



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.
13/036,445	02/28/2011	Michael Baentsch	CH920090047US1 (714)	4961
46320	7590	10/03/2016	EXAMINER	
CRGO LAW STEVEN M. GREENBERG 7900 Glades Road SUITE 520 BOCA RATON, FL 33434			MEHRMANESH, AMIR	
			ART UNIT	PAPER NUMBER
			2496	
			NOTIFICATION DATE	DELIVERY MODE
			10/03/2016	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):

docketing@crgolaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHAEL BAENTSCH, HAROLD D. DYKEMAN,
MICHAEL C. OSBORNE, and TAMAS VISEGRADY

Appeal 2015-007153
Application 13/036,445
Technology Center 2400

Before KALYAN K. DESHPANDE, DAVID M. KOHUT, and
JUSTIN T. ARBES, *Administrative Patent Judges*.

KOHUT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE¹

Appellants seek review under 35 U.S.C. § 134(a) of the Examiner's Non-Final Rejection of claims 1 and 4–15.² We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

We AFFIRM.

INVENTION

Appellants' invention is directed to server data management. Spec.

¶ 2.

Claim 1 is illustrative of the invention and reproduced below:

1. A security device (6) for facilitating management of secret items used by a remote server (2) to authenticate operations of the server (2), the device (6) comprising

a computer interface (11) for connecting the device (6) to a local user computer (5) for communication with the remote server (2) via a data communications network (3),

a memory device interface (12) for interfacing with a memory device (9) inserted into a slot of the security device (6),

a user interface (13), and

control logic (16) adapted:

to establish between the security device (6) and the remote server (2), via the local user computer (5), a mutually-authenticated connection for encrypted end-to-end communications between the security device (6) and the remote server (2);

¹ Our Decision makes reference to Appellants' Reply Brief ("Reply Br.," filed July 22, 2015), and Appeal Brief ("App. Br.," filed December 16, 2014), and the Examiner's Answer ("Ans.," mailed May 22, 2015) and Non-Final Office Action ("Non-Final Act.," mailed July 16, 2014).

² Claims 2 and 3 were canceled previously.

memory device” and “restor[ing] secret data items from the memory [] of the memory device [] to the remote server,” as recited in independent claim 1, and similarly recited in independent claims 11, 12, and 15?

ANALYSIS

Claim 11 rejected under 35 U.S.C. § 101

Claim 11 recites a “computer program stored in a computer readable storage medium, the computer program comprising program code for causing a processor” to perform certain actions. The Examiner finds that the term “computer readable storage medium” encompasses non-statutory subject matter because the Specification does not preclude “computer readable storage medium” from including non-statutory subject matter, such as signals and carrier waves.³ Non-Final Act. 5 (citing Spec. ¶ 18); Ans. 2–3.

Appellants argue that the term “computer readable storage medium” is directed to statutory subject matter because the Specification describes a storage medium, by way of example, as a disk. App. Br. 10 (citing Spec. ¶ 18); Reply Br. 2–5. We do not find Appellants’ argument persuasive

³ The Examiner suggests modifying the claim language to include the adjective “non-transitory” for the recited “computer readable storage medium” to overcome the rejection. Non-Final Act. 3. This suggestion is in accordance with guidance provided by the Office. *See Subject Matter Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010) (“A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation ‘non-transitory’ to the claim.”).

because the example of a computer readable storage medium described in the Specification does not preclude non-transitory subject matter.

The Specification recites “a computer program . . . may be . . . embodied in a computer-readable medium such as a disk or an electronic transmission for loading in a security device.” Spec. ¶ 18. The phrase “such as” is non-limiting and does not preclude the computer program from being embodied in other types of media, which may include signals. Without language in the Specification that limits a “computer readable storage medium” to only statutory subject matter, the broadest reasonable interpretation of the claimed “computer readable storage medium” encompasses non-statutory subject matter (e.g., a signal *per se*). *Ex parte Mewherter*, 107 USPQ2d 1857, 1862 (PTAB 2013) (precedential).

