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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BRIAN L. GILMAN and WILLIAM G. PAGAN

Appeal 2015-008236
Application 13/329,295
Technology Center 2100

Before MARC S. HOFF, JENNIFER L. McKEOWN, and
LINZY T. McCARTNEY, *Administrative Patent Judges*.

McKEOWN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's
decision to reject claims 1–12. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

Appellants' invention relates "to software application update distribution and more particularly to determining a frequency of distributing software updates to end user devices." Spec. ¶ 2.

Claim 1 is illustrative of the claimed invention and reads as follows:

1. A method for configurably recommending a software application update, the method comprising:
 - receiving an update for a software application along with a set of different ratings for the update;
 - comparing in memory of a computer the set of ratings with a pre-stored threshold; and,
 - prompting in the computer to apply the update to the software application responsive to the set of ratings meeting the pre-stored threshold.

THE REJECTIONS

The Examiner rejected claims 9–12 under 35 U.S.C. § 101 as being directed to a non-statutory subject matter. Final Act. 6–7.¹

The Examiner rejected claims 1, 4, 5, 8, 9, and 12 under 35 U.S.C. § 103(a) as unpatentable over Mahaffey et al. (US 2011/0047620 A1; Feb. 24, 2011) and Burke et al. (US 2010/0318986 A1; Dec. 16, 2010). Final Act. 7–13.

The Examiner rejected claims 2, 3, 6, 7, 10, and 11 under 35 U.S.C. § 103(a) as unpatentable over Mahaffey, Burke, and Sprosts et al. (US 2007/0220607 A1; Sept. 20, 2007). Final Act. 13–15.

¹ Throughout this decision, we also refer to (1) the Final Action mailed Nov. 28, 2014 ("Final Act."); (2) the Appeal Brief filed May 4, 2015 ("App. Br."); (3) the Examiner's Answer mailed June 16, 2015 ("Ans."); and (4) the Reply Brief filed Sept. 16, 2015 ("Reply Br.").

ANALYSIS

THE § 101 REJECTION

Claims 9–12

Based on the record before us, we are not persuaded that the Examiner erred in rejecting claims 9–12 as being directed to non-statutory subject matter. Specifically, the Examiner rejects claim 9 “as being directed to a non-statutory transitory signal.” Final Act. 3. According to Appellants, the Examiner erred because claim 9 recites “a computer readable storage medium *comprising a device* having computer readable program code embodied therewith” App. Br. 4–5 (emphasis added).

Appellants define device as “an object, machine, or piece of equipment that has been made for some special purpose.” App. Br. 5 (citing a Merriam Webster’s Dictionary definition). Appellants assert that the Specification “reinforces this notion by referring to a device as RAM, ROM, EEPROM or CD-ROM.” App. Br. 5. The Examiner, on the other hand, identifies that

[u]nder the broadest reasonable interpretation, a device includes at least: (1) “something devised or contrived for bringing about some end or result”; (2) “the result of contriving[”]; or (3) “something devised or framed by art or inventive power.” (See the attached definitions of “device” from the *Oxford English Dictionary* at items 6 and 7.

Final Act. 3.

We are not persuaded that the use of the term “device” precludes a transitory signal. Claim 9 recites a computer readable storage medium *comprising a device* and, as such, given the open-ended nature of *comprising*, the computer readable storage medium claim 9 would not be

limited to only a device. *See, e.g., Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501 (Fed. Cir. 1997).

We also note that the Specification refers to an *exemplary* computer readable storage medium as “a portable computer diskette, a hard disk, a random access memory (RAM), a read-only memory (ROM), an erasable programmable read-only memory (EPROM or Flash memory), an optical fiber, a portable compact disc read-only memory (CD-ROM), an optical storage device, [and] a magnetic storage device.” Spec. ¶ 21. The Specification does not limit computer readable storage medium to only these examples. The Specification further identifies “an electrical connection having one or more wires” as computer readable storage medium. Spec. ¶ 21. This language may at least suggest to a skilled artisan that the computer readable storage medium is the signal traveling through the electrical connection. As such, we find Appellants’ argument unpersuasive.

Accordingly, we sustain the Examiner’s rejection of claim 9, as well as dependent claims 10–12, as being directed to non-statutory subject matter.

