UNITED STATES PATENT AND TRADEMARK OFFICE

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13/586,242	08/15/2012	Vijay K. Aggarwal	YOR920110612US1	2617

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PTOL-90A (Rev. 04/07)

UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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Ex parte VIJAY K. AGGARWAL, LORRAINE M. HERGER,
MATTHEW A. McCARTHY, and CLOFFORD A. PICKOVER[1]
_____

Appeal 2018-008891
Application 13/586,242
Technology Center 3600
_____

Before ROBERT E. NAPPI, MARC S. HOFF, and SCOTT B. HOWARD,
Administrative Patent Judges.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the Final

Rejection of claims 1, 3 through 12, 19 and 21 through 24. We have

jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM–IN-PART.

INVENTION

The invention is directed to a system to obtain software licenses by

predicting software license needs. Abstract and Paragraph 1 of Appellant's

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[1] We use the word Appellant to refer to "applicant" as defined in 37 C.F.R.
§ 1.42(a). Appellant identifies the real party in interest as International
Business Machines Corporation. App. Br. 3.

Specification. Claim 1 is illustrative of the invention and is reproduced below:

> 1.   A method comprising:
>
>   providing, by a software monitor computer server to each of multiple computerized devices, a software application, wherein a number of licenses limit simultaneous use of said software application by said computerized devices to said number of licenses, said number of licenses being less than a total number of said computerized devices, and said software monitor computer server having access to said multiple computerized devices over a computer network;
>
>   tracking, by said software monitor computer server, usage by said computerized devices of said software application;
>
>   based on said tracking, developing, by said software monitor computer server, historical use patterns of said software application by said computerized devices;
>
>   receiving, by said software monitor computer server, calendar input from electronic calendars on said computerized devices;
>
>   analyzing, by said software monitor computer server, said calendar input;
>
>   based on said analyzing, identifying, by said software monitor computer server, future calendared uses and non-uses of said software application, said identifying future calendared uses and non-uses is based on appointments in said electronic calendars that indicate that said software application will be required or will not be required, said identifying future calendared uses and non-uses comprises one of: identifying an activity description in said electronic calendars; and identifying the type of file that is used for a calendar activity;
>
>   collecting, by said software monitor computer server, network speed data;

calculating, by said software monitor computer server, historical network speed patterns by analyzing said network speed data collected;

generating, by said software monitor computer server, a predicted speed of network connection at a time of said future calendared uses and non-uses of said software application by analyzing said historical network speed patterns;

adjusting, by said software monitor computer server, time slots of said future calendared uses and non-uses of said software application based on said predicted speed of network connection at a time of said future calendared uses and non-uses of said software application, to produce adjusted future calendared uses and non-uses of said software application;

predicting, by said software monitor computer server, future license grant needs of said computerized device for said software application, said predicting future license grant needs is based on said historical use patterns and said adjusted future calendared uses and non-uses of said software application; and

performing, by said software monitor computer server, one of the following:

obtaining additional simultaneous use software application licenses for additional ones of said computerized devices based on said historical use patterns and said future calendared uses and non-uses indicating that said future license grant needs exceed said number of licenses; and

returning some of said licenses, based on said historical use patterns and said future calendared uses and non-uses indicating that said number of licenses exceed said future license grant needs.

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REJECTIONS AT ISSUE

The Examiner has rejected claims 7 through 12 under 35 U.S.C. §
112, first paragraph, as failing to comply with the written description
requirement. Final Act. 5–10.[2]

The Examiner has rejected claims 1, 3 through 6, 19 and 21 through
24 under 35 U.S.C. § 112, second paragraph, as being indefinite. Final Act.
10–13.

The Examiner has rejected claims 1, 3 through 5, and 19 through 23
under 35 U.S.C. § 103(a) as being unpatentable over Lenard (US
2004/0010440 A1, published Jan. 15, 2004), Varadarajan (US 2004/0260589
A1, published Dec. 23, 2004), Doss (US 2004/0064585 A1, published Apr.
1, 2004), and Gotesdyner (US 2012/0192016 A1, published July 26, 2012).
Final Act. 13–22.

The Examiner has rejected claims 6, and 24 under 35 U.S.C. § 103(a)
as being unpatentable over Lenard, Varadarajan, Doss, Gotesdyner, and
Read (US 2005/0049973 A1, published Mar. 3, 2005). Final Act. 22–24.

The Examiner has rejected claims 7 and 9 through 11 under 35 U.S.C.
§ 103(a) as being unpatentable over Lenard, Varadarajan, Doss, Gotesdyner,
and Anderson (US 2005/0028153 A1, published Feb. 3, 2005). Final Act.
24–34.

The Examiner has rejected claim 8 under 35 U.S.C. § 103(a) as being
unpatentable over Lenard, Varadarajan, Doss, Gotesdyner, and Weiss (US
2009/0024712 A1, Jan. 22, 2009). Final Act. 34–35.

