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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/641,853	08/15/2003	Arthur Louis Gaetano JR.	IT-03-003	2920

40604 7590 01/13/2012

MITEL NETWORKS CORPORATION
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EXAMINER	
AGWUMEZIE, CHARLES C	
ART UNIT	PAPER NUMBER
3685	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ARTHUR LOUIS GAETANO JR.

Appeal 2010-004240
Application 10/641,853
Technology Center 3600

Before: ANTON W. FETTING, JOSEPH A. FISCHETTI, and BIBHU R. MOHANTY, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellant seeks our review under 35 U.S.C. § 134 from the Examiner's final rejection of claims 6-10 and 19-23. Claim 24 is canceled. Claims 1-5, 11-18, and 25-32 are withdrawn. We affirm and designate our affirmance as a new ground of rejection (37 C.F.R. § 41.50(b)).

THE INVENTION

Appellant claims a system and method for software site licensing (Spec. 1:4). Claims 6 and 19 are illustrative:

> 6. A software site license system comprising:
>
> a license sales site generating and transmitting a software license;
>
> a target site computer having a software site application, said software license corresponding to said software site application and said target site computer;
>
> a programming workstation receiving said software license from said sales site and uploading said license to said target; and
>
> a storage coupled to said target site, said storage including a plurality of licenses received from said workstation, said plurality of licenses comprising at least one previously uploaded license corresponding to a previous version of said software site application on said target, and said previously uploaded license capable of reload to said target without additional contact with said license sales site or another license transfer from said workstation.
>
> 19. A process for reloading a previously uploaded software site license corresponding to a software application, said process comprising;
>
> executing a management application on a programming workstation;
>
> coupling said programming workstation to a target computer having said software application thereon;

displaying on said programming workstation a list comprising a plurality of stored licenses applicable for and stored at said target computer;

viewing said list and selecting from said list said previously uploaded stored license from said plurality of stored licenses;

applying said previously uploaded license at said target computer as a current license; and

updating said list of said plurality of licenses to reflect the reload.

REFERENCES

The Examiner relies on the following prior art:

Stupek	US 5,960,189	Sep. 28, 1999
Misra	US 6,189,146 B1	Feb. 13, 2001
Klave	US 2003/0135728 A1	Jul. 17, 2003
Peinado	US 2005/0097368 A1	May 5, 2005

REJECTIONS

The following rejections are before us for review.

Rejection of claims 6-8[1] under 35 U.S.C. § 103(a) over Misra and Peinado.

Rejection of claims 9 and 10 under 35 U.S.C. § 103(a) over Misra, Peinado, and Stupek.

Rejection of claims 19, 20 and 23 under 35 U.S.C. § 103(a) over Misra and Klave.

Rejection of claims 21, and 22 under 35 U.S.C. § 103(a) over Misra, Klave, and Stupek.

[1] This ground was incorrectly labeled in the Answer, but the Examiner corrected it in the Miscellaneous Communication mailed October 2, 2009.

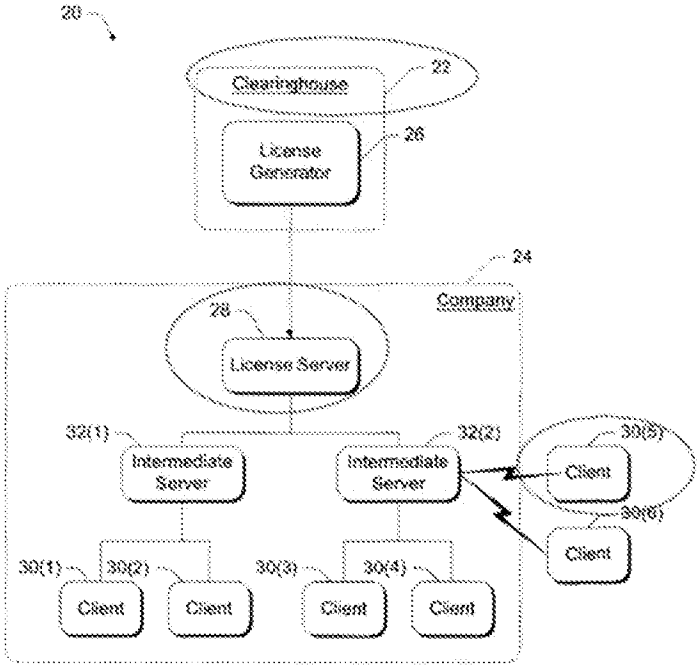
ISSUE

Did the Examiner err in finding that Misra discloses that old licenses in local client storage are replaced during version upgrades, based on a policy assumption that upgraded licenses will work for previous software versions?

FINDINGS OF FACT

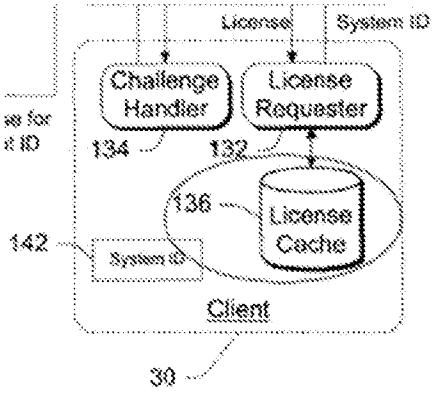
We find the following facts by a preponderance of the evidence.

1. Misra's "license generator located at a licensing clearinghouse" discloses the claimed *license sales site generating and transmitting a software license*. (Col. 2, ll. 22-23).
2. Misra's client 30, which "is responsible for managing the storage of that license" discloses the claimed *target site computer having a software site application, said software license corresponding to said software site application and said target site computer*. (Col. 4, ll. 64-67).
3. Misra's license server 28 discloses a *programming workstation receiving said software license from said sales site and uploading said license to said target*. (Col. 4, ll. 23-24).
4. Misra discloses the relationship of the *license sales site*/licensing clearinghouse 22, the *target site computer*/client 30, and the *programming workstation*/license server 28 as shown in Figure 1. Annotated Figure 1 of Misra is reproduced below:



Annotated Figure 1 of Misra depicts licensing clearinghouse 22, license server 28, and client 30.

5. Misra's license cache 136 that is part of client 30, as shown in Figure 3, discloses the claimed *storage coupled to said target site, said storage including a plurality of licenses received from said workstation*. An annotated portion of Misra's Figure 3 is reproduced below:



An annotated portion of Figure 3 of Misra depicts client 30 and license cache 136.

6. Misra discloses that license cache 136 stores the claimed *a plurality of licenses received from said workstation*/license server, in that the "license requestor **132** verifies the signature on the license to confirm that it came from the license server **28** and stores the software license in the license cache **136**. It is the responsibility of the license requester **132** to manage the licenses stored in the cache **136**." (Col. 12, ll. 8-12).
7. Misra discloses that the license cache 136 is kept in persistent storage (col. 12, ll. 15-16).
8. Misra discloses that when a license is upgraded to a license for a new version, the "client **30** replaces the old license with the upgraded one in the license cache **136** (step **252**)." (Col. 16, ll. 65-67).
9. Misra discloses that "licenses are assumed to be backward compatible. That is, a next generation 5.X license is always accepted by a current generation 4.X server." (Col. 17, ll. 1-3).
10. Misra discloses storing information about licenses in storage at the *target*/client 30, in that "licenses are organized in the license cache **136** according to information about the license issuing authority and product ID." (Col. 12, ll. 12-14).
11. Klave discloses a system for loading individual software components on a device (para. [0008]).
12. Klave discloses a "loading table" which "may be a license table including a list of licenses relating to the individual software components." (Para. [0011]).
13. Klave discloses *displaying* and *viewing* the list of licenses, and *selecting* from the list of licenses, stating, the "loading table **206** is then read **606**

and a corresponding feature list is displayed to the user. The user may then enable or disable **608** features as desired." (Para. [0047]).

