claims 1–16 under 35 U.S.C. § 103(a).

REVERSED