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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/461,872	08/26/2009	Gerald Ristow	JAR-4041-69	6327
23117	7590	10/31/2016	EXAMINER	
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			GEBRESENBET, DINKU W	
			ART UNIT	PAPER NUMBER
			2164	
			NOTIFICATION DATE	DELIVERY MODE
			10/31/2016	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GERALD RISTOW and JOACHIM VOEGELE

Appeal 2015-007679¹
Application 12/461,872
Technology Center 2100

Before ALLEN R. MACDONALD, DEBRA K. STEPHENS, and
PHILLIP A. BENNETT, *Administrative Patent Judges*.

BENNETT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Final Rejection of claims 1–8, 10, 12–15, and 18–20. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Appellants identify the real party in interest as SOFTWARE AG, a corporation of the country of Germany. App. Br. 3.

CLAIMED SUBJECT MATTER

The claims are directed to a database system, access application and method for controlling access to contents of an external database. Claim 1 is reproduced below, and is illustrative of the claimed subject matter.²

1. A database system configured to provide read-only access to data that is stored in a database, the database system comprising:

a processing system that includes at least one computer processor, the processing system configured to:

extract a subset of data from the database;

store, on a non-transitory storage medium, the extracted subset of data in a read-only database;

store a time-stamp that is associated with the extracted subset of data in the read-only database;

encrypt the data stored in the read-only database;

and

store an access application, on the non-transitory storage medium, in accordance with the read-only database, the access application including control logic that is, in conjunction with at least one processor, configured to:

provide exclusive access to data stored in the read-only database to a user via the access application, wherein the exclusive access provided to the user is based on a license file that is stored in accordance with the read-only database;

² We note the typographical error in the last limitation of claim 1 which concludes with the phrase “based the license file.” It is apparent to us this phrase is intended to be “based on the license file,” and for purposes of this appeal, we interpret it this way. We recommend this error and a similar error in claim 15 be corrected in the event of further prosecution.

decrypt the encrypted data so as to provide unencrypted data to the user via the provided exclusive access; and

control an amount of data that is allowed to be copied from the read-only database to an external computing source for further processing based [on] the license file.

App. Br. 23 (Claims App'x).

REFERENCES

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

Berger et al.	US 6,424,972 B1	July 23, 2002
Pence et al.	US 2003/0115069 A1	June 19, 2003
Karimzadeh et al.	US 2007/0006322 A1	Jan. 4, 2007
Debrunner	US 2007/0266064 A1	Nov. 15, 2007
Rogers et al.	US 7,870,502 B2	Jan. 11, 2011

REJECTIONS

Claims 1, 3–8, 12–14, and 18–20 stand rejected under 35 U.S.C. § 103(a) as being obvious over Debrunner, Karimzadeh, and Pence.

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being obvious over Debrunner, Karimzadeh, Pence, and Berger.

Claims 10 and 15 stand rejected under 35 U.S.C. § 103(a) as being obvious over Debrunner, Karimzadeh, Pence, and Rogers.

ISSUES FOR DECISION

(1) Did the Examiner err in finding the cited combination teaches, suggests, or otherwise renders obvious a system configured to “control an

amount of data that is allowed to be copied from the read-only database to an external computing source for further processing based [on] the license file,” as recited in claim 1?

(2) Did the Examiner err in finding a motivation to combine Debrunner, Karimzadeh, and Pence?

(3) Did the Examiner err in finding the cited combination teaches, suggests, or otherwise renders obvious the “non-transitory storage medium is a read-only storage medium,” as recited in claim 3 and recited similarly in claim 6?

(4) Did the Examiner err in finding the cited combination teaches, suggests, or otherwise renders obvious “wherein the read-only database, associated time stamps, access application, and the license file are all stored on the same portable storage medium” as recited in claim 19?

(5) Did the Examiner err in finding the cited combination teaches, suggests, or otherwise renders obvious “wherein an amount of data that is allowed to be copied from the read-only database to the clipboard is based [on] the license file,” as recited in claim 15.

ANALYSIS

First Issue

The Examiner rejects the independent claims based on the combination of Debrunner, Karimzadeh, and Pence. The Examiner finds Pence teaches the “control” limitation recited in at the end of claim 1 and recited similarly in claims 12 and 13. Final Action 7–8 (citing Pence ¶¶ 11, 15); Ans. 6 (additionally citing Pence ¶¶ 3, 19).

Appellants challenge the Examiner’s findings. More specifically, Appellants argue Pence does not teach or suggest a processing system configured to “control an amount of data that is allowed to be copied from the read-only database to an external computing source for further processing based [on] the license file” because paragraphs 11 and 15 cited by the Examiner, relate to separate parts of Pence’s system—the License File and the License Server, respectively. App. Br. 13–14. Appellants contend Pence’s teaching of tracking the amount of content downloaded by a user and comparing it to the amount of content the user is permitted, is not carried out by the License File, but instead is carried out by the License Server. App. Br. 14. Appellants further argue because these features are implemented on the License Server (and not the License File), Pence does not teach the “control” limitation. App. Br. 14. According to Appellants, tracking an amount of data and comparing the tracked amount of data to the amount permitted is different from controlling the amount of data that can be copied, and that a person of ordinary skill in the art would not have modified Pence to implement the functions of the License Server in the License File. App. Br. 14–15.