14. Misra discloses a *predetermined number of licenses* based on the number of licenses purchased, stating the "license server **28** monitors the software licenses that have been granted to clients. The license server **28** can distribute licenses to new clients as long as it has available non-assigned licenses." (Col. 4, ll. 23-26).
15. Klave discloses a system for loading individual software components in computers (para. [0008]).
16. Stupek discloses the claimed *generating a summary of proposed modifications which will result from applying said previously uploaded license at said target and displaying said summary*, in that "the upgrade advisor **11** presents a report and/or graphical display to the user. This output is in the form of upgrade recommendations, each supported by an explanation of the reasons for upgrade." (Col. 4, ll. 6-9).

ANALYSIS

Claims 6-8 – New Ground

The rejection is affirmed as to claims 6-8. Appellant does not separately argue claims 7 and 8 that depend from independent claim 6. We select claim 6 as representative, and claims 7 and 8 fall therewith. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellant argues that "neither Misra nor Peinado, either alone or in combination, teach, suggest or disclose all the elements" of the claims. (App. Br. 13). Appellant's argument is based on the Examiner's statement that Misra does not disclose the claimed *storage coupled to said target site*, and that Peinado fails to "disclose that a previously uploaded license is

available for reload to the client without additional contact with the license server." (App. Br. 9-11) (emphasis omitted).

We are not persuaded by Appellant's argument. First, Misra discloses a *license sales site* at the licensing clearinghouse 22, the *programming workstation* at the license server 28, and the *target site computer* at the client 30 (FF 1-4). Misra further discloses the claimed *storage coupled to said target site, said storage including a plurality of licenses received from said workstation* at license cache 136 (FF 5-7).

Furthermore, we find that Misra also discloses a process for upgrading licenses from an older version to a newer version and, as part of this upgrade process, the old license in cache 136 is replaced by the new license which is backward compatible with the old license (FF 8, 9). We find that whether old licenses are replaced or retained, based on whether new licenses for new software versions work or does not work with older versions of software, is not a patentable distinction. A backwards-compatible license is a license for a new software version that also permits use of an old software version on which the newer version is based. It is common sense that if a new software version license only operates on the new version, the old license must be retained to enable the new version to operate on top of the old version. The obvious and predictable alternative would be to make the new license backward compatible as taught by Misra. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 401 (2007) ("If a person of ordinary skill in the art can implement a predictable variation, and would see the benefit of doing so, § 103 likely bars its patentability."). We therefore find that claim 6 is obvious over Misra, and find Peinado's disclosure is cumulative.

Since our analysis of the references differs from that of the Examiner, we designate our affirmance as a new rejection under 37 CFR § 41.50(b).

Claims 9 and 10

We affirm the rejection of claims 9 and 10. Appellant does not separately argue claim 10 that depends from claim 9. We select claim 9 as representative and claim 10 falls therewith. *See* 37 C.F.R. § 41.37(c)(1)(vii). Claim 9 recites, *inter alia*, "a summary of proposed modifications which will result from a reload of said previously uploaded license."

The Examiner relied on Stupek to disclose this limitation (Ans. 7-8). Appellant argues that Stupek does not disclose this limitation because "a 'summary of proposed modifications' is quite different than 'the reasons for an upgrade'" (App. Br. 14).

We are not persuaded by Appellant's argument. The limitation of *a summary of proposed modifications* in claim 9 is non-functional descriptive material because it describes data content that is part of claim 6 and which is not itself a structural component. Misra discloses information about licenses stored in the *storage* (FF 10), and thus discloses that it stores content at least similar to *a summary of proposed modifications*, thus meeting the claim 9 requirement.

Claims 19 and 20

We also affirm the rejection of claims 19 and 20. Appellant does not separately argue claim 20 that depends from independent claim 19. We select claim 19 as representative and claim 20 falls therewith. *See* 37 C.F.R. § 41.37(c)(1)(vii).

The Examiner found that Misra discloses the limitations of claim 19, except for the *displaying*, *viewing*, and *selecting* requirements, which the Examiner found in Klave (Ans. 9-10).

Appellant first argues, "Klave does not discuss the ability to reload a previously uploaded software site license corresponding to a software application, nor does the Examiner recite any specific passages of Klave to support that it does." (App. Br. 16).

Appellant's argument is not well taken because Appellant is attacking the references individually when the rejection is based on a combination of references. *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981). The Examiner found that Misra discloses *executing*, *coupling*, *applying*, and *updating,* and relied on Klave for the *displaying*, *viewing*, and *selecting* limitations (Ans. 9-10). Therefore, Appellant's argument as to Klave is unpersuasive.

Additionally, claim 19 does not require "the ability to reload a previously uploaded software site license" because this language only appears in the preamble, but not in the body of the claim. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999). Therefore, Appellant's argument as to reloading is unpersuasive because the reloading is not required in the body of the claim, because the claim does not limit from where the license was *uploaded*.

Nonetheless, even if this were not the case, we find Misra discloses that licenses are uploaded to the *programming workstation ... from said sales site* (FF 3), which we construe as an *uploaded license* that meets the claim requirement.

Appellant further argues, "Misra does not teach storing licenses locally at the client, but rather discloses that the license server must forward the previously uploaded license to the intermediate server which then passes it on to the client." (App. Br. 16). We disagree because Misra discloses storing a plurality of licenses "locally at the client" at cache 136 (FF 10).

Claim 23

Dependent claim 23 recites, *inter alia*, "wherein said plurality of stored licenses comprises a predetermined number of licenses and as a new license is added an older license is deleted."

Appellant argues, the "Examiner cites Misra Figure 8 and Table 1 for support of this limitation. A review of Figure 8 and Table 1 fails to provide any support for the limitation . . ." (App. Br. 16). We are not persuaded by Appellant's argument. Misra discloses a predetermined number of licenses are stored (FF 14) and that, in normal operation, when a license is upgraded the older, lower-level license is replaced (FF 8), thus meeting the claim requirements.

Claims 21 and 22

We affirm the rejection of claims 21 and 22. Appellant does not separately argue claim 21. We select claim 22 as representative and claim 21 falls therewith. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Claim 21 recites, *inter alia*, "generating a summary of proposed modifications which will result from applying said previously uploaded

license at said target and displaying said summary." This is similar to the system of claim 9, which recites the component of the "summary."

Appellant argues claim 21 based on the arguments presented with respect to claims 9 and 10 (App. Br. 13, 17). We are not persuaded of error in the Examiner's rejection because while the method of claim 21 requires *generating* and *displaying summary* information about a software upgrade, the information in the summary is non-functional descriptive material that does not affect the process of *generating* and *displaying a summary*. Moreover, Stupek discloses an upgrade advisor component that presents/displays a report with an explanation of reasons for a software upgrade (FF 16), meeting the claim requirement.

CONCLUSIONS OF LAW

The Examiner did not err in rejecting claims 6-8 under 35 U.S.C. § 103(a) over Misra and Peinado.

The Examiner did not err in rejecting claims 9 and 10 under 35 U.S.C. § 103(a) over Misra, Peinado, and Stupek.

The Examiner did not err in rejecting claims 19, 20, and 23 under 35 U.S.C. § 103(a) over Misra, Peinado, and Klave.

The Examiner did not err in rejecting claims 21 and 22 under 35 U.S.C. § 103(a) over Misra, Klave, and Stupek.

DECISION

For the above reasons, the Examiner's rejection of claims 6-10 and 19-23 is AFFIRMED, and we designate our affirmance as containing a new ground of rejection.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 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 CFR § 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).

