

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID M. SIEFERT

Appeal No. 1996-3670
Application No. 08/217,063

ON BRIEF

Before HAIRSTON, FLEMING, and BARRY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

The examiner rejected claims 1-7. The appellant appeals therefrom under 35 U.S.C. § 134(a). We affirm-in-part.

BACKGROUND

The appellant's invention detects updates to computer software and automatically downloads updated software to a computer. More specifically, remote computers have access to servers, which store computer programs called "master programs." The remote computers also store copies of the master programs.

New versions of the master programs become available periodically. The invention includes software, running on the remote computers, that detects when such new versions become available. When the availability of a new version is detected, the software requests that the new version be downloaded to the remote computers. The invention then installs the new version in the remote computers without intervention from a user.

A further understanding of the invention can be achieved by reading the following claim:

7. A method of installing software in a local computer, comprising:
 - a) establishing a data link with a remote computer;
 - b) downloading [sic], from the remote computer to the local computer:
 - i) installation software;
 - ii) software to be installed;
 - c) running the installation software, which installs the software, without significant input from a user.

(Appeal Br. at 27.)

Claims 1-7 stand rejected under § 112, ¶ 1, as non-enabled and under 35 U.S.C. § 112, ¶ 2, as indefinite. In addition, claims 1-6 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent 5,155,847 ("Kirouac") and claim 7 stands rejected under § 103(a) as obvious over U.S. Patent 5,166,886 ("Molnar").

OPINION

After considering the record, we are persuaded that the examiner erred in rejecting claims 1 and 3-7 as indefinite, claims 1-7 as non-enabled, and claims 1-6 as obvious. We are also persuaded, however, that he did not err in rejecting claim 2 as indefinite and claim 7 as obvious. Accordingly, we affirm-in-part. Our opinion addresses the following rejections:

- indefiniteness rejection
- enablement rejection
- obviousness rejection.

I. Indefiniteness Rejection

Rather than reiterate the positions of the examiner or appellant *in toto*, we address the six points of contention therebetween. First, the examiner asserts, "[w]ith respect to claim 1, it is unclear how the functions of the software means

are being provided." (Examiner's Answer at 4.) The appellant argues, "claim 1 recites the 'software means' in combination with the computer that runs it." (Reply Br. at 2.)

"The test for definiteness is whether one skilled in the art would understand the bounds of the claim when read in light of the specification. *Orthokinetics Inc., v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, Section 112 demands no more. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1385, 231 USPQ 81, 94 (Fed. Cir. 1986)." *Miles Labs., Inc. v. Shandon Inc.*, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993).

Here, as argued by the appellant, claim 1 recites the "software means" in combination with the personal computer on which it runs. In view of the recitation, we are persuaded that one skilled in the art would understand that "the computer-software combination," (Reply Br. at 2), provides the claimed functions of the software means. Therefore, we reverse the rejection of claim 1 as indefinite.

Second, the examiner asserts, "[i]n the preamble of claim 2, 'Apparatus of claim 1' lacks proper antecedent basis."

(Examiner's Answer at 4.) The appellant argues, "Section 112 does not require further limitation of a particular apparatus contained within the parent claim. The parent claim, overall, is further limited." (Appeal Br. at 19.)

A claim is indefinite "where the language 'said lever' appears in a dependent claim where no such 'lever' has been previously recited in a parent claim to that dependent claim. . . ." *Ex parte Moelands*, 3 USPQ2d 1474, 1476 (Bd.Pat.App. & Int. 1987). Here, although the language "[a]pparatus according to claim 1" appears in dependent claim 2, no such "apparatus" has been previously recited in parent claim 1. Furthermore, the parent claim includes more than one element that could be interpreted as the referenced apparatus, e.g., a SERVER, a PC. Therefore, we affirm the rejection of claim 2 as indefinite.

Third, the examiner asserts, "[w]ith respect to claims 3-6, it is unclear how, or if, the multiple computers are interrelated." (Examiner's Answer at 4.) The appellant argues,

"`interrelationships' are, inherently contained within the claims." (Appeal Br. at 23.)

Here, claims 3-6 specify downloading software from some computers to other computers. We are persuaded that one skilled in the art would understand that "if a computer downloads an update from another computer, some `interrelationship' exists." (Appeal Br. at 23.) Therefore, we reverse the rejection of claims 3, 5, and 6 as indefinite. Regarding claim 4, we must still address the fourth point of contention.

