UNITED STATES PATENT AND TRADEMARK OFFICE

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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 BILL ESSARY and STEPHEN H. TOUB

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Appeal 2016-002539
Application 13/716,887
Technology Center 2400

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Before JOHN A. JEFFERY, KAMRAN JIVANI, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants[1] appeal under 35 U.S.C. § 134(a) from the Examiner's
decision to reject claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).
We affirm.

STATEMENT OF THE CASE

Appellants' invention controls access to source code by enabling
access to encrypted source code according to configured access rights. *See*
generally Abstract. Claim 1 is illustrative:

> 1. A method in a server for managing access rights to computer
> program source code, comprising:

_____

[1] Appellants name Microsoft Corporation as the real party in interest. App.
Br. 1.

encrypting the source code;

configuring access rights to the encrypted source code;

hosting the encrypted source code at a network-accessible location;

receiving an access attempt for the encrypted source code by a digital rights management (DRM) enabled software development tool; and

enabling access to the encrypted source code by the DRM enabled software development tool according to the configured access rights.

THE REJECTIONS

The Examiner rejected claims 1, 4, 6–8, 11, 12, 14, 15, 18, and 20 under 35 U.S.C. § 102(b)[2] as anticipated by Ting (US 2006/0212714 A1; Sept. 21, 2006). Final Act. 9–12.[3]

The Examiner rejected claims 2, 9, and 16 under 35 U.S.C. § 103 as unpatentable over Ting and Seeman (US 2003/0200459 A1; Oct. 23, 2003). Final Act. 13–16.

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[2] Although the Examiner omits the particular subsection of pre-AIA § 102 on which the anticipation rejection is based, subsection (b) nonetheless applies here since the cited Ting reference published more than a year before Appellants' filing date. Therefore, we presume that the Examiner intended to reject the claims on this basis, and treat any error associated with this omission as harmless.

[3] Throughout this opinion, we refer to (1) the Final Rejection mailed Dec. 31, 2014 ("Final Act."); (2) the Appeal Brief filed June 11, 2015 ("App. Br."); (3) the Examiner's Answer mailed November 17, 2015 ("Ans."); and (4) the Reply Brief filed December 21, 2015 ("Reply Br."). Although the Reply Brief is not paginated (unlike the Appeal Brief), we nonetheless refer to the Reply Brief's pages in the order that they appear in the record.

The Examiner rejected claims 3, 10, and 17 under 35 U.S.C. § 103 as unpatentable over Ting and Nagpal (US 2011/0276805 A1; Nov. 10, 2011). Final Act. 16–18.

The Examiner rejected claims 5, 13, and 19 under 35 U.S.C. § 103 as unpatentable over Ting and Thomsen (2008/0270462 A1; Oct. 30, 2008). Final Act. 18–20.

THE ANTICIPATION REJECTION

The Examiner finds that Ting discloses every recited element of claim 1 including receiving an access attempt for encrypted source code by a digital rights management (DRM) enabled software development tool, namely Ting's application 40 and interceptor 60 collectively. Final Act. 9–10; Ans. 4–5.

Appellants argue that Ting does not teach a DRM enabled software development tool as claimed. App. Br. 7–9; Reply Br. 2–4. According to Appellants, Ting's applications and tools do not perform security functions, and Ting's supervisor and associated interceptor is not a software development tool. *Id.* Appellants add that the Examiner's interpreting independent claims 8 and 15 under pre-AIA 35 U.S.C. § 112, sixth paragraph is improper. App. Br. 11–12; Reply Br. 5–6.

ISSUES

Under § 102, has the Examiner erred in rejecting claims 1, 8, and 15 by (1) finding that Ting discloses a DRM enabled software development tool, and (2) interpreting certain limitations in claims 8 and 15 under § 112, sixth paragraph?

