UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/641,853	08/15/2003	Arthur Louis Gaetano JR.	IT-03-003	2920

40604 7590 01/13/2012

MITEL NETWORKS CORPORATION
7300 WEST BOSTON STREET
CHANDLER, AZ 85226

EXAMINER	
AGWUMEZIE, CHARLES C	
ART UNIT	**PAPER NUMBER**
3685	
MAIL DATE	**DELIVERY MODE**
01/13/2012	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ARTHUR LOUIS GAETANO JR.

Appeal 2010-004240
Application 10/641,853
Technology Center 3600

Before: ANTON W. FETTING, JOSEPH A. FISCHETTI, and BIBHU R. MOHANTY, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellant seeks our review under 35 U.S.C. § 134 from the Examiner's final rejection of claims 6-10 and 19-23. Claim 24 is canceled. Claims 1-5, 11-18, and 25-32 are withdrawn. We affirm and designate our affirmance as a new ground of rejection (37 C.F.R. § 41.50(b)).

THE INVENTION

Appellant claims a system and method for software site licensing (Spec. 1:4). Claims 6 and 19 are illustrative:

> 6. A software site license system comprising:
>
> a license sales site generating and transmitting a software license;
>
> a target site computer having a software site application, said software license corresponding to said software site application and said target site computer;
>
> a programming workstation receiving said software license from said sales site and uploading said license to said target; and
>
> a storage coupled to said target site, said storage including a plurality of licenses received from said workstation, said plurality of licenses comprising at least one previously uploaded license corresponding to a previous version of said software site application on said target, and said previously uploaded license capable of reload to said target without additional contact with said license sales site or another license transfer from said workstation.
>
> 19. A process for reloading a previously uploaded software site license corresponding to a software application, said process comprising;
>
> executing a management application on a programming workstation;
>
> coupling said programming workstation to a target computer having said software application thereon;

displaying on said programming workstation a list comprising a plurality of stored licenses applicable for and stored at said target computer;

viewing said list and selecting from said list said previously uploaded stored license from said plurality of stored licenses;

applying said previously uploaded license at said target computer as a current license; and

updating said list of said plurality of licenses to reflect the reload.

REFERENCES

The Examiner relies on the following prior art:

Stupek	US 5,960,189	Sep. 28, 1999
Misra	US 6,189,146 B1	Feb. 13, 2001
Klave	US 2003/0135728 A1	Jul. 17, 2003
Peinado	US 2005/0097368 A1	May 5, 2005

REJECTIONS

The following rejections are before us for review.

Rejection of claims 6-8[1] under 35 U.S.C. § 103(a) over Misra and Peinado.

Rejection of claims 9 and 10 under 35 U.S.C. § 103(a) over Misra, Peinado, and Stupek.

Rejection of claims 19, 20 and 23 under 35 U.S.C. § 103(a) over Misra and Klave.

Rejection of claims 21, and 22 under 35 U.S.C. § 103(a) over Misra, Klave, and Stupek.

[1] This ground was incorrectly labeled in the Answer, but the Examiner corrected it in the Miscellaneous Communication mailed October 2, 2009.

