UNITED STATES PATENT AND TRADEMARK OFFICE

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CRGO LAW	MASKULINSKI, MICHAEL C
STEVEN M. GREENBERG	
7900 Glades Road	

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Ex parte JIM A. HARRISON, ROB C. JONES,
PHIL R. LEE, and ANDY WRIGHT

_____

Appeal 2015-005641
Application 13/547,674
Technology Center 2100

_____

Before CATHERINE SHIANG, MELISSA A. HAAPALA, and
KAMRAN JIVANI, *Administrative Patent Judges.*

JIVANI, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants[1] seek our review under 35 U.S.C. § 134(a) of the
Examiner's final decisions rejecting claims 7–18, which are all the claims
pending in the present application.[2] We have jurisdiction under
35 U.S.C. § 6(b).

We AFFIRM.

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[1] Appellants identify International Business Machines Corporation as the
real party in interest. App. Br. 2.
[2] Claims 1–6 are cancelled. App. Br. 10.

STATEMENT OF THE CASE

The present application relates to transaction server performance monitoring. Spec. ¶ 2.

Claim 13 is illustrative (disputed limitation emphasized):

13.   A computer program product for predicting transaction server performance failure in a transaction processing environment, the computer program product comprising:

 a computer readable storage medium comprising a storage device having computer readable program code embodied therewith, the computer readable program code comprising:

 computer readable program code for receiving a performance metric for a transaction server during nominal operation of the transaction server;

 computer readable program code for comparing the performance metric to a benchmark of performance metrics for the transaction server; and,

 computer readable program code for responding to [L1] *the performance metric falling outside a threshold variance from the benchmark* by generating an alert of a potential impending failure of the transaction server.

The Rejections

Claims 7, 8, and 10–18 stand provisionally rejected for non-statutory double patenting as anticipated by claims 1–6 of co-pending Application No. 13/915,707.

Claims 13–18 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 7–18 stand rejected under 35 U.S.C. § 103(a) over Dickerson (US 8,326,971 B2; Dec. 4, 2012) and Smith (US 6,986,076 B1; Jan. 10, 2006).

ANALYSIS

Double Patenting

Claims 7, 8, and 10–18 stand provisionally rejected for non-statutory double patenting as anticipated by claims 1–6 of co-pending Application No. 13/915,707. Final Act. 3–4. Appellants fail to address this provisional rejection. Arguments not made are considered waived. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2014).

Accordingly, we sustain the Examiner's provisional non-statutory double patenting rejection of claims 7, 8, and 10–18 as anticipated by claims 1–6 of co-pending Application No. 13/915,707.

Non-Statutory Subject Matter

Appellants contend the Examiner errs in rejecting claims 13–18 because claim 13 is directed to a storage device and "clearly, a storage device is not a transitory signal medium." App. Br. 4.

We are not persuaded by Appellants' argument. Under a broad but reasonable interpretation, the scope of the "computer program product" recited in the preamble of claim 13 covers (under the open-ended term "comprising") a "computer readable storage medium," that medium itself comprising a "storage device having computer readable program code embodied therewith . . . ." *See e.g., Genentech, Inc. v. Chiron Corp.,*

112 F.3d 495, 501 (Fed. Cir. 1997) ("Comprising is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.").

Our reviewing court has held computer-readable media encompassing transitory signals to be non-statutory *per se*. *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007); *see also Manual of Patent Examining Procedure* (MPEP) § 2106(I) (9th ed. Rev. 07.2015, Nov. 2015). Further, limiting the claim to computer-useable media storing computer-readable program code, although narrowing, does not sufficiently circumscribe the claim to statutory subject matter. *Ex parte Mewherter*, 107 USPQ2d 1857, 1862 (PTAB 2013) (precedential-in-part) (machine-readable storage medium is non-statutory where specification silent as to meaning).

Appellants fail to identify in the Specification an express and unambiguous disclaimer of transitory forms of storage mediums. Instead, paragraph 26 of the Specification broadly describes a "computer readable storage medium" using exemplary, non-limiting language: "A computer readable storage medium *may be, for example, but not limited to*, an electronic, magnetic, optical, electromagnetic, infrared, or semiconductor system, apparatus, or device, or any suitable combination of the foregoing." (Emphasis added). We accord claim limitations the broadest reasonable interpretation consistent with the Specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). We find the exemplary language in the Specification (¶ 26) (i.e., "*may be, for example, but not limited to*") (emphasis added) is open-ended, and therefore fails to provide the artisan

with notice of a limiting definition, or an *express, unambiguous* disclaimer. We additionally find paragraph 26 of the Specification is silent regarding any mention of "non-transitory," as are claims 13–18 on appeal.

