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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte VLADYSLAV KULCHYTSKYY

Appeal 2019-002464
Application 15/096,497
Technology Center 2600

Before LINZY T. McCARTNEY, JAMES W. DEJMEK, and MICHAEL T. CYGAN, *Administrative Patent Judges*.

CYGAN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant[1] appeals from the Examiner's decision to reject claims 1–8 and 10–15. Appeal Br. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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[1] We use the word "Appellant" to refer to "applicant" as defined in 37 C.F.R. § 1.42 (2018). Appellant identifies the real party in interest as SugarCRM, Inc. Appeal Br. 2.

CLAIMED SUBJECT MATTER

The claimed invention relates to a biometric state switching method. Appeal Br 1. Independent claim 1 is illustrative, with the limitations at issue italicized for emphasis:

> 1. A biometric state switching method comprising:
>
> storing in a database a multiplicity of different states of an application and a multiplicity of different fingerprints, each in connection with a different state of a corresponding application;
>
> authenticating an end user into use of a computing device by receiving in a fingerprint scanner affixed to the computing device a scanned fingerprint, matching the scanned fingerprint to one of the different fingerprints in the database, and if the scanned finger print matches one of the different fingerprints in the database, authenticating the end user into user of the computing device; and,
>
> subsequent to authentication, *executing an application* in memory of the computing device, identifying a state for the application stored in connection with the one of the different fingerprints matched to the scanned fingerprint, and *setting a state of execution of the application to the identified state*.

Independent claims 6 and 11 recite, respectively, a system and a computer program product having the above-italicized limitations. Appeal Br. 17, 19 (Claims App.). Dependent claims 2–5, 7, 8, 10, and 12–15 each incorporate the limitations of their respective independent claims. Appeal Br. 16–20. (Claims App.).

REFERENCES

Name	Reference	Date
Coogan et al. ("Coogan")	US 2007/0140530 A1	June 21, 2007
Kulchytskyy	US 10,133,471 B2	Nov. 20, 2018

REJECTIONS

Claims 1–8 and 10–15 are rejected under 35 U.S.C. § 112(b).

Claims 1–8 and 10–15 are rejected under 35 U.S.C. § 102(a)(1) as being anticipated by Coogan.

Claims 1–8 and 10–15 are provisionally rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1, 3, 4, 7, and 12 of copending U.S. Application 15/096,471, now Kulchytskyy.

OPINION

A. Indefiniteness

We have reviewed the Examiner's indefiniteness rejection (Final Act. 5–6) and Appellant's contentions in the Appeal Brief (Appeal Br. 2). We have further reviewed the discussion in the Examiner's Answer (Ans. 3) and the Reply Brief (Reply Br. 2).

The Examiner rejects claim 1 as being unclear whether the term "an application" in line 3 is related to the "corresponding application" in line 5, or to the "an application" recited in line 12. Final Act. 6. The Examiner rejects independent claims 6 and 11 for having similar limitations, and rejects the dependent claims for having the aforementioned limitations by virtue of dependency. *Id.*

Appellant argues,

> [f]or the purposes of this Appeal Brief, the Board is requested to read Appellants' claims in light of Examiner's suggestions in the Final Office Action. Specifically, claim 1, lines 3 through 5 should read: a multiplicity of different states of an application and a multiplicity of different fingerprints, each in connection with a different <u>one of the</u> state<u>s</u> of ~~a corresponding~~ the application.

Appeal Br. 5. Appellant further requests that claims 1, 6, and 11 should read "executing the application" rather than "executing an application." Reply Br. 2.

We are not persuaded of error in the Examiner's rejection. Appellant has not argued that the Examiner erred in making the rejection. Although Appellant asks us to read such limitations into the claim, our decision is limited to the language of the claims as they exist upon appeal. *See, e.g.*, *In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998) ("[T]he name of the game is the claim"). Consequently, we affirm the Examiner's rejection of claims 1–8 and 10–15.

B. Anticipation

We have reviewed the Examiner's anticipation rejection over Coogan (Final Act. 3–4, 7–8) and Appellant's contentions in the Appeal Brief (Appeal Br. 10–15). We have further reviewed the discussion in the Examiner's Answer (Ans. 5–7) and Appellant's Reply Brief (Reply Br. 4–6). Appellant primarily contends that Coogan does not set a state of execution of an application to an identified state. Reply Br. 5–6. We are not persuaded by Appellant's arguments.

