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KING & SCHICKLI, PLLC 800 CORPORATE DRIVE, SUITE 200 LEXINGTON, KY 40503			BECHTEL, KEVIN M	
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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* BRENT R. BEACHEM, MERRILL K. SMITH,  
and RICHARD B. ROLLINS

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Appeal 2015-007921  
Application 12/220,893  
Technology Center 2400

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Before JOHN A. EVANS, CARL L. SILVERMAN, and JOHN D.  
HAMANN, *Administrative Patent Judges*.

EVANS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants<sup>1</sup> seek our review under 35 U.S.C. § 134(a) of the Examiner's Final Rejection of Claims 1–30, which are all the claims pending in the application. Br. 3. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.<sup>2</sup>

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<sup>1</sup> The Appeal Brief identifies Novell, Incorporated, as the real party in interest. Br. 3.

<sup>2</sup> Rather than reiterate the arguments of Appellants and the Examiner, we refer to the Appeal Brief (filed April 7, 2015, “Br.”), the Examiner’s Answer (mailed July 8, 2015, “Ans.”), the Final Office Action (mailed November 19, 2014, “Final Act.”), and the Specification (filed July 29, 2008, “Spec.”) for their respective details.

## STATEMENT OF THE CASE

The claims relate to a method for locating an internet phone. *See* Abstract.

### *The Invention*

Claims 1, 9, 16, 17, and 20 are independent. An understanding of the invention can be derived from a reading of exemplary Claim 1, which is reproduced below with some formatting added:

1. In a computing system environment, a method of counteracting a security threat infecting or attacking a computing device of the environment, comprising:

identifying whether the computing device has been compromised by the security threat; if so,

developing an effective active countermeasure to counteract the security threat; and

operationally replacing the computing device having been identified as compromised with a virtual computing device having the active countermeasure installed thereon.

### *References and Rejections*

The Examiner relies upon the prior art as follows:

Sobel	US 7,565,382 B1	Filed: Aug. 14, 2003
Wing, <i>et al.</i> ,	US 2004/0172574 A1	Priority: May 27, 2002

1. Claims 1–30 stand rejected under 35 U.S.C. § 112(a, or pre-AIA 1<sup>st</sup> ¶) as lacking enablement. Final Act. 14–15.
2. Claims 26–30 stand rejected under 35 U.S.C. § 112(a, or pre-AIA 1<sup>st</sup> ¶) as failing the written description requirement. Final Act. 15–17.
3. Claims 1–30 stand rejected under 35 U.S.C. § 112(b, or pre-AIA 2<sup>nd</sup> ¶) as indefinite. Final Act. 17–18.

4. Claims 1–30 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Final Act. 18–20.
5. Claims 1–3, 5–10, 12–15, 20–24, 26, 27, and 30 stand rejected under 35 U.S.C. § 102(b) as anticipated by Wing. Final Act. 21–28.
6. Claims 4, 11, 16–19, 25, 28, and 29 stand rejected under 35 U.S.C. § 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over Wing. Final Act. 28–33.
7. Claims 1–30 stand rejected under 35 U.S.C. § 103(a) as obvious over Wing and Sobel. Final Act. 33–38.

#### ANALYSIS

We have reviewed the rejections of Claims 1–30 in light of Appellants’ arguments that the Examiner erred. We have considered in this decision only those arguments Appellants actually raised in the Brief. Any other arguments which Appellants could have made but chose not to make in the Brief are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv). We are not persuaded that Appellants identify error. Upon consideration of the arguments presented in the Appeal Brief, we agree with the Examiner that all the pending claims are unpatentable over the cited combination of references. We adopt as our own the findings and reasons set forth in the rejection from which this appeal is taken and in the Examiner’s Answer. We provide the following explanation to highlight and address specific arguments and findings primarily for emphasis. We consider Appellants’ arguments *seriatim*, as they are presented in the Appeal Brief, pages 14–33.

CLAIMS 1–30: ENABLEMENT

The claims recite, *inter alia*, “developing an effective active countermeasure to counteract the security threat.” The Examiner finds the only means disclosed for developing a “countermeasure” is “locating a [security] patch.” Final Act. 14. The Examiner finds the claim recitation is an unbounded functional claim limitation that extends to all methods of countermeasure development and is not adequately supported by the written description, nor is commensurate in scope with the enabling disclosure. *Id.*

Appellants contend the Specification discloses the skilled artisan is well aware of effective countermeasures to known threats to computing environments, which include viruses, malware, and others. Br. 14.

The Examiner finds Appellants’ Specification enables known countermeasures, such as installing anti-virus software or a software patch directed to a known virus. Final. Act. 3. However, the Examiner finds there is a very significant difference in scope between “finding a patch” for “a particular known virus” (a scope which the Examiner agrees is enabled) versus the entirety of the scope encompassed by “developing an effective active countermeasure to counteract the security threat,” which the Examiner finds is not enabled. *Id.* at 16; *see* Ans. 4–6.

Appellants do not file a Reply to the Examiner’s Answer. We find the Examiner’s findings to be reasonable and we are not persuaded that the Examiner has erred.

#### CLAIMS 26–30: WRITTEN DESCRIPTION

The Examiner finds the Claim 26 recitation “wherein the active countermeasure is one or more of a patch, an anti-virus patch, and an anti-virus computer program product,” is not supported by the Specification.