AFFIRMED; 37 C.F.R. § 41.50(b)

nlk

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/641,853	08/15/2003	Arthur Louis Gaetano JR.	IT-03-003	2920

40604 7590 03/05/2010

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EXAMINER	
AGWUMEZIE, CHARLES C	
ART UNIT	**PAPER NUMBER**
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MITEL NETWORKS CORPORATION
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Appeal No: 2010-004240
Application: 10/641,853
Appellant: Arthur Louis Gaetano

Board of Patent Appeals and Interferences
Docketing Notice

Application 10/641,853 was received from the Technology Center at the Board on February 17, 2010 and has been assigned Appeal No: 2010-004240.

A review of the file indicates that the following documents have been filed by appellant:

Appeal Brief filed on:	June 09, 2009
Reply Brief filed on:	NONE
Request for Hearing filed on:	NONE

In all future communications regarding this appeal, please include both the application number and the appeal number.

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By order of the Board of Patent Appeals and Interferences.

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40604 7590 10/02/2009

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AGWUMEZIE, CHARLES C	

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
10641853	8/15/2003	GAETANO, ARTHUR LOUIS	IT-03-003

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EXAMINER	
CHARLES C. AGWUMEZIE	
ART UNIT	**PAPER**
3685	20090930

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Commissioner for Patents

This is to notify you that Examiner incorrectly listed claim 24 in the Grounds for rejection section of the Examiner's answer (see Grounds for Rejection section 9 of the Examiner's answer). Claim 24 is a cancelled claim and should not have been listed. The section should read CLAIMS 6-8 INSTEAD OF CLAIMS 6-10 and 19-24.

/Charlie C Agwumezie/
Primary Examiner, Art Unit 3685
September 30, 2009

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10/641,853	08/15/2003	Arthur Louis Gaetano JR.	IT-03-003	2920

40604 7590 09/16/2009

MITEL NETWORKS CORPORATION
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EXAMINER	
AGWUMEZIE, CHARLES C	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/641,853
Filing Date: August 15, 2003
Appellant(s): GAETANO, ARTHUR LOUIS

Michelle Whittington
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 15, 2009 appealing from the Office action mailed October 9, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,189,146	MISRA	2-2001
2005/0097368 A1	PEINADO et al	5-2005

5,960,189	STUPEK et al	09-1999
2003/0135728 A1	KLAVE et al	7-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. **Claims 6-10 and 19-24**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Misra et al U.S. Patent No. 6,189,146 B1(herein after "Misra") in view of Peinado et al U.S. patent Application Publication No. 2005/0097368 A1 (herein after "Peinado").

3. As per **claim 6**, Misra discloses a software site license system comprising:

a license sales site generating and transmitting a software license (fig. 1, which discloses Clearinghouse, license generator; col. 2, lines 20-45; …clearinghouse…);

a target site computer having a software site application, said software license corresponding to said software site application and said target site computer (fig. 1; col. 2, lines 20-45; …intermediate servers provide resources to clients…corresponding to licenses…);

a programming workstation receiving said software license from said sales site and uploading said license to said target (fig. 1; col. 4, lines 20-40; …license generator sends the license packs to license server…); and

a storage coupled to said target site, said storage including a plurality of licenses received from said workstation, said plurality of licenses comprising at least one previously uploaded license corresponding to a previous version of said software site application on said target, and said previously uploaded license capable of reload to said target without additional contact with said license sales site or another license transfer from said workstation

4. What Misra does not explicitly disclose is:

a storage coupled to said target site, said storage including a plurality of licenses received from said workstation, said plurality of licenses comprising at least one previously uploaded license corresponding to a previous version of said software site application on said target, and said previously uploaded license capable of reload to said target without additional contact with said license sales site or another license transfer from said workstation.

5. Peinado discloses:

a storage coupled to said target site, said storage including a plurality of licenses received from said workstation, said plurality of licenses comprising at least one previously uploaded license corresponding to a previous version of said software site application on said target, and said previously uploaded license capable of reload to said target without additional contact with said license sales site or another license

transfer from said workstation (see fig. 5A, which discloses check for valid, enabling licenses 16, in license store 38; 0140, which discloses that "the DRM system 32 either locates a valid, enabling license 16 in the license store steps 515, 517 or attempt to acquire a valid license"; 0142, which discloses that multiple such licenses 16 may be found, especially if the owner of the digital content 12, … obtained multiple ones of such licenses 16"; see also 0143-0144)

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Misra et al and incorporate a storage coupled to said target site, said storage including a plurality of licenses received from said workstation, said plurality of licenses comprising at least one previously uploaded license corresponding to a previous version of said software site application on said target, and said previously uploaded license capable of reload to said target without additional contact with said license sales site or another license transfer from said workstation in view of the teachings of Peinado since the claimed invention is merely a combination of old elements, and in combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

6. As per **claim 7**, Misra further discloses the software site license system, wherein said license sales site transmits an electronic file comprising said license to said programming workstation (col. 2, lines 30-45; col. 4, lines 20-40; "…license generator sends the license packs to license server…").

7. As per **claim 8**, Misra failed to explicitly disclose the software site license system, wherein said target site computer selects from said storage said previously uploaded license corresponding to said previous version of said software site application, and the selection occurs transparent to a user upon reinstallation of said previous version of said software site application.

Peinado discloses the software site license system, wherein said target site computer selects from said storage said previously uploaded license corresponding to said previous version of said software site application, and the selection occurs transparent to a user upon reinstallation of said previous version of said software site application (0142, which discloses that "based on the content ID of the digital content 12, the license evaluator 36 looks for any license 16 in the license store 38 that contains an identification of applicability to such content ID").

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Misra et al and incorporate the software site license system, wherein said target site computer selects from said storage said previously uploaded license corresponding to said previous version of said software site application, and the selection occurs transparent to a user upon reinstallation of said previous version of said software site application in view of the teachings of Peinado since the claimed invention is merely a combination of old elements, and in combination each element merely would have performed the same

function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

8. **Claims 9-10**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Misra et al U.S. Patent No. 6,189,146 B1(herein after "Misra") in view of Peinado et al U.S. patent Application Publication No. 2005/0097368 A1 (herein after "Peinado") as applied to claim 6 above, and further in view of Stupek, Jr. et al (herein after "Stupek") U.S. Patent No. 5,960,189.

9. As per **claims 9**, both Misra and Peinado failed to explicitly disclose the software site license system further comprising a summary of proposed modifications which will result from a reload of said previously uploaded license.

Stupek discloses the software site license system further comprising a summary of proposed modifications which will result from a reload of said previously uploaded license (see fig. 5B, which discloses "description of change between this version and previous version"; fig. 9, "upgrade reasons"; col. 4, lines 5-30, which discloses that "when the analysis is complete, the upgrade advisor II presents a report and/or graphical display to the user …upgrade recommendations…").

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Misra et al and incorporate the software site license system further comprising a summary of proposed modifications which will result from a reload of said previously uploaded license in view of the

teachings of Peinado since the claimed invention is merely a combination of old elements, and in combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

10. As per **Claims 10,** Misra et al does not expressly show a system wherein said summary is displayed on a display of said programming workstation.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The granting of license to client would have been performed the same regardless since the granting or refusal to grant the license is not dependent or associated on the display of the summary. Thus, this descriptive material will not distinguish the claimed invention from prior art in terms of patentability, see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to display the summary on the display workstation because such data does not functionally relate to the steps in the method or system claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Alternatively Stupek discloses a system wherein said summary is displayed on a display of said programming workstation (col. 4, lines 5-30, which discloses that “when

the analysis is complete, the upgrade advisor II presents a report and/or graphical display to the user …upgrade recommendations…").