Fourth, the examiner asserts, "[w]ith respect to claims 4 and 7, the specifications of `without intervention of a user,' and `without significant input from a user' do not positively limit the invention as they merely state what the invention is not, rather than what the invention is." (Examiner's Answer at 4.) The appellant argues, "the **mere presence** of a negative limitation does not invalidate an entire claim." (Appeal Br. at 24.)

"[N]egative limitations, *per se*, do not necessarily fail to define the invention. The Manual of Patent Examining Procedure,

3rd Ed., Sec. 706.03(d) refers to a negative limitation such as 'non-poisonous' or 'non-alcoholic' as not indefinite since it leaves a single and definite alternative and may be the least cumbersome way to express the limitation." *In re Bankowski*, 318 F.2d 778, 783, 138 USPQ 75, 79 (CCPA 1963).

Here, although the expressions "without intervention of a user" and "without significant input from a user" are negative limitations, the examiner has not shown that either limitation fails to define the invention. We agree with the appellant that the limitations "do not state 'what *the invention* is not.'" (Appeal Br. at 25.) Therefore, we reverse the rejection of claim 4 as indefinite. Regarding claim 7, we must still address the fifth and sixth points of contention.

Fifth, with respect to claim 7, the examiner asserts, "it is unclear what is meant by 'significant input' as there is no point of reference provided to differentiate between significant and insignificant." (Examiner's Answer at 4.) "[B]readth is not to be equated with indefiniteness, as we have said many times." *In re Miller*, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971). Here, we recognize that the limitation "without significant input

from a user" is broad, permitting little or no input from a user. Although the limitation may be even broader than the appellant intended, however, we do not view it as indefinite.

Sixth, the examiner asserts, "[w]ith respect to claim 7, it is unclear what structure is used for 'running the installation software.'" (Examiner's Answer at 4.) Again, we recognize that the claim is broad, permitting the claimed "local computer," the claimed "remote computer," or both computers to run the claimed "installation software." Although the limitation may be even broader than the appellant intended, however, we do not view it as indefinite. Therefore, we reverse the rejection of claim 7 as indefinite.

II. Enablement Rejection

Observing that "[t]he claims set forth 'software means for detecting ... and, upon detection, requesting,'" (Examiner's Answer at 3), the examiner asserts, "appellant's claims suggest[] that software means alone, without benefit of processing by hardware, [is] capable of providing function." (*Id.* 10.) The appellant argues that his "claims do not state this. EVERY CLAIM recites a computer." (Reply Br. at 7.)

Here, although the examiner rejects claims 1-7, the claimed limitation of a "software means" cited by the examiner appears only in claim 1. As explained regarding the indefiniteness rejection of claim 1, moreover, we agree with the appellant that "the computer-software combination," (Reply Br. at 2), provides the claimed functions of the software means. Therefore, we reverse the rejection of claims 1-7 as non-enabled.

III. Obviousness Rejection

We address the three points of contention between the examiner and appellant. First, the examiner asserts, "[w]ith respect to claim 1, Kirouac taught the invention substantially as claimed including the personal computer (PC) comprising . . . means for detecting when the server obtains access to updated versions of said computer programs (col.1, [sic] lines 60-66), and upon detection receiving said updates (col.2, lines 4-16)." (Examiner's Answer at 4.) The appellant argues, "claim 1 recites that the 'software means' *detects* when a SERVER obtains updated programs. This 'software means' resides on, a PC (see preamble)." (Appeal Br. at 6.)

"Analysis begins with a key legal question -- *what is the invention claimed?*" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). We agree with the appellant that the claimed software for detecting when a server obtains updated programs resides on the PC of claim 1.

Having determined what subject matter is being claimed, the next inquiry is whether the subject matter is anticipated or obvious. "'A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.'" *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, we are not persuaded that teachings from the prior art itself would have suggested that the claimed software for detecting when a server obtains updated programs resides on the PC of claim 1. To the contrary, we agree with the appellant that "[i]n *Kirouac*, it appears that the 'comparison software' resides on the central computer." (Appeal Br. at 6.) Specifically, "[a]s patches P are made to either the mandatory programs MP₁ or

to any of the optional programs OP_{1y}, the central computer system 14 monitors and records the changes made to the software. . . ." Col. 4, ll. 29-33. Therefore, we reverse the rejection of claim 1 as obvious.

Turning to claim 2, we recall that an obviousness rejection should not be based on "speculations and assumptions." *In re Steele*, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). "All words in a claim must be considered in judging the patentability of that claim against the prior art. If no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious-the claim becomes indefinite." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Here, for the reasons we explained in addressing the indefiniteness of claim 2, our analysis leaves us in a quandary about what the claim specifies. Speculations and assumptions would be required to decide the scope of the claim. Therefore, we reverse *pro forma* the rejection of claim 2 as obvious.