The Examiner finds, *inter alia*, that Coogan discloses setting "states of the application" in the form of computer software instructions in an ATM application that execute tasks based upon recognition of specific fingerprints. Ans. 5–6. The Examiner finds Coogan's ATM to identify and execute the set of instructions associated with the fingerprint in order to accomplish tasks such as "Balance Inquiry" or "Deposit." *Id.* at 6. The Examiner further finds Coogan to authenticate a user "against a fingerprint database (step 506), followed by determining which command to execute

(block 508), and finally executing the command associated with the finger (block 510)." *Id.* at 7.

Appellant contends that Coogan does not disclose "identifying a state for the application stored in connection with the one of the different fingerprints matched to the scanned fingerprint and setting a state of execution of the application to the identified state," as "[e]ssentially present" in the independent claims. Appeal Br. 10–11. Appellant argues that Coogan instead teaches "associating separate commands in the application with different fingerprints." *Id.* at 11–12. Appellant further characterizes Coogan as having commands that may be customized based upon fingerprint input in which a command is executed upon recognizing a fingerprint of an authorized user. *Id.* at 12–13 (citing Coogan ¶ 36). Appellant argues that Coogan "makes no reference to an identified state of execution or state of the ATM application," and thus fails to describe all elements of claim 1. *Id.* at 13. Appellant argues that in Coogan, upon the fingerprint being recognized, an operation such as withdrawal is performed irrespective of any state or state of the execution of the ATM application. *Id.* Appellant further argues that a state of an application may include a configuration of commands, and an application is in a state of execution when it is able to execute commands. *Id.* at 14. Appellant differentiates Coogan as being in a state of execution as the commands are executed by the application, whereas Appellant characterizes claim 1 as using fingerprint matching to set the state of the application into a state of execution. *Id.* at 14–15.

Anticipation requires a single prior art reference to describe, either expressly or inherently, each and every element as set forth in the claim. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631

(Fed. Cir. 1987). The issue turns upon whether the ATM application instructions of Coogan perform a task that describes, either expressly or inherently, setting the state of an application into a state of execution.

To interpret the term "state of execution," we turn to paragraph 21 of the Specification, following Appellant's direction. Appeal Br. 3. There, Appellant describes a "fingerprint-to-state table." Spec. ¶ 21. If a scanned fingerprint matches an entry in the table, the corresponding state is applied to a corresponding application (block 370). *Id.* The application of a state, through functions and acts specified in the blocks, is performed by computer instructions. *Id.* ¶ 26.

In view of the description in the Specification, we are not persuaded by Appellant's arguments. Appellant argues that the claim requires fingerprints to be associated with separate states of execution, followed by setting a state of execution corresponding to an identified fingerprint. Appeal Br. 10–11. The Specification describes the claimed "setting a state of execution" as an act, performed by a block, which is implemented by computer instructions. Spec. ¶ 21. We agree with the Examiner that Coogan's association of fingerprints with particular commands, which are then implemented by computer instructions, describes the claimed invention.

Appellant further argues that Coogan does not anticipate claim 1 because the Examiner's nonstatutory double patenting rejection states that the language of claim 1 is not identical to the language in Kulchytskyy. Reply Br. 6. However, the double patenting rejection is based on Kulchytskyy, not Coogan. Accordingly, whether claim 1 has identical language as Kulchytskyy is not relevant to whether claim 1 is anticipated by Coogan.

For the aforementioned reasons, we are not persuaded that the Examiner has erred in rejecting claim 1 as being anticipated by Coogan. Because claims 2–8 and 10–15 have not been argued separately, those claims fall with claim 1, and we sustain the Examiner's rejection of claims 2–8 and 10–15. 37 C.F.R. 41.37 (c)(1)(iv).

C. Double Patenting

We have reviewed the Examiner's nonstatutory double patenting rejection (Final Act. 3–5) and Appellant's contentions in the Appeal Brief (Appeal Br. 5–10). We have further reviewed the discussion in the Examiner's Answer (Ans. 3–5) and the Reply Brief (Reply Br. 2–3). At the time of the Final Rejection, the rejection was made over copending application 15/096,471. During the briefing of this appeal, application 15/096,471 issued as U.S. Patent 10,133,471 B2. Because the conflicting claims have now been patented, the rejection is no longer a "provisional" rejection. *See* MPEP 1504.06 ("A provisional double patenting rejection will be converted into a double patenting rejection when the first application, which is the basis for the rejection, publishes as an application publication or issues as a patent").

