UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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Ex parte SYMON SZU-YUAN CHANG, JOSEPH S. SANFILIPPO JAYARAM RAJAN KASI and CHRISTOPHER CRALL

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Appeal No. 2006-1561
Application No. 10/246,276

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ON BRIEF

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Before JERRY SMITH, RUGGIERO, and SAADAT, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-31.

The disclosed invention pertains to a method for dynamic negotiation of security arrangements between web services.

Representative claim 1 is reproduced as follows:

1. A method of dynamically determining security options for exchange of at least one message between services, the message having one or more parts, the method including:

- providing machine readable security profiles for first and second services, wherein the security profiles identify a plurality of security elements that are acceptable to the respective services and the security elements include:
    - o requirements to sign one or more parts of the message;
    - o requirements to encrypt one or more parts of the message;
    - o one or more signing option subsets for the signing algorithm including a signing algorithm and to be applied to one or more parts of the message;
    - o one or more encryption option subsets for the encryption algorithm including an encryption algorithm to be applied to one or more parts of the message;
    - o one or more signature keys to use with the signature algorithm;
    - o one or more encryption keys to use with the encryption algorithm;

- at least one authentication algorithm to be applied to one or more parts of the message;

- accessing the security profiles and selecting a particular set of the security elements for the message that is acceptable to the respective services; and
- communicating the message between the respective services compliant with the particular option set.

The examiner relies on the following references:

Tseng et al. (Tseng)	U.S. Pat. 5,159,630	Oct. 27, 1992
Davis et al. (Davis)	U.S. Pat. 6,389,533	May 14, 2002

The following rejection is on appeal before us:

1. Claims 1-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Tseng in view of Davis.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

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

It is our view, after consideration of the record before us, that the evidence relied upon by the examiner does support the examiner's rejection of claims 1-31. Accordingly, we affirm.

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). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343. The examiner cannot

simply reach conclusions based on the examiner's own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313 (Fed. Cir. 2000). See also In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). 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 and the relative persuasiveness of the arguments. 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). 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 briefs have not been considered and are deemed to be waived. See 37 C.F.R. § 41.37(c)(1)(vii) (2004).

At the outset, we note that the primary Tseng reference is directed to a facsimile message encryption system wherein an encryption zone on a page is defined by boundary markers that can be designated by solid lines, dotted lines, edge marks, and the like, such that the boundary markers can be easily recognized by an image sensor [col. 3, lines 10-19]. Once the image sensor senses a boundary maker, all text following the boundary marker is encrypted using a specific algorithm or “key” until an end mark is sensed, at which time the transmitting machine resumes normal operation as a conventional facsimile machine [col. 3, lines 40-55]. Tseng discloses that the particular encryption algorithm employed may be as simple as a

random number generator or as complex as a data encryption standard (DES) [col. 3, lines 65-68]. On the receiving end, a protocol is transmitted between the transmitting and receiving facsimile machines to ensure that the receiving machine applies the proper decoding to the received encrypted messages [col. 4, lines 12-15].

We note that the secondary Davis reference is directed to an anonymity server system that encrypts addresses to protect the confidentiality of data in a response message without relying upon the integrity of a system operator [col. 1, lines 55-57 and 66]. The encrypted address is placed into an outgoing electronic message before re-routing to the target system to allow the target system to re-route the response back to the anonymity system [abstract]. Davis teaches a cryptographic device comprising a processor and a memory containing at least one key [col. 1, lines 61-63]. The anonymity server taught by Davis first determines whether a response to an incoming electronic message is requested [col. 1, lines 63-67, cont'd col. 2, lines 1-2]. If so, then the address of the system associated with the cryptographic device is encrypted with a key [col. 1, lines 66 and 67]. The encrypted address is placed into the outgoing electronic message response before transmission [col. 2, lines 1 and 2]. In particular, we note that Davis defines a "key" at col. 2, lines 58-64:

> A "key" is an encoding and/or decoding parameter such as, for example, public or private keys used by well-known or later established asymmetric key cryptographic

> functions or a secret key shared in confidence between the two electronic systems executing a well-known or later established symmetric key cryptographic function.