Second, the examiner asserts, "the multiple computers [of claims 3-6] are merely multiple implementations [sic] of Kirouac. . . ." (Examiner's Answer at 9.) The appellant argues, "[c]laim 3(a) recites that software masters are stored at **multiple** computers. In contrast, Kirouac shows storage of 'initial versions' MPX at a *single* central computer. (Column 4, lines 9 -19.)" (Appeal Br. at 9.)

Claims 3-6 require that **multiple** computers store computer programs to be downloaded to other computers. "In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)).

Here, we are not persuaded that teachings from the prior art itself would have suggested that multiple computers store computer programs to be downloaded to other computers. Although Kirouac discloses downloading computer programs to computers, the programs are stored on only one computer. Specifically, "[r]eferring to FIG. 1, a software support system 10 is shown for

upgrading software used in remote computer systems 12 from a central computer system 14." We do not understand the examiner's assertion about the multiple computers being "merely multiple implementations of Kirouac. . . ." (Examiner's Answer at 9.) Therefore, we reverse the rejection of claims 3-6 as obvious.

Third, the examiner asserts, "Molnar taught . . . the steps of . . . b] downloading from the remote computer installation software (col.16, lines 1-3) and software to be installed (col.15, lines 67-68); and c] running the installation software, which installs the software (col.16, lines 1-3)." (Examiner's Answer at 6.) Observing that claim 7 recites "i) **installation software**; ii) software to be installed; c) **running the installation software, which installs the software, without significant input from a user**," (Appeal Br. at 11), the appellant argues, "[t]he **bold** recitations are absent from Molnar." (*Id.*)

"[T]he Board must give claims their broadest reasonable construction. . . ." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000). "Moreover, limitations are not to be read into the claims from the specification." *In re Van*

Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).¹

Here, giving claim 7 its broadest reasonable construction and recalling our treatment of the indefiniteness rejection of claim 7, the limitations recited by the appellant merely require downloading, to a computer, installation software and software to be installed and then running the installation software with little or no input from a user.

"[A] disclosure that anticipates under Section 102 also renders the claim invalid under Section 103, for 'anticipation is the epitome of obviousness.'" *Connell v. Sears, Roebuck & Co.*,

¹ "The PTO broadly interprets claims during examination of a patent application since the applicant may 'amend his claims to obtain protection commensurate with his actual contribution to the art.'" *In re Yamamoto*, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984) (quoting *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550 (CCPA 1969)). "This approach serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified. Applicants' interests are not impaired since they are not foreclosed from obtaining appropriate coverage for their invention with express claim language." *Id.* at 1571-72, 222 USPQ at 936 (citing *Prater*, 415 F.2d at 1405 n.31, 162 USPQ at 550 n.31).

722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983) (quoting *In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982)). Obviousness follows *ipso facto*, moreover, from an anticipatory reference. *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1446, 221 USPQ 385, 390 (Fed. Cir. 1984). “[A]nticipation is a question of fact.” *Hyatt*, 211 F.3d at 1371, 54 USPQ2d at 1667 (citing *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812, 814-15 (1869); *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997)).

Here, we find that the columns cited by the examiner teach that Molnar downloads, to a computer 42, installation software called a “broadcast program” and software to be installed called a “vended program” and then runs the broadcast program with little or no input from a user. Specifically, before such downloading, “the central site issues a validation code or key that is received by the computer #42.” (Col. 15, ll. 65-66.) The key then “enables the receiver #38 [associated with computer 42] to access . . . a broadcast program that can load the vended program from the broadcast stream and copy it onto a storage medium that is available on the computer #42.” Col. 15,

1. 67 - col. 16, l. 3. Therefore, we affirm the rejection of claim 7 as obvious.

CONCLUSION

In summary, the rejections of claims 1 and 3-7 under § 112, ¶ 2; claims 1-7 under § 112, ¶ 1; and claims 1-6 under § 103(a) are reversed. In contrast, the rejections of claim 2 under § 112, ¶ 2 and claim 7 under § 103(a) are affirmed. Our affirmances are based only on the arguments made in the briefs. Arguments not made therein are neither before us nor at issue but are considered waived.

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
LANCE LEONARD BARRY)	
Administrative Patent Judge)	

Appeal No. 1996-3670
Application No. 08/217,063

Page 18

JAMES M. STOVER
NCR CORPORATION
1700 SOUTH PATTERSON BLVD, WHQ4
DAYTON, OH 45479