UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
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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 BORIS ASIPOV[1]

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Appeal 2018-001084
Application 14/935,400
Technology Center 2400

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Before MICHAEL J. STRAUSS, MICHAEL M. BARRY, and
DAVID J. CUTITTA II, *Administrative Patent Judges.*

CUTITTA, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Final Rejection of claims 1–20, all the pending claims in the present application. *See* Appeal Br. 5. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

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[1] Appellant names Microsoft Technology Licensing, LLC and Microsoft Corporation, as the real parties in interest. *See* Appeal Br. 2.

STATEMENT OF THE CASE

Invention

Appellant indicates the invention relates to "using a flash storage device to prevent unauthorized use of software." Spec. ¶ 5.[2]

Exemplary Claims

Claims 1, 11, and 16 are independent claims. Claims 1, 2, and 9 are exemplary and are reproduced below with limitations at issue in italics:

> 1.   A machine-implemented method of employing a flash storage device in selectively controlling use of software, the machine-implemented method comprising:
>
> accessing license information encoded in the flash storage device, *wherein writeability or non-writeability of respective sectors of a plurality of sectors of the flash storage device, as determined through at least one attempted or actual write operation, corresponds to values of a plurality of data bits of at least a portion of the license information*; and
>
> selectively controlling the use of the software based at least in part on the accessed license information.
>
> 2.   The machine-implemented method of claim 1, wherein accessing the license information includes:
>
> *reading the portion of the license information from the flash storage device by performing at least one write operation to each of multiple sectors of the plurality of sectors.*

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[2] This Decision refers to: (1) Appellant's Specification ("Spec.") filed November 7, 2015; (2) the Final Office Action ("Final Act.") mailed August 26, 2016; (3) the Appeal Brief ("Appeal Br.") filed April 25, 2017; (4) the Examiner's Answer ("Ans.") mailed September 11, 2017; (5) the Examiner's Supplemental Answer ("Supp. Ans.") mailed September 13, 2017; and (6) the Reply Brief ("Reply Br.") filed November 10, 2017.

> 9. The machine-implemented method of claim 1,
> *wherein a writeable sector of the plurality of sectors represents*
> *a value of "one" for a particular data bit of the plurality of*
> *data bits and a non-writeable sector of the plurality of sectors*
> *represents a value of "zero" for another data bit of the*
> *plurality of data bits.*

Appeal Br. 18, 20.

REFERENCES

The Examiner relies upon the following prior art in rejecting the claims on appeal:

Bisbee et al. ("Bisbee")	US 6,367,013 B1	Apr. 02, 2002
DeMello et al. ("DeMello")	US 2005/0108556 A1	May 19, 2005
Lee et al. ("Lee")	US 2005/0193161 A1	Sept. 01, 2005
Oh et al. ("Oh")	US 2006/0059194 A1	Mar. 16, 2006
Den Hollander et al. ("Den Hollander")	US 2008/0304389 A1	Dec. 11, 2008
Tomoji et al. ("Tomoji")	JP 06-348535	Dec. 22, 1994

O. Shalitin, *Security Made Solid with Non-Volatile NOVeA®*,
http://docshare02.docshare.tips/files/6226/62267088.pdf
("Shalitin").

REJECTIONS[3]

Claims 1, 3, 6–10, 13, and 16–17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Shalitin, Den Hollander, Oh, Lee, and Appellant's Admitted Prior Art ("AAPA"). Final Act. 9–18.

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[3] The Final Office Action incorrectly indicates that claim 4 is objected to but not rejected. *See* Final Act. 1. Claim 4, however, although not rejected under 35 U.S.C. § 103(a), is rejected on the ground of obviousness-type double patenting. *See* Final Act. 4.

Claims 2, 11, 12, 15, and 18–20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Shalitin, Den Hollander, Oh, Lee, AAPA, Bisbee, and Tomoji. Final Act. 18–23.

Claims 5 and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Shalitin, Den Hollander, Oh, Lee, AAPA, and DeMello. Final Act. 23–21.

Claims 1–20 are rejected on the ground of obviousness-type double patenting over claim 1 of U.S. Patent 8,452,967 B2 and over claim 1 of U.S. Patent 9,213,846 B2. Final Act. 4–8.

Our review in this appeal is limited only to the above rejections and the issues raised by Appellant. Arguments not made are waived. *See* Manual of Patent Examining Procedures (MPEP) § 1205.02; 37 C.F.R. §§ 41.37(c)(1)(iv), 41.39(a)(1).