Davis also defines a "digital signature" at col. 2, lines 65-67, cont'd col. 3, lines 1-9:

> A "digital signature" is digital information encrypted with a private key of its signatory to ensure that the information has not been illicitly modified after being digitally signed. As a result, a digital signature authenticates the integrity of digital information provided in its entirety or as a digest produced by a one-way hash function. A "one-way hash function" includes a function, mathematical or otherwise, that takes information of a variable-length and converts it into a fixed-length result (referred to as a "digest"). The term "one-way" indicates that there does not readily exist an inverse function to recover any discernible portion of the original information from the digest.

We consider the examiner's rejection of claims 1-31 under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Tseng in view of Davis. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii), we consider the claims as they are separately argued in the briefs, instead of according to the particular grouping initially proposed by appellants in the brief [page 2] and later changed in the reply brief [page 15].

As per independent claim 1:

Appellants argue that the examiner has failed to provide an "evidentiary quality suggestion" that would motivate one of ordinary skill in the art to modify Tseng with Davis, and also that the combination of Tseng with Davis proffered by the examiner would change Tseng's principle of operation [brief, page 2]. Appellants argue that there is no mention in Tseng of e-mail and there is no mention in Davis of facsimile machines [brief, page

3]. Appellants further argue that the examiner has impermissibly used hindsight to combine the teachings of Davis with Tseng [brief, page 7].

The examiner responds that one of ordinary skill in the art would have been motivated to combine Davis with the teaching of Tseng because, as Davis discloses at col. 6, lines 57-60, the digital signature guarantees the identity of the sender which is an imperative and highly useful feature when sending a confidential message from one party to the next [answer, page 4]. The examiner argues that Davis relates to providing electronic messages transmitted between two electronic systems (col. 2, lines 38-42), and not just specifically to e-mails [answer, page 5]. The examiner further argues that a fax is an electronic message that is transmitted between two machines and, because both Tseng and Davis teach electronic communications, the principle of operation of Tseng would not be changed by modifying Tseng with the teachings of Davis [answer, page 5].

We note that the Court of Appeals for the Federal Circuit has determined that the motivation to combine under § 103 must come from a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor [emphasis added]. Ruiz v. A.B. Chance Co., 234 F.3d 654, 665, 57 USPQ2d 1161, 1167

(Fed. Cir. 2000). The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972); In re Dillon, 919 F.2d 688, 692-93, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991).

In the instant case, we note that the motivation proffered by the examiner is taken directly from the Davis reference [Davis, col. 6, lines 57-60; see also the final rejection, page 4, last paragraph, emphasis added]. Significantly, Davis explicitly discloses: "The optional digital signature 920 provides assurances to the original sender that the intended recipient is, in fact, responding to the electronic message" [col. 6, lines 57-60]. Therefore, we find that the motivation proffered by the examiner would compel an artisan at the time of the invention to modify Tseng with the teachings of Davis in order to provide the enhanced security that a digital signature provides.

We do not see how combining a digital signature as taught by Davis with Tseng would change Tseng's principle of operation, as argued by appellants. In contrast, modifying Tseng by adding a digital signature would clearly provide enhanced security. We agree with the examiner that Tseng

and Davis both broadly teach electronic communications between sending and receiving systems. As pointed out by the examiner, the system taught by Davis is not limited to e-mail communications [answer, page 5, line 6]. Davis explicitly discloses a wide variety of electronic sending and receiving systems at col. 3, lines 43-50:

> Each of the electronic systems 120_1 and 120_2 include a computer (e.g., portable, desktop, server, mainframe, network computer, etc.) or any other equipment accessible to communication link 110. Examples of the "other equipment" include, for example, a network television, a network printer, a telephone, a personal digital assistant and the like. In this embodiment, each electronic system 120_1 or 120_2 is uniquely addressed on communication link 110.

Appellants have pointed out that there is no mention in Tseng of e-mail and there is no mention in Davis of facsimile machines [brief, page 3]. Appellants appear to be arguing that Tseng and Davis cannot be combined because they are non-analogous references. The Court of Appeals for the Federal Circuit has set forth two criteria for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. In re Kahn, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), citing In re Oetiker, 977 F.2d 1443, 1447, 24 USPQ2d 1443, 1445-6 (Fed. Cir. 1992). Even assuming, arguendo, that e-mail communications and fax machine

communications may be construed as different fields of endeavor (as argued by appellants), we find that the Davis teaching of digital signatures is nevertheless reasonably pertinent to the particular problem with which the inventor [Tseng] is involved [emphasis added]. Tseng clearly is involved with the secure transmission of electronic facsimile transmissions where the security would be further improved by adding the enhanced feature of the digital signatures taught by Davis, as argued by the examiner [answer, page 4; see also Davis, col. 6, lines 57-60]. We therefore conclude that Davis is not excludable from consideration as non-analogous art. Accordingly, we agree with the examiner that modifying Tseng with the teachings of Davis would not change Tseng's principle of operation, and further, that an artisan would have been motivated to combine the analogous references of Tseng and Davis for essentially the same reasons argued by the examiner. Because the examiner has provided a proper motivation statement combining two analogous references, we do not agree with appellants that the examiner has impermissibly relied upon hindsight to reconstruct appellants' claimed invention.

