

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FLAVIO M. MANDULEY

Appeal No. 95-4184
Application 07/813,080¹

ON BRIEF

Before JERRY SMITH, BARRETT, and FLEMING, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed December 24, 1991, entitled "REMOTE ACTIVATION OF SOFTWARE FEATURES IN A DATA PROCESSING DEVICE."

Appeal No. 95-4184
Application 07/813,080

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 19-23, 27-33, and 37, all of the claims pending in the application. Claims 1-18, 24-26, and 34-36 have been cancelled. The Amendment after Final Rejection received January 6, 1995 (Paper No. 11), has not been entered.

We reverse.

The disclosed invention is directed to a method for remotely activating an optional feature, such as a software application program, in a data processing device. The method includes the step of automatically ordering additional necessary hardware for the data processing device if activation of the optional feature requires additional necessary hardware. For example, if the requested optional feature was an envelope printing feature which required an envelope printer peripheral, and the hardware was not present, an order would automatically be placed for the hardware; specification, pages 12-13.

Claim 19 is reproduced below.

19. A method of activating an optional feature in a data processing device to enable said data processing device to access said optional feature for execution by said data processing device, said optional feature being

stored in said data processing device, said method comprising the steps of:

- (a) receiving a request to activate said optional feature;
- (b) in response to said activation request generating an activation request code, said activation request code including information which identifies said data processing device and said optional feature;
- (c) transmitting said activation request code to a data center; said data center responding to receipt of said activation request code to generate an activation code, said activation code identifying said optional feature; and
- (d) inputting said activation code to said data processing device, said data processing device responding to said activation code to enable access to said optional feature; whereby,
- (e) activation of said optional feature occurs under control of said data center; and,
- (f) and the further step of automatically ordering additional necessary hardware for said data processing device if activation of said optional feature in said data processing device requires said additional necessary hardware.

The examiner relies on what the examiner considers to be admitted prior art and the following prior art references:

Dunham et al. (Dunham)	4,791,565	December 13, 1988
Robert et al. (Robert)	4,937,863	June 26, 1990
Wilson et al. (Wilson)	5,113,222	May 12, 1992
		(filed January 22, 1991)
Calvert et al. (Calvert)	5,287,505	February 15, 1994
		(effective filing date March 17, 1988)

Appeal No. 95-4184
Application 07/813,080

Claims 19-23 and 27-33 stand rejected under 35 U.S.C. § 103 as being unpatentable over Robert or Dunham in view of Calvert and what the examiner considers to be admitted prior art.

Claim 37 stands rejected under 35 U.S.C. § 103 as being unpatentable over Robert or Dunham in view of Calvert and Wilson.

We refer to the Examiner's Answer (Paper No. 15) for a statement of the examiner's position and to the Brief (Paper No. 14) for appellant's position.

OPINION

We agree with the examiner that Robert and Dunham disclose steps (a) through (e) of claims 19 and 37, but do not disclose step (f), the automatic ordering of additional necessary hardware required by the activation of the optional feature. The "optional feature" corresponds to a particular software program that the user wants to run in Robert and Dunham.

In Robert (col. 3, lines 41-47):

When a user wishes to use a licensed program 14, a GRANT LICENSE request message is generated which requests information as to the licensing status of the licensed

Appeal No. 95-4184
Application 07/813,080

program 14. The GRANT LICENSE request message is transmitted to the licensing policy module 15, which notifies the operating system of the request.

The policy module receiving the GRANT LICENSE request (also shown as step 50 in figures 4A-1) corresponds to claimed step (a). "The operating system 13, in turn, passes the request, along with the system marketing model of the specific system 16 being used by the user, to the license management facility 10 which determines whether use of the program is permitted under the license." Col. 3, lines 47-51. The system is identified by the system marketing model (SMM) code (col. 2, lines 60-62). Thus, the action of the operating system sending the request and the SMM to the license management facility (also shown in step 52 in figure 4A-1) corresponds to claimed step (b) and the "transmitting" step in claimed step (c).

