

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ROBERT A. DIFALCO and THOMAS E. GOOD

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Appeal 2008-0421  
Application 10/328,957<sup>1</sup>  
Technology Center 2100

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Decided: January 14, 2009

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*Before* JAY P. LUCAS, THU A. DANG and STEPHEN C. SIU,  
*Administrative Patent Judges.*

LUCAS, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal from a final rejection of claims 1 to 49 under authority of 35 U.S.C. § 134. The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

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<sup>1</sup> Application filed December 24, 2002. The real party in interest is Tripwire, Inc of Portland, OR.

Appellants' invention relates to a method and apparatus for assuring the integrity of services distributed across a network from a server to a requesting client computer. In the words of the Appellants:

In a networked computing environment, a server is equipped to assure the integrity of the service components of a service, including the direct service providing component and one or more supporting components as requested, and a client is equipped to request on behalf of an application in need of the service the integrity assurance. The client is further equipped to either request or accept the service, only upon receiving the integrity assurance. In one embodiment, the request for integrity assurance, and the subsequent conditional request or acceptance of the service is performed in real time.

(Abstract; Spec. 32)

Claim 1 is exemplary:

1. In a networked computing environment, a method of operation comprising:  
a client, having a need for a service of a server with the service to be provided from the server by a plurality of service providing components residing and to be executed on the server including a direct service providing component and one or more supporting components supporting the direct service providing component in providing the service, requesting the server to assure the integrity of the service providing components including the direct service providing component and the one or more supporting components;  
and

the client either requesting the service to be provided or accepting the requested service only upon receiving the requested integrity assurance from the server.

#### PRIOR ART

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Ashley	6,909,992	Jun. 21, 2005
Shear	6,157,721	Dec. 5, 2000
McManis	6,067,575	May 23, 2000
Jamroga	6,574,742	Jun. 3, 2003

#### REJECTIONS

R1: Claims 1 to 3, 7, 11 to 13, 19 to 21, 28 to 30, 37 to 39, 43 to 45, and 49 stand rejected under 35 U.S.C. § 103(a) for being obvious over Ashley in view of Shear.

R2: Claims 4 to 5, 8, 14, 16, 22 to 23, 25, 31, 32, 34, 40, 41, 46 and 47 stand rejected under 35 U.S.C. § 103(a) for being obvious over Ashley and Shear in view of McManis.

R3: Claims 9 to 10, 17 to 18, 26 to 27, and 35 to 36 stand rejected under 35 U.S.C. § 103(a) for being obvious over Ashley and Shear further in view of Jamroga.

R4: Claims 6, 15, 24, 33, 42 and 48 stand rejected under 35 U.S.C. § 103(a) for being obvious over Ashley and Shear further in view of McManis and Jamroga.

The claims will be consider together, as two issues are dispositive of all of the claims.

Appellants contend that the claimed subject matter is not rendered obvious by Ashley and Shear alone, or in combination with McManis or Jamroga, for failure of Ashley and Shear to teach key limitations. The Examiner contends that each of the claims is properly rejected.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this opinion. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived.

We affirm the rejections.

#### ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). The issue turns on whether Shear (and Ashley) teach that the server, on which the software to be distributed resides, is requested by a client to assure the integrity of the software being distributed. Also at issue is whether Shear and Ashley teach a client “either requesting a service to be provided or accepting a requested service only upon receiving the requested integrity assurance from the server since there is no disclosure or even suggestion related to requesting the integrity assurance in the first place.” (App. Br. 8, middle).

## FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellants have invented a secure method (and apparatus) for distributing services and objects from a server across a network to such clients as phones, personal digital assistants and computers. (Spec. 9, middle). The client receiving these services from a server may request an integrity assurance from the server, and if such assurance is not granted decline to accept the service. (*Id.* at 11, middle).
2. [Further findings of fact are presented in the Analysis section below.]

## PRINCIPLES OF LAW

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)).

"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.

The analysis begins with an interpretation of the claims: “Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims . . . . The second step in the analyses requires a comparison of the properly construed claim to the prior art.” *Medichem S.A. v. Rolabo S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).

Our reviewing court states in *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) that “claims must be interpreted as broadly as their terms reasonably allow.” Our reviewing court further states that “the words of a claim 'are generally given their ordinary and customary meaning.'” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). The “ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.” *Id.* at 1313.

## ANALYSIS

From our review of the administrative record, we find that Examiner has presented a prima facie case for the rejections of Appellants’ claims under 35 U.S.C. § 103. The prima facie case is presented on pages 3 to 7 of the Examiner’s Answer. In opposition, Appellants present the following arguments.

