

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY W. LEROSE

Appeal 2007-1289
Application 10/425,899
Technology Center 2100

Decided: May 15, 2007

Before JAMES D. THOMAS, JOSEPH L. DIXON, and JEAN R. HOMERE, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 4 through 6, 8, 10, 13, 15, 16, and 20 through 22. We have jurisdiction under 35 U.S.C. §§ 6(b) and 134(a). An Oral Hearing on this appeal occurred on May 9, 2007.

As best representative of the disclosed and claimed invention, independent claim 21 is reproduced below:

21. A method of securing a computer file, the method comprising the steps of:

substantially attaching a memory device to a first computer, said memory device comprising a USB flash drive having operating software loaded thereon and a preloaded file structure, and said operating software configured to recognize the computer file, and for operating the software on the memory device;

transferring the computer file to the memory device from the computer by operating the software on the memory device;

compressing and encrypting the computer file by operating the software on the memory device, and applying a file extension to said compressed and encrypted computer file indicating the file is encrypted;

substantially unattaching the memory device from the first computer;

substantially attaching the memory device with the encrypted file to a second computer; and

decrypting the computer file by operating the software on the memory device, whereby a user knows the file is to be decrypted from said file extension.

The following references are relied upon or made reference to by the Examiner:

Mooney	US 6,351,813 B!	Feb. 26, 2002
Sabet-Shanghi	US 2002/0186842 A1	Dec. 12, 2002 (Filed Dec. 6, 2001)
Koh	US 6,757,783 B2	Jun. 29, 2004 (Filed Nov. 28, 2001)

In considering the merits of the rejection of the claims on appeal, we have made reference to the Appeal Brief filed on May 30, 2006, and the amended, corrected Appeal Brief filed on October 6, 2006. Likewise, we

have considered the positions set forth by the Examiner in the first Answer mailed on August 24, 2006, and the supplemental Answer mailed on January 24, 2007. It is noted that both Answers appear to be the same. Of principal interest here, the Examiner has not repeated the rejection of the claims on appeal utilizing a reference to Hsu but has set forth a new ground of rejection based upon Sabet-Shanghai in view of Mooney. Specifically, the Examiner indicates at the bottom of page 9 of these Answers that arguments made in the principal Briefs as to Hsu are moot in view of the new grounds of rejection. Since the initial rejection utilizing the reference to Hsu has not been repeated in the Answer but has been generally indicated here as being withdrawn, we consider only the rejection utilizing Mooney. We have considered and the Examiner has made reference to the comments in both the initial Brief and amended, corrected Brief pertaining only to Sabet-Shanghai. In turn, the Reply Brief filed on October 26, 2006 is the only Brief that argues the rejection utilizing Mooney.

Rather than repeat the positions of the Appellant and the Examiner, reference is made to the respective Briefs and Answers for positions of the Appellant and the Examiner.

OPINION

Generally, for the reasons set forth by the Examiner in the Answer, we sustain the new rejection of all claims on appeal under 35 U.S.C. § 103 on the basis of the combined teachings and showings of Sabet-Shanghai in view of Mooney.

At the outset, 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 must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1996). Furthermore, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, No. 04-1350, slip op at 14 (U.S., Apr. 30, 2007)(quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

As to independent claims 21 and 22, pages 3 and 4 of the Answer set forth the Examiner’s initial statement of the rejection of independent claims 21 and 22 which is expanded upon based upon the Examiner’s responsive arguments beginning at page 6. As emphasized at pages 7, 9 and apparently set forth as a restatement of the rejection at page 10 of the Answer, the Examiner considers that Sabet teaches a memory device in figure 1 comprising the memory stick 13 and/or a portable device in this figure as depicted by element 15, which together are removably attachable to a first computer shown in that figure by a USB connector. Whereas the portable device and software loaded thereon has a preloaded file structure such as discussed at Sabet page 3, paragraphs 0029 and 0034 utilizing this approach, the Examiner considers Sabet to teach substantially all the subject matter of representative independent claim 21 on appeal except for the claimed file extension for which the Examiner relies upon Mooney. Correspondingly, Appellant’s remarks beginning at page 4 of the Reply Brief do not contest

the proper combinability within 35 U.S.C. § 103 of the teachings and suggestions of Sabet and Mooney.

