

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JAKOB NIELSEN

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Appeal No. 2001-0331  
Application No. 09/122,982

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ON BRIEF

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Before THOMAS, JERRY SMITH, and LEVY, Administrative Patent Judges.  
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-4, 9-11, 13-16, 21-23, 25-28, 33-35, and 37<sup>1</sup>.

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<sup>1</sup> The rejection of claims 5-8, 17-20, and 29-32 under 35 U.S.C. § 103(a) has been withdrawn by the examiner (answer, page 3).

BACKGROUND

Appellant's invention relates to a method and system for escrowed backup of hotelled World Wide Web sites. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced as follows:

1.<sup>2</sup> A method executed in a computer system for facilitating storage of a backup copy of data for a client company, the computer system including a host computer system which stores a native copy of data and an escrow computer system, the escrow computer system including a security mechanism for preventing unauthorized access to the escrow computer system from the host computer system, the method comprising the steps of:

using the host computer system for automatically,  
storing the native copy of the data in a file;  
converting the file into a format that can be emailed; and  
sending the converted file to the escrow computer as an email message.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Hoffman et al. (Hoffman)                    5,613,012                    March 18, 1997

"Pegasus For Windows", Shareware, 1996

"Using Netscape 2" (Netscape 2), 2nd Ed.; P. 287, 330, 1995

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<sup>2</sup> As noted by appellant (reply brief, pages 6 and 7), a correct copy of the appealed claims is appended to the reply brief.

Claims 1-11, 13-23, and 25-35 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 1-4, 9-11, 13-16, 21-23, 25-28, 33-35, and 37 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Hoffman or Netscape 2 or Pegasus<sup>3</sup>.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 13, mailed May 17, 2000) for the examiner's complete reasoning in support of the rejections, and to appellant's brief (Paper No. 12, filed April 14, 2000) and reply brief (Paper No. 16, filed August 2, 2000) for appellant's arguments thereagainst. Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered. See 37 CFR 1.192(a).

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<sup>3</sup> The examiner (answer, page 5) additionally objects to the specification under 37 CFR § 1.75(d)(1) and MPEP § 1302.01, and objects to the drawing under 37 CFR § 1.83(a) as failing to fully illustrate the claims. These objections are reviewable by way of petition to the Commissioner, and are not properly before the Board; see MPEP Eighth Edition, Revision 1, § 706.01, (Feb. 2003).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of indefiniteness and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we affirm-in-part. We begin with the rejection of claims 1-11, 13-23, and 25-35 under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

The examiner's position (answer, page 4) is that the term "automatically" is not clearly supported in the original disclosure. The examiner states that the term does not constitute new matter, but that the claims are vague and

indefinite as the term is not defined or clear from the specification, as required by 37 CFR 1.75(d)(1). The examiner acknowledges (answer, page 5) that "[t]he term, though, appeared to have some support with a reading of the text relating to Fig. 2."

Appellant asserts (brief, page 4) that the system uses cron files, and that once the cron files are set up, the computer system automatically executes the cron files, providing clear support for the term "automatically." Appellant (reply brief, page 3) refers to page 656 of "A User Guide to the Unix System<sup>4</sup>, Second Edition," © 1985) for an explanation of a cron file. It is further argued (reply brief, page 4) that the term automatically is being used in its ordinary meaning, and that since one of ordinary skill in the art would understand the intended meaning of the term "automatically," there is no reason why the word needs to be in the specification.

We find that appellants' specification (page 12) discloses that the steps of figure 2 are typically initiated by a background process which accesses a cron file. A cron file maintains a list of routines that should be run by the computer,

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<sup>4</sup> At the request of the Board, a copy of this document has been provided to the Board by appellant, and placed in the application file.

as well as an indication of when the routines should be run. For example, a cron file may contain an entry that the backup routine should be run at specified intervals. In step 201 (figure 2), the backup process stores the client's data into a file. The data to be stored comprises the client's web site. In step 203 (page 26), the backup routine encrypts the file containing the client's data. In steps 205 and 207, the source identifier is obtained and a checksum operation is performed on the encrypted file to create a meta-file. In step 211, the backup routine converts the meta-file into a format that can be e-mailed to the escrow computer 150. The backup routine executes the "uuencode" command to accomplish this task.