11. **Claims 19-20, and 23,** , are rejected under 35 U.S.C. 103(a) as being unpatentable over Misra et al U.S. Patent No. 6,189,146 B1(herein after "Misra") in view of Klave et al (hereinafter "Klave") U.S. patent Application Publication No. 2003/0135728 A1.

12. As per **claim 19**, Misra discloses a process for reloading a previously uploaded software site license corresponding to a software application, said process comprising:

executing a management application on a programming workstation (fig. 1, which discloses Clearinghouse, license generator; col. 2, lines 20-45; …clearinghouse…);

coupling said programming workstation to a target computer having said software application thereon (fig. 1; col. 2, lines 20-45; …intermediate servers provide resources to clients…corresponding to licenses…);

displaying on said programming workstation a list comprising a plurality of stored licenses applicable for and stored at said target computer;

viewing said list and selecting from said list said previously uploaded stored license from said plurality of stored licenses;

applying said previously uploaded license at said target computer as a current license (col. 3, lines 1-7, col. 4, lines 49-58 and col. 12, lines 15-25, which discloses that

license server realizes … that the license has already been issued …the old license is simply returned to the client….”); and

updating said list of said plurality of licenses to reflect the reload (col. 3, lines 1-7, col. 4, lines 49-58 and col. 11, lines 25-30; col. 12, lines 15-25).

13. What Misra does not explicitly disclose is:

displaying on said programming workstation a list comprising a plurality of stored licenses applicable for and stored at said target computer;

viewing said list and selecting from said list said previously uploaded stored license from said plurality of stored licenses;

14. Klave discloses:

displaying on said programming workstation a list comprising a plurality of stored licenses applicable for and stored at said target computer (see fig. 6, which discloses user selects features enabling/disabling menu…loading table read and corresponding features list displayed to user…; 0011, which discloses that the loading table may be a license table including list of licenses relating to the individual software components…);

viewing said list and selecting from said list said previously uploaded stored license from said plurality of stored licenses (see fig. 6; 0011);

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant’s invention to modify the system of Misra et al and incorporate a process comprising displaying on said programming workstation a list comprising a plurality of stored licenses applicable for and stored at said target computer; viewing said list and selecting from said list said previously uploaded stored license from said

plurality of stored licenses in view of the teachings of Klave since the claimed invention is merely a combination of old elements, and in combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

15. As per **claims 20**, Misra et al further discloses the process, wherein said coupling occurs over the Internet (fig. 1).

16. As per **claim 23**, Misra et al further discloses the process, wherein said plurality of stored licenses comprises a predetermined number of licenses and as a new license is added an older license is deleted (fig. 8; table 1).

17. **Claims 21-22**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Misra et al U.S. Patent No. 6,189,146 B1(herein after "Misra") in view of Klave et al (hereinafter "Klave") U.S. patent Application Publication No. 2003/0135728 A1 as applied to claim19 above, and further in view of Stupek, Jr. et al (herein after "Stupek") U.S. Patent No. 5,960,189.

18. As per **claim 21**, both Misra and Klave failed to explicitly disclose the software site license system further comprising a summary of proposed modifications which will result from a reload of said previously uploaded license.

Stupek discloses the software site license system further comprising a summary of proposed modifications which will result from a reload of said previously uploaded license (see fig. 5B, which discloses "description of change between this version and previous version"; fig. 9, "upgrade reasons"; col. 4, lines 5-30, which discloses that "when the analysis is complete, the upgrade advisor II presents a report and/or graphical display to the user …upgrade recommendations…").

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Misra et al and incorporate the software site license system further comprising a summary of proposed modifications which will result from a reload of said previously uploaded license in view of the teachings of Stupek since the claimed invention is merely a combination of old elements, and in combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

19. As per **claim 22**, both Misra and Klave failed to explicitly disclose the process, wherein said applying step occurs only after receiving an approval of said summary.

Stupek discloses the process, wherein said applying step occurs only after receiving an approval of said summary (fig. 9, "upgrade reasons"; col. 4, lines 5-30, which discloses that "when the analysis is complete, the upgrade advisor II presents a report and/or graphical display to the user …upgrade recommendations…")

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Misra et al and incorporate the process wherein said applying step occurs only after receiving an approval of said summary in view of the teachings of Stupek since the claimed invention is merely a combination of old elements, and in combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

(10) Response to Argument

With respect to **claim 6**, Appellant argues that neither Misra nor Peinado discloses "a storage coupled to said target site, said storage including a plurality of licenses received from said workstation, said plurality of licenses comprising at least one previously uploaded license corresponding to a previous version of said software site application on said target, and said previously uploaded license capable of reload to said target without additional contact with said license sales site or another license transfer from said workstation." Specifically that Peinado does not teach or suggest or disclose that a previously uploaded license is available for reload to the client without additional contact with the license server.

In response, Examiner respectfully disagrees with Appellant's characterization for the following reasons: (1) Appellant's argument is limited than what is being claimed – the fact that the license is capable of reload to the target does not mean that it is actually being reloaded (2) Peinado's invention is capable of performing the claimed

function. For example Peinado describes a DRM system 32 that locates a valid, enabling license 16 in the license store of the client (see fig. 5A, 0140, step 515, 517) or in the alternative attempt to acquire a valid license from the license server if no valid license is found locally at the client device. The license is downloaded and stored at the client machine in license store 38. The license store 38, may contain a number of licenses 16 for device 14. Peinado Clearly describes a license store that contains multiple licenses and that when the digital content is rendered the DRM searches the client license store for a valid license. If none is found, the DRM attempts to acquire a license from the server. Among these processes as described by Peinado, one of ordinary skill would find it predictable that over some time period, reloading a previously uploaded license that is stored in client license store would occur since if a valid license is found in the client license store, it will reload it to the client without contacting the license server. Accordingly it would be predictable that the old license if found in the license store is capable of reload without additional contact with the license sales site or another transfer from the workstation since the license is stored or maintained within the client machine. Furthermore the concept of “reloading previously uploaded license corresponding to a previous version of said software site application on said target is a well known concept in the art. For example corporations and individuals usually downgrade their application if upgrade of that version is not functioning properly as long as the previous version of the application program exits. If the previous version of the application exits, downgrading to the previous version is always an attractive option in order to avoid downtime.

Applicant further argues with respect to claim 6, that Examiner is failing to fully appreciate what is being reloaded. That Appellant's claim recites that a previously uploaded license corresponding to previous version of said software site application on said target is capable of reload to the target.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). For example Misra have already discloses or described situations whereby the intermediate server 32 determines whether the license has expired and/or is for the older version of the application. Since Misra covers the previous version of the software site application it is not necessary that Peinado also cover it. But even if Peinado is required to describe previous version of the software site application, Examiner sees no reason why the digital content as disclosed by Peinado is not a software site application. Appellant is reminded that Misra is capable of reloading the previously uploaded license that corresponds to a previous version of the software site application on the target computer but not without contacting the license server. Peinado was introduced merely for the purpose of reloading the license without contacting the license server if the valid license is found in the client's license store 38.

With respect to **claims 9-10**, Appellant argues that Misra and Peinado fail to teach, suggest or disclose all the elements of claims 6, for which claims 9-10 depend. That because claim 6 is patentably distinct over the cited references, claims 9-10 are

equally distinct. That Appellant's claim recites "a summary of proposed modifications which will result from a reload of said previously uploaded license." Specifically, that a "summary of proposed modifications" is quite different than the reasons for an upgrade.