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[2] Throughout this Opinion, we refer to the Appeal Brief, filed April 9, 2018
("App. Br."), the Reply Brief, Filed September 19, 2018 (Reply Br.); the
Examiner's Answer, mailed July 26, 2018 ("Answer"), and the Final Office
Action, mailed November 16, 2017 ("Final Act.").

The Examiner has rejected claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Lenard, Varadarajan, Doss, Gotesdyner, and Weiss . Final Act. 35–36.

ANALYSIS

We have reviewed Appellant's arguments in the Briefs, the Examiner's rejections, and the Examiner's response to Appellant's arguments. Appellant's arguments have not persuaded us of error in the Examiner's rejections of claims 7 through 12 under 35 U.S.C. § 112, first paragraph, but have persuaded us of error in the Examiner's rejection of claims 1, 3 through 6, 19 and 21 through 24 under 35 U.S.C. § 112, second paragraph, and claims 1, 3 through 12, 19 and 21 through 24 under 35 U.S.C. § 103.

Rejection under 35 U.S.C. § 112, first paragraph

Appellants argue that the written description rejection of independent claim 7, and depend claims 8 through 12, is in error as paragraph 4 of Appellant's Specification provides support for the claim limitation directed to substituting a software application. App. Br. 23; Reply Br. 10–11.

The Examiner provides a detailed explanation of the rejection on pages 6 through 10 of the Final Action, citing paragraphs 18, 19, 20, 23, 26, 27, 35, 36, and 37 of Appellant's Specification. The Examiner finds that the Specification discusses providing software that can be used as a substitute and thus reduces or eliminates additional licenses. The Examiner finds that the Specification does not teach the claim 7 limitation of "substituting said substitute software application in place of said software application" which

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the Examiner interprets as replacing the software application in the user device. Final Act. 9; Answer 46.

We concur with the Examiner's claim interpretation and finding that the Appellant's originally filed Specification demonstrates possession of the claimed invention. The written description requirement serves "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him; how the specification accomplishes this is not material." *In re Wertheim*, 541 F.2d 257, 262 (CCPA 1976). Claim 7 recites "providing … a software application" and "determining … whether a substitute software application is acceptable" and, based upon this determination, "updating … by substituting said software application in place of said software application." Thus, we consider the Examiner's interpretation of the claim as reciting replacing (substituting in place of) the software application with another software application (substitute application) in the user device to be reasonable. Paragraph 4 of Appellant's Specification, cited by Appellant, does not teach this; rather, this paragraph merely states that a substitute application may be provided to users if insufficient licenses are available, not that the software is substituted in place of (replaces) the software if sufficient licenses are available. Accordingly, we are not persuaded of error, and sustain the Examiner's rejection of 7 through 12 under 35 U.S.C. § 112 first paragraph as failing to comply with the written description requirement.

Rejection under 35 U.S.C. § 112 second paragraph

The Examiner rejects claims 1 and 19 as they recite obtaining or returning additional licenses "based on said historical use patterns and said

future calendared uses and non-uses indicating that said future license grant

needs exceed said number of licenses." Final Act 10–12. The Examiner

considers that the claim language is unclear as to whether the term indicating

refers to both the historical and the future calendared uses and non-uses.

Final Act. 10–11, Answer 47. Further, the Examiner rejects claim 7 as

missing an essential step of the user reply and acceptance to the server's

request of use a substitute software application. Final Act. 12–13; Answer

48.

> Appellant argues that claims 1 and 19 are definite stating:

>> Standard English grammar provides that the foregoing
>> means that an action is performed based on: 1) historical
>> use patterns, and 2) future calendared uses, and 3) non-
>> uses indicating that future license grant needs exceed the
>> number of licenses. The fact that the word "indicating"
>> is not repeated prior to each "and" conjunction in such a
>> phrase does not change the clear meaning that all the
>> terms preceding "and" indicate that the needs exceed the
>> number, as other interpretations are illogical. When one
>> interpretation of language is logical, and another is
>> illogical, the logical interpretation prevails as the
>> intention of the author.

App. Br. 24. Further, with respect to claim 7, Appellant argues that the

claim recites:

>> the alleged missing features are included within the claim
>> language "determining, by said software monitor
>> computer server, whether a substitute software
>> application is acceptable" and "based on said substitute
>> software application being acceptable." Thus, the claims
>> determine whether the substitute software is acceptable,
>> and perform actions if it is acceptable.