In Robert, if the license management facility determines that the usage of the desired licensed program is permitted under usage restrictions "the license management facility transmits a usage approved response to the operating system 13" (col. 4, lines 31-33). The step of the license management facility transmitting a positive response to the

Appeal No. 95-4184
Application 07/813,080

operating system (also shown as step 76 in figure 4A-3) corresponds to the steps of the data center responding to the receipt of a request to generate an activation code identifying the software in claimed step (c) and the step of inputting the activation code to the data processing device in claimed step (d). The operating system in Robert then transmits the approval to the licensing policy model, which then permits usage of the licensed program (shown as steps 77 and 78 in figure 4A-4), which corresponds to the step of the data processing step responding to the activation code to enable access to the optional feature in claimed step (d). Therefore, Robert activates an optional feature (a software program) under control of a data center (the license management facility) as recited in the "whereby" clause of step (e).

In Dunham, a software protection device 10 monitors the security port of central processor 16. When a terminal 14 requests authorization to run a particular program, the central processor issues a request on security lines 18 to device 10 to inquire whether running of the program is authorized (col. 4, line 65, to col. 5, line 7). This

Appeal No. 95-4184
Application 07/813,080

corresponds to claimed steps (a), (b), and the "transmitting" step of step (c), where the device 10 is the data center. If the request is within the authorization provided by the software license, device 10 provides a response to the central processor 16 indicating that operation of the program is authorized and the program is then permitted to run (col. 5, lines 12-18). This corresponds to the remainder of claimed step (c) and to steps (c), (d), and (e).

We agree with the examiner's handling of appellant's arguments regarding Robert and Dunham in the Examiner's Answer. In particular, we agree that appellant does not point to the limitations in the claims that are relied on to support the arguments and we do not find supporting limitations; therefore, the arguments are not commensurate in scope with the claims. See In re Self, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982) ("Many of appellant's arguments fail from the outset because . . . they are not based on limitations appearing in the claims."). For example, the arguments about a "license" seem to ignore that Robert performs the recited steps; it does not make any difference that the steps are performed in connection with a licensing arrangement or other

Appeal No. 95-4184
Application 07/813,080

additional criteria. Moreover, although appellant's application does not mention that activation is based on licensing of software, since "[s]oftware is typically sold under license" (Robert, col. 1, lines 45-46), it is probable that part of the basis for authorization in appellant's method would implicitly involve licensing.

The examiner acknowledges that Robert and Dunham do not disclose step (f) and applies Calvert as evidence of obviousness of automatically ordering parts (Examiner's Answer, page 4). Appellant argues that "Calvert is teaching a 'repair' and is not teaching that a software/hardware configuration analysis can be made and that hardware can be automatically ordered at the customer site to overcome a deficiency in the hardware configuration required by the customer program selection" (Brief, pages 4-5). The examiner disagrees with the argument for the following reasons (Examiner's Answer, page 10):

First, Calvert clearly teaches "configuration analysis" in that it is only by knowing what the correct configuration is that an incorrect configuration that needs repair can be determined. Second, if a part is needed in order for a computer system to operate correctly, the [sic, then] clearly the part is a ["']deficiency in the hardware configuration'".

Appeal No. 95-4184
Application 07/813,080

The examiner appears to be responding to the wording of appellant's argument rather than the claim language.

Claims 19 and 37 both require "automatically ordering additional necessary hardware" upon the condition that "said optional feature in said data processing system requires said additional necessary hardware." This is the language that supports appellant's argument about "a deficiency in the hardware configuration required by the customer program selection" (Brief, page 5) Calvert provides a system and method for automated servicing of data processing systems. The customer system detects data concerning its own configuration and problem symptoms, which are communicated to a central service data processing system. The system service automatically orders hardware repair modules and software fixes (abstract; col. 11, lines 50-60). However, Calvert only orders repair or replacement hardware for failing hardware components of the customers system and does not order additional hardware. Nor does Calvert disclose or suggest ordering hardware upon the condition that the activated "optional feature in said data processing system requires said additional necessary hardware." Calvert does not disclose

Appeal No. 95-4184
Application 07/813,080

activation of an optional feature. The examiner does not address the limitations about additional hardware required by the user's selection of an optional feature. Thus, we conclude that the examiner has failed to establish a prima facie case of obviousness with respect to independent claims 19 and 37. The rejections of claims 19-23, 27-33, and 37 are reversed.

REVERSED

JERRY SMITH)	
Administrative	Patent Judge)
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)	
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)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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Appeal No. 95-4184
Application 07/813,080

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