In response, Examiner respectfully disagrees and submits that Stupek clearly discloses a summary of the proposed modifications which included "description of changes between this version the previous version" (see fig. 5B), recommendations by the upgrade advisor II (col. 4, lines 5-30) and in addition the reasons for the upgrade. (see fig. 9). Accordingly the summary of the proposed modification is not different from the summary disclosed by Stupek.

With respect to **claims 19, 20 and 23**, Appellant argues that these claims are patentable over the combination of Misra and Klave. Specifically that Klave does not disclose or teach "displaying on said programming workstation a list comprising a plurality of stored licenses applicable for and stored at said target computer"; "viewing said list and selecting from said list said previously uploaded stored license from said plurality of stored licenses"

In response Examiner respectfully disagrees and submits that Klave does disclose the claimed features. For example Klave discloses that the user selects features enabling/disabling menu…loading table read and corresponding features list displayed to user…(see fig. 6) that the loading table may be a license table including list of licenses relating to the individual software components…(0011). Accordingly it is Examiner's position that Klave does disclose the claimed features as shown in the rejection.

With respect to **claim 23**, Appellant argues that this claim depends from claim 19 and recites that the "plurality of stored licenses comprises a predetermined number of licenses and as a new license is added an older license is deleted" That the cited figure fails to provide any support for the rejection.

In response, Examiner respectfully disagrees and submits that Misra discloses this limitation. It is not in doubt whether Misra stores plurality of licenses (number of generated or purchased licenses from clearinghouse) that comprises a predetermined number of licenses and as a new license is added an older license is deleted. For example when a client request license the old software license (see fig. 8, send old s/w license) is returned or deleted from the client and replaced with a new license (see fig. 8, replace old license in cache). According Misra does disclose the claimed limitation.

With respect to **claim 21-22**, Appellant argues that Stupek does not discloses the summary proposed modification which will result from a reload of said previously uploaded license.

In response Examiner respectfully disagrees and submits that Stupek does teach or suggest "a summary of the proposed modifications" which included "description of changes between this version and the previous version" (see fig. 5B), recommendations by the upgrade advisor II (col. 4, lines 5-30) and in addition the reasons for the upgrade. (see fig. 9). Accordingly Stupek does disclose a summary of the proposed modification as argued in claims 9-10 above and further reiterated herein.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Charlie C Agwumezie/
Primary Examiner, Art Unit 3685
September 9, 2009

Conferees:

Vincent Millin /vm/
Appeals Conference Specialist

/A. J. F./
Andrew J. Fischer
Supervisory Patent Examiner, Art Unit 3621

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED IN FIRST CLASS MAIL TO THE U.S. PATENT AND TRADEMARK OFFICE ON THE DATE INDICATED BELOW:

Date of Mailing: June 9, 2009 By: Michelle Whittington

Michelle Whittington

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Gaetano Jr. Atty. Docket No: IT-03-003

Appln. No.: 10/641,853 Group Art Unit: 3685

Filed: August 15, 2003 Examiner: AGWUMEZIE, Charles C.

Title: SYSTEM AND METHOD FOR SOFTWARE SITE LICENSING

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P.O. Box 1450
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BRIEF ON APPEAL

Pursuant to Appellant's Notice of Appeal filed on January 9, 2009, Appellant presents this Brief in appeal of the Final Rejection dated October 9, 2008.

I. REAL PARTY IN INTEREST

The real party in interest for this appeal and the present application is Inter-Tel, Inc., by way of an Assignment recorded in the U.S. Patent and Trademark Office at reel 014410, frame 0155. However, on June 28, 2006, Inter-Tel, Inc. reincorporated from Arizona to Delaware and changed its corporate name to Inter-Tel (Delaware), Inc. On August 16, 2007, Inter-Tel (Delaware), Inc. and Mitel Networks Corp. merged and the

resulting parent company is Mitel Networks Corp. having a principal place of business at 350 Legget Drive, Kanata, Ontario, Canada K2K 2W7. Thus, to the extent the assignee and the parent companies are the real parties in interest, then Inter-Tel, Inc. as assignee and Mitel Networks Corp. as parent.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences before the Board of Patent Appeals and Interferences or related judicial proceedings known to Appellant, the Appellant's legal representatives, or assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-32 have at one time, been pending in the present application. On March 27, 2007, Appellant cancelled claim 17. On June 29, 2007, the Examiner finally rejected all claims pending, 1-16 and 18-32. On October 1, 2007, Appellant responded with arguments and a Notice of Appeal. On December 10, 2007, the Examiner reopened prosecution and stated that all claims pending were subject to a restriction requirement. The Examiner separated the claims into (1) Species I which included claims 1-5, 11-16 and 18; (2) Species II which included claims 6-10 and 19-24; and (3) Species III which included claims 25-32. In response, Appellant elected Species II which comprises claims 6-10 and 19-24; claims 1-5, 11-18 and 25-32 were withdrawn. On June 19, 2008, Applicant cancelled claim 24. On October 9, 2008, the Examiner finally rejected all claims pending, claims 6-10 and 19-23.

Thus, claims 6-10 and 19-23 stand finally rejected and claims 6-10 and 19-23 are on appeal. Claims **Appendix A** containing a copy of the claims subject to this appeal is attached.

IV. STATUS OF AMENDMENTS

On June 29, 2007, the Examiner finally rejected all claims then-pending (1-16 and 18-32) under §§102 and 103 in view of Misra et al., U.S. Patent No. 6,189,146 and Misra in combination with Ryder, Sr. et al., U.S. Patent No. 4,953,209 and Doherty, U.S. Patent No. 6,920,567. On October 1, 2007, Applicant responded to the Final Action with arguments in favor of patentability over the cited references and filed a Notice of Appeal. On December 10, 2007, the Examiner reopened prosecution and stated that all claims pending, 1-16 and 18-32, were subject to a restriction requirement and separated them into (1) Species I which included claims 1-5, 11-16 and 18; (2) Species II which included claims 6-10 and 19-24; and (3) Species III which included claims 25-32. In response, Applicant elected with traverse Species II (claims 6-10 and 19-24) and claims 1-5, 11-18 and 25-32 were withdrawn. On March 19, 2008, the Examiner made final the restriction requirement and rejected all claims pending under 35 USC §103(a) as being unpatentable over Misra in view of Peinado et al., U.S. Patent Application Publication No. 2005/0097368. Additionally, claims 9, 10, 21 and 22 were rejected under 35 USC §103(a) as being unpatentable over Misra in view of Peinado and further in view of Stupek et al., U.S. Patent No. 5,960,189. On June 19, 2008, Applicant responded with arguments in favor of patentability over the cited references and cancelled claim 24.

On October 9, 2008, the Examiner finally rejected all claims pending, 6-10 and 19-23, under 35 USC §103(a) as being unpatentable over Misra in view of Peinado. Additionally, the Examiner finally rejected claims 9 and 10 over Misra in view of Peinado and further in view of Stupek; claims 19, 20 and 23 over Misra in view of Klave et al., U.S. Patent Application Publication No. 2003/0135728. A1, (hereinafter "Klave"); claims 21-22 over Misra in view of Klave and further in view of Stupek. A Notice of Appeal was filed on January 9, 2009.

No claim amendments or responses have been submitted after the October 9, 2008 Final Action or the Notice of Appeal.

V. SUMMARY OF CLAIMED SUBJECT MATTER

A concise explanation of the subject matter defined in each of the claims involved in the appeal (claims 6-10 and 19-23) is provided.

The claims do not stand or fall together. Each claim is to be considered by the Board in view of the arguments and comments submitted herein and of record.