We are unpersuaded by Appellants’ arguments. Appellants acknowledge Pence teaches keeping a running total of the amount of content downloaded by a user and comparing it to an amount permitted. App. Br. 14. But, Appellants contend this functionality cannot be considered a teaching of controlling the amount of data that can be copied. *Id.* We disagree. Although Pence does not explicitly state that a user exceeding their permitted allotment of downloaded content would be restricted, Pence suggests the amount of copied data would be limited. Pence ¶¶ 3, 15. As

noted by the Examiner, paragraph 3 of Pence describes the use of conventional subscription management methods in which a user can download up to a “maximum amount of content allowed.” A person of ordinary skill in the art would have appreciated that enforcing these types of subscription policies would have entailed limiting an amount of copied data.

Moreover, Appellants’ contention regarding the License File and License Server (App. Br. 12–15) does not apprise us of error because Pence discloses “[r]egardless of how the servers are interfaced and accessed, the information contained on the servers can be shared between the servers and the Client to allow for the proper licensing to be created and enforced.” Pence ¶ 16. In view of this disclosure, Pence teaches that the License File (which is on the client) and License Server (stored on the servers) are used cooperatively to enforce licensing requirements such as the maximum content allowed as described in paragraphs 3 and 15. Accordingly, we discern no error in the Examiner’s finding Pence teaches or suggests controlling of the amount of data that is allowed to be copied based on the license file.

Second Issue

Appellants also assert that the combination of Debrunner, Karimzadeh, and Pence is improper. In disputing the Examiner’s rationale, Appellants assert three main contentions. First, Appellants contend a person of ordinary skill in the art would not have combined Pence with Debrunner and Karimzadeh. App. Br. 15–16. Second, Appellants contend a person of ordinary skill in the art would not have controlled an amount of data allowed to be copied by using Karimzadeh’s access control matrix. *Id.* at 16–17. Third, Appellants argue combining Karimzadeh with Debrunner would have

changed the principle of operation of Debrunner's database system. *Id.* at 17–18. We address each argument in turn.

In contesting the propriety of combining Pence with Debrunner and Karimzadeh, Appellants argue Pence teaches away from the combination because Pence is concerned with digital rights management and his license files would not be effective in the context of Debrunner's system. *Id.* at 16–17. We disagree. Pence does not teach away from the sharing of data as Appellants contend. Rather, Pence is concerned with reducing the risk of creating *unauthorized* copies of content. Pence Abstract. Pence is not concerned with preventing copying or sharing of data in a general sense as Appellants allege. Nor do we find persuasive Appellants' contention that “[t]he resulting system advocated for in the Final Office Action would effectively destroy Pence's system” (App. Br. 16), as it is Debrunner that is modified by the teachings of Pence, and not the other way around.

Appellants also argue a person of ordinary skill in the art would not have controlled an amount of data allowed to be copied using Karimzadeh's access control matrix. App. Br. 16–17. Appellants argue these types of security features are used for controlling access and not what is done with the access. App. Br. 17. Appellants also argue the Examiner has engaged in impermissible hindsight, and Pence's teachings could not be successfully incorporated within the structure of Karimzadeh's access control matrix. Reply Br. 2–3. The test for obviousness, however, is not whether the secondary reference may be bodily incorporated into the structure of the primary reference. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). The test is whether a person of ordinary skill in the art, in possession of teachings of the references, would have a reason to combine them to achieve the claimed

invention. *Allied Erecting & Dismantling Co. v. Genesis Attachments, LLC*, 825 F.3d 1373, 1381 (Fed. Cir. 2016).

Here, the Examiner finds, and we agree, that it would have been obvious for Debrunner's distribution system and Karimzadeh's access control matrix to be modified to include the known functionality provided by Pence, because doing so would provide improved ability to track and protect content and reduce the risk of the creation of unauthorized copies of protected data. Final Act. 8; Ans. 6–7. As such, the proposed modification would amount to only a combination of known methods which yield predictable results to one of ordinary skill in the art. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

Appellants also challenge the propriety of the Examiner's proposed combination of Debrunner and Karimzadeh. App. Br. 18–19. The Examiner finds it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Debrunner's read-only database system with the time-stamping, encryption, and exclusive access based on a license file taught by Karimzadeh in order to provide portable, multi-user, secure database and a system and method for storage and retrieval of select data by an authorized user. Final Act. 7; Ans. 5–6. Appellants argue combining Karimzadeh with Debrunner would have changed the principle of operation of Debrunner's database system. *Id.* at 18–19. Appellants assert that a skilled artisan "taking the teachings of Debrunner as a whole, would **not** have sought to add unwanted processing time (encryption) to a system that is concerned with performance for no benefit." *Id.* at 18.