Appellants argue that Tseng does not teach the claimed limitations of (1) providing machine-readable security profiles, (2) accessing the security profiles element, and (3) the communicating element [brief, page 4]. In

particular, appellants argue that Tseng does not teach "one or more encryption keys to use with the encryption algorithm," as claimed [id.]. Appellants further argue that Tseng does not teach a security profile that includes "one or more encryption option subsets" that are machine-readable [id.]. Appellants acknowledge that Tseng does teach the use of a key as part of an encryption algorithm, at col. 3, lines 47-49 [id.]. However, appellants argue that the key taught by Tseng is not part of a security profile, as claimed [id.]. Appellants further argue that Tseng's disclosure of using a modem negotiation protocol to assure that the receiving and sending machines use the same encryption algorithm (col. 4, lines 12-15, 27 and 28) is not the same as the claimed "security profile" [id.].

With respect to "accessing the security profiles and selecting a particular set of the security elements for the message that is acceptable to the respective services" [claim 1], the examiner notes that messages found in the encryption zones of each type of boundary markers are what will be encrypted for transmission [answer, page 7]. The examiner argues that successful communication necessarily requires agreement between the sender and the receiver with respect to a particular encryption/decryption scheme, i.e., both sender and receiver must know what type of boundary or security profile was used with the message [id., emphasis added]. Significantly, the examiner notes that the claimed "security profiles" broadly

read upon the particular encryption/decryption algorithm chosen by the user, as disclosed by Tseng at col. 3, lines 60-68 [id.].

We agree with the examiner that the claimed "security profiles" broadly read upon the particular encryption/decryption algorithms selected by the user. Clearly, successful transmission and reception of an encrypted fax requires both the sending and the receiving machines to know the particular encryption algorithms (i.e., corresponding to the claimed "security profiles"), as disclosed by Tseng in col. 3, lines 60-68, and further in col. 4, lines 1-40 that particularly describe the receiving/decoding process [emphasis added].

Appellants further argue that Tseng does not teach a security profile that includes "one or more encryption option subsets that are machine-readable" [brief, page 4]. The examiner disagrees, noting that the disputed limitation actually requires: "one or more encryption option subsets for the encryption algorithm including an encryption algorithm to be applied to one or more parts of the message" [answer, page 8; see also claim 1]. The examiner further notes that the passage in Tseng relied upon to meet this limitation is located at column 3, lines 60-68, which as appellants point out, describes a plurality of user-selectable encryption algorithms [answer, page 8, see also brief at page 4]. The examiner emphasizes that the cited passage states that the encryption algorithms are user-selectable [id.; see

also Tseng at col. 3, line 61, emphasis added]. The examiner further notes that the limitation of "one or more encryption option subsets" is recited in claim 1 as being a part of a "security element'', and is not claimed as part of a "security profile" [answer, page 8, see claim 1]. We note that the argued limitation of "machine-readable" [brief, page 4, ¶2, line 3] is not explicitly claimed with respect to the recited "security elements" and we further agree with the examiner who observes that when a user [of Tseng's invention] chooses an encryption algorithm, the fax machine must be able to read the user's selection and the machine must be able to read from memory the steps to execute the chosen encryption algorithm [answer, page 8, emphasis added]. Accordingly, we agree with the examiner that Tseng does teach "one or more encryption option subsets for the encryption algorithm including an encryption algorithm to be applied to one or more parts of the message," as claimed, for essentially the same reasons argued by the examiner.

