

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No. 09/947,801

Filed: 09/06/2001

For: DISTRIBUTED COMPUTING SYSTEM

Examiner: Chirag R. Patel Art Unit: 2141

In re Application of: Jed Margolin

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir,

Appellant's Response to Examiner's Answer filed 1/24/2006 to Appellant's Appeal Brief

As required under 37 CFR 41.41 (a)(1) this Response to Examiner's Answer to Appellant's Appeal Brief is filed within two months of mailing of Examiner's Answer to Appellant's Appeal Brief and is in furtherance of the Notice of Appeal filed in this case on September 6, 2005.

Summary

- 1.** The Examiner has misquoted Appellant on an issue of merit.
- 2.** In using the Microsoft Press Computer Dictionary, Third Edition, ©1997 Microsoft Corporation to define the term *server*, Examiner failed to note that he was using definition #2 or even that the reference provides another definition. Where there are multiple definitions of a word or different shadings of the definition of a word, dictionaries list them in the order in which they are most commonly used. Therefore, Examiner failed to cite the most commonly used definition of *server*.
- 3.** The Examiner's citation of *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993) is misleading in view of *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

Detailed Response

1. The Examiner has misquoted Appellant on an issue of merit.

On Examiner Response, Page 11, third paragraph Examiner quotes from Appellant's Appeal Brief:

D) Applicant argues "The Examiner's supervisor introduced a new argument in his Examiner's Interview Summary for the telephone interview held August 25, 2005. This argument appears only in the Interview Summary. It was not discussed during the Interview. It does not appear in either the First or Second Office Actions. The Examiner's supervisor introduced a new argument in his Examiner's Interview Summary for the telephone interview held August 25, 2005. It was discussed that Ellis's definition of network provider included an individual and thus the definition of subscribe is the same as disclosure"

Examiner's misquote came either from Appellant's Appeal Brief Page 4:

4. The Examiner's supervisor introduced a new argument in his Examiner's Interview Summary for the telephone interview held August 25, 2005. This argument appears only in the Interview Summary. It was not discussed during the Interview. It does not appear in either the First or Second Office Actions.

or from Page 7.

4. The Examiner's supervisor introduced a new argument in his Examiner's Interview Summary for the telephone interview held August 25, 2005.

This new argument states:

It was discussed that Ellis's definition of network provider included an individual and thus the definition of subscribe is the same as disclosure.

This argument appears only in the Interview Summary. It was not discussed during the Interview. It does not appear in either the First or Second Office Actions. It was **not** discussed that Ellis's definition of network provider included an individual. If the issue had been brought up Applicant would have pointed out that the individual/network provider still had to be different from the individual/PC owner in order for Ellis to be useful. Otherwise, Ellis's financial arrangement would be with himself and would render Ellis' patent invalid for lack of usefulness.

Examiner's misquote has the Appellant agreeing that "*It was discussed that Ellis's definition of network provider included an individual and thus the definition of subscribe is the same as disclosure*" which is the opposite of what Appellant actually said. The Examiner has either been incredibly careless or is attempting to deceive BPAI.

The Examiner then goes on to state on Page 12 first paragraph:

Response to D) It was discussed in the first and second office actions, because that paragraph was quoted in Ellis (US 6,167,428) as listed below in the ground of rejections under Col 7 line 66 — Col 8 line 14) was cited in both office actions under claim 1 that cited the portion that disclosed that the individual as the subscriber. This passage was presented by the examiner in the first, non-final office and final action and can be referenced under the ground of rejections under section 10.