From our review of appellants' specification, we find that the term automatic refers to the backup of data, conversion of the file into a format for e-mailing, and e-mailing the file to the escrow computer, without intervention by the user. 37 CFR § 1.75(d)(1) sets forth, in part, that:

The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description (underlining added).

From the language of 37 CFR § 1.75(d)(1), we find that the claim language requires either antecedent basis or clear support in the specification. From the portions of the specification referred to, supra, we find clear support in the specification for the term "automatically" found in appellants' claims, and accordingly, find the claim language to be definite within the meaning of 35 U.S.C. § 112, second paragraph. We therefore reverse the rejection of claims 1-11, 13-23, and 25-35 under 35 U.S.C. § 112, second paragraph.

We turn next to the rejection of claims 1-4, 9-11, 13-16, 21-23, 25-28, 33-35, and 37 under 35 U.S.C. § 103(a) as unpatentable over Hoffman or Netscape 2 or Pegasus.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion

or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

We begin with claim 1. The examiner's position (answer, pages 3 and 4) is that in the three reference, the execution of E-mail transmission is done fairly "automatically" by appropriate actuation of software by an operator. The examiner asserts that Hoffman teaches the encryption of an e-mail message, and that

other information can be attached to the message. Pegasus teaches that any message and file may be sent to any other computer for any purpose. The examiner asserts (answer, page 4) that "[T]he present claims do not distinguish over the generic use of this known software e-mail function for sending any file attached to an e-mail message, where the operation can be loosely characterized as having steps done "automatically." Netscape teaches RSA encryption of all of its transmissions which include file attachments with coding preferences, which include e-mail. Netscape further teaches the ability of a firewall to be penetrated by e-mail. It is asserted (id.) that it would have been obvious to send an encrypted message or a copy of a file from a source computer to another computer, and to consider any backup computer as an escrow computer. The examiner additionally argues (answer, page 4) that:

Many programs periodically back-up data automatically, but that is not claimed, and alone it would read on some of the first Windows version's of Word and Word Perfect. Thus, it would have been obvious to have periodically executed back-up routines on some data manually, to the extent that the automatic nature of some of its software functions are not of concern here. To further e-mail such is within the realm of e-mailings per se found in the three references.

Appellant asserts (brief, pages 5 and 6) that:

Although the cited references may teach basic email functions, none of these references teach an escrow computer nor disclose or suggest automatically storing a native copy of the data in a file, converting the file into a format that can be emailed, and sending the converted file to an escrow computer as an email message. In addition, each reference requires user intervention, thus they are not automatic.

It is further argued (id.) that the examiner fails to provide any suggestion to modify the references to teach each and every element in the claims. It is argued (brief, page 6) that:

In **claim 1**, a method executed on a host computer system automatically stores a native copy of the data in a file, converts the file into a format that can be emailed, and sends the converted file on an escrow computer as an email message. The cited art fails to disclose or suggest these steps. Moreover, user intervention is not required to operate the transmission of the email message, as required by the cited art.

Appellant further asserts (reply brief, page 5) that none of the references performs the automatic functions as recited in claim 1. With respect to the examiner's assertion that many programs periodically back-up data automatically, it is additionally argued that the cited word-processing programs do not send a converted file to another computer as an e-mail message.

We find that Hoffman (col. 6, lines 9-15) is directed to "an improved identification system for determining an individual's

identity from a comparison of an individual's biometrics sample and personal identification code gathered during a bid step with biometrics sample and personal identification code for that individual gathered during a registration step and stored at a remote site wherein there is a data processing center." Hoffman discloses the use of e-mail including encryption of messages (col. 33, lines 25-68), with public and private keys (col. 31, lines 27-30), and electronic signatures (col. 31, lines col. 32, line 65 through col. 33, line 14). Netscape 2 discloses (page 287) that some fire walls allow e-mail traffic, which limits security to "mail bombs" and other e-mail based attacks. Netscape 2 also discloses encryption (page 288) and storing copies of outgoing messages (page 330). Pegasus discloses encryption of e-mails as well as automatically sending a copy of the message to the sender. It is disclosed that Pegasus will remember your preferences from one session to the next. Thus, we find that the references generally teach the use of e-mail with encryption of the data sent.