Appellants argue that the "key" disclosed by Tseng as part of an encryption algorithm (col. 3, lines 47-49), is not part of a security profile [brief, page 4]. We disagree, as we have found supra that the particular encryption algorithms known by the sending and receiving machines correspond to the recited security profiles [emphasis added]. We note that Davis also discloses the use of a "key," as discussed supra. Likewise, we

find that a broad but reasonable interpretation of the claimed "security profiles" reads upon Tseng's disclosure of using a modem negotiation protocol to ensure that both the sending and receiving machines use the same encryption algorithm, as necessary to effect communications [Tseng, col. 4, lines 12-15, 27 and 28]. Therefore, we agree with the examiner that Tseng teaches (1) providing machine-readable security profiles, and (2) accessing the security profiles element, for essentially the same reasons argued by the examiner.

With respect to element (3) i.e., the communicating element, we note that appellants have merely asserted that the limitations of "communicating the message between the respective services compliant with the particular option set, selected after reviewing the respective security profiles" are not taught by the Tseng reference [answer, page 4, ¶5, emphasis added]. In particular, we note that the argued language: "selected after reviewing the respective security profiles" is not claimed [claim 1, emphasis added]. A basic canon of claim construction is that one may not read a limitation into a claim from the written description. Renishaw plc v. Marposs Societa' per Azioni, 158 F.3d 1243, 1248, 48 USPQ2d 1117, 1120 (Fed. Cir. 1998). Patentability is based upon the claims. "It is the claims that measure the invention." SRI Int'l v. Matsushita Elec. Corp., 775 F.2d 1107, 1121, 227 USPQ 577, 585 (Fed. Cir. 1985) (en banc). When making a patentability

determination, the claimed invention must be compared to the prior art [emphasis added].

We further note that appellants have failed to point out the specific distinctions believed to render this portion of the claim patentable over the applied references, as required by 37 C.F.R. § 1.111(b). A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of § 1.111(b). As discussed supra, arguments that appellants could have made but chose not to make in the briefs have not been considered and are deemed to be waived. See 37 C.F.R. § 41.37(c)(1)(vii) (2004).

In summary, with respect to independent claim 1, we agree with the examiner that the cited combination of Tseng and Davis teaches all the limitations of the claim. We further find that the examiner has provided a proper motivation statement combining two analogous references. Accordingly, we will sustain the examiner's rejection of independent claim 1 for essentially the same reasons argued by the examiner.

As per claim 2:

Appellants note that the examiner rejected claim 2 on the basis that a registry accessible to the first and second services is inherent in Tseng [brief, page 8]. Appellants argue that the menu and keyboard arrangement in Tseng (Fig. 1), and the modem negotiation protocol described in column 4 provide an alternative means of configuring the facsimile machines and therefore contradict any claim of inherency [id.].

In response, we agree with the examiner's reasoning, as set forth in the final rejection [page 5], that a broad but reasonable interpretation of claim 2 reads upon the common encryption protocol that necessarily must be accessible (e.g., inherently in memory, i.e., corresponding to the claimed "registry") to both machines for successful communications to occur [see Tseng col. 3, lines 56-68, see also col. 2, lines 12-15]. Accordingly, we will sustain the examiner's rejection of claim 2 for essentially the same reasons set forth in the final rejection [page 5].

As per claim 3:

Appellants argue that Tseng, at column 4, lines 22-30, refers to a modem negotiation protocol, which is not the same as a machine-readable default security profile [brief, page 12]. The examiner responds that within the cited passage [col. 4, lines 28-30], Tseng states: "The security level can

be designated, for example, in a designated place in an encryption zone" [answer, page 12]. We agree with the examiner that a broad but reasonable interpretation of the claimed "default security profile" reads upon the Tseng disclosure of the security level being designated at a designated place [col. 4, lines 22-30]. Likewise, we find that the claimed "default security profile" also reads upon the Tseng disclosure of an "agreed-upon series of digits" [col. 4, line 20], that inherently (i.e., necessarily) requires both sending and receiving machines to adopt a common designated (i.e., "default") security level for successful communications to occur between the two machines [emphasis added]. Accordingly, we will sustain the examiner's rejection of claim 3 for essentially the same reasons argued by the examiner.

As per claim 4:

Appellants argue that they do not find in the cited passages any notion of a registry defining individual parts of a message to be signed in either reference [brief, page 13]. Significantly, we note the argued limitation of a registry is not recited in claim 4, nor is a registry recited in independent claim 1 from which claim 4 depends [emphasis added]. We find that the examiner reasonably relies upon the digital signature taught by Davis as teaching the claimed "requirements to sign" [final office action, page 5].

Accordingly, we will sustain the examiner's rejection of claim 4 for essentially the same reasons set forth in the final rejection [page 5].

