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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SETH NICKELL and BRYAN WILLIAM CLARK

Appeal 2010-008158
Application 11/171,452
Technology Center 2100

Before ELENI MANTIS MERCADER, BRADLEY W. BAUMEISTER,
and DENISE M. POTHIER, *Administrative Patent Judges*.

BAUMEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL

SUMMARY

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-3 and 5-8, which stand rejected under 35 U.S.C. § 103(a) as obvious over McCulligh (US 6,643,784 B1; Nov. 4, 2003) in view of Hiles (US 6,026,491; Feb. 15, 2000).

We reverse.

Pursuant to our authority under 37 C.F.R. 41.50(b), we reject independent claim 1 under 35 U.S.C. § 101 for being directed to non-patentable subject matter.

STATEMENT OF THE CASE

Appellants describe their invention as follows:

Methods and systems are provided to assist users with the entry of strong passwords. The password may be considered strong if it satisfies one or more requirements. A set of these requirements may be selected and then presented to the user. The requirements may be randomly selected one by one or as a group. The requirements may also be presented to the user one by one in a random order or in the form of a list with a random order. As characters for the password are entered, the user may then be notified when one or more [sic: of] the requirements have been satisfied.

(Abstract).

Independent claim 1 is illustrative:

1. A method of creating a password, wherein the password is subject to a set of requirements, said method comprising:

randomly selecting a first requirement from the set of requirements;

providing the first requirement for creating the password;

receiving characters for the password;

determining whether the characters satisfy the first requirement;

providing information that indicates whether the characters satisfy the first requirement; and

randomly selecting a second requirement for creating the password from the set of requirements in response to the characters satisfying the first requirement, wherein the second requirement is selected independently of the first requirement.

POSITIONS AND CONTENTIONS

The Examiner finds that McCulligh discloses every limitation of claim 1 except “McCulligh does not teach that the first and second requirements for creating the password are *randomly* selected independently from a set of requirements” (Ans. 5). The Examiner finds, though, that “[r]andomly selecting requirements from a set of requirements was well-known” (*id.*). To support this finding, the Examiner cites Hiles, which the Examiner maintains, “teaches such random selection of requirements for forming a password” (*id.* (citing col. 4, ll. 10-21)).

Appellants contend that “*Hiles* fails to disclose, teach, or suggest a random selection of requirements for forming a password, and fails to cure the deficiencies of *McCulligh*” (App. Br. 11). Appellants specifically assert, *inter alia*, “that *Hiles* [instead] teaches allowing access only after a user provides successful personalized response phrases, or passwords, to a series of sequentially-presented challenge phrases” (Reply Br. 6).

ANALYSIS

Appellants’ arguments are persuasive. The portions of Hiles cited by the Examiner are directed to protocols for selecting challenge phrases (*e.g.*,

Ans. 10 (citing col. 4, ll. 10-21)). Challenge phrases are phrases “selected by the user to serve as a reminder of the appropriate response” (col. 2, ll. 37-38). This “appropriate response,” or answer to the challenge, is a “very long password phrase[]” that allows the user to gain access to the system (col. 1, ll. 66-67; col. 2, ll. 2-4, 10-19). The act of randomly generating challenge phrases that serve as prompts for a user’s previously-created passwords is not the same thing as randomly selecting requirements for *creating* a password, as required by claim 1.

Accordingly, we do not sustain the Examiner’s rejection of:
(1) independent claims 1, 7, and 8, which all contain commensurate limitations of randomly selecting a second requirement for creating a password, or (2) claims 2, 3, 5, and 6, which depend from independent claim 1.

NEW REJECTION UNDER 35 U.S.C. § 101

Independent claim 1 is directed to a method of creating a password. Although a method (or “process”) is one of the four patent-eligible subject matter categories, further analysis indicates that claim 1 wholly embraces a judicially recognized exception. *See* Memorandum from Andrew H. Hirshfeld, Acting Deputy Comm’r for Patent Examination Policy, U.S. Patent and Trademark Office, to the Technology Center Directors, *New Interim Patent Subject Matter Eligibility Examination Instructions* (August 24, 2009), *available at* http://www.uspto.gov/web/offices/pac/dapp/opla/2009-08-25_interim_101_instructions.pdf.

Claim 1 does not recite any computer or other machine. For example, the claim does *not* recite that the steps of randomly selecting and providing

the requirements must be performed by a computer, that the steps of receiving characters for the password must be performed by a computer, or that the step of determining whether the characters satisfy any requirements must be performed by a computer. As such, claim 1 is broad enough to read on two human beings communicating verbally, with the first person performing all of the recited steps. For example, the first person: (1) selects and provides through speech the requirements for creating the password and the information that indicates whether the characters satisfy the requirements to a second person; (2) receives the selected characters for the password from the second person through speech; and (3) determines whether the characters satisfy the requirements by making mental decisions based upon some previously established set of parameters.

We, therefore, conclude that claim 1 is not tied to a particular machine or apparatus, and claim 1 does not transform a particular article to a different state or thing. That is, claim 1 fails the so-called “machine-or-transformation test.” The claim, instead, wholly embraces the judicially recognized exception of abstract ideas. Specifically, the claim is directed to a set of mental processes and communications that can be performed solely by a human being.

Having determined that claim 1 fails the machine-or-transformation test, we next consider whether any additional factors indicate that claim 1 is nonetheless patent-eligible. *See* Memorandum from Robert W. Bahr, Acting Assoc. Comm’r for Patent Examination Policy, U.S. Patent and Trademark Office, to the Patent Examining Corps, *Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of Bilski v. Kappos* (July 27, 2010), *available at*

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http://www.uspto.gov/patents/law/exam/bilski_guidance_27jul2010.pdf
(including *Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of Bilski v. Kappos*, 75 Fed. Reg. 43,922 (July 27, 2010) (notice)).

We are unable to identify any additional factors that would weigh towards eligibility. We therefore exercise our authority under 37 C.F.R. § 41.50(b), rejecting independent claim 1 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Although we decline to reject every claim under our discretionary authority under 37 C.F.R. § 41.50(b), we emphasize that our decision does not mean the remaining claims are patent eligible under § 101. Rather, we merely leave the patentability determination of these claims to the Examiner. *See* MPEP § 1213.02.

DECISION

The Examiner's decision rejecting claims 1-3 and 5-8 is reversed.

Pursuant to our authority under 37 C.F.R. § 41.50(b), we enter a new ground of rejection for claim 1 under 35 U.S.C. § 101.

Regulation 37 C.F.R. § 41.50(b) (2007) states that “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Furthermore, 37 C.F.R. § 41.50(b) also provides that Appellants, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new grounds 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

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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).

REVERSED
37 C.F.R. § 41.50(b)

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