As stated by the court in In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) "[t]he name of the game is the claim." Claims will be given their broadest reasonable interpretation consistent with the specification, and

limitations appearing in the specification are not to be read into the claims. In re Etter, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. cir. 1985). We find that claim 1 recites "using the host computer system for automatically, storing the native copy of the data in a file; converting the file into a format that can be emailed; and sending the converted file to the escrow computer as an email message." From the language of claim 1, we find that the claim requires automatically performing each of the three recited steps. Although we find that the automatic file back-ups of the word processor programs referred to by the examiner will automatically store a native copy of the data in a file when executing an automatic backup routine, we find that neither the word processor programs nor the references automatically perform the steps of "converting the file into a format that can be e-mailed; and sending the converted file to the escrow computer as an e-mail message." Although we agree with the examiner that these two steps can be performed by the systems of Hoffman, Netscape 2, or Pegasus, we find that in the references applied by the examiner, these steps are not automatically performed, but rather are initiated by the operator of the system. The term "automatically" cannot be ignored.

We are not persuaded by the examiner's assertion (answer, page 4) that "the operation can be loosely characterized as having steps done automatically." The fact that the reference "may be loosely characterized" by the examiner as "automatically" performing the recited steps is insufficient to meet the claimed subject matter. For the reasons set forth, supra, with respect to the claim construction of claim 1, we find that the references do not provide automatic converting of the file into a format that can be e-mailed; and sending the converted file to the escrow computer as an e-mail message, as asserted by appellant. Accordingly, the rejection of claim 1, and claims 2-4 and 9-11, dependent therefrom, under 35 U.S.C. § 103(a) is reversed.

We turn next to independent claims 13 and 25. Appellant asserts (brief, page 8) that with respect to claim 13 that:

In **claim 13**, a computer program executed in a computer system uses code which automatically stores a native copy of the data in a file, converts the file into a format that can be emailed, and sends the converted file to an escrow computer as an email message. The cited art fails to disclose or suggest these steps. Moreover, user intervention is not required to operate the transmission of the email message, as required by the cited art.

Appellant further asserts (brief, page 10) that with respect to claim 25 that:

In **claim 25**, a computer system has mechanisms configured to automatically stores a native copy of the data in a file, converts the file into a format that can be emailed, and sends the converted file to an escrow computer as an email message. The cited art fails to disclose or suggest these steps. Moreover, user intervention is not required to operate the transmission of the email message, as required by the cited art.

From our review of claims 13 and 25, we find that appellant's arguments are not commensurate with the language of independent claims 13 and 25. In contrast to claim 1, which required that the system automatically performed the three recited steps of "using the host computer system for automatically, storing the native copy of the data in a file; converting the file into a format that can be emailed; and sending the converted file to the escrow computer as an email message," claim 13 requires "automatically making a back-up copy of data for a client company" in the preamble, and does not require that the three later recited code operations are automatically performed. Giving weight to the preamble, the claim language requires automatically making a back-up copy but does not require "code that stores the native copy of the data in a file; code that converts the file into a format that can be emailed; and code that sends the converted file to the escrow

computer as an email message." Similarly, claim 25 does not require that the apparatus includes a mechanism automatically "configured to store the native copy of the data in a file; configured to convert the file into a format that can be emailed; and configured to send the converted file to the escrow computer as an email message." We find that the automatic back-up in the word processor programs referred to by the examiner will automatically make a back-up copy of a file. Appellant does not dispute the examiner's assertion that automatic file backup programs are known. The apparatuses of the references will carry out the recited limitations when directed to do so by the user. In addition, we agree with the examiner that a computer receiving the e-mail can be considered as being an escrow computer. Appellant has not argued any specific definition of an escrow computer that would not be met by a back-up computer. In sum, we find that appellant's assertion that the claims recite code or a mechanism for "automatically" storing the native copy of the data in a file; converting the file into a format that can be emailed; and sending the converted file to the escrow computer as an email message," to be inconsistent with the language of independent claims 13 and 25. Accordingly, the rejection of claims 13 and 25 under 35 U.S.C. § 103(a) is affirmed.

