

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD K. JOHNSON

Appeal 2007-4139
Application 10/334,865
Technology Center 2100

Decided: April 30, 2008

Before ALLEN R. MACDONALD, ST. JOHN COURTENAY III, and
STEPHEN C. SIU, *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 claims 1-22, 24-27, 29-32, 34-37, and 39-47. Claims 23, 28, 33, and 38 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM IN PART.

THE INVENTION

The disclosed invention relates generally to managing software configurations of devices. More particularly, Appellant's invention is directed to automatically restoring the software configuration of a device in response to an event precipitating restoration (Spec. 1).

Independent claim 1 is illustrative:

1. A method of restoring software configurations of devices, said method comprising:

automatically tracking an obtaining of a software component for a device, the software component being obtained subsequent to installation of an initial software configuration of the device, and wherein the automatically tracking comprises automatically registering, responsive to the obtaining, the software component with a hardware identifier of the device to associate the software component with the particular device, said hardware identifier being automatically provided by the device, absent user intervention; and

automatically restoring a software configuration of the device, said automatically restoring comprising automatically identifying the device to be restored via the hardware identifier and automatically providing to the device the software component registered to the hardware identifier of the device.

THE REFERENCE

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

“Handbook for the Palm VTM Organizer,” 1998, 3COM Corporation (“Palm”).

THE REJECTIONS

Claims 2 and 17 stand rejected under 35 U.S.C. § 112, second paragraph.

Claims 1-22, 24-27, 29-32, 34-37, and 39-47 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Palm.

PRINCIPLES OF LAW

Appellant has 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). In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citation omitted).

“Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference.” *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether

it also covers subject matter not in the prior art.”) (internal citations omitted).

ANALYSIS

35 U.S.C. § 112, second paragraph

At the outset, we *pro forma* affirm the Examiner’s 35 U.S.C. § 112, second paragraph rejection of claims 2 and 17. Appellant does not contest the antecedent basis problem pointed out by the Examiner, as Appellant attempted to remedy the aforementioned problem by filing an after-final amendment that was denied entry by the Examiner (*see Br.* 7).

Anticipation under 35 U.S.C. § 102

Regarding the anticipation rejection, we address the arguments presented in the Brief only to the extent that Appellant’s arguments are directed to claimed subject matter. Patentability is based upon the claims. “It is the claims that measure the invention.” *SRI Int’l v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (*en banc*). “Moreover, limitations are not to be read into the claims from the specification.” *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

Claims 1, 16, 29, and 31

We consider the Examiner’s rejection of claims 1, 16, 29, and 31 as being anticipated by Palm. Since Appellant’s arguments with respect to this rejection have treated these claims as a single group which stand or fall

together, we select independent claim 1 as the representative claim for this rejection. *See* 37 C.F.R. § 41.37(c)(1)(vii).

We consider the following issues that flow from the contentions of the Appellant and the Examiner:

Regarding the issue of whether the Palm reference discloses a hardware identifier that is provided automatically by the device (Br. 9), we note that Palm expressly discloses: “Enter a user name *for your organizer* and click OK.” (Palm 60, emphasis added). Therefore, we agree with the Examiner that the entered “user name” corresponds to the unique name (i.e., hardware identifier) associated with the Palm organizer. While this name or identifier must be initially configured by the user before performing a first “HotSync” operation (Palm 60), we nevertheless agree with the Examiner that all subsequent operations automatically provide the unique organizer name (i.e., hardware identifier) as an integral part of each “HotSync” operation. It is our view that without such a unique organizer name (i.e., hardware identifier), the Palm Desktop would not know which organizer to perform synchronization with (*see* Palm, p. 60, e.g., “Every organizer should have a unique name.”).