The Examiner rejects claim 1 over Kulchytskyy's claim 1, which read as follows (emphasis added in *italics*):

Claim 1	*Kulchytskyy claim 1*
A biometric state switching method comprising: storing in a database a *multiplicity of different states of an application* and a multiplicity of different fingerprints, each *in connection with a different state of a corresponding*	A biometric shortcut method comprising: storing in a database a multiplicity of different fingerprints, each *in connection with a different command for a corresponding*

application;	*application*;
authenticating an end user into use of a computing device by receiving in a fingerprint scanner affixed to the computing device a scanned fingerprint, matching the scanned fingerprint to one of the different fingerprints in the database, and if the scanned finger print matches one of the different fingerprints in the database, authenticating the end user into user of the computing device; and,	authenticating an end user into use of a computing device; and, subsequent to authentication, receiving in a fingerprint scanner affixed to the computing device a scanned fingerprint, matching the scanned fingerprint to one of the different fingerprints in the database,
subsequent to authentication, *executing an application* in memory of the computing device, identifying a state for the application stored in connection with the one of the different fingerprints matched to the scanned fingerprint, and *setting a state of execution of the application to the identified state*.	*determining a command for a corresponding application* stored in connection with the one of the different fingerprints matched to the scanned fingerprint, and *issuing the command in the corresponding application executing in the computing device*.

The Examiner finds,

> [b]oth the instant application and the copending application #15/096471 are [a] computer-based system which, by definition, involves issuance of "command[s]" in the form a set of instructions or programs. The instructions or programs define a "state of execution of the application" that instructs a computer to do a specific task such as processing the fingerprint of a specific finger. Different finger corresponds to different processing (i.e., different command) associated with a different set of instructions/programs (i.e., different state of execution of the application).

Final Act. 3. The Examiner further states that the Specification indicates that different tasks are associated with different sets of instructions. Ans. 4

(citing Spec. ¶ 27 "each block in the flowchart or block diagrams may represent a module, segment, or portion of instructions, which comprises one or more executable instructions for implementing the specified logical function(s)").

Appellant argues that the claimed "multiplicity of different states of an application" and "setting a state of execution of the application to the identified state" based on a fingerprint identification is not the same as Kulchytskyy's "different commands" and "issuing the command in the corresponding application" based on a fingerprint identification. Appeal Br. 7. Appellant argues that the Examiner has not provided any basis for the Examiner's interpretation. *Id.* at 7–8.

Appellant further proposes definitions, taken from a computing dictionary, of the terms "command," "state," "execution," and "stateless." *Id.* at 8 (citing *The Free On-line Dictionary of Computing*). Appellant argues that a "state of an application is a temporary configuration of the application based on previous interaction with the application, which may include a temporary configuration of commands." *Id.* at 9. Appellant further argues that "a state of an application is in a state of execution when the state of the application is able to issue commands." *Id.* Appellant argues that commands are a specific set of instructions that may occur in stateful or stateless applications. *Id.* Appellant concludes that "issuing a command in an application that is already in a state of execution is necessarily different than setting a state of the application before the state of the application is in a state of execution." *Id.*

We are not persuaded by Appellant's arguments. In the Examiner's interpretation, a command defines a state of execution of the application that

instructs a computer to do a specific task. Final Act. 3; Ans. 4. We find the Specification to support such an interpretation. As discussed, *supra* at 6, the claimed "setting a state of execution" is described as an act that is implemented by computer instructions. Spec. ¶ 21. Appellant's proffered definitions show that a state of an application is a configuration based on computer instructions. *See* Appeal Br. 9. We do not find this argument inconsistent with the Examiner's interpretation. Accordingly, we sustain the Examiner's rejection of claim 1. Because claims 2–8 and 10–15 have not been argued separately, those claims fall with claim 1, and we sustain the Examiner's rejection of claims 2–8 and 10–15. 37 C.F.R. 41.37 (c)(1)(iv).

CONCLUSION

For the above-described reasons, we affirm the Examiner's rejections of claims 1–8 and 10–15 as being indefinite under 35 U.S.C. § 112(b), and as being unpatentable on the ground of nonstatutory double patenting over Kulchytskyy, and as being anticipated by Coogan under 35 U.S.C. § 102(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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	References/Grounds	Affirmed	Reversed
1–8, 10–15		Double Patenting	1–8, 10–15	
1–8, 10–15	112(b)	Indefiniteness	1–8, 10–15	
1–8, 10–15	102(a)(1)	Coogan	1–8, 10–15	

Overall Outcome			1–8, 10–15	

AFFIRMED