We turn next to dependent claims 14-16 and 26-28. Each of these claims deal with encryption/decryption of data. Appellant asserts (brief, page 8) that the references do not show the specific limitations of these claims. We make reference to our findings, supra, with respect to the teachings of Hoffman concerning encryption, and public and private keys, and affirm the rejection of claims 14-16 and 26-28 under 35 U.S.C. § 103(a) as suggested by Hoffman. We find Netscape 2 and Pegasus to be cumulative.

We turn next to the rejection of claims 21 and 33. Each of these claims recite that the data is one or more files of web pages. From the disclosure of Hoffman of using internet e-mail for electronic documents (col. 57, lines 21 and 22), we find that Hoffman teaches that the data files can be web files. Accordingly, we find that Hoffman teaches or suggests the language of claims 21 and 33, and that the references to Netscape 2 and Pegasus are cumulative. The rejection of claims 21 and 33 under 35 U.S.C. § 103(a) is therefore affirmed.

We turn next to claims 22 and 34. These claims recite that the codes or mechanisms that store invoke a tar command to package the data into one file. Although the use of tar commands are old, and Hoffman discloses sending document text in one or

more parts, we find no teaching or suggestion, and none has been brought to our attention by the examiner, that would have suggested to an artisan packaging data into one file.

Accordingly, the rejection of claims 22 and 34 under 35 U.S.C. § 103(a) is reversed.

We turn next to the rejection of claims 23 and 35. These claims recite that the code or mechanism that converts the file to a format that can be e-mailed invokes a uuencode command. We take notice of the fact that the uuencode command is old and well known for converting files into a format for e-mailing. In view of the teachings of Hoffman, Netscape 2, and Pegasus of sending files by e-mail, we find that an artisan would have been motivated to use the uuencode command which is commonly used for formatting files for e-mail<sup>5</sup>.

We turn next to independent claim 37. Appellant asserts (Brief, page 12) that:

In **claim 37**, a method periodically initiates a routine for periodically initiating a routine for backing up data at specified intervals, stores a native copy of the data in a file, converts the file into a format that can be emailed, and sends the converted file to an escrow computer as an email message. The cited art fails to disclose or suggest these steps. Moreover, user intervention is not

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<sup>5</sup> Microsoft Press, Computer Dictionary, Third Edition, 1997. A copy of the relevant page is attached to this decision.

required to operate the transmission of the email message, as required by the cited art.

For the reasons set forth, supra, with respect to claims 13 and 25, we find that claim 37 does not recite how the routine is initiated and does not preclude user intervention to operate the transmission of an e-mail message. We additionally find that the automatic file back-up of the word processing programs referred to by the examiner will periodically initiate a routine for backing up data at specific intervals. The data in the format used by the word processing program will be in native format, and will inherently be stored in a file. Upon e-mailing the file, the file will be converted into a format that can be e-mailed. The computer the data is e-mailed to can be considered a backup computer. Thus, we find that the prior art references to Hoffman and Netscape 2 establish a prima facie case of obviousness that has not been successfully been rebutted by appellant, and that the reference to Pegasus is cumulative. Accordingly, the rejection of claim 37 under 35 U.S.C. § 103(a) is affirmed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-11, 13-23, and 25-35 under 35 U.S.C. § 112, second paragraph is reversed. The rejection of claims 1-4 and 9-11, 22 and 34 under 35 U.S.C. § 103 is reversed. The rejection of claims 13, 21-23, 25-28, 33 35, and 37 under 35 U.S.C. § 103(a) is affirmed. No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136 (a).

AFFIRMED-IN-PART

JAMES D. THOMAS	)	
Administrative Patent Judge	)	
	)	
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	)	
	)	BOARD OF PATENT
JERRY SMITH	)	APPEALS
Administrative Patent Judge	)	AND
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STUART S. LEVY	)	
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