App. Br. 24

We have reviewed claims 1, 7, and 19 and concur with Appellant's arguments. It is clear from claims 1 and 19 that the "indicating", in the limitations of obtaining or returning licenses limitation, is referring to all the uses (future and calendared) and the non-uses. Thus, we do not consider claims 1 and 19 to be indefinite as identified by the Examiner. Further, we disagree with the Examiner that the claim recites an essential step. As identified by Appellant, claim 7 recites "determining, by said software monitor computer server, whether a substitute software application is acceptable," the Examiner has not shown, nor do we find that the Specification identifies that it is essential that this determination is made based upon a user reply, how the determination is made is merely a question of claim scope. Thus, the claim is not indefinite based on the reason identified by the Examiner. As we disagree with the Examiner that claims 1, 7 and 9 are indefinite, we do not sustain the Examiner's rejection of claims 1, 3 through 6, 19 and 21 through 24 under 35 U.S.C. § 112 second paragraph.

Rejection under 35 U.S.C. § 103

Appellant argues that the combination of Lenard, Varadarajan, Doss, and Gotesdyner do not teach that time slots of the future calendared uses and non-uses of software, which are used to predict software license needs, are adjusted based on the predicted speed of the network connection at the time of the future calendared uses and non-uses as recited in independent claims 1 and 19. App. Br. 12–19.

The Examiner responds to Appellant's arguments by finding that Lenard teaches predicting future software license needs based upon usage and finding that Varadarajan teaches predicting software license needs based upon future calendared events. Answer 36 through 37. Further, the Examiner finds that Doss teaches predicting a user's calendar based upon external data and that Gotesdyner teaches future events that may occur on a network are predicted based upon network speeds. Answer 39, 41 (citing paragraphs 7 and 85 of Gotesdyner). Based upon these findings, the Examiner concludes the skilled artisan would combine the teachings to arrive at the disputed limitation.

We disagree with the Examiner's conclusion of obviousness. Leonard and Varadarajan are both concerned with predicting software license needs. *See* abstracts of Leonard and Varadarajan. We concur with the Examiner that Varadarajan teaches the prediction is based upon scheduled use of the software and that the system interfaces with other project planning software, and thus it seems reasonable that the skilled artisan would look to teachings of adjusting a user's calendar such as taught by Doss, to provide input to predicting software usage. Answer 37 (citing Varadarajan para 40). However, we have reviewed the cited teachings of Gotesdyner and we do not agree that the skilled artisan would combine the Gotesdyner's teachings of predicting network failure to adjust calendar entries used to predict software license usage, as the Examiner concludes. The Examiner has not cited to a teaching in either Gotesdyner or Doss that discusses adjusting calendar entries based upon predicted network speed as claimed, let alone using such adjustment in predicting software license needs as claimed. Accordingly, we do not sustain the Examiner's rejection of independent

claims 1, 19 and dependent claims 3 through 5 and 20 through 23 similarly rejected.

Appellant argues independent claim 7 recites a similar limitation directed to adjusting calendar slots of uses and non-uses of software based upon network speed and the rejection is in error for same reasons as discussed above. App Br. 20.

The Examiner's rejection of independent claim 7 similarly relies upon the combination of Lenard, Varadarajan, Doss, and Gotesdyner to teach this disputed limitation and relies upon the additional teachings of Anderson to teach the limitation directed to substitute software. Final Act. 24–32, Answer 44–45.

As discussed above, with respect to claim 1, we disagree with the Examiner's conclusion that the combination of Lenard, Varadarajan, Doss, and Gotesdyner teaches time slots of the future calendared uses and non-uses of software, which are used to predict software license needs, are adjusted based on the predicted speed of the network connection at the time of the future calendared uses and non-uses. The Examiner has not shown that the additional disclosure of Anderson teaches this limitation. Therefore, we similarly do not sustain the Examiner's rejection of independent claim 7 and claims 9 through 11 similarly rejected.

The Examiner's rejections of dependent claims 6, 8, 12, and 24 rely on the disclosures of Lenard, Varadarajan, Doss, and Gotesdyner to teach the disputed limitations of independent claims 1, 7, and 19. Accordingly, we do not sustain the Examiner's rejections of these claims, for the same reasons as discussed above with respect to claim 1.

CONCLUSION

The Examiner's decision rejecting claims 1, 3 through 12, 19 and 21

through 24 is affirmed–in–part.

Claims Rejected	35 U.S.C §	Reference(s)/Basis	Affirmed	Reversed
7–12	112, 1st Para.	Written Description	7–12	
1, 3–6, 9 and 21–24	112, 2nd Para	Indefiniteness		1, 3–6, 9 and 21–24
1, 3 – 5, and 19 – 23	103(a)	Lenard, Varadarajan, Doss, and Gotesdyner		1, 3 – 5, and 19 – 23
6 and 24	103(a)	Lenard, Varadarajan, Doss, Gotesdyner and Read		6 and 24
7 and 9–11	103(a)	Lenard, Varadarajan, Doss, Gotesdyner and Anderson		7 and 9–11
8	103(a)	Lenard, Varadarajan, Doss, and Gotesdyner and Weiss		8
12	103(a)	Lenard, Varadarajan, Doss, and Gotesdyner, Anderson and Read		12
Outcome			7–12	1, 3–6, 9 and 21–24

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-IN-PART