ANALYSIS

Claims 1, 4, 6, and 7

We begin by construing the key disputed limitation of claim 1 which recites, in pertinent part, a DRM enabled software development tool. The Specification does not define this term, unlike other terms whose concrete definitions leave no doubt as to their meaning. *See, e.g.,* Spec. ¶ 90 (defining, among other terms, "computer program medium" and "modulated data signal").

Appellants' Specification does, however, indicate that DRM is a class of access control technologies used by hardware manufacturers, publishers, copyright holders, and individuals to limit the use of digital content and devices after sale. Spec. ¶ 3. Notably, DRM enabled software development tools can decrypt and interact with source code, as enabled by the particular access rights assigned to the code. Spec. ¶¶ 5, 26–27.

To this end, the Specification describes an *exemplary* embodiment in Figure 1 where computing devices 102a and 102b communicate with server 104 containing encrypted source code 118. *See* Spec. ¶¶ 28–31. Notably, both computing devices include respective software development tools 108a and 108b, that each include respective DRM modules 112a and 112b that enable the tools to interact with the encrypted source code according to access rights information. *See* Spec. ¶¶ 31–32.

Our emphasis underscores that this embodiment is merely exemplary, for the Specification is replete with exemplary and non-limiting language in this regard. *See, e.g.,* Spec. ¶¶ 20–22, 28, 34, 39. Nevertheless, this description informs our understanding of the recited DRM enabled software development tool, at least with respect to an exemplary implementation.

Figure 3 of the present application shows a software development environment 300 including a DRM module 302 and plural software development tools, including code editor 304, static analysis tool 310, compiler 306, profiler 312, debugger 308, and deployment tool 314. Spec. ¶ 40. Although this embodiment uses a *single* DRM module to provide DRM functionality for *multiple* software development tools, one or more of these software development tools may include its own DRM module in another embodiment. Spec. ¶ 80.

Therefore, a software development tool can be DRM-enabled not only by including its own DRM module as in Figure 1 of the present application, but also via DRM functionality provided by an external module, such as the DRM module 302 that services multiple software development tools 304– 314 in Figure 3. *Accord* Ans. 5 (noting this latter alternative).

In light of these alternatives, we see no error in the Examiner's reliance on Ting's application 42 *and* the supervisor's interceptor module 60 for teaching the recited DRM enabled software development tool. Ans. 5. Not only is this software application a *development tool* as noted in Ting's paragraph 26, it is effectively *DRM-enabled* via the functionality provided by the supervisor's interceptor module—functionality that protects source code by enforcing associated access rights as the Examiner indicates. *See* Ans. 4–5; *see also* Ting ¶¶ 26, 30, 32.

Although Ting's application 42 *itself* is not DRM-enabled as Appellant indicates (App. Br. 7–9; Reply Br. 3–4), it is nevertheless DRM-enabled via its interaction with the supervisor's interceptor module as noted previously. On this record, then, we see no error in the Examiner's finding that the application and interceptor *together* constitute a DRM enabled

software development tool. Ans. 5. This interpretation reasonably comports with the embodiment in Figure 3 of the present application that uses an external DRM module to provide DRM functionality for multiple software development tools—functionality that effectively renders those tools DRM-enabled. Appellants' arguments are, therefore, unavailing and not commensurate with the scope of the claim.

Therefore, we are not persuaded that the Examiner erred in rejecting claim 1, and claims 4, 6, and 7 not argued separately with particularity.

Claims 8, 11, 12, 14, 15, 18, and 20

We also sustain the Examiner's rejection of independent claims 8 and 15 reciting limitations commensurate with those in independent claim 1. Final Act. 10–12. As noted previously, we see no error in the Examiner's finding that Ting's application and interceptor *together* constitute a DRM enabled software development tool. Ans. 5.

Nor are we persuaded that the Examiner's interpreting independent claims 8 and 15 under pre-AIA 35 U.S.C. § 112, sixth paragraph is improper despite Appellants' contentions to the contrary. App. Br. 11–12; Reply Br. 5–6.