The Ellis paragraph cited by the Examiner says:

For this new network and its structural relationships, a network provider is defined in the broadest possible way as any entity (corporation or other business, government, not-for-profit, cooperative, consortium, committee, association, community, or other organization or individual) that provides personal computer users (very broadly defined below) with initial and continuing connection hardware and/or software and/or firmware and/or other components and/or services to any network, such as the Internet and Internet II or WWW or their present or future equivalents, coexistors or successors, like the MetaInternet, including any of the current types of Internet access providers (ISP's) including telecommunication companies, television cable or broadcast companies, electrical power companies, satellite communications companies, or their present or future equivalents, coexistors or successors. The connection means used in the networks of the network providers, including between personal computers or equivalents or successors, would preferably be very broad bandwidth, by such means as fiber optic cable or wireless for example, but not excluding any other means, including television coaxial cable and telephone twisted pair, as well as associated gateways, bridges, routers, and switches with all associated hardware and/or software and/or firmware and/or other components and their present or future equivalents or successors. The computers used by the providers include any computers, including mainframes, minicomputers, servers, and personal computers, and associated their associated hardware and/or software and/or firmware and/or other components, and their present or future equivalents or successors.

In the First Office Action, the Examiner's reference to the Ellis paragraph states:

As per claims 1 and 3, Ellis discloses a distributed computing system comprising:

(a) a home network server in a subscriber's home; (Col 7 lines 66-67, Col 8 lines 1-14 and 23-28)

Examiner did not state how the Ellis reference constituted a home network server in a subscriber's home. Since the Ellis paragraph does not contain the terms *home*, *home network*, or *subscriber* Examiner's rejection was indistinct, and continues to be indistinct.

In the Second Office Action the Examiner merely repeated this rejection, again without pointing out how anything in the quoted Ellis paragraph constituted a home network server or a subscriber as defined in Appellant's Application.

The very first time the Examiner made the statement:

"It was discussed that Ellis's definition of network provider included an individual and thus the definition of subscribe is the same as disclosure."

was in Examiner's Interview Summary for the telephone interview held August 25, 2005. It was not made in the First Office Action, the Second Office Action, or in any telephone interview including the telephone interview of August 5, 2005. Appellant notes that the Examiner failed to file an Examiner's Interview Summary for this telephone interview. Appellant's summary of the telephone interview of August 5, 2005 appears in the File Wrapper as **8/12/2005 Miscellaneous Incoming Letter**.

Appellant also wishes to point out that regardless of whether Ellis' definition of network provider includes an individual:

1. The individual/network provider still had to be different from the individual/PC owner in order for Ellis to be useful and, therefore, valid.
2. The Examiner's statement, "*and thus the definition of subscribe is the same as disclosure*" is a non sequitur and has no relevance to the definition of network provider.

2. In using the Microsoft Press Computer Dictionary, Third Edition, ©1997 Microsoft Corporation to define the term server, Examiner failed to note that he was using definition #2 or even that the reference provides another definition.

The complete definition from Microsoft Press Computer Dictionary, Third Edition, ©1997 Microsoft Corporation for the term *server* is (leaving out the pronunciation guide), from page 430:

server *n.* **1.** On a local area network (LAN), a computer running administrative software that controls access to the network and its resources, such as printers and disk drives, and provides resources to computers functioning as workstations on the network. **2.** On the Internet or other network, a computer or program that responds to commands from a client. For example, a file server may contain an archive of data or program files; when a client submits a request for a file, the server transfers a copy of the file to the client. *See also* client/server architecture. *Compare* client (definition 3).

Where there are multiple definitions of a word or different shadings of the definition of a word, dictionaries list them in the order in which they are most commonly used. Therefore, the Examiner failed to cite the most commonly used definition of *server*.

Since the Examiner has chosen Microsoft as the final arbiter of what terms mean, the correct definition to use would be the first one:

1. On a local area network (LAN), a computer running administrative software that controls access to the network and its resources, such as printers and disk drives, and provides resources to computers functioning as workstations on the network.

Under this definition, Ellis' *PC 1* is clearly not a server. In Ellis' response to the First Office Action for his application 09/320,660 he made clear the importance of being able to run applications on his *PC 1* which were not available to the operating systems typically used by servers. (The First Office Action was mailed October 14, 1999, Ellis' Response is dated April 14, 2000, and the application was eventually issued as U.S. Patent 6,167,428 .)