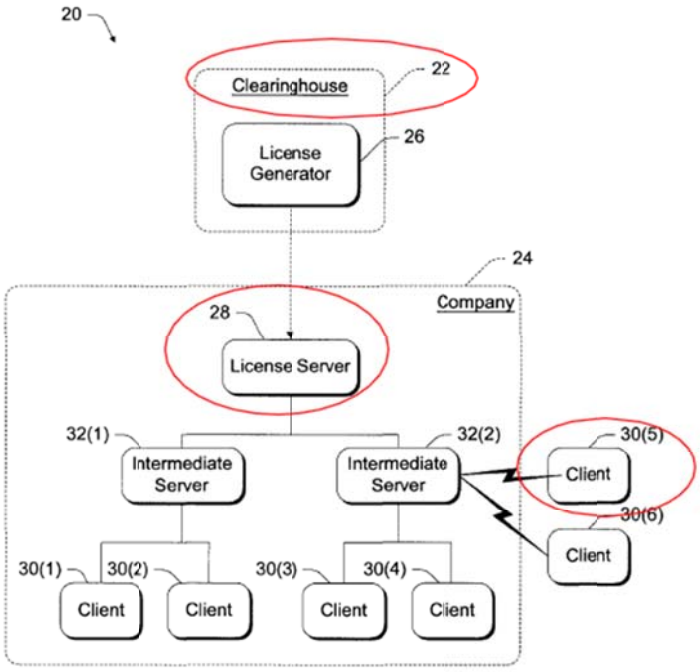
ISSUE

Did the Examiner err in finding that Misra discloses that old licenses in local client storage are replaced during version upgrades, based on a policy assumption that upgraded licenses will work for previous software versions?

FINDINGS OF FACT

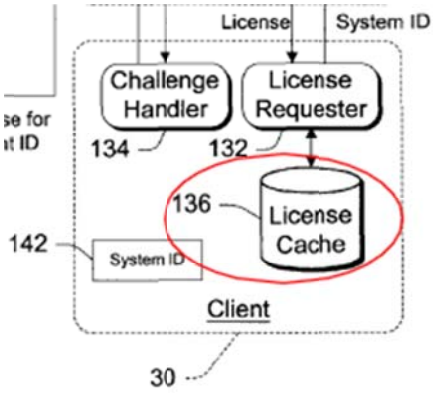
We find the following facts by a preponderance of the evidence.

1. Misra's "license generator located at a licensing clearinghouse" discloses the claimed *license sales site generating and transmitting a software license*. (Col. 2, ll. 22-23).
2. Misra's client 30, which "is responsible for managing the storage of that license" discloses the claimed *target site computer having a software site application, said software license corresponding to said software site application and said target site computer*. (Col. 4, ll. 64-67).
3. Misra's license server 28 discloses a *programming workstation receiving said software license from said sales site and uploading said license to said target*. (Col. 4, ll. 23-24).
4. Misra discloses the relationship of the *license sales site*/licensing clearinghouse 22, the *target site computer*/client 30, and the *programming workstation*/license server 28 as shown in Figure 1. Annotated Figure 1 of Misra is reproduced below:



Annotated Figure 1 of Misra depicts licensing clearinghouse 22, license server 28, and client 30.

5. Misra's license cache 136 that is part of client 30, as shown in Figure 3, discloses the claimed *storage coupled to said target site, said storage including a plurality of licenses received from said workstation*. An annotated portion of Misra's Figure 3 is reproduced below:



An annotated portion of Figure 3 of Misra depicts client 30 and license cache 136.

6. Misra discloses that license cache 136 stores the claimed *a plurality of licenses received from said workstation*/license server, in that the "license requestor **132** verifies the signature on the license to confirm that it came from the license server **28** and stores the software license in the license cache **136**. It is the responsibility of the license requester **132** to manage the licenses stored in the cache **136**." (Col. 12, ll. 8-12).
7. Misra discloses that the license cache 136 is kept in persistent storage (col. 12, ll. 15-16).
8. Misra discloses that when a license is upgraded to a license for a new version, the "client **30** replaces the old license with the upgraded one in the license cache **136** (step **252**)." (Col. 16, ll. 65-67).
9. Misra discloses that "licenses are assumed to be backward compatible. That is, a next generation 5.X license is always accepted by a current generation 4.X server." (Col. 17, ll. 1-3).
10. Misra discloses storing information about licenses in storage at the *target*/client 30, in that "licenses are organized in the license cache **136** according to information about the license issuing authority and product ID." (Col. 12, ll. 12-14).
11. Klave discloses a system for loading individual software components on a device (para. [0008]).
12. Klave discloses a "loading table" which "may be a license table including a list of licenses relating to the individual software components." (Para. [0011]).
13. Klave discloses *displaying* and *viewing* the list of licenses, and *selecting* from the list of licenses, stating, the "loading table **206** is then read **606**

and a corresponding feature list is displayed to the user. The user may then enable or disable **608** features as desired." (Para. [0047]).