First, Appellants' arguments in the Briefs improperly incorporate arguments made during prosecution. *See* MANUAL OF PATENT EXAMINING PROCEDURE (MPEP) § 1205.02 (9th ed. Rev. 08.2017, Jan. 2018) ("It is essential that the Board be provided with a brief fully stating the position of the appellant with respect to each ground of rejection presented for review in the appeal so that no search of the Record is required in order to determine

that position. Thus, the brief should not incorporate or reference previous responses.").

Nevertheless, even if Appellants' arguments were properly presented (which they are not), we still find them unpersuasive. Claim 8 recites, in pertinent part, a source code access manager comprising an encryption module configured to encrypt the source code. But apart from reciting that this element is *configured to* perform this function, the claim recites no particular structure to achieve that end apart from the access manager's implementation in a server.

Although omitting the term "means" in a claim element creates a rebuttable presumption that § 112, sixth paragraph does not apply, such an omission does not automatically prevent that element from being construed as a means-plus-function element. *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1348 (Fed. Cir. 2015) (en banc). In such a case, § 112, sixth paragraph will apply if the claim term fails to recite sufficiently definite structure, or else recites function without reciting sufficient structure for performing that function. *Id.* at 1349.

That is the case here. First, the term "module" is merely a generic description for software or hardware that performs the specified functions. That is, this term is merely a nonce word or "non-structural generic placeholder" that is tantamount to the term "means" because it fails to connote sufficiently definite structure and, in the context of claim 8, invokes § 112, sixth paragraph. *Cf. id.* at 1350 (discussing similar nonce words). That MPEP § 2181(I)(A) includes *"module for"* as one of several exemplary non-structural generic placeholders only bolsters this conclusion. Although the claim 8's "module" is modified by the word "encryption," this modifier

does not add sufficient structure to the recited element to preclude § 112, sixth paragraph construction, for it merely identifies the element's recited function. *Cf. Ex parte Lakkala*, No. 2011-001526 (PTAB Mar. 13, 2013) (expanded panel) (informative); *Ex parte Erol*, No. 2011-001143 (PTAB Mar. 13, 2013) (expanded panel) (informative); *Ex parte Smith*, No. 2012-007631 (PTAB Mar. 14, 2013) (expanded panel) (informative)).[4]

We reach a similar conclusion regarding the three recited modules in independent claim 15. Here again, these terms are merely nonce words or "non-structural generic placeholders" that are tantamount to the term "means" because they fail to connote sufficiently definite structure. Nor do their respective modifying terms add sufficient structure to the recited elements to preclude § 112, sixth paragraph construction, for they merely identify the elements' recited functions.

Therefore, we are not persuaded that the Examiner erred in rejecting independent claims 8 and 15 and claims 11, 12, 14, 18, and 20 not argued separately with particularity.

THE OBVIOUSNESS REJECTIONS

We also sustain the Examiner's obviousness rejections of claims 2, 3, 5, 9, 10, 13, 16, 17, and 19. Final Act. 13–20. Despite nominally arguing these claims separately, Appellants reiterate similar arguments made in connection with claims 1, 8, and 15, and allege that the additional cited

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[4] These three informative Opinions are available from the Board's web page entitled "Key Decisions Involving Functional Claiming" at http://www.uspto.gov/patents-application-process/appealing-patent-decisions/decisions-and-opinions/key-decisions

references fail to cure those purported deficiencies. *See* App. Br. 10–11; Reply Br. 4–5. We are not persuaded by these arguments for the reasons previously discussed.

CONCLUSION

The Examiner did not err in rejecting (1) claims 1, 4, 6–8, 11, 12, 14, 15, 18, and 20 under § 102, and (2) claims 2, 3, 5, 9, 10, 13, 16, 17, and 19 under § 103.

DECISION

We affirm the Examiner's decision to reject claims 1–20.

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