*Arguments with respect to the rejection  
of claims 1 to 49  
under 35 U.S.C. § 103*

Appellants have presented two arguments against the rejection of claim 1 and those claims rejected with that claim under R1. (App. Br. 7-9). Appellants have repeated those arguments, with minor variations, for those claims rejected under R2, R3 and R4. (App. Br. 9-12). As such, all the claims 1 to 49 will be considered together.

Appellants contend that the Examiner has erred in rejecting the claims under 35 U.S.C. § 103 for failure of the key reference Shear to teach “the server on which the [software to be distributed] resides being requested, by a client, to assure the integrity of the [software to be distributed]”. (App. Br. 8, middle). Appellants interpret Shear to be teaching that the software to be distributed is the integrity verifying software itself. (*Id.*).

The Shear reference is used by the Examiner to supplement the teachings of the Ashley reference in rejecting the claims under appeal. Ashley teaches the claimed distribution of a service from a server including a direct service providing component and one or more supporting components supporting the direct service providing component. (Col. 9, bottom paragraph). Shear is used to contribute the teaching of the claimed limitations “requesting the server to assure the integrity of the service providing components . . . .” and “the client either requesting the service to be provided or accepting the requested service only upon receiving the requested integrity assurance from the server.” (*See* claim 1 above.)

Appellants contend that Shear does not teach that the client in that patent requests the server to assure the integrity of the software being distributed. (App. Br. 8, middle). We do not read Shear in that manner. Shear teaches the secure distribution of objects #54 (software, video, etc.) from a server of provider #52 to various users #56a, b, and c. (Fig. 1, Col. 8, l. 14 to 29). The objects are sent by secure means to a “protected processing environment” #108 in the devices #57 of the client users. The objects, in one embodiment of the patent, are released to the users only on the presentation of a public key #124, sometimes called a second key #124, by the user to the protected processing environment #108. Upon presentation of that key, the object is released to the user. (Col. 13, l. 63).

We find that a broad but fair reading of the claims allows one to read the user’s presentation of the key to release the object #54 as the claimed “requesting the server to assure the integrity of the service providing components”. The key is part of the Public Key Infrastructure system disclosed by Shear, which encrypts not only the substance of the object #54 (the video or software being distributed) but also the included specification #110, which is protected by a digital signature. (Col. 10, l. 13). The digital signature contains elements that assure the integrity of the object being distributed. (Col. 10, l. 15). Thus the presentation of the key is a request to unlock the assurance of integrity.

We thus decline to find error in the Examiner’s application of Shear to teach the limitation of the server being requested to assure the integrity of the delivered software.

Appellants' second contention builds on the first. Appellants contend that “[l]ikewise Shear et al. do not disclose or suggest a client either requesting a service to be provided or accepting a requested service only upon receiving the requested integrity assurance form the server since there is no disclosure or even suggestion related to requesting the integrity assurance in the first place.” (App. Br. 8, middle).

As we mentioned with the first contention, we consider the presentation of the key to unlock the encryption as a request for the integrity of the service. As the Examiner points out, Shear also teaches the claimed accepting of a requested service (#54) only upon accepting the assurance of integrity. (Ans. 9, middle). In consequence, we decline to accept the Appellants' second contention, as stated above, since we find Shear teaching both the request for integrity assurance and the rejection of the package if such assurance is not forthcoming.

We thus find that the Examiner did not err in stating this rejection with regard to the Appellants' second contention.

#### CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1 to 49 under 35 U.S.C. § 103.

#### DECISION

R1: The rejection of claims 1 to 3, 7, 11 to 13, 19 to 21, 28 to 30, 37 to 39, 43 to 45, and 49 under 35 U.S.C. § 103(a) for being obvious over Ashley in view of Shear is affirmed.

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R2: The rejection of claims 4 to 5, 8, 14, 16, 22 to 23, 25, 31, 32, 34, 40, 41, 46 and 47 under 35 U.S.C. § 103(a) for being obvious over Ashley and Shear in view of McManis is affirmed.

R3: The rejection of claims 9 to 10, 17 to 18, 26 to 27, and 35 to 36 under 35 U.S.C. § 103(a) for being obvious over Ashley and Shear further in view of Jamroga is affirmed.

R4: The rejection of claims 6, 15, 24, 33, 42 and 48 under 35 U.S.C. § 103(a) for being obvious over Ashley and Shear further in view of McManis and Jamroga 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

msc

SCHWABE, WILLIAMSON & WYATT, P.C.  
PACWEST CENTER, SUITE 1900  
1211 SW FIFTH AVENUE  
PORTLAND OR 97204