From Ellis' Response, Page 24 Second Paragraph:

The Examiner appears to have rejected claims 27-41 because of a belief that UNIX and NT servers can be run on personal computers and can be made to function temporarily as a master personal computer or as a slave personal computer, as similarly recited in claims 27-41. However, a UNIX or an NT server functions as a server, not as a master personal computer or as a slave personal computer, which require applications not found in UNIX or NT operating systems. Therefore, Applicant submits that neither Seti@home nor a UNIX or an NT server running on personal computers discloses, teaches or suggests:

Ellis then discusses how this relates to his claims. However, the importance of being able to run standard PC applications on Ellis' *PC I* has been established and, under Microsoft's primary definition of server, *PC I* lacks the administrative software required to be a server.

Contrast this to Appellant's definition of Home Network Server. From Appellant's application:

SUMMARY OF THE INVENTION

[0014] A Home Network Server is used in a home to network various clients such as PCs, sensors, actuators, and other devices. It also provides the Internet connection to the various client devices in the Home Network. The Home Network Server also provides a firewall to prevent unauthorized access to the Home Network from the Internet. The use of a Home Network Server, as opposed to the use of peer-to-peer networking, allows a robust operating system to be used. It also allows the users on the Home Network to add additional applications to their PCs without fear of jeopardizing the proper functioning of their Internet security program (firewall) or the distributed computing software. (Although a firewall is not strictly necessary, prudence dictates its use.)

In terms of the Microsoft definition Appellant's Home Network Server is:

On a local area network (LAN), a computer running administrative software [*robust operating system*] that controls access to the network and its resources, such as printers and disk drives, and provides resources to computers functioning as workstations [*various clients such as PCs, sensors, actuators, and other devices*] on the network.

Since the Examiner has chosen the Microsoft Dictionary as his reference it is instructive to see how Microsoft has defined other terms:

On Page 329

network server *n.* See server.

home network – not defined

On Page 235

home *n.* A beginning position, such as the top left corner of a character-based display, the left end of a line of text, cell A1 of a spreadsheet, or the top of a document.

Oops.

This suggests that a **Home Network Server** is a Server whose purpose is limited to something having to do with a beginning position of a document.

There are two choices in interpreting this result.

1. The Microsoft Dictionary is internally inconsistent and should not have been used as a reference.
2. Microsoft felt that the common meaning of home is so obvious that it did not have to be defined.

A more appropriate reference would have been the Microsoft Computer Dictionary, Fourth Edition, ©1999 Microsoft Corporation since Appellant's Application claims priority of U.S. Provisional Application No. 60/249,830 filed on November 17, 2000.

Unfortunately the Fourth Edition provides the same definitions for the terms under discussion except that it leaves out the pronunciation keys for the words.

However, since the Examiner has also used the Microsoft Computer Dictionary, Fifth Edition, ©2002 Microsoft Corporation as a reference it will be instructive to see how it defines the terms under discussion.

The term **server** is substantially the same. On page 474:

server *n.* **1.** On a local area network (LAN), a computer running administrative software that controls access to the network and its resources, such as printers and disk drives, and provides resources to computers functioning as workstations on the network. **2.** On the Internet or other network, a computer or program that responds to commands from a client. For example, a file server may contain an archive of data or program files; when a client submits a request for a file, the server transfers a copy of the file to the client. See also application server (definitions 1 and 2), client/server architecture. Compare client (definition 3).

(The section which is different from the Third and Fourth Editions is underlined.)

The definition for **Network Server** is the same. On page 364:

network server *n.* See server.

The definition for **Home** is the same. On page 255:

home *n.* A beginning position, such as the top left corner of a character-based display, the left end of a line of text, cell A1 of a spreadsheet, or the top of a document.

However, the Fifth Edition does contain a definition for **Home Network**. On Page 255:

home network n. 1. A communications network in a home or building used for home automation. Home networks can use wiring (existing or new) or wireless connections. See also home automation, home controller. 2. Two or more computers in a home that are interconnected to form a local area network (LAN).

