

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH C. LOWE, JONATHAN L. EDWARDS,
and SRIN N. KUMAR

Appeal 2007-1113
Application 10/876,523
Technology Center 2100

Decided: July 27, 2007

Before HOWARD B. BLANKENSHIP, ALLEN R. MACDONALD, and
JOHN A. JEFFERY, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1-9 and 11-20, the only claims pending in
this application. We have jurisdiction under 35 U.S.C. §§ 6(b), 134(a).

INTRODUCTION

The claims are directed to a system and method for enhancing computer network security. When a request is received to open a file on a local computer, it is determined whether the request is received from a local process operating on a local computer or from a remote computer. Such determination may be made for security purposes. (Abstract.) Claims 1 and 15 are illustrative:

1. A security method, comprising:
 - receiving a request to open a file on a local computer; and
 - determining whether the request is a local request received from a local process operating on the local computer or a remote request received from a remote computer coupled to the local computer via a network;
 - wherein the remote request is handled with more scrutiny with respect to the local request by at least one of denying the remote request to open the file and utilizing more virus signatures during scanning.

15. The method as recited in claim 1, wherein the security method is utilized to counter terrorism by preventing infection of cyber-frameworks with malware initiated by terrorists.

The Examiner relies on the following prior art references to show unpatentability:

Szor	US 2004/0168070 A1	Aug. 26, 2004
McIchionc	US 6,973,578 B1	Dec. 6, 2005

The rejections as presented by the Examiner are as follows:

1. Claim 15 is rejected under 35 U.S.C. §§ 101 and 112, 2nd ¶.
2. Claims 1-5, 13, 14, 16-18, and 20 are rejected under 35 U.S.C. § 102(e) as being anticipated by McIchionc.

3. Claims 6-9, 11, 12, and 19 are rejected under 35 U.S.C § 103(a) as unpatentable over McIchionc and Szor.

OPINION

Claim 15

The Examiner submits:

Claim 15 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131,149 USPQ 475 (D.D.C. 1966).

(Answer 3.)

Dunki and *Clinical Products* each addressed a claim drawn to the “use” of a composition of matter. We find the cases inapposite. In this case, claim 15 is drawn to specific application of a method, and incorporates the process steps set forth in base claim 1 – a claim whose recitation of statutory subject matter is undisputed. Claim 15 merely recites a “wherein” clause to further limit the process recited in claim 1. As the Examiner has failed to demonstrate that claim 15 is not a proper process claim under 35 U.S.C. § 101, we do not sustain the rejection.

Nor do we sustain the rejection of the claim under § 112, 2nd ¶ for indefiniteness. The function of claims is (1) to point out what the invention is in such a way as to distinguish it from the prior art; and (2) to define the scope of protection afforded by the patent. *In re Vamco Machine & Tool, Inc.*, 752 F.2d 1564, 1577 n.5, 224 USPQ 617, 635 n.5 (Fed. Cir. 1985). The legal standard for definiteness is whether a claim reasonably apprises

those of skill in the art of its scope. *In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). The inquiry is merely to determine whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). The definiteness of the language employed must be analyzed -- not in a vacuum, but in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. *Id.*

As we have noted, claim 15 simply recites a “wherein” clause with the intent of further limiting the process recited in claim 1. Claim 15 is drawn to a process but does not need to set forth any active process steps, as those are set forth by base claim 1. Further, we agree with Appellants that, contrary to the statement of the rejection, the claim does not purport to discover *how* an attack is initiated by terrorists, nor does the method *only* prevent attacks initiated by terrorists. The claim would be infringed if the method of claim 1 prevented infection of cyber-frameworks with malware initiated by terrorists.¹

Claims 1-5, 13, 14, 16-18, and 20

Claims 1-5, 13, 14, 16-18, and 20 stand rejected under § 102(e) as being anticipated by McIchionc. Based on Appellants’ remarks in the Brief,

¹ The Examiner’s rejection is not based on perceived difficulty in determining what may constitute a “terrorist.” In any event, the Specification (at 13) provides a definition of a “terrorist” in the context of the instant invention.

we will consider claim 1 as representative in our review of the § 102 rejection. (*See* 37 C.F.R. § 41.37(c)(1)(vii)).

McIchoinc describes a method (Fig. 2) of computer virus scanning. In step 202, an indication is first received that a file is being accessed by a process. The indication that a file is being accessed may be accomplished by a file call command “or by any other technique known in the art.” (McIchoinc col. 3, ll. 56-61). The “accessing” of files may include opening, reading, executing, indexing, organizing, editing, or moving the files. (Col. 3, l. 62 - col. 4, l. 9).

McIchoinc Figure 2 and Figure 4 further demonstrate that different virus detection actions may be taken based on the type (category) of process that may be accessing the files. In particular, an action may be based on the user of the process accessing the files, with further discrimination based on the location of the user; e.g., whether at a local or a remote console. (McIchoinc col. 5, ll. 3-31).