14. Misra discloses a *predetermined number of licenses* based on the number of licenses purchased, stating the "license server **28** monitors the software licenses that have been granted to clients. The license server **28** can distribute licenses to new clients as long as it has available non-assigned licenses." (Col. 4, ll. 23-26).
15. Klave discloses a system for loading individual software components in computers (para. [0008]).
16. Stupek discloses the claimed *generating a summary of proposed modifications which will result from applying said previously uploaded license at said target and displaying said summary*, in that "the upgrade advisor **11** presents a report and/or graphical display to the user. This output is in the form of upgrade recommendations, each supported by an explanation of the reasons for upgrade." (Col. 4, ll. 6-9).

ANALYSIS

Claims 6-8 – New Ground

The rejection is affirmed as to claims 6-8. Appellant does not separately argue claims 7 and 8 that depend from independent claim 6. We select claim 6 as representative, and claims 7 and 8 fall therewith. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellant argues that "neither Misra nor Peinado, either alone or in combination, teach, suggest or disclose all the elements" of the claims. (App. Br. 13). Appellant's argument is based on the Examiner's statement that Misra does not disclose the claimed *storage coupled to said target site*, and that Peinado fails to "disclose that a previously uploaded license is

available for reload to the client without additional contact with the license server." (App. Br. 9-11) (emphasis omitted).

We are not persuaded by Appellant's argument. First, Misra discloses a *license sales site* at the licensing clearinghouse 22, the *programming workstation* at the license server 28, and the *target site computer* at the client 30 (FF 1-4). Misra further discloses the claimed *storage coupled to said target site, said storage including a plurality of licenses received from said workstation* at license cache 136 (FF 5-7).

Furthermore, we find that Misra also discloses a process for upgrading licenses from an older version to a newer version and, as part of this upgrade process, the old license in cache 136 is replaced by the new license which is backward compatible with the old license (FF 8, 9). We find that whether old licenses are replaced or retained, based on whether new licenses for new software versions work or does not work with older versions of software, is not a patentable distinction. A backwards-compatible license is a license for a new software version that also permits use of an old software version on which the newer version is based. It is common sense that if a new software version license only operates on the new version, the old license must be retained to enable the new version to operate on top of the old version. The obvious and predictable alternative would be to make the new license backward compatible as taught by Misra. *KSR Int'l Co. v. Teleflex Inc*., 550 U.S. 398, 401 (2007) ("If a person of ordinary skill in the art can implement a predictable variation, and would see the benefit of doing so, § 103 likely bars its patentability."). We therefore find that claim 6 is obvious over Misra, and find Peinado's disclosure is cumulative.

Since our analysis of the references differs from that of the Examiner, we designate our affirmance as a new rejection under 37 CFR § 41.50(b).

Claims 9 and 10

We affirm the rejection of claims 9 and 10. Appellant does not separately argue claim 10 that depends from claim 9. We select claim 9 as representative and claim 10 falls therewith. *See* 37 C.F.R. § 41.37(c)(1)(vii). Claim 9 recites, *inter alia*, "a summary of proposed modifications which will result from a reload of said previously uploaded license."

The Examiner relied on Stupek to disclose this limitation (Ans. 7-8). Appellant argues that Stupek does not disclose this limitation because "a 'summary of proposed modifications' is quite different than 'the reasons for an upgrade'" (App. Br. 14).

We are not persuaded by Appellant's argument. The limitation of *a summary of proposed modifications* in claim 9 is non-functional descriptive material because it describes data content that is part of claim 6 and which is not itself a structural component. Misra discloses information about licenses stored in the *storage* (FF 10), and thus discloses that it stores content at least similar to *a summary of proposed modifications*, thus meeting the claim 9 requirement.

Claims 19 and 20

We also affirm the rejection of claims 19 and 20. Appellant does not separately argue claim 20 that depends from independent claim 19. We select claim 19 as representative and claim 20 falls therewith. *See* 37 C.F.R. § 41.37(c)(1)(vii).