The subject matter of Claim 6 is directed towards a software site license system (*see e.g.,* Fig. 1 (100)) comprising:

a license sales site generating and transmitting a software license (*see e.g.,* par. [0035], [0039]; Fig. 1 (104));

a target site computer (*see e.g.,* par. [0040]; Fig. 1 (112)) having a software site application, said software license corresponding to said software site application and said target site computer (*see e.g.,* par. [0041]);

a programming workstation receiving said software license from said sales site and uploading said license to said target (*see e.g.,* par. [0036]-[0039], [0042]-[0044]); Fig. 1 (115-117)); and

a storage coupled to said target site (*see e.g.,* par. [0014], [0040]; Fig. 1 (119)), said storage including a plurality of licenses received from said workstation, said plurality of licenses comprising at least one previously uploaded license corresponding to a previous version of said software site application on said target, and said previously uploaded license capable of reload to said target without additional contact with said

license sales site or another license transfer from said workstation (*see e.g.,* par. [0055], [0059], [0060], [0061]).

The subject matter of Claim 7 is directed towards the software site license system of claim 6, wherein said license sales site transmits an electronic file comprising said license to said programming workstation (*see e.g.,* par. [0039]).

The subject matter of Claim 8 is directed towards the software site license system of claim 6, wherein said target site computer selects from said storage said previously uploaded license corresponding to said previous version of said software site application, and the selection occurs transparent to a user upon reinstallation of said previous version of said software site application (*see e.g.,* par. [0015], [0061]).

The subject matter of Claim 9 is directed towards the software site license system of claim 6 further comprising a summary of proposed modifications which will result from a reload of said previously uploaded license (*see e.g.,* [0052], [0053], [0061]; Fig. 4).

The subject matter of Claim 10 is directed towards the software site license system of claim 9, wherein said summary is displayed on a display of said programming workstation (*see e.g,* par. [0053]; Fig. 4).

The subject matter of Claim 19 is directed towards a process for reloading a previously uploaded software site license corresponding to a software application (*see e.g.,* Fig. 3), said process comprising;

executing a management application on a programming workstation (*see e.g.,* par. [0037], [0058] ; Fig. 3 (302));

coupling said programming workstation to a target computer having said software application thereon (*see e.g.,* par. [0039], [0042]-[0044], [0058]; Fig. 3 (310));

displaying on said programming workstation a list comprising a plurality of stored licenses applicable for and stored at said target computer (*see e.g.,* par. [0056]);

viewing said list and selecting from said list said previously uploaded stored license from said plurality of stored licenses (*see e.g.,* par. [0061]);

applying said previously uploaded license at said target computer as a current license (*see e.g.,* par. [0061]); Fig. 3 (340)); and

updating said list of said plurality of licenses to reflect the reload (*see e.g.,* par. [0055], [0062]; Fig. 2 (236)).

The subject matter of Claim 20 is directed towards the process of claim 19, wherein said coupling occurs over the Internet (*see e.g.,* par. [0039], [0042]; Fig. 1).

The subject matter of Claim 21 is directed towards the process of claim 19 further comprising generating a summary of proposed modifications which will result from applying said previously uploaded license at said target and displaying said summary (*see e.g.,* [0052], [0053], [0061]; Fig. 4).

The subject matter of Claim 22 is directed towards the process of claim 21, wherein said applying step occurs only after receiving an approval of said summary (*see e.g.,* [0052], [0053], [0061]).

The subject matter of Claim 23 is directed towards the process of claim 19, wherein said plurality of stored licenses comprises a predetermined number of licenses and as a new license is added an older license is deleted (*see e.g.,* [0063]).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The only issues for consideration on this Appeal are:

A. Whether **claims 6-8** and are unpatentable as having been obvious under 35 U.S.C. §103(a) over the proposed combination of Misra et al., U.S. Patent No. 6,189,146 and Peinado et al., U.S. Pub. No. 2005/0097368;

B. Whether **claims 9-10** are unpatentable as having been obvious under 35 U.S.C. §103(a) over the proposed combination of Misra, Peinado and Stupek, Jr. et al., U.S. Patent No. 5,960,189;

C. Whether **claims 19, 20 and 23** are unpatentable as having been obvious under 35 U.S.C. §103(a) over the proposed combination of Misra and Klave et al., U.S. Pub. No. 2003/0135728; and

D. Whether **claims 21-22** are unpatentable as having been obvious under 35 U.S.C. §103(a) over the proposed combination of Misra, Klave and Stupek.

VII. ARGUMENT

LEGAL STANDARD

The PTO bears the burden of establishing a proper case of *prima facie* obviousness. *In re Rijckaert*, 9 F.3d 781, 783 (Fed. Cir. 1993). In order to satisfy this burden, [the Office personnel] must: (a) determine the scope and contents of the prior art; (b) ascertain the differences between the prior art and the claims in issue; (c) determine the level of ordinary skill in the pertinent art; and evaluate any evidence of secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

If the proposed modification or combination of the prior art would "change the principle of operation of the prior art invention being modified, then the teachings of the

references are not sufficient to render the claims *prima facie* obvious." *In re Ratti*, 270 F.2d 810 (CCPA 1959).

If proposed modification would render the prior art unsatisfactory for its intended purpose, there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). There must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___,____, 82 USPQ2d 1385, 1396 (2007).

A. CLAIMS 6-8 ARE PATENTABLE OVER THE COMBINATION OF MISRA AND PEINADO

ARGUMENT

Appellant has detailed the disclosure of Misra in previous Responses (*see e.g.,* 03/27/07 Resp to 1st OA; 10/01/07 Resp to 2nd OA; 12/17/07 Resp to 3rd OA; 06/19/08 Resp to 4th OA), thus it would be somewhat redundant to fully describe Misra again. However, for clarity, portions of Misra are reiterated below.

In general, Misra discloses a software licensing system wherein a company sends a purchase request to a license generator for a software license. The license generator creates the software license and sends it to a license server. The license server 28 is responsible for distributing the software licenses to the individual clients and stores the individual software licenses for subsequent distribution to clients 30. When a client needs a license, the license server determines the client's operating system platform and grants the appropriate license and the *current license* is stored locally at the client. The license server 28 maintains an inventory of licenses that have been purchased and monitors the licenses that have been granted to the clients.

Reload of License

Misra does not explicitly show the steps for reloading an existing license in a Figure, however it does discuss the process for recovering previously issued licenses. When the intermediate server 32 requests a license on behalf of the client 30, the license server 28 initially checks if the requesting client has already been issued a license. When this situation is detected, *the **license server** reissues the existing license to the client*. This is actually reissuing the same license, ***from the license server to the client,*** that was previously issued. This allows the client to gracefully recover licenses from the license server when they are lost. [Misra column 3 lines 1-7, column 4 lines 49-58, and column 12 lines 15-24 "*license server realizes...that the license has already been issued...the old license is simply returned to the client.*"]. The client 30 includes a local cache 136 that is capable of storing a *single license* for the client. For example, throughout Misra, it is disclosed that the cache "replaces" old licenses with upgraded licenses and that old licenses must be "returned" from the client (step 240). Presumably, the reissued license replaces any licenses in the license cache 136 and the reissued license becomes the current license for client 30. **Thus, the license server forwards the previously uploaded license to the intermediate server which passes it on to the client. The client stores the reissued license in the cache. The requirement that the *license server has to forward the previously issued license back to the client* evidences that the client itself *does not store the previously issued license in the cache.***

The Examiner admits that Mirsa fails to disclose:

"*a storage coupled to said target site, said storage including a plurality of licenses received from said workstation, said plurality of licenses comprising at least one previously uploaded license corresponding to a previous version of said software site applicaotion on said target, and said previously uploaded license capable of reload to*

said target without additional contact with said license sales site or another license transfer from said workstation."

as recited in Appellant's **claim 6**. To fill in the deficiency, the Examiner cites Peinado.