As per claims 5 and 8:

Appellants again restate their argument that it is not practical to combine e-mail signing taught by Davis with Tseng's facsimile machine [brief, page 9, ¶1]. We note that we have addressed this argument supra with respect to claim 1. Accordingly, we will sustain the examiner's rejection of claims 5 and 8 for essentially the same reasons set forth in the final rejection [pages 5 and 6].

As per claim 6:

Appellants argue that the Tseng reference, at column 3, lines 1-18, refers to marks on a piece of paper fed into a fax machine, and not to encryption requirements stored as machine-readable sender's and receiver's security profiles [brief, page 9]. We note that claim 6 recites: "wherein the requirements to encrypt are applied to individual parts of the message" [emphasis added]. We agree with the examiner that the encryption zones taught by Tseng at col. 3, lines 1-18, refer to individual parts (i.e., the encrypted portions) of the message, as explicitly shown in figures 2 and 3, as designated by "encrypted area." Accordingly, we will sustain the

examiner's rejection of claim 6 for essentially the same reasons set forth in the final rejection [page 6].

As per claims 7 and 9:

Appellants argue that the Examiner relies upon Davis to encrypt the entire facsimile transmission, instead of just the part designated by boundary markers on the paper [brief, page 9]. Appellants further argue that this combination would impermissibly change the principle of operation of Tseng, entirely contrary to Tseng's invention [id.]. We note that we have addressed this argument supra with respect to claim 1. We further note that Tseng alone teaches all the limitations of claims 7 and 9. We find that the teachings of Davis are cumulative to Tseng and unnecessary to support the rejection of claims 7 and 9. In particular, we find that because the Tseng reference broadly enables boundary markers to be defined at arbitrary places on a page, that Tseng provides for total page encryption at one extreme, or partial-page, or even no encryption [i.e., clean areas, col. 3, line 6] at the other extreme [see col. 3, boundary markers 37, and associated discussion, lines 11-43]. In affirming a multiple reference rejection under 35 U.S.C. § 103, the Board may rely on one reference alone in an obviousness rationale without designating it as a new ground of rejection. In re Bush, 296 F.2d 491, 496, 131 USPQ 263, 266-67 (CCPA 1961); In re Boyer, 363

F.2d 455, 458, n.2, 150 USPQ 441, 444, n.2 (CCPA 1966). Accordingly, we will sustain the examiner's rejection of claims 7 and 9 based upon the teachings of Tseng alone.

As per claims 16 and 31:

Appellants argue that Davis (at col. 3, lines 52-67) suggests using electronic messages to authenticate the anonymous remailing server before sending it an e-mail to remail [brief, page 9]. Appellants further argue that "combining this with Tseng is nonsense," as the physically combined facsimile machine and e-mail remailer would eliminate authentication between the fax and remailer, both on the sending end [id.]. Appellants again restate the argument that the combination proffered by the examiner improperly requires changing Tseng's principle of operation away from using a standard fax modem data stream [id.].

We note that we have previously addressed appellants' argument that modifying Tseng with the teachings of Davis changes Tseng's principle of operation [see claim 1, as discussed supra]. We note that claim 16 recites: "wherein the authentication algorithm includes submitting credentials accompanying the message for examination by the service receiving the message" [emphasis added]. We note that claim 31 further recites: "wherein the security profiles further include one or more resources used to

authenticate the service sending the message" [emphasis added]. We agree with the examiner that a broad but reasonable interpretation of the recited language for both claims 16 and 31 reads upon the Davis teaching of authentication as set forth by the examiner in the final rejection [final office action, page 10 (claim 16) and page 13 (claim 31); see also Davis, col. 7, lines 52-67, and col. 8, lines 1-11]. In particular, we note that the examiner relies upon Davis solely for the teaching of authentication [emphasis added]. Accordingly, we will sustain the examiner's rejection of claims 16 and 31 for essentially the same reasons argued by the examiner in the final rejection [pages 10 and 13].