In considering whether the Specification expressly disclaims all transitory mediums from the scope of the "computer readable storage medium" recited in claim 13, we must also weigh the additional open-ended description in paragraph 33 that appears to contravene a disclaimer: "The description of the present invention has been presented for purposes of illustration and description, *but is not intended to be exhaustive or limited to the invention in the form disclosed.*" Spec. ¶ 33 (emphasis added).[3] Additionally, we are unable to find in the entirety of Appellants' Specification (including the claims and drawings) *any* mention of the term "non-transitory" that would be the basis for an express disclaimer *clearly and unambiguously* excluding *all transitory forms* of mediums from the scope of the claims.

Here, we find no clear "non-transitory" disclaimer in the Specification or claims. Given the open-ended, non-limiting descriptions found in paragraphs 26 and 33 of the Specification, and because claim 13 is *silent* regarding any mention of a computer readable *signal* medium (Spec. ¶ 27), and particularly because claim 13 does not positively recite a *non-transitory*

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[3] *Accord Williamson v. Citrix Online, LLC,* 792 F.3d 1339, 1346–47 (Fed. Cir. 2015) ("This court has repeatedly 'cautioned against limiting the claimed invention to preferred embodiments or specific examples in the specification'") (quoting *Teleflex, Inc. v. Ficosa N. Am. Corp.,* 299 F.3d 1313, 1328 (Fed. Cir. 2002)).

"computer readable storage medium," on this record, we are not persuaded of Examiner error. For at least these reasons, we find Appellants' Specification, and Appellants claims 13–18, do not expressly and unambiguously disclaim all transitory forms of the recited "computer readable storage medium."

We find a preponderance of the evidence supports the Examiner's finding that the cited portion of the Specification (¶ 26) does not limit the computer readable storage medium comprising a storage device having computer readable program code embodied therewith, as recited in claim 13, "to tangible, non-transitory embodiments." Final Act. 4. Thus, we agree with the Examiner's broad, yet reasonable, reading that the scope of the claim also covers non-statutory transitory mediums.

Under *Mewherter*, the scope of a "computer readable storage medium" was held to encompass transitory media such as signals or carrier waves, where, as here, the Specification does not expressly disclaim transitory forms. Therefore, we find *Mewherter* is controlling regarding claims 13–18, as rejected by the Examiner under 35 U.S.C. § 101.

Accordingly, on this record, and by a preponderance of the evidence, we sustain the Examiner's 35 U.S.C. § 101 rejection of claims 13–18.

Obviousness

Based on Appellants' arguments, we decide the appeal on the basis of representative claim 13. *See* 37 C.F.R. § 41.37(c)(1)(iv)(2014). Appellants contend the Examiner "has simplified the language of the independent claims and has completely omitted consideration of the claim term

'benchmark.'" App. Br. 7 (emphasis omitted). Appellants elaborate, the Examiner has "misconstrued the critical claim term 'benchmark' to merely mean a threshold." Reply Br. 5.

We have considered Appellants' argument in the Appeal Brief and Reply Brief, as well as the Examiner's Answer thereto. We are not persuaded by Appellants' argument for at least the following reasons.

Initially, as a matter of claim construction, we find Appellants have not defined explicitly the term "benchmark" in the claim nor the Specification. We apply the broadest reasonable interpretation of claim terms, consistent with the specification, as would be understood by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (citations omitted). Where, as here, the Specification does not explicitly define a term, the term should be given its ordinary meaning. *See In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989); *Morris*, 127 F.3d at 1054.

In support of their argument, Appellants proffer a dictionary definition of the term benchmark. App. Br. 8. However, we observe the MICROSOFT COMPUTER DICTIONARY defines "benchmark" as:

> (A) A standard against which measurements or comparisons can be made. *See also*: benchmark program; benchmark problem.

> (B) A procedure, problem, or test that can be used to compare systems or components to each other or to a standard as in definition (A).

> (C) A recovery file.

MICROSOFT COMPUTER DICTIONARY 96 (5th ed. 2002). Consistent with the Specification and given this dictionary definition, we decline to limit the term benchmark to the definition proffered by Appellants, but instead construe the term benchmark to encompass, *inter alia*, a standard against which measurements or comparisons can be made.

In light of the above construction, we are not persuaded by Appellants' argument that the cited references fail to meet limitation L1. Rather, we agree with the Examiner that Dickerson's monitoring of performance data produced in response to execution of a synthetic transaction (i.e., the performance metric) and the synthetic transaction itself (i.e. the benchmark) in combination with Smith's use of proactive failover when a monitored event exceeds a threshold (i.e., the metric falling outside a threshold variance from the benchmark) at minimum suggests limitation L1. Ans. 10–11; Dickerson 6:21–24. More specifically, we agree with the Examiner that Smith's synthetic transactions meet the claimed benchmark (Ans. 10), as we have construed that term.

Accordingly, we sustain the Examiner's 35 U.S.C. § 103(a) rejection of claims 7–18.

DECISION

We affirm the Examiner's decisions rejecting claims 7–18.

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