ANALYSIS

Rejection under § 103(a) of Claim 1

Issue 1: Does the Examiner err in finding the cited combination of references teaches or suggests

> wherein writeability or non-writeability of respective sectors of a plurality of sectors of the flash storage device, as determined through at least one attempted or actual write operation, corresponds to values of a plurality of data bits of at least a portion of the license information,

as recited in claim 1?

The Examiner relies on the combination of Den Hollander, Lee, and AAPA to teach or suggest the limitation at issue. *See* Ans. 3; Final Act. 10–12.

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Appellant disputes the Examiner's factual findings. Appellant argues Den Hollander does not teach writeability of respective sectors because "it is not particularly relevant to . . . Den Hollander . . . where the encoded data is stored. Rather, such data may be stored in 'sectors[,]' but . . . Den Hollander . . . [does not] discuss the particular sectors that may be used." Appeal Br. 9; *see* Reply Br. 2–3.

We are unpersuaded of Examiner error because Appellant's argument that Den Hollander does not teach writeability of respective sectors is not responsive to the Examiner's factual findings, which rely on the combined teachings of Den Hollander, Lee, and AAPA. *See* Ans. 3; Final Act. 10–12. The Examiner finds, and we agree, that AAPA and Lee, in combination with Den Hollander, teaches or suggests writeability of sectors. *Id.* In particular, the Examiner relies on AAPA and Lee for teaching or suggesting the argued writeability or non-writeability and Hollander for teaching sectors such that the combination of the references teaches or suggests the disputed limitation, not Hollander standing alone. *Id.*

Appellant next argues "the applied art simply do not disclose, teach, or suggest any technology for testing or otherwise determining '*writeability or non-writeability*' of any sector '*through at least one attempted or actual write operation*[.]'" Appeal Br. 9 (brackets in original).

The Examiner responds by finding that AAPA teaches this limitation because AAPA teaches that a sector becomes unusable after approximately one million writes and "it is determined the sector is writeable for every attempt up to the approximately one millionth write where it is determined the sector is no longer usable/writeable." Ans. 4. The Examiner notes " it is at least implicitly determined the sector is writeable for every attempt up to

the approximately one millionth write where it is at least implicitly determined the sector is no longer usable/writeable." Supp. Ans. 4.

Appellant responds that "the Supplemental Answer did not provide the [necessary] 'articulated reasoning'" because "the examiner did not point to any specific portion of any reference for the claimed the determination or determining referred to [in] the 'determined' portion of this claim recitation." Reply Br. 4.

We are unpersuaded of Examiner error because Appellant fails to specifically address the Examiner's finding that AAPA implicitly determines the sector is writeable or unwriteable as it transitions from "the approximately one millionth write" to the following write "where it is at least implicitly determined the sector is no longer usable/writeable." Supp. Ans. 4. "The question under [35 U.S.C. § 103(a)] is not merely what the references expressly teach but what they would have **suggested** to one of ordinary skill in the art at the time the invention was made." *Merck & Co. v. Biocraft Laboratories, Inc.*, 874 F.2d 804, 807 (Fed. Cir. 1989) (emphasis added) (quoting *In re Lamberti*, 545 F.2d 747, 750 (Fed. Cir. 1976); *see also* MPEP § 2123. We agree with the Examiner's finding that AAPA's discussion of a writeability threshold of one million writes teaches, or at least suggests, determining writeability or non-writeability of respective sectors through at least one attempted or actual write operation, as recited in claim 1. *See* Spec. ¶ 13.

For the reasons discussed, we sustain the Examiner's 35 U.S.C. § 103(a) rejection of claim 1. We also sustain, for similar reasons, the Examiner's § 103(a) rejection of independent claims 11 and 16, which are only argued nominally separately from claim 1. *See* Appeal Br. 14–15.

Dependent claims 3, 5–8, 10, 12–15, and 17–20, which either are not argued separately or are only argued nominally, fall with their respective independent claims. *See* Appeal Br. 12–16.

Rejection under § 103(a) of Claim 2

Issue 2: Does the Examiner err in finding the combination of Shalitin, Den Hollander, Oh, Lee, AAPA, Bisbee, and Tomoji teaches or suggests "reading the portion of the license information from the flash storage device by performing at least one write operation to each of multiple sectors of the plurality of sectors," as recited in claim 2?