Appellants argue in the briefs that an indication that a file is being accessed by a process is not “receiving a request to open a file on a local computer” as recited in claim 1. The claim does not specify what generates or what receives the “request” to open a file. We find that the interception of a file call command (to open a file), as described by the reference, is receiving a request to open a file on a local computer, within the meaning of claim 1. Moreover, Appellants’ arguments carry less weight when we compare an operating system described by the reference (col. 3, ll. 45-48) with Appellants’ description of how a file is opened in such an operating system (Specification 2: final ¶ - 3: 10). In McIchoinc, the file call

command to open a file is intercepted before an operating system kernel processes the command.

To demonstrate anticipation of instant claim 1, the Examiner chooses to show the alternative of “utilizing more virus signatures during scanning” for the function of the remote request being handled with more scrutiny with respect to the local request. A reasonable inference may be drawn from the reference that heightened scrutiny (e.g., checking for more virus signatures) is to occur during scanning for a remote request, since McIchoinc distinguishes between local and remote requests. Moreover, the description of actions in Table 1 (col. 6) of the reference and column 6, lines 55 through 62, upon which the Examiner relies, provides further support for the Examiner’s finding that the reference meets the requirements of the “wherein” clause of claim 1.

We have considered all of Appellants’ arguments in the briefs but are not persuaded of error in the Examiner’s finding of anticipation with respect to claim 1. Appellants’ arguments, in the main, seem based on supposed requirements that are not commensurate with the broad scope of the claim and on the fact that McIchoinc does not use all the same terms that are recited in the claim. With respect to claim scope, our reviewing court has repeatedly warned against confining the claims to specific embodiments described in the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323, 75 USPQ2d 1321, 1334 (Fed. Cir. 2005) (en banc). With respect to anticipation, every element of the claimed invention must be identically shown in a single reference, but this is not an “ipsissimis verbis” test. *In re Bond*, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990).

We therefore sustain the rejection of claims 1-5, 13, 14, 16-18, and 20 under 35 U.S.C. § 102(e) as being anticipated by McIchionc.

Claims 6-9, 11, 12, and 19

Claims 6-9, 11, 12, and 19 stand rejected under 35 U.S.C § 103(a) as unpatentable over McIchionc and Szor. We sustain the rejection of claims 6-9, 11, and 12, because Appellants rely on the arguments that we find unpersuasive with respect to McIchionc as applied against claim 1. (*See Br. 15.*)

The statement of the rejection of claim 19 (Answer 9-10) finds that McIchionc does not disclose multiple steps of the claim, but the teachings absent from McIchionc are asserted to be contained in Szor. The rejection relies on paragraphs 7, 10, 11, and 12 of Szor, most of which relate to the background of the invention described in the reference.

Szor teaches in the referenced sections that, in certain operating systems, user mode code does not have direct access to kernel mode (operating system) code, and that the user address space and the operating system address space are kept separate. Szor documents a need for virus scanners that may check not only user address space, but also kernel address space since some newly emerged viruses are implemented as drivers in the kernel address space.

We agree with Appellants that Szor is not sufficient to teach all that the rejection attributes to the reference. We find no teaching for categorizing requests as local or remote based on the start address of code associated with an identified thread being within or not within the kernel component, and scanning files accordingly. In particular, we do not find

disclosure or suggestion in Szor for the determining and categorizing steps that the rejection (Answer 9) attributes to the reference.

Thus, we have sustained the rejection of claims 6-9, 11, and 12 but we do not sustain the rejection of claim 19.

Claim 15 Revisited -- New Grounds of Rejection

Instant claim 1 is anticipated by McIchionc (*see supra*). The Examiner finds (Answer 11) that McIchionc discloses preventing infection of cyber-frameworks with malware, at least for the reason that all anti-virus software does so. We find the position to be reasonable. The further requirements of instant claim 15 set forth nothing different from McIchionc because, as Appellants admit (e.g., Br. 11), the claim does not require preventing attacks *only* by terrorists. Nor does the claim require, for that matter, any kind of identification of the origin of malware. The method set forth by claim 15 would thus be interpreted by the artisan as being met by the (instant claim 1) method described by McIchionc in its normal use. To the extent that claim 15 might be interpreted as requiring a conscious effort to utilize the method of claim 1 against malware initiated by terrorists, we find that it would have been obvious to the artisan to apply the method described by McIchionc against *any* potential infection, including “malware initiated by terrorists.”

We therefore reject claim 15 under 35 U.S.C. §§ 102(e)(2) and/or 103(a) over McIchionc, pursuant to our authority under 37 C.F.R. § 41.50(b).

CONCLUSION

In summary, the rejection of claim 15 under 35 U.S.C. §§ 101 and 112, 2nd ¶ is reversed as to both grounds. The rejection of claims 1-5, 13, 14, 16-18, and 20 under 35 U.S.C. § 102(e) as being anticipated by McIchionc is affirmed. The rejection of claims 6-9, 11, 12, and 19 under 35 U.S.C. § 103(a) as unpatentable over McIchionc and Szor is affirmed with respect to claims 6-9, 11, and 12 but reversed with respect to claim 19.

A new rejection of claim 15 under 35 U.S.C. §§ 102(e)(2) and/or 103(a) over McIchionc is set forth herein.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (2006). 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 C.F.R. § 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).

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AFFIRMED-IN-PART -- 37 C.F.R. § 41.50(b)

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