Final Act. 16. The Examiner finds written description support for “finding a patch for the application” when “a particular known virus is discovered that infects applications.” *Id.* The Examiner finds there is no disclosure that anti-virus software effective against known threats is an “active countermeasure” against the unknown threats that are within the scope of the claims. *Id.*

Appellants refer to a disclosed “specific example of a patch for an application to counteract a known virus (an ‘anti-virus patch’)” and contend such disclosure provides a person of skill with sufficient detail to conclude the inventors possessed the full scope of the invention. Br. 16.

The Examiner finds Appellants fail to disclose developing a countermeasure against an unknown threat. Ans. 16.

Appellants do not file a Reply to the Examiner’s Answer. We find the Examiner’s findings to be reasonable and we are not persuaded that the Examiner has erred.

#### CLAIMS 1–30: INDEFINITENESS

The Examiner finds the term “active countermeasure” is not defined. Final Act. 17. The Examiner finds Appellants disclose an “active” countermeasure is well-known in the art and is “one or more of a patch, an anti-virus patch, and an antivirus computer program product.” *Id.* However, the Examiner finds the disclosed countermeasures are “data structures” and are not “active.” *Id.*

Appellants contend the Specification discloses “testing of one or more countermeasures specifically designed to counteract a detected security threat, i.e., an ‘active’ countermeasure.” Br. 17.

The Examiner finds Appellants disclose a patch as an active countermeasure, but that Appellants argue the patch disclosed by Wing is passive. Ans. 14. The Examiner finds Appellants do not sufficiently distinguish their claimed “active” patch from what they allege is a “passive” patch disclosed by Wing. *Id.*

Appellants do not file a Reply to the Examiner’s Answer. We find the Examiner’s findings to be reasonable and we are not persuaded that the Examiner has erred.

#### CLAIMS 1–30: NON-STATUTORY SUBJECT MATTER

The Examiner finds the claims are directed to the abstract idea of replacing a compromised computer with one protected against the threat. Final Act. 18. The Examiner finds Appellants disclose no computer is required to perform the act. Rather, the claimed “replacing” is satisfied by a user locating and installing a software patch. Final Act. 19.

Appellants contend their claims meet the “machine-or-transformation test,” a test that remains valid post *Alice*. *See* Br. 18–19.

Appellants have not persuaded us that the claims may be met by a human user installing a software patch and do not require acts performed by a machine.

#### CLAIMS 1–3, 5–10, 12–15, 20–24, 26, 27, AND 30: ANTICIPATION BY WING

Appellants contend Wing fails to disclose replacing a failed or compromised server with a virtual computing device including a tested and proven countermeasure installed thereon. Br. 22. Appellants argue Wing has no teaching of installing anything on the rollback virtual machine before

failover. A rollback virtual machine is a replica of the machine before it was corrupted without any active countermeasures installed thereon. As such, Wing's rollback machine cannot anticipate the Appellants' claimed subject matter. *Id.*

The Examiner finds Wing provides two relevant disclosures. The Examiner finds Wing discloses a "rollback" operation to the "most recent viable rollback virtual machine." Ans. 23. .

The Examiner further finds Wing discloses running an antivirus product. *Id.* The Examiner finds Appellants disclose an "active" countermeasure is well-known in the art and is "one or more of a patch, an anti-virus patch, and an antivirus computer program product." Final Act. 17. Appellants do not file a Reply to the Examiner's Answer and are not persuasive that the Examiner has erred.

CLAIMS 4, 11, 16–19, 25, 28, AND 29: ANTICIPATION/OBVIOUS OVER WING.

Appellants advance substantially the same contentions as alleged above in favor of Claims 1–3, 5–10, 12–15, 20–24, 26, 27, and 30. *See* Br. 23–24. Appellants do not file a Reply to the Examiner's Answer and, as discussed above, we are not persuaded that the Examiner has erred.

Appellants next contend the Examiner fails to provide motivation to modify Wing. Br. 26. Appellants do not file a Reply to the Examiner's Answer and, as discussed above, we are not persuaded that the Examiner has erred in finding Wing, without modifications, meets the claimed limitations.

CLAIMS 1–30: OBVIOUSNESS OVER WING AND SOBEL

As discussed above, we agree with Appellants that Wing teaches rollback to a prior state, but does not disclose updating the virus protection

of the rollback machine. The Examiner finds Sobel provides a clear statement of the need to update the protection of system restoration images (rollback machines). Appellants do not file a Reply to the Examiner's Answer and, as discussed above, we are not persuaded that the Examiner has erred.

#### DECISION

The rejection of Claims 1–30 under 35 U.S.C. § 112(a, or pre-AIA 1<sup>st</sup> ¶) as lacking enablement is AFFIRMED.

The rejection of Claims 26–30 under 35 U.S.C. § 112(a, or pre-AIA 1<sup>st</sup> ¶) as failing the written description requirement is AFFIRMED.

The rejection of Claims 1–30 under 35 U.S.C. § 112(b, or pre-AIA 2<sup>nd</sup> ¶) as indefinite is AFFIRMED.

The rejection of Claims 1–30 under 35 U.S.C. § 101 is AFFIRMED.

The rejection of Claims 1–3, 5–10, 12–15, 20–24, 26, 27, and 30 under 35 U.S.C. § 102(b) is AFFIRMED.

The rejection of Claims 4, 11, 16–19, 25, 28, and 29 under 35 U.S.C. § 102(b), or in the alternative, under 35 U.S.C. § 103(a) is AFFIRMED.

The rejection of Claims 1–30 under 35 U.S.C. § 103(a) 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