THE OBVIOUSNESS REJECTION BASED ON MAHAFFEY AND BURKE

Claims 1, 4, 5, 8, 9, and 12

Based on the record before us, we are not persuaded that the Examiner erred in rejecting claims 1, 4, 5, 8, 9, and 12 as unpatentable over Mahaffey and Burke.

Appellants contend that the combination of Mahaffey and Burke fail to teach or suggest “prompting in a computer to apply an update to the application in response to a set of ratings which meet a pre-stored threshold.” App. Br. 6–10. Appellants, more specifically, argue that

“Mahaffey only taught ‘a determination of an assessment of privacy, security and battery rating’ in contrast to the claimed ‘ratings for [an] update [for a software application].’” App. Br. 8. Additionally, Appellants assert:

Lacking in [the cited paragraph of Mahaffey] is the claimed comparing of the set of ratings with a pre-stored threshold and prompts the end user to apply the update to the software application when to the ratings meet the pre-stored threshold. *Rather, in paragraph [0183] an assessment is compared to a threshold value and if the value is exceeded, the installation is blocked-or at least the end user is warned. But, in paragraph [0183] there is no comparison of any values in response to which an end user is prompted to perform the installation.*

App. Br. 9 (emphasis added); *see also* Reply Br. 7. Appellants recognize that Burke teaches prompting an end user to apply an update, but allege that the combination of Mahaffey and Burke lacks prompting to apply an update in response to the set of ratings meeting the pre-stored threshold.

App. Br. 10.

These arguments by Appellants fail to consider the combined teachings of Mahaffey and Burke and, thus, are unavailing. As the Examiner finds, Mahaffey teaches comparing the set of ratings with a pre-stored threshold and taking some action with respect to a software update in response to meeting the pre-stored threshold. *See* Ans. 5–6 (citing Mahaffey ¶¶ 183, 184 (explaining that Mahaffey describes comparing privacy, security, and battery ratings with policy thresholds to determine whether an application update installation is allowed)). Burke teaches prompting to apply an update in response to meeting a threshold. *See* Final Act. 8 (citing Burke ¶ 56 (explaining that Burke teaches the server allowing an update in response to a level of similarity meeting a threshold)); *see also* Ans. 7.

Considering these teachings together, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Mahaffey, which discloses comparing a set of ratings of an update to a threshold, by incorporating prompting to allow the update in response to meeting a threshold, as taught by Burke. Final Act. 8; *see also* Ans. 6. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). As such, we are not persuaded that the Examiner erred in finding that Mahaffey and Burke combined teach prompting in the computer to apply the update to the software application responsive to the set of ratings meeting the pre-stored threshold.

Appellants also argue that Mahaffey teaches away from combination with Burke. *See* Reply Br. 8–9 (arguing that issuing an alert to warn a user rather than blocking an application is exactly the opposite and thus teaches away from prompting the computer to apply the update in response to meeting the pre-stored threshold). This argument, however, was raised for the first time in the Reply Brief and is, therefore, waived as untimely. *Compare* Reply Br. 8–9 with App. Br. 6–10. *See also Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (informative) (“[T]he reply brief [is not] an opportunity to make arguments that could have been made in the principal brief on appeal to rebut the Examiner’s rejections, but were not.”).

Moreover, Mahaffey’s mere discussion of notifying or warning a user of undesirability of the application does not discourage the skilled artisan from alternatively prompting the user to apply the software application update when a threshold is met. *See DePuy Spine, Inc. v. Medtronic*

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Sofamor Danek, Inc., 567 F.3d 1314, 1327 (Fed. Cir. 2009) (“A reference does not teach away . . . if it merely expresses a general preference for an alternative invention[.]”); *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

Accordingly, we sustain the Examiner’s rejection of claims 1, 4, 5, 8, 9, and 12 as unpatentable over Mahaffey and Burke.

THE OBVIOUSNESS REJECTION BASED ON MAHAFFEY, BURKE AND SPROSTS

Claims 2, 3, 6, 7, 10, and 11

Appellants do not present separate arguments for dependent claims 2, 3, 6, 7, 10, and 11, but rather rely on the arguments presented for claims 1, 5, and 9. As discussed above, we find these arguments unpersuasive.

Accordingly, we sustain the Examiner’s rejection of claims 2, 3, 6, 7, 10, and 11 as unpatentable over Mahaffey, Burke, and Sprosts.

DECISION

We affirm the Examiner’s decision to reject claims 1–12.

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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED