

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte VAUGHN SCOTT IVERSON and JOHN WHITLEY RICHARDSON

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Appeal No. 2003-0325  
Application No. 08/775,077

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ON BRIEF

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Before RUGGIERO, DIXON, 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 1-8 and 14-17, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to a method and apparatus for authenticating information. An understanding of the invention

can be derived from a reading of exemplary claim 1, which is reproduced as follows:

1. An automatically-authenticating information object embodied in a computer-readable storage medium accessible from a first computer, said automatically-authenticating information object comprising:

an information segment to be authenticated;

an authenticator address corresponding to a predetermined authenticator resident on a second computer, the predetermined authenticator comprising an application configured to perform authentication of the information segment; and

a set of instructions for automatically authenticating the information segment when an attempt is made to access said information segment, said set of instructions including instructions for establishing a communications link between said automatically-authenticating information object on said first computer and said predetermined authenticator on said second computer using said authenticator address, transmitting an authentication request from the automatically-authenticating information object to said predetermined authenticator, receiving a responsive communication from said predetermined authenticator, and permitting the information segment to be accessed if the responsive communication indicates that the information segment is authentic.

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

|                            |           |              |
|----------------------------|-----------|--------------|
| Haber et al. (Haber)       | 5,136,646 | Aug. 4, 1992 |
| Graziano et al. (Graziano) | 5,191,613 | Mar. 2, 1993 |
| Loucks et al. (Loucks)     | 5,481,720 | Jan. 2, 1996 |

Claims 1, 5, 14 and 16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Loucks.

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Loucks in view of Haber.

Claims 3, 4 and 6-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Loucks in view of Graziano.

Claims 15 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Loucks.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 29, mailed June 14, 2002) for the examiner's complete reasoning in support of the rejections, and to appellants' brief (Paper No. 28, filed April 3, 2002) and reply brief (Paper No. 30, filed July 11, 2002) for appellants' arguments thereagainst. Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered. See 37 CFR 1.192(a).

#### 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 anticipation and obviousness relied upon by the examiner as support for the rejections. We

have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' 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 reverse, essentially for the reasons set forth by appellants. We begin with the rejection of claims 1, 5, 14 and 16 under 35 U.S.C. § 102(b) as being anticipated by Loucks.

To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). As stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting Hansgirg v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939))

(internal citations omitted):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

The examiner's position is set forth on pages 4-6 of the examiner's answer. Specifically, the examiner asserts (answer, page 4) that service 514 of Loucks relates to applicants'

object, and that authentication agent 512 of Loucks relates to appellants' authentication agent. Appellants assert (brief, page 5) that Loucks is silent as to an information object including an information segment, and (brief, page 6) that:

There is no information object that automatically establishes communications with a predetermined authenticator for the purpose of authenticating an information segment. Authentication in Loucks does not occur as a result of an attempt to access an information segment in an automatically-authenticating information object, but rather as a result of the first computer directing a service request to a known service provider.

It is further argued (id.) that:

Applying the Examiner's rationale, this would require that the authentication agent 512 of Loucks be configured to authenticate the service 514. However, the authentication agent 512 of Loucks is instead configured to authenticate that the requestor 504 is authorized to use the service 514.

and that (id.):

Loucks nowhere suggests that the service 514 invokes the authentication agent 512 for the purpose of authenticating the service 514 itself.

From our review of Loucks, we find that Loucks is directed to providing authentication 502, 512 to enable a requestor 504 to access a service 514 (figure 5). As shown in the figure, a requestor 504 requests authentication from authentication agent 502 through messages 520. A second machine 513 contains a

service 514 that makes use of a second authentication agent 512.