The Examiner found that Misra discloses the limitations of claim 19, except for the *displaying*, *viewing*, and *selecting* requirements, which the Examiner found in Klave (Ans. 9-10).

Appellant first argues, "Klave does not discuss the ability to reload a previously uploaded software site license corresponding to a software application, nor does the Examiner recite any specific passages of Klave to support that it does." (App. Br. 16).

Appellant's argument is not well taken because Appellant is attacking the references individually when the rejection is based on a combination of references. *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981). The Examiner found that Misra discloses *executing*, *coupling*, *applying*, and *updating*, and relied on Klave for the *displaying*, *viewing*, and *selecting* limitations (Ans. 9-10). Therefore, Appellant's argument as to Klave is unpersuasive.

Additionally, claim 19 does not require "the ability to reload a previously uploaded software site license" because this language only appears in the preamble, but not in the body of the claim. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co*., 182 F.3d 1298, 1305 (Fed. Cir. 1999). Therefore, Appellant's argument as to reloading is unpersuasive because the reloading is not required in the body of the claim, because the claim does not limit from where the license was *uploaded*.

Nonetheless, even if this were not the case, we find Misra discloses that licenses are uploaded to the *programming workstation ... from said sales site* (FF 3), which we construe as an *uploaded license* that meets the claim requirement.

Appellant further argues, "Misra does not teach storing licenses locally at the client, but rather discloses that the license server must forward the previously uploaded license to the intermediate server which then passes it on to the client." (App. Br. 16). We disagree because Misra discloses storing a plurality of licenses "locally at the client" at cache 136 (FF 10).

Claim 23

Dependent claim 23 recites, *inter alia*, "wherein said plurality of stored licenses comprises a predetermined number of licenses and as a new license is added an older license is deleted."

Appellant argues, the "Examiner cites Misra Figure 8 and Table 1 for support of this limitation. A review of Figure 8 and Table 1 fails to provide any support for the limitation . . ." (App. Br. 16). We are not persuaded by Appellant's argument. Misra discloses a predetermined number of licenses are stored (FF 14) and that, in normal operation, when a license is upgraded the older, lower-level license is replaced (FF 8), thus meeting the claim requirements.

Claims 21 and 22

We affirm the rejection of claims 21 and 22. Appellant does not separately argue claim 21. We select claim 22 as representative and claim 21 falls therewith. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Claim 21 recites, *inter alia*, "generating a summary of proposed modifications which will result from applying said previously uploaded

license at said target and displaying said summary." This is similar to the system of claim 9, which recites the component of the "summary."

Appellant argues claim 21 based on the arguments presented with respect to claims 9 and 10 (App. Br. 13, 17). We are not persuaded of error in the Examiner's rejection because while the method of claim 21 requires *generating* and *displaying summary* information about a software upgrade, the information in the summary is non-functional descriptive material that does not affect the process of *generating* and *displaying a summary*. Moreover, Stupek discloses an upgrade advisor component that presents/displays a report with an explanation of reasons for a software upgrade (FF 16), meeting the claim requirement.

CONCLUSIONS OF LAW

The Examiner did not err in rejecting claims 6-8 under 35 U.S.C. § 103(a) over Misra and Peinado.

The Examiner did not err in rejecting claims 9 and 10 under 35 U.S.C. § 103(a) over Misra, Peinado, and Stupek.

The Examiner did not err in rejecting claims 19, 20, and 23 under 35 U.S.C. § 103(a) over Misra, Peinado, and Klave.

The Examiner did not err in rejecting claims 21 and 22 under 35 U.S.C. § 103(a) over Misra, Klave, and Stupek.

DECISION

For the above reasons, the Examiner's rejection of claims 6-10 and 19-23 is AFFIRMED, and we designate our affirmance as containing a new ground of rejection.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record . . . .

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).

AFFIRMED; 37 C.F.R. § 41.50(b)

nlk