The Examiner relies primarily on the combination of Den Hollander, Bisbee, and Tomoji to teach the limitation at issue. Final Act. 29–30. In interpreting claim 2, the Examiner concludes that the claimed write operation is "considered extra-solution activity" because the claim does not specify "any details regarding the write operation." *See* Final Act. 18–19. On that basis, the Examiner indicates the extra-solution portion need not be given patentable weight in the interpretation of claim 2. *Id.*

Appellant argues that the Examiner does not provide support for the conclusion that the omitted recitation is "'extra-solution activity' [and] would be *per se* obvious" and asserts the Examiner must consider all words in the claim. Appeal Br. 11 (citing MPEP § 2143.03).

We find Appellant's argument persuasive. Extra-solution or post-solution activity is generally discussed in the context of determining patentable subject matter under 35 U.S.C. § 101. *See Bilski v. Kappos*, 561 U.S. 593, 610–11 (2010). We are aware of no legal basis premised on post-

solution activity, for ignoring specific limitations when interpreting the claim to determine obviousness under 35 U.S.C. § 103(a).

Accordingly, on this record we do not sustain the Examiner's 35 U.S.C. § 103(a) rejection of claim 2.

Rejection under § 103(a) of Claim 9

Issue 3: Does the Examiner err in finding the combination of Shalitin, Den Hollander, Oh, Lee, and AAPA teaches or suggests "wherein a writeable sector of the plurality of sectors represents a value of 'one' for a particular data bit of the plurality of data bits and a non-writeable sector of the plurality of sectors represents a value of 'zero' for another data bit of the plurality of data bits," as recited in claim 9?

The Examiner finds Den Hollander teaches the limitation at issue. Specifically, the Examiner relies on Den Hollander's discussion of a recorded pattern consisting "of a sequence of first areas 13, interleaved by second areas 14" wherein "[t]he first areas 13 and the second areas 14 are present along a recording track 15, and correspond respectively to the logical values 1 and 0, or vice-versa." Final Act. 17 (citing Den Hollander ¶ 51).

Appellant argues "Den Hollander's paragraph [0051] does not refer to a 'sector[,]' much less a 'writeable'' or 'non-writeable' or sectors, but instead "refers to 'areas' . . ., [which] are not sectors." Appeal Br. 13.

The Examiner, in turn, revises the rejection to rely on the combination of Den Hollander, AAPA, and Lee to teach the disputed limitation and specifically finds that AAPA and Lee teach a writeable sector. Ans. 5–6. In response, Appellant argues "the Examiner has not addressed the fact that

'areas of the recording track' [in Den Hollander] are not . . . sectors."
Reply 6–7.

We are unpersuaded of Examiner error because Appellant's argument distinguishing Den Hollander is not responsive to the Examiner's factual findings, which rely on the combined teachings of Den Hollander AAPA, and Lee. *See* Ans. 5–6.

We, therefore, sustain the Examiner's 35 U.S.C. § 103(a) rejection of claim 9. Appellant only nominally argues claim 10 separately, noting that "[t]he rejection of claim 10 appears to mirror the rejection of claim 9 except for the different logical values for 'writeable' or 'non-writeable' sectors." Appeal Br. 14. We, therefore, sustain the rejection of claim 10 for reasons similar to those provided for claim 9.

Non-Statutory Double Patenting Rejection

Appellant does not challenge the Examiner's non-statutory double-patenting rejection. Rather, Appellant requests "that the double patenting rejections be held in abeyance until the Office is otherwise ready to allow this application." Appeal Br. 6. The Examiner, however, dispels any suggestion that the double-patenting rejection is not an issue for consideration by asserting that "[e]very ground of rejection set forth in the Final Rejection Office action dated November 02, 2016 from which the appeal is taken is being maintained." Ans. 3. Despite being on notice that the double-patenting rejection is not being held in abeyance, Appellant does not challenge the rejection in the Reply Brief. Nor has Appellant filed a terminal disclaimer as of November 1, 2018.

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Because Appellant presents no arguments pertaining to this pending obviousness double patenting rejection (see generally Appeal Br.), we summarily sustain this rejection. See MPEP § 1205.02 ("If a ground of rejection stated by the examiner is not addressed in the appellant's brief, that ground of rejection will be summarily sustained by the Board.").

Accordingly, we summarily sustain the Examiner's non-statutory double-patenting rejection of claims 1–20.

DECISION

We affirm the Examiner's decision to reject claims 1, 3, and 5–20 under 35 U.S.C. § 103(a).

We reverse the Examiner's decision to reject claim 2 under 35 U.S.C. § 103(a).

We affirm the Examiner's decision to reject claims 1–20 on the ground of obviousness-type double patenting.

Because we affirm at least one ground of rejection with respect to each claim on appeal, we affirm the Examiner's decision rejecting claims 1–20. *See* 37 C.F.R. § 41.50(a)(1).

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