As set forth in claim 21 on appeal, the claimed memory device is stated to comprise a USB flash drive. By the use of the connective “comprising” the memory device is capable of including more than the flash drive. Even by cursory inspection of figure 1 of Sabet, the peripheral device or portable device 15 in this reference is connected by USB connector to the host computer 11 and the portable device 15 may be construed as the claimed memory device to which it may be fairly said also comprises a flash drive in the form of the SD memory card 13. Pages 1 through 3 of Sabet clearly suggest if not explicitly teach to the artisan, particularly in conjunction with the closing remarks at page 11 of this patent, the use of a USB flash drive as a form of flash memory. Sabet’s teachings are solely based upon the use of a flash memory 13. This specific teaching value disclosed is in the form of a SD memory card as shown in figure 1 but the narrative teachings are much more expansive. In any event, the particular form in which the memory 13 is shown in Sabet has not been contested by Appellant’s arguments in the Brief and Reply Brief.

The nature of the teachings in Sabet make it clear that the compression and expansion as well as the encryption and decryption functions occur in the portable device 15 which is inclusive of the manner in which the broadly recited “memory device” of representative claim 21 defines it as well. Once the memory stick 13 is inserted in the portable device 15 it is fair to characterize in the art the portable device 15 as a memory device which in turn has operating software therein to perform the functions of compressing and encrypting information, the converse functions

of which are also taught for decrypting purposes. Independent claim 22 is considered to be collectively argued with the features of representative independent claim 21 on appeal. The functionality of claim 21 is stated with respect to the memory device and not the USB flash drive per se.

Of particular interest in Sabet are the teachings at figures 1, 2, 3B, 6 and various parts of figure 8. The various internal parts of portable device 15 are shown in figure 2 and a corresponding showing in figure 3B shows the internal structure in block diagram form of the flash memory stick 13. It is apparent to the artisan from both figures at least that file structures are essentially taught as to both elements.

In a corresponding environment, Mooney clearly shows corresponding structure in figures 1, 4, 7, 8, and 11. The use of file extensions to identify file structures in the memory structures of Mooney is illustrated in figure 4 in the form of a main screen or user interface. In addition to the specific teachings at columns 2 and 6 outlined by the Examiner in the rejection, which specifically teach of the use of specialized file extensions to identify the encrypted information, it appears to us that the entire discussion at column 6 beginning at line 16 through line 30, encompassing what the Examiner relies upon here, is also instructive. File structures and extensions thereof are well recognized in the data processing arts to separately identify different data structures, files, programs, or applications.

In addition to the Examiner's responsive arguments in the Answer beginning at page 6 addressing the positions set forth by Appellant in the principal Briefs on appeal, Appellant's remarks in the Reply Brief focus almost exclusively on alleged disclosed versus claimed features to

distinguish over the teachings and suggestions of Mooney and Sabet together. The disclosed invention plainly utilizes well-known prior art flash memory devices as does Sabet, for example. Appellant's attempts in the Reply Brief to essentially belittle Sabet's teachings by arguing that the controller and processing functions of Appellant's claimed flash drive are more simpler and less complicated than those of the disclosed invention are misplaced since these features are not reflective in the claims on appeal. Moreover, the Reply Brief does not appear to directly challenge the Examiner's view that the claimed "memory device" comprises the portable device 15 with its flash memory 13 placed in it.

Moreover, Appellant's remarks in the Reply Brief do not contest the Examiner's reference to the Koh patent as being representative of a USB port connectable flash drive *per se*. Of particular note here from our review of this reference, figures 1, 4, 5, 11, and 12 of Koh contains significant corresponding teachings to those in Sabet. In fact figure 4 of Koh presents a depiction of a conventional USB port compatible flash memory drive well-known in the art. Figures 1 and 5 of this reference have block diagram representations of the internal controller/microprocessor with internal programming memory and storage capabilities compatible with those shown in figure 3B of Sabet. Although, not relied upon by the Examiner as basis to formulate the rejection of the claims on appeal, we note in passing that Koh appears to us to be directly pertinent to the claimed and disclosed subject matter.

In addition to the Examiner's remarks with respect to the argued dependent claims, we note that the features recited in dependent claim 4 on appeal relate to Appellant's reliance upon prior art Blowfish compression

Appeal 2007-1289
Application 10/425,899

and encryption capabilities discussed at page 8 of the Specification as filed. An artisan's understanding of the software within the portable device 15 of Sabet as well as the limited software within the flash memory 13 of this reference are both separate from the operating system software on the computer 11 in Sabet's figure 1 to the extent recited in dependent claim 8 on appeal. Our earlier remarks in this opinion are reflective of the obvious nature of the subject matter of claims 13, 15, 16, and 20.

In view of the foregoing, the decision of the Examiner rejecting all claims on appeal under 35 U.S.C. § 103 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). See 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

pgc

Daniels Daniels & Verdonik, P.A.
Suite 200 Generation Plaza
1822 N. C. Highway 54 East
Durham, NC 27713