Therefore, we find that the argued language of claim 1 (i.e., “said hardware identifier being automatically provided by the device, absent user intervention . . . ”) broadly but reasonably reads on each subsequent automatic “HotSync” operation where the organizer name is necessarily provided as part of the synchronization operation. Moreover, we agree with the Examiner that the file synchronization performed by each Palm

“HotSync” operation would not be possible without the software components being registered (i.e., associated) with a hardware identifier (i.e., organizer device name) (*see* Palm, pp. 58-59, e.g., “The “HotSync” process automatically synchronizes – that is, exchanges and updates – data between your organizer and Palm Desktop software. Changes you make on your organizer or Palm Desktop software appear in both places after a HotSync operation.”).

Regarding the issue of whether the Palm reference discloses the recited limitations of “automatically restoring a software configuration of the device . . . ” (claim 1), we conclude that a broad but reasonable interpretation of the claim language does not preclude initiating an automatic synchronization (i.e., restoring) operation by user action. Indeed, our interpretation is entirely consistent with Appellant’s own Specification which broadly discloses that the initiation of an automatic recovery may be *manual* or automatic, as follows:

[0036] Regardless of the definition of a catastrophic software failure, recovery is initiated in response thereto. The initiation of recovery may be manual or automatic. For example, a user may manually start the process or the device may automatically go into recovery, when recovery is indicated. *Notwithstanding how the process is started, the recovery itself is automatic, in accordance with an aspect of the present invention* [emphasis added].
(Spec. 8).

Accordingly, we agree with the Examiner that the “HotSync” operation *automatically* restores a software configuration of the Palm organizer device after a “HotSync” operation is manually initiated by user

action (*see also* Palm, p. 47, e.g., “you can restore all synchronized data at the next “HotSync” operation.”).

From the above discussion, we conclude that Appellant has not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner’s rejection. Therefore, we sustain the Examiner’s rejection of representative claim 1 (and claims 16, 29, and 31 that fall therewith) as being anticipated by Palm.

Claims 13, 26, and 41

We consider next the Examiner’s rejection of claims 13, 26, and 41 as being anticipated by Palm. Since Appellant’s arguments with respect to this rejection have treated these claims as a single group which stand or fall together, we select independent claim 13 as the representative claim for this rejection. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Regarding representative claim 13, we note that Appellant essentially argues the same issues previously addressed with respect to claim 1. Therefore, we restate our response to representative claim 1, as discussed above. In particular, we emphasize our factual finding that the entered “user name” corresponds to the unique name (i.e., hardware identifier) associated with the Palm organizer. *See* Palm 60, i.e., “Enter a user name *for your organizer* and click OK.” (Emphasis added). Consistent with our discussion above for claim 1, and for the reasons set forth by the Examiner in the Answer, we find that the Palm reference discloses the argued limitations of “automatically providing to a recovery unit, by a device, an

identifier of the device, said automatically providing being absent user intervention.” (Claim 13). We agree with the Examiner that all subsequent operations automatically provide the unique organizer name (i.e., hardware identifier) as a necessary part of each “HotSync” operation. Without such a unique organizer name (i.e., hardware identifier), the Palm Desktop would not know which organizer to perform synchronization with, as previously discussed.

It is also our view that the “HotSync” operation performs the step of “automatically determining, by the recovery unit, that the software configuration of the device is to be restored” after each “HotSync” operation is started by user action. (Claim 13). We note that Appellant’s own Specification broadly discloses that the initiation of an automatic recovery may be *manual* or automatic, as previously discussed. (*See Spec. 8, ¶[0036]*).

From the above discussion, we conclude that Appellant has not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner’s rejection. Therefore, we sustain the Examiner’s rejection of representative claim 13 (and claims 26 and 41 that fall therewith) as being anticipated by Palm.

Dependent claim 44

We consider next the Examiner’s rejection of dependent claim 44 as being anticipated by Palm.

Appellant contends that Palm does not disclose automatically detecting a failure, and then automatically initiating recovery, responsive to that detected failure. (Br. 12).

