

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERALD J. HANAM, KURT R. ROSS,
JOHN D. MORRISON, and GARY A. ZELLERBACK

Appeal 2007-3453
Application 10/406,870
Technology Center 2100

Decided: February 11, 2008

Before JEAN R. HOMERE, JAY P. LUCAS, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claim 11. We have jurisdiction under 35 U.S.C. § 6(b). The Examiner has indicated that claims 1, 3-10, and 17-26 are allowable over the prior art of record (Ans. 5). The Examiner has further indicated that claims 12-16 would be allowable if rewritten in independent form (Ans. 7). Claim 2 has been cancelled. We AFFIRM.

THE INVENTION

The disclosed invention relates generally to transferring electronic files from one location to another over a network. More particularly, Appellants' invention relates to a client-server system having a download manager application on the client which provides real-time file verification, i.e., error detection, of downloaded files by comparing error detection data to a verification file generated by a verification application on the server (Spec. 1).

Independent claim 11 is the sole claim on appeal:

11. A download manager for downloading a data file from a server to a client, the data file having a separate associated verification file containing first error detection data associated with each of a respective plurality of segments of the data file, the download manager comprising an executable program for:

downloading at least a portion of the data file;

generating second error detection data associated with the downloaded portion of the data file; and

comparing a corresponding portion of the first error detection data and second error detection data to determine if errors occurred in the data file.

THE REFERENCE

The Examiner relies upon the following reference as evidence in support of the rejection:

Hudson

US 5,925,140

Jul. 20, 1999

THE REJECTION

Claim 11 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Hudson.

PRINCIPLES OF LAW

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740. Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). Therefore, we look to Appellants’ Briefs to show error in the proffered *prima facie* case.

ISSUE(S)

We decide the question of whether Appellants have shown the Examiner erred in holding that the cited Hudson reference renders obvious the claimed subject matter. More particularly, we have determined that the following issue is dispositive in this appeal:

Whether Appellants have shown the Examiner erred in finding that Hudson teaches a “data file having a separate associated verification file containing first error detection data associated

with each of a respective plurality of segments of the data file . . . ,” as claimed (*see* independent claim 11).

The Examiner, as finder of fact, has determined that the language of the claim broadly but reasonably encompasses Hudson’s teaching of a CRC code 1214 (Fig. 12) (i.e., corresponding to the claimed verification file containing first error correction data) that is located inside Hudson’s frame, as shown in Fig. 12 (Ans. 6). The Examiner further concludes that the limitations argued by Appellants are only found in the preamble of the claim, and thus should not be accorded patentable weight (*id.*).

Appellants contend that there is nothing in Hudson that teaches or suggests a *separate* verification file containing first error detection data associated with each of a plurality of segments in the data file, as claimed (Reply Br. 2). Appellants aver that the phrase “having a separate associated verification file” does not mean that the verification file is located *inside* the data file, as argued by the Examiner (*id.*). Appellants further contend that the terminology in the preamble imposes structural limitations on the data file and verification file (Reply Br. 3). Thus, Appellants reason that the terms in the preamble of claim 11 must be treated as claim limitations. In support, Appellants cite: *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257 (Fed. Cir. 1989); and *Pac-Tec Inc. v. Amerace Corp.*, 903 F.2d 796, 801 (Fed. Cir. 1990). (Reply Br. 3). Appellants also point out that the preamble terms “data file” and “first error detection data” are specifically referred to in the body of claim 11 (Reply Br. 4).

ANALYSIS

Preamble

We begin our analysis by noting that when limitations in the body of the claim rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention. *See, e.g., Electro Sci. Indus. v. Dynamic Details, Inc.*, 307 F.3d 1343, 1348 (Fed. Cir. 2002); and *Rapoport v. Dement*, 254 F.3d 1053, 1059 (Fed. Cir. 2001). Therefore, we agree with Appellants that the claim terms “data file” and “first error detection data” (as recited in the body of claim 11) derive antecedent basis from the preamble and are thus properly treated as claim limitations.