In general, Peinado discloses an architecture for enforcement of rights in digital content. When a user requests a license, the client machine (user's computing device 14) sends local ID information to the license server 24, and such license server issues a license 16 only if the information is current and valid. The license is downloaded and stored at the client machine in license store 38. The license store 38 may contain a number of licenses 16 for device 14. When a user attempts to render digital content on the computing device, the rendering application invokes a Digital Rights Management (DRM) system on the device. If the user is attempting to render the digital content for the first time, the DRM either directs the user to the license server 24 to obtain a license or obtains the license transparently for the user. It is important to note that license server 24 is a separate element from client machine 14. When the DRM system 32 has been requested to render a piece of digital content 12 and one or more licenses 16 corresponding to the content are present in the license store 38, a license evaluator 36 of the DRM proceeds to determine if the licenses are valid. If no valid license is found, then the DRM may perform a license acquisition.

Appellant's independent **claim 6** recites that the storage includes "*at least one previously uploaded license corresponding to a* ***previous version of said software site application on said target****, and said previously uploaded license capable of reload to said target without additional contact with said license sales site or another license transfer from said workstation*." As explainted in Appellant's specification, it is desirable to maintain previous licenses onsite for convenient site reactivation, if needed. (Specification [0010]). For example, when a new software application or upgrade has

been installed along with the new license, it is possible that the new application will not perform properly. The user may then wish to simply go back to the previous software application until the errors in the new version are corrected. The license for the old version as well as the new version are readily available so the old license can be quickly reloaded *without additional contact with the license sales site or another transfer from the workstation*. (Applicant's Figure 3). In other words, the previously uploaded license can be reloaded to the target computer without further contact with a licensing server.

On pages 2, 3 and 5 the Action, the Examiner points to Peinado Figure 5A for support. The description of Figure 5A begins at par. [0140]; "the DRM system 32 either locates a valid, enabling license 16 in the license store (steps 515, 517) or attempts to acquire a valid license *from the license server 24*."

It is undisputed that the license store contains multiple licenses. In fact, most computing devices today include multiple licenses so that multiple types of applications can run. Peinado discloses that when the digital content is rendered (e.g., played), the DRM system searches the license store for a valid license associated with that particular digital content. If none is found, the DRM attempts to acquire a license from the server. **Nowhere does Peinado teach, suggest or disclose that a previously uploaded license is available for reload to the client without additional contact with the license server**.

The Examiner seemingly admits that Peinado fails to teach that a previously uploaded license is available for reload to the client without additional contact with the license server, and states that "it is *predictable* that over some time period, reloading a previously uploaded license would occur...and that the old license if found in the license store is capable of reload without additional contact." However, the Examiner is failing to fully appreciate *what* is being reloaded. Appellant's claim recites that a previously uploaded license corresponding to *previous version of said software site application on*

said target is capable of reload the target. In other words, as the claim recites, the target computer having a "software site application" and the software license corresponds to the software site application and the target computer. The storage coupled to the target computer includes at least one previously uploaded license that corresponds to a *previous version of the software site application on the target computer* and the previously uploaded license is capable of reload.

For clarity, Appellant explains in the specification that often times when a new software application or upgrade is installed on a computer, the new application may not perform as expected. Thus, the user may wish to simply go back to the previously installed software application until the developer corrects the errors in the new version. Thus, the previously uploaded license that corresponds to the previous version of the software site application is readily retreivable from the storage. (See e.g., Appellant's par. [0058]-[0059]).

Peinado fails to disclose having "versions" of software site applications and in fact, it is questionable whether the "digital content 12" as disclosed by Peinado is even equivalent to a "software site application" as claimed by Appellant. Peinado discloses that "digital content" is digital audio, digital video, digital text, digitial data, digital multimedia, ect. , where such digital content is to be distributed to users. Upon being received by the user, such user renders or "plays" the digital content with the aid of an appropriate rendering device such as a media player. (Peinado par. [0004]). Thus, the "digital content" as described in Peinado is akin to an electronic book, movie or music and not a "software site application" as disclosed by Appellant.

Appellant claims a "software site license" system for use with a "software site application" on a target computer. As is commonly known, a "site license" is obtained to enable software programs at a "site". For example, companies purchase software for use on mulitple computers but will only buy one copy of the application (i.e., "software

site application") and a license to enable the number of reproductions at the site. Thus, a "site license" and a "software site application" are very different than a one-time download of digital content for personal viewing or listening. It is highly unlikely that Peinado's "digital content" can be considered a "software site application" since a main objective to Peinado is to prevent copying to other systems or re-distribution of the content.

Because Peinado is silent with respect to reloading of previously uploaded licenses, the Examiner attempts to make an argument that it is "predictable" that "over some time" a license in the license store will be a previously uploaded license. Appellant submits that this is a long stretch and in fact, contradicts what Peinado actually discloses regarding reissuing of licenses. For example, Peinado par [0177] states that when a license needs to be reissued "it is preferable that the **license server 24** maintain a database 50 of issued licenses 16 (FIG.1), and that ***such license server 24 provide a user with a copy or re-issue of an issued license 16 if the user is in fact entitled to such re-issue.***" Thus, Peinado clearly anticipates that if a reissue of a license is needed, that the license be sent ***from the license server to the user*** and not retrieved from the license store as suggested by the Examiner.

Accordingly, Appellant submits that neither Misra and Peinado, either in alone or in combination, teach, suggest or disclose all the elements of Appellant's **claims 6-8** as recited.

B. CLAIMS 9-10 ARE PATENTABLE OVER THE COMBINATION OF MISRA, PEINADO AND STUPEK

ARGUMENT

By the Examiner's admission, Misra and Peinado fail to disclose the software site license comprises "a summary of proposed modifications which will result from a reload

of said previously uploaded license." The Examiner cites Stupek to fill in the deficiency. As pointed out, the combination of Misra and Peinado fail to teach, suggest or disclose all the elements of Appellant's claim 6, for which claims 9-10 depend. Accordingly, Appellant submits that because claim 6 is patentably distinct over the cited references, claims 9-10 are equally distinct.

Nonetheless, Appellant rebuts the Examiner's contentions that Stupek discloses the claimed limitation. The Examiner points to Stupek Figures 5B and 9 as well as column 4, lines 5-30 for support. Figure 5B depicts "template for records in an upgrade database" and specifically, the "Description database 27" of Figure 5B stores information that describes each upgrade found in a package. A description 27e of the *change between the updated version and the previous version* of the upgrade object is provided. The description 27e includes reasons why the upgrade is necessary, drawing information from development release notes, test reports and field service reports. (Stupek col. 7 lines 35-51). Further, Figure 9 depicts a screen shot of a graphical user interfacr for an upgrade advisor as disclosed by Stupek. Specifically, the "reasons 59 for the upgrade (i.e., upgrade description) are displayed in the list box 51". (Stupek col. 9 lines 32-36). Finally, the upgrade advisor 11 presents a report and/or grahical display to the user. This output is in the form of "upgrade recommondations, each supported by an explanation of the reasons for upgrade". (Stupek col. 4 lines 5-10).

In contrast, Appellant's claims recite "a summary of proposed modifications which will result from a reload of said previously uploaded license." Appellant submits that a "summary of proposed modifications" is quite different than "the reasons for an upgrade" such as what is supported by release notes and field reports. For example, Appellant's Figure 4 is an exemplary display of the proposed modifications. As is readily seen, the "summary" may provide a comparison of the current license features with the to-be installed license features. At a glance, the installer can view the

differences in features between the old and new licenses. (Appellent's par. [0053]). The "reasons" why an upgrade is recommended is not akin to a "summary of proposed modification" such as a comparison of features. Furthermore, Stupek speaks only to displaying the "reasons for the upgrade" and does not specifically mention displaying anything with respect to "a reload of a previously uploaded license."