Appellant is pleased that Microsoft's 2002 edition adapted substantially the same definition for **Home Network** as Appellant used in the year 2000 even though Microsoft also failed to define the term **home**. It is clear that, like Appellant, Microsoft felt that the common meaning of **home** is so obvious that it did not have to be defined.

Contrast this to the Examiner and his Supervisor who have taken the position that since the term **home** has so many common meanings (which they fail to list or even cite their reference) and Appellant failed to explicitly define the term, the word **home** has no meaning at all.

From Examiner's Response, Page 11 second paragraph:

Response to C) The examiner and the supervisor has *{sic}* read and interpreted "home" in light of the specifications that "home" can be very broadly defined and can be interpreted in many different contexts. A thorough review of the disclosure did not disclose any specific definition of "home".

The Examiner and his supervisor have gone from *allowing* an Applicant to be his own lexicographer to *requiring* the Applicant to be his own lexicographer especially if the Applicant uses a commonly used term whose meaning is understood to most of the English-speaking world.

Examiner and his Supervisor have failed to see the consequences of their actions. Consider the following scenario.

1. BPAI affirms Examiner.
2. Appellant appeals to the Court of Appeals for the Federal Circuit.
3. The Court of Appeals for the Federal Circuit affirms BPAI, thereby setting a precedent for all patents including those already issued.

Appellant wishes to note that as of this date there are 29 U.S. Patents assigned to Microsoft which use the term *home network*. Not one of these 29 patents appears to define the term *home*. In the event these patents were challenged, Microsoft's position would be considerably weakened by the precedent that the Examiner and his Supervisor wish to set. The Patent Database lists a total of 1407 issued patents which use the term "home network." Appellant will leave it to the Examiner to determine which, if any, of the remaining 1378 patents define the term *home*.

The Examiner and his Supervisor have already opened this door. It is up to BPAI to decide whether or not to go through it.

3. The Examiner's citation of *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993) is misleading in view of *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

In *In re Morris*, in holding that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit, the Court ruled:

The Solicitor is correct, and we reject appellants' invitation to construe either of the cases cited by appellants so as to overrule, *sub silentio*, decades old case law. Some cases state the standard as "the broadest reasonable interpretation," *see, e.g., In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993), others include the qualifier "consistent with the specification" or similar language, *see, e.g., In re Bond*, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990). Since it would be unreasonable for the PTO to ignore any interpretive guidance afforded by the applicant's written description, either phrasing connotes the same notion: as an initial matter, the PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification.

The Examiner is invited to pay attention to this part.

Since it would be unreasonable for the PTO to ignore any interpretive guidance afforded by the applicant's written description, either phrasing connotes the same notion: as an initial matter, the PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification.

Conclusion

The purpose of a language like English is to allow people to communicate with each other. Communications is already difficult enough because the meanings that people give to words depends on their life experiences as well as their education (formal or not). Communications also requires that people act in good faith, that they actually want to communicate. It is clear from the record that the Examiner and his Supervisor are not acting in good faith, that they have no intention of having meaningful communications.

The word *home* is a very good word. It is also a very old word whose roots stretch back through Middle English to Old English (also called Anglo-Saxon because it was the Germanic dialect spoken by the Angles and Saxons when they invaded Britain in the Fifth Century), and all the way back to Indo-European. Everybody knows what a home is (even people who don't have one) with the exception of the Examiner and his Supervisor.

The Examiner has misquoted Appellant's Appeal Brief on an issue of merit, deliberately used a less-common definition of *server* in order to serve his purposes, and misused *In re Van Geuns*. In their determination to deny Appellant the patent rights to his invention the Examiner and his Supervisor have failed to see that they are setting a precedent that threatens the patent system itself by requiring that an Applicant define every commonly-used word. Words must be defined by using other words, so there is no end to this. Eventually they will be arguing what the meaning of "is" is.

For these and other good reasons Appellant respectfully demands that this case be forwarded to BPAI without further delay.

Respectfully submitted,

A handwritten signature in cursive script that reads "Jed Margolin". The signature is written in black ink and is positioned above a solid horizontal line.

Jed Margolin
pro se inventor
March 16, 2006
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