We agree with the Examiner that Debrunner and Karimzadeh are properly combinable, and disagree with Appellants' assertions that the

teachings of the references are incompatible. Appellants' argument rests on an assumption that a skilled artisan would not seek to improve security in a database system if the improved security had any impact on performance. App. Br. 18. The record before us does not support such an assumption. The Federal Circuit has recognized when a proposed modification of a reference may impede some of its functionality, a combination of references is still proper. *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006) (“[a] given course of action often has simultaneous advantages and disadvantages, and this does not necessarily obviate motivation to combine”). While it may be possible that adding the security benefits of Karimzadeh might slow Debrunner's system to some extent, neither reference supports Appellants' assertion that the combination invariably “would have resulted in ‘bottlenecks that slow the database system, creating delays, timeout, and other problems.’” App. Br. 19 (quoting Debrunner ¶ 4). Rather, given the importance of data security recognized by Karimzadeh, we conclude a person of ordinary skill in the art would have seen a benefit in improving the security of Debrunner system, even if this security benefit involved some degree of trade-off in performance. As a result, we are not persuaded a skilled artisan would have been discouraged from combining the teachings of Debrunner and Karimzadeh.

Accordingly, the Examiner did not improperly combine Debrunner, Karimzadeh, and Pence.

Third Issue

Appellants separately argue for patentability of claims 3 and 6 which recite “the non-transitory storage medium is a read-only storage medium” (claim 3) and “the non-transitory storage medium is also a read-only

medium” (claim 6). App. Br. 19–20. The Examiner finds that Debrunner teaches the use of a portable storage medium such as an optical compact disk (CD) that can be used to transfer a portion of Debrunner’s central database. Final Act. 9; Ans. 4–5, 7 (citing Debrunner ¶ 28). Appellants contend that there is no teaching in Karimzadeh of a “read-only medium” as set forth in claims 3 and 6 because Karimzadeh indicates only that the data is read-only, and not that the medium upon which the data is stored is read-only. App. Br. 19.

Appellants’ arguments regarding claims 3 and 6 do not apprise us of error because the Examiner does not rely on Karimzadeh for a teaching of the “non-transitory medium is also a read-only medium.” Rather, the Examiner relies on Debrunner’s teaching of the use of “a portable storage medium such as an optical compact disk (CD).” Final Act. 9 (emphasis omitted); Ans. 7 (citing Debrunner ¶ 28). We agree with the Examiner that a person of ordinary skill in the art at the time of invention would have understood a compact disk to include a read-only portable storage medium, a finding not contested by Appellants. Accordingly, we discern no error in the Examiner’s findings with respect to claims 3 and 6.

Fourth Issue

Appellants assert Examiner error with respect to the rejection of claim 19, which depends from claim 12 and recites “wherein the read-only database, associated time stamps, access application, and the license file are all stored on the same portable storage medium.” App. Br. 20. The Examiner finds that Karimzadeh discloses this claim limitation at paragraphs 14, 62, and 77–78. Final Act. 15–16; Ans. 9. Appellants argue that the alleged combination fails to teach or suggest providing the read-only

database, associated timestamps, access application, and license file on the same medium because Pence tracks data on a server computer which is not portable or the same medium that contains the other elements. App. Br. 20.

We are unpersuaded by Appellants' arguments regarding claim 19. In focusing their arguments on the teachings of Pence, Appellants also do not explain why the Examiner's reliance on Karimzadeh is misplaced. As such, Appellants' arguments do not apprise us of Examiner error with respect to claim 19. In our view, the Examiner correctly finds that Karimzadeh teaches storing a read-only database, associated timestamps, access application, and license file on a portable storage medium. Final Act. 15; Ans. 8–9. Accordingly, we find no error in the Examiner's rejection of claim 19.

Fifth Issue

Appellants also challenge the Examiner's rejection of claim 15 which recites "wherein an amount of data that is allowed to be copied from the read-only database to the clipboard is based [on] the license file." App. Br. 21. The Examiner finds Rogers teaches the use of a clipboard and is properly combinable with the remaining cited references. These findings are not challenged by Appellants. The Examiner relies on Pence for "an amount of data that is allowed to be copied from the read-only database . . . is based on the license file." Final Act. 19–20; Ans. 10. Contesting this rejection, Appellants argue Rogers does not teach restricting the amount of data that can be copied to the clipboard. App. Br. 21. We are unpersuaded by Appellants' argument because it does not address the rejection made by the Examiner. Although the Examiner relies on Rogers for copying data to the clipboard (Final Act. 18), the Examiner relies on Pence, and not Rogers, as disclosing the remainder of claim 15. Final Act. 19–20; Ans. 10. Appellants

do not provide any explanation of why the Examiner's reliance on Pence is insufficient in that regard.³ Accordingly, we find no error in the rejection of claim 15.

Remaining Claims

Appellants do not set forth any separate arguments for patentability of claims not specifically addressed above. As such, claims 2–8, 10, 14, 18, and 20 fall with claims 1, 12, 13, 15, and 19. 37 C.F.R. § 41.37(c)(1)(iv).

DECISION

The Examiner's rejection of claims 1–8, 10, 12–15, and 18–20 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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

³ To the extent Appellants rely on prior arguments regarding Pence, we do not find those arguments persuasive for the reasons set forth above.