We disagree. It is our view that the weight of the evidence supports the Examiner's finding that after any data loss event (e.g., hard reset or battery failure), the Palm "HotSync" operation will automatically detect a file synchronization anomaly (i.e., data loss) and correct it, albeit after user action initiates the "HotSync" operation. We conclude that a broad but reasonable interpretation of the claim language does not preclude initiating an automatic synchronization (i.e., restoring) operation by user action, as previously discussed. (*See Spec. 8, ¶[0036]*). Appellant's own Specification broadly discloses that the initiation of an automatic recovery may be *manual* or automatic, as previously discussed. (*See Spec. 8, ¶[0036]*). Because Appellant has not shown that the Examiner has erred, we sustain the Examiner's rejection of claim 44 as being anticipated by Palm.

Independent Claim 30

We consider next the Examiner's rejection of independent claim 30 as being anticipated by Palm.

Appellant contends that Palm does not disclose automatically detecting a condition of a device for which restoration of the device is desired, as well as automatically restoring, in response to detecting that condition, a software configuration of the device. (Br. 16).

We disagree. We restate our previous analyses of representative claims 1 and 13, and, in particular, claim 44. In our view that after any data loss event (e.g., hard reset or battery failure), the Palm “HotSync” operation will automatically detect a file synchronization anomaly (i.e., data loss) and correct it, albeit after user action initiates the “HotSync” operation, as previously discussed. We again conclude that a broad but reasonable interpretation of the claim language does not preclude initiating an automatic synchronization (i.e., restoring) operation by user action. (*See Spec. 8, ¶[0036]).*

Appellant further contends that Palm does not disclose the automatic tracking of software components of the device and of automatically providing to the device those components that are automatically tracked. (Br. 17).

After reviewing the evidence before us, it is our view that the Palm “HotSync” operation performs the argued functions of automatically tracking software components of the device and of automatically providing to the device those components that are automatically tracked (*see* Palm, pp. 58-59, e.g., “The “HotSync” process automatically synchronizes – that is, exchanges and updates – data between your organizer and Palm Desktop software. Changes you make on your organizer or Palm Desktop software appear in both places after a HotSync operation.”).

Because Appellant has not shown that the Examiner has erred, we sustain the Examiner's rejection of independent claim 30 as being anticipated by Palm.

Dependent claims 45 and 46

Because we conclude that Appellant has met the burden of showing error for claims 45 and 46, we reverse the Examiner's rejection of these claims for the following reasons:

Regarding claim 45, we find that Palm does not fairly disclose "automatically determining, *absent user intervention*, at least one of a patch and an update pertaining to the software configuration of the device to be provided to the device," as claimed (emphasis added). In particular, we find the Examiner admits in the Answer that the selection of the software is performed by a manual step. (*See* Answer 18).

Regarding claim 46, we agree with Appellant that the portion of page 91 of the Palm reference (i.e., "Shows version information for Address book."), as relied on by the Examiner, does not fairly disclose determining the appropriate version of the software component to be provided, as required by the language of claim 46.

Dependent claims 2-12, 14, 15, 17-22, 24, 25, 27, 32-37, 39, 40, 42-43, and 47

Appellant has not presented any substantive arguments directed separately to the patentability of dependent claims 2-12, 14, 15, 17-22, 24, 25, 27, 32-37, 39, 40, 42-43, and 47. Therefore, we sustain the Examiner's rejection of these claims as being anticipated by Palm. *See In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii).

Appeal 2007-4139
Application 10/334,865

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellant has not shown the Examiner erred in rejecting claims 2 and 17 under 35 U.S.C. § 112, second paragraph. We conclude that Appellant has not shown the Examiner erred in rejecting claims 1-22, 24-27, 29-32, 34-37, 39-44, and 47 under 35 U.S.C. § 102(b) for anticipation. However, we conclude that Appellant has shown the Examiner erred in rejecting claims 45 and 46 under 35 U.S.C. § 102(b) for anticipation.

DECISION

We affirm the Examiner's decision rejecting claims 1-22, 24-27, 29-32, 34-37, 39-44, and 47.

We reverse the Examiner's decision rejecting claims 45 and 46.

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-IN-PART

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HESLIN ROTHENBERG FARLEY & MESITI PC
5 COLUMBIA CIRCLE
ALBANY NY 12203