Appellants also argue that the Board has found either the term “computer readable storage medium” or “machine-accessible storage medium” to be statutory in *Ex parte Mehta*, Appeal No. 2008-004853, 2009 WL 4004962 (BPAI 2009) (non-precedential); *Ex parte Hu*, Appeal No. 2010-000151, 2012 WL 439708 (BPAI 2012) (non-precedential); *Ex parte Dureau*, Appeal No. 2009-007211, 2010 WL 3389299 (BPAI 2010) (non-precedential); *Ex parte Bash*, Appeal No. 2009-007202, 2010 WL 5199590 (BPAI 2010) (non-precedential); and *Ex parte Raverdy*, Appeal No. 2010-006461, 2012 WL 5387573 (PTAB 2012) (non-precedential). *See* App. Br. 7–9; *see also* Reply Br. 2–3. As a preliminary matter, none of these cases have been designated as precedential, and therefore, are not binding. Thus, we are bound by the decision in *Ex parte Mewherter*, where the Board concluded that unless the claim language, given its broadest reasonable interpretation in light of the Specification, precludes non-statutory subject

matter, a “storage medium” can potentially include non-statutory subject matter, such as signals *per se*, and thereby not satisfy § 101. *See Ex parte Mewherter*, 107 USPQ2d at 1862. Thus, we are not persuaded that the Examiner erred in determining that claim 11, reciting the term “computer readable storage medium,” is directed to non-statutory subject matter.

Claims 1 and 4–15 rejected under 35 U.S.C. § 103(a)

Claim 1 recites “stor[ing] the secret data items in a memory [] of the memory device” and “restor[ing] secret data items from the memory [] of the memory device [] to the remote server.” Independent claims 11, 12, and 15 recite similar limitations.

The Examiner finds that Hamid teaches the disputed limitations. Specifically, the Examiner’s finding is based upon Hamid’s teaching of transferring data from a server and storing it in the memory of a portable storage device, and reconstructing a server by uploading the stored data to the server. Non-Final Act. 9–10 (citing Hamid ¶¶ 54, 57, Fig. 7); Ans. 4–6.

Appellants argue that the Examiner’s finding is in error. App. Br. 13–15; Reply Br. 7–8. Appellants argue that Weigold³ fails to teach storing secret data from the remote server in the smartcard and restoring the remote server using the smartcard’s stored secret data. App. Br. 13–14; Reply Br. 7–8. We disagree with Appellants’ argument because the Examiner relies upon Hamid to teach the portable storage device memory performing the storing and restoring functions. *See* Non-Final Act. 9–10; Ans. 4–5.

³ Appellants’ Appeal and Reply Briefs refer to the Weigold reference as “Weingold.” *See* App. Br. *passim*; *see also* Reply Br. *passim*. We hold this to be harmless error and make the correction here.

Appellants additionally contend that rather than “stor[ing] the secret data items in a memory [] of the memory device,” Hamid teaches transferring data from a remote server to a computer and into a portable data storage device. App. Br. 14; Reply Br. 9–10 (citing Hamid, Fig. 7). We disagree with Appellants. Appellants’ argument consists only of an instruction to compare Hamid’s teaching with the claimed subject matter, but does not indicate why one of ordinary skill in the art at the time of Appellants’ invention would not have reasonably understood that the portable data storage device of Hamid could serve as the claimed memory of the memory device. *See* App. Br. 14; *see also* Reply Br. 9–10. As such, Appellants’ argument does not persuade us of Examiner error because it fails to explain sufficiently the difference between Hamid and the claimed invention.

Appellants also argue that Hamid fails to teach “restor[ing] secret data items from the memory [] of the memory device [] to the remote server” because “nowhere in Figure 5 is it provided that data from a memory device inserted into a security device of a computer is restored to a remote server.” *See* App. Br. 12; Reply Br. 9–13 (citing Hamid, Fig. 5). We do not agree. We agree with the Examiner (Non-Final Act. 9; Ans. 5–6) and find no reason why uploading data stored on the portable storage device memory to a server, as taught in Hamid, is any different than that which is claimed. Without further evidence or argument, we do not find Appellants’ argument persuasive of Examiner error because it fails to explain sufficiently the difference between Hamid and the claimed invention.

Accordingly, for the reasons stated above, we sustain the Examiner’s rejection of independent claims 1, 11, 12, and 15. Appellants do not argue

separately the Examiner's rejection of dependent claims 4–10, 13, and 14 over the combination of Hamid and Weigold. Thus, we summarily sustain the Examiner's rejection of claims 4–10, 13, and 14 as unpatentable over the combination of Hamid and Weigold.

CONCLUSION

The Examiner did not err in determining that claim 11, reciting the term “computer readable storage medium,” is directed to non-statutory subject matter.

The Examiner did not err in finding the combination of Hamid and Weigold teaches “stor[ing] the secret data items in a memory [] of the memory device” and “restor[ing] secret data items from the memory [] of the memory device [] to the remote server,” as recited in independent claim 1, and similarly recited in independent claims 11, 12, and 15.

SUMMARY

The Examiner's rejection of claim 11 under 35 U.S.C. § 101 as being directed to non-statutory subject matter is affirmed.

The Examiner's rejection of claims 1 and 4–15 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Hamid and Weigold 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