As per claim 17:

Appellants argue that there is no notion in the Tseng reference of security profiles including preference statements [brief, pages 9 and 10, emphasis added]. Appellants point to Tseng at column 3, lines 56-68 and assert that the plurality of choices disclosed by Tseng does not meet the limitations recited in claim 17: i.e., "wherein the security profiles further include statements of preferences among the signing and encryption security elements and selecting the particular option subset takes into account the preferences of at least one of the services" [brief, pages 9 and 10]. In response, the examiner points out that the rejection on page 11 of the final

office action also relies upon col. 4, lines 27 and 28, in addition to col. 3, lines 56-68 [answer, page 14]. The examiner argues that the language of claim 17 broadly reads upon Tseng's user-selected encryption algorithms [col. 3, lines 56-68], and also Tseng's teaching of where the security level is designated in a designated place in an encryption zone [answer, page 14; see also Tseng, col. 4, lines 27 and 28]. We agree that these aspects of Tseng clearly take into account the preferences of at least one of the services, as claimed [emphasis added]. Therefore, we agree with the examiner that a broad but reasonable interpretation of claim 17 reads upon Tseng in the manner relied upon by the examiner. Accordingly, we will sustain the examiner's rejection of claim 17 for essentially the same reasons argued by the examiner.

As per claims 18 and 19:

Appellants note that Tseng at column 4, lines 19-30, explains that the selected security level will be the maximum level requested by either fax machine [brief, page 10]. Appellants argue that this does not meet a limitation that favors the preference of the service receiving the message [id., emphasis added].

In response, the examiner argues that in the cited passage [Tseng at column 4, lines 19-30], the security protocol is set up using the common highest level of security, not the highest security level requested by either fax machine [answer, page 15, emphasis added]. The examiner asserts that the preferences of both services are taken into consideration [id., emphasis added] and therefore Tseng's teaching of mutually acceptable security protocols meets the claim requirements of: "wherein selecting the particular option subset corresponds to the option subset that is acceptable to the respective services and most preferred by the service receiving the message" [claim 18, emphasis added]. The examiner submits that both claims 18 and 19 read upon Tseng's disclosure at column 4, lines 19-30, for this reason [answer, page 15]. We note that claim 19 recites: "wherein selecting the particular option subset corresponds to the option subset that is acceptable to the respective services and most preferred by the service sending the message" [emphasis added]. We agree with the examiner that both claims 18 and 19, when accorded a broad but reasonable interpretation, read upon Tseng's teaching of mutually acceptable security protocols, as argued by the examiner [emphasis added]. Accordingly, we will sustain the examiner's rejection of claims 18 and 19 for essentially the same reasons argued by the examiner.

As per claims 20-28 and 30:

Appellants argue that claims 18-28 and 30 [which include claims 20-28 and 30, and which all depend from claim 17], are allowable for at least the same reasons as claim 17 [brief, page 10]. Accordingly, because we have sustained the examiner's rejection of claim 17, we will sustain the examiner's rejection of claims 20-28 and 30 for the same reasons discussed supra with respect to claim 17.

As per claims 29-31:

Appellants argue that there is no concept in Tseng of a registry including resources used to implement a signature, encryption, and authentication [brief, page 10, emphasis added]. Appellants further argue that Tseng does not include either a registry or storage of resources in a registry [id., emphasis added].

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993). As pointed out by the examiner, both claims 29 and 31 are silent with respect to any recitation of "a registry" [answer, page 15, emphasis added]. We note that claims 29 and 31 both depend upon claim 1 and that claim 1 is

also silent respect to any recitation of "a registry" [emphasis added]. Similarly, claim 30 is silent respect to any recitation of "a registry" [emphasis added]. Claim 30 depends upon claim 17 that is also silent with respect to any recitation of "a registry" [emphasis added]. Claim 17 depends upon claim 1. We find that appellants are again impermissibly arguing limitations that are not claimed. Accordingly, we will sustain the examiner's rejection of claims 29-31 for the same reasons argued by the examiner.

As per claims 10-15 (not argued separately)

We note that appellants have argued separately all claims except dependent claims 10-15. Pursuant to our authority under 37 C.F.R. § 41.37(c)(1)(vii) (2004), we have selected claim 1 as the representative claim for dependent claims 10-15. We note that claims 10-15 all depend, either directly or indirectly, upon independent claim 1. Because we have sustained the examiner's rejection of claim 1, we will also sustain the examiner's rejection of dependent claims 10-15 for the same reasons as discussed supra with respect to independent claim 1.

In summary, we have sustained the examiner's rejection of all claims under appeal. Therefore, the decision of the examiner rejecting claims 1-31 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED.

Jerry Smith Administrative Patent Judge	)
Joseph F. Ruggiero Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
Mahshid D. Saadat Administrative Patent Judge	)

JS/sjc/eld

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