Requestor 504 communicates with service 514 via request-for-

service request 411 and its reply 412 (col. 8, lines 35-49). In

addition (see figures 4-6), before a process at a first machine

503 begins to send a request 411, to use the services of a second

machine 513, an authentication procedure is performed. The

requesting process 504 sends a message 520 to the first

authenticating agent 502 at the first node to initiate

authentication. This message contains information 531 describing

the process making the request and information 532 identifying

the requested service. The first authentication agent 502 uses

the content of message 520 to construct a reply 521. Reply 521

contains authentication information and an authentication ack

534. The service receiving the request 411 passes the

authentication information to the authentication agent 512. In

message 524 sent from agent 512 to service 514, the agent places

a set of credentials 536 that describe the remote requestor in a

manner that is meaningful to the service 514. The service makes

a determination, based on the credentials on the authentication

and authorization of the requestor's permission to request an

operation 420 of the service 514. The results of the

determination are returned in a reply message 412. The requestor receives the reply 412 and extracts authentication ack 419 and compares it to authentication ack 534 previously received from local authentication agent 502. If the two acks are bitwise equal, the requestor is assured of the remote service's identity (col. 8, line 56 through col. 9, line 50).

From our review of Loucks, we do not agree with the examiner that service 514 can be considered to be the information object, because service 514 does not request service, but rather, allows requestor 504 to access the service 514. In addition, we agree with appellants (reply brief, page 2) that the service of Loucks does not include an information segment to be authenticated. Instead, it is to the service that the request for service is authenticated. We further agree with appellants (id.) that:

Nor can the service 514 correspond to the information segment according to the invention, since unlike the information segment, the service is not included in an information object, nor is it the subject of a request for authentication.

From our review of the examiner's position, we find that the examiner was cognizant that in Loucks, a requestor obtains authentication in order to obtain access to a service 514, and does not permit the information segment of the information object to be accessed if the responsive communication from the

authenticator indicates that the information segment is authentic, as required by claim 1. In an attempt to meet independent claims 1 and 8, the examiner appears to have adopted an interpretation of Loucks in which the examiner considers service 514 of Loucks to be the information object. However, this interpretation fails because in Loucks, the reply to the authentication determination is sent to the requestor, and permits the requestor to have access to service 514. In addition, service 514 does not include an information segment to be authenticated. The authentication process provides the requestor with access to the service. Since the service 514 does not request authentication, and does not include an information segment to be accessed upon successful authentication, Loucks does not anticipate claims 1 or 8. From all of the above, we find that the examiner has failed to establish a prima facie case of anticipation of claims 1 and 8. The rejection of claims 1, 5, 14 and 16 under 35 U.S.C. § 102(b) is therefore reversed.

In addition, we reverse the rejection of claims 2-4, 6-8, 15 and 17 because the examiner has not established the obviousness of independent claims 1 and 8 over Loucks, and has not established that the secondary references of Haber and Graziano make up for the basic deficiencies of Loucks. Accordingly, the

rejection of claims 2-4, 6-8, 15 and 17 under 35 U.S.C. § 103(a)  
is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims  
1, 5, 14 and 16 under 35 U.S.C. § 102(b) is reversed. The  
decision of the examiner to reject claims 2-4, 6-8, 15 and 17  
under 35 U.S.C. § 103(a) is reversed.

REVERSED

|                             |   |                 |
|-----------------------------|---|-----------------|
| JOSEPH F. RUGGIERO          | ) |                 |
| Administrative Patent Judge | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
|                             | ) | BOARD OF PATENT |
| JOSEPH L. DIXON             | ) | APPEALS         |
| Administrative Patent Judge | ) | AND             |
|                             | ) | INTERFERENCES   |
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| STUART S. LEVY              | ) |                 |
| Administrative Patent Judge | ) |                 |

Appeal No. 2003-0325  
Application No. 08/775,077

Page 10

SSL/gjh

Appeal No. 2003-0325  
Application No. 08/775,077

Page 11

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APPEAL NO. 2003-0325 - JUDGE LEVY  
APPLICATION NO. 08/775,077

APJ LEVY

APJ RUGGIERO

APJ DIXON

DECISION: **REVERSED**

Prepared By:

**DRAFT TYPED:** 09 Feb 05

**FINAL TYPED:**