However, we do not agree with Appellants’ contention that the preamble terms should be accorded patentable weight because the terminology of the preamble purportedly imposes “structural limitations” on the recited “data file” and “verification file.” (*see* claim 11 preamble). We find the facts of *Corning Glass Works* and *Pac-Tec Inc.* (as cited by Appellants) are inapposite to the facts presented here. In particular, both *Corning Glass Works* and *Pac-Tec Inc.* were concerned with tangible machine or component structures, as distinguished from a particular arrangement of data, as claimed by Appellants (*see* claim 11, “the data file having a separate associated verification file containing first error detection data associated with each of a respective plurality of segments of the data file . . . :”).

Claim Construction

We broadly but reasonably construe the claimed “data file” as an arrangement of *data* that may be transmitted (i.e., downloaded) over a

communications link and may be stored on a storage medium (claim 11). Similarly, we broadly but reasonably construe the claimed “verification file” as an arrangement of *verification data* that may be transmitted or downloaded over a communications link and may be stored on a storage medium (*id.*). After considering the evidence before us, we conclude that Appellants’ claimed “data file” broadly but reasonably encompasses the collection of data blocks 1212 contained within Hudson’s download frame, as shown in Fig. 12.

We further conclude that downloading a “data file having a separate associated verification file containing first error detection data associated with each of a respective plurality of segments of the data file . . . ” (as claimed) broadly but reasonably encompasses downloading a data file (consisting of n data blocks 1212 or data segments) where each data block 1212 (i.e., data segment) has an associated CRC 1214 (i.e., where the CRC 1214 is a “verification file” that contains “first error detection data” associated with each of a respective plurality of data blocks or segments), as shown by Hudson in Fig. 12 (*see also* instant claim 11).

Because Hudson teaches that “[t]he CRC code is an error detection code that allows errors in the contents of a block of memory to be detected,” (col. 7, ll. 24-26), we find Hudson’s CRC code 1214 is a *single* “verification file” (i.e., an arrangement of verification data) that is associated with each data block or segment 1212 that makes up the data file portion of Hudson’s download frame (*see* Hudson, Fig. 12, col. 8, ll. 16-32). Because a file is merely an arrangement of data, we find that a file may include many data elements or a single data element (such as a single CRC code 1214, Fig. 12).

For at least the aforementioned reasons, we conclude that Appellants have not shown error in the Examiner’s prima facie case of obviousness. Therefore, we sustain the Examiner’s rejection of independent claim 11 as being unpatentable over Hudson.

OTHER ISSUE

In the event that prosecution is reopened in this application, we leave it to the Examiner to consider whether the subject matter of claim 11 constitutes eligible subject matter under 35 U.S.C. § 101 in view of *In re Comiskey*, 499 F.3d 1365 (Fed. Cir. 2007). Here, we note that claim 11 recites a “download manager” to be used for the intended purpose of “downloading a data file from a server to a client” In particular, we note that the “download manager” expressly comprises “an executable program,” as claimed (*see* claim 11, preamble, emphasis added). Moreover, we conclude that the broad scope of the claimed “client,” (i.e., a requestor of services) and “server” (i.e., a provider of services) reasonably encompasses software-only embodiments. We also note that the claimed “client” and “server” are not expressly supported in the body of the claim. Thus, we conclude that Appellants’ claim 11 broadly encompasses a method for downloading data without integrating a machine (e.g., a computer), or constituting a process of manufacture, or altering a composition of matter. Therefore, the nature of the subject matter claimed may be reasonably construed as a mental process since the language of claim 11 broadly encompasses non-tangible embodiments. Because claim 11 on appeal is not tied to a machine or other statutory subject class, the Examiner should consider a rejection of claim 11 under 35 U.S.C. § 101.

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CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have not shown the Examiner erred in rejecting claim 11 under 35 U.S.C. § 103(a) for obviousness.

DECISION

The decision of the Examiner rejecting claim 11 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

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