Accordingly, Appellant submits that Stupek, either in alone or in combination with Misra and Peinado, teach, suggest or disclose all the elements of Appellant's **claims 9-10** as recited.

C. CLAIMS 19, 20 AND 23 ARE PATENTABLE OVER THE COMBINATION OF MISRA AND KLAVE

ARGUMENT

The Examiner admits that Misra fails to disclose "*displaying on said programming workstation a list comprising a plurality of stored licenses applicable for and stored at said target computer; and viewing said list and selecting from said list said previously uploaded stored license from said plurality of stored licenses*" as recited in Appellent's claim 19. The Examiner cites Klave to fill in the deficiencies

Klave discloses a system to reduce volatile memory usage by loading individual software components. An embedded device or system 26 typically includes hardware components and is a multi-functional peripheral, such as a combination printer/fax/copier. (Klave par. [0025]). The embedded device 26 includes both volatile memory (RAM) and non-volatile memory (ROM, flash). (*see e.g.,* Klave Fig. 1). The non-volatile memory 81 according to Klave includes a loading table 206, which may be a license table, including a list of licenses relating to the individual software components. The loading table may be configured based on licenses for each software component. (Klave par. [0041]; Table 2). The embedded device 26 may include a

communications module for communications with a computer and web inferface. (Klave par. [0012]).). In certain embodiments, the user may configure the loading table through use of a web browser.

Contrary to Klave, Appellant's claim 19 recites "selecting from said list [comprising a plurality of stored licenses applicable for and stored at said target computer] *said previously uploaded stored license*". Klave does not discuss the ability to reload a previously uploaded software site license corresponding to a software application, nor does the Examiner recite any specific passages of Klave to support that it does. Klave's objective is to "**reduce volatile memory usage.**" Thus, it seems contradictory to Klave's objective to keep previously uploaded licenses stored as this certainly takes memory. Accordingly, it seems unlikely that Klave would favor storing previously uploaded licenses and keeping such licenses available for reload. Further, as was already pointed out, Misra does not teach storing licenses locally at the client, but rather discloses that the license server must forward the previously uploaded license to the intermediate server which then passes it on to the client.

Appellant's claim 23, which depends from claim 19, recites that the "plurality of stored licenses comprises a predetermined number of licenses and as a new license is added an older license is deleted." The Examiner cites Misra Figure 8 and Table 1 for support of this limitation. A review of Figure 8 and Table 1 fails to provide any support for the limitation and it is difficult to determine why these illustrations were selected by the Examiner. Since the Examiner has yet to elaborate in any of the Actions, Appellant hopes that the Examiner's Answer will provide some insight.

Accordingly, Appellant submits that neither Misra and Klave, either in alone or in combination, teach, suggest or disclose all the elements of Appellant's **claims 19, 20 and 23** as recited.

D. CLAIMS 21-22 ARE PATENTABLE OVER THE COMBINATION OF MISRA, KLAVE AND STUPEK

ARGUMENT

By the Examiner's admission, Misra and Klave fail to disclose the software site license further comprising a summary of proposed modifications which will result from applying said previously uploaded license." As with previous claims 9 and 10, the Examiner cites Stupek to fill in the deficiency. As just pointed out, the combination of Misra and Klave fail to teach, suggest or disclose all the elements of Appellant's claim 19, for which claims 21-22 depend. Accordingly, Appellant submits that because claim 19 is patentably distinct over the cited references, claims 21-22 are equally distinct.

Nonetheless, Appellant rebuts the Examiner's contentions that Stupek discloses the claimed limitation. Appellant directs the Board to the arguments above under "B" for support of Appellant's rebuttal. Accordingly, Appellant submits that Stupek, either in alone or in combination with Misra and Klave, teach, suggest or disclose all the elements of Appellant's **claims 21-22** as recited.

VIII. CONCLUSION

It is respectfully submitted that in view of the foregoing all of the pending claims are patentable over the cited prior art and the Board is respectfully requested to overturn the rejections of record and allow this application to issue.

IX. CLAIMS APPENDIX

A claims **Appendix A** containing a copy of claims subject to this appeal is attached.

X. EVIDENCE APPENDIX

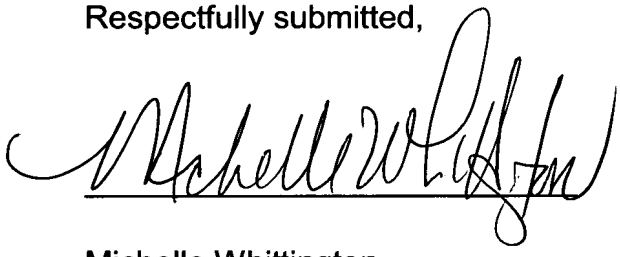
None submitted.

XI. RELATED PROCEEDINGS APPENDIX

None (no related proceedings).

The Commissioner is hereby authorized to charge any additional fees and credit any overpayment associated with this Appeal to Inter-Tel Deposit Account No. 502721.

Respectfully submitted,



Michelle Whittington

Appellant's Attorney

Registration No. 43,844

Mitel Networks Corporation

Date: June 9, 2009

APPENDIX A
CLAIMS

1-5 (withdrawn)

6. A software site license system comprising:

a license sales site generating and transmitting a software license;

a target site computer having a software site application, said software license corresponding to said software site application and said target site computer;

a programming workstation receiving said software license from said sales site and uploading said license to said target; and

a storage coupled to said target site, said storage including a plurality of licenses received from said workstation, said plurality of licenses comprising at least one previously uploaded license corresponding to a previous version of said software site application on said target, and said previously uploaded license capable of reload to said target without additional contact with said license sales site or another license transfer from said workstation.

7. The software site license system of claim 6, wherein said license sales site transmits an electronic file comprising said license to said programming workstation.

8. The software site license system of claim 6, wherein said target site computer selects from said storage said previously uploaded license corresponding to said previous version of said software site application, and the selection occurs transparent to a user upon reinstallation of said previous version of said software site application.

9. The software site license system of claim 6 further comprising a summary of proposed modifications which will result from a reload of said previously uploaded license.

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CLAIMS

10. The software site license system of claim 9, wherein said summary is displayed on a display of said programming workstation.

11-18 (withdrawn)

19. A process for reloading a previously uploaded software site license corresponding to a software application, said process comprising;

executing a management application on a programming workstation;

coupling said programming workstation to a target computer having said software application thereon;

displaying on said programming workstation a list comprising a plurality of stored licenses applicable for and stored at said target computer;

viewing said list and selecting from said list said previously uploaded stored license from said plurality of stored licenses;

applying said previously uploaded license at said target computer as a current license; and

updating said list of said plurality of licenses to reflect the reload.

20. The process of claim 19, wherein said coupling occurs over the Internet.

21. The process of claim 19 further comprising generating a summary of proposed modifications which will result from applying said previously uploaded license at said target and displaying said summary.

22. The process of claim 21, wherein said applying step occurs only after receiving an approval of said summary.

APPENDIX A
CLAIMS

23. The process of claim 19, wherein said plurality of stored licenses comprises a predetermined number of licenses and as a new license is added an older license is deleted.

24 (cancelled)

25-32 (withdrawn)

APPENDIX B
(Evidence Appendix)

There is no additional evidence relied upon in this Appeal.

APPENDIX C
(Related Proceedings Appendix)

There are no proceedings or decisions related to this Appeal.