

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* WARD SCOTT FOSTER, ROBERT JOHN MADRIL, JR., and  
SHELL STERLING SIMPSON

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Appeal 2009-004152  
Application 10/229,642  
Technology Center 2100

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Decided: February 4, 2010

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Before JAMES D. THOMAS, ST. JOHN COURTENAY III, and  
CAROLYN D. THOMAS, *Administrative Patent Judges*.

J. THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 4-9, 12-15, and 21-26. Claims 1-3, 10, 11, and 16-20 have been cancelled.

We reverse and institute new grounds of rejection under 37 C.F.R. §41.50(b).

## II. INVENTION

The instant invention discloses:

Authorizing access to a network resource utilizing an autonomous authorization service. One method embodying the invention includes receiving a request to access a resource and acquiring credentials, identifying an authorization service that is autonomous of the resource, providing the credentials to the authorization service and requesting authorization to access the resource. The authorization service authenticates the credentials and authorizes access the resource only if the credentials are authentic.

(Spec. 19, Abst.; Figs 1-3, and 5).

## III. ILLUSTRATIVE CLAIM

4. In a computer network, a method for authorizing a request by an application to access a resource on behalf of a user, comprising:  
    providing an authorization service that is autonomous from the application and  
    the resource;  
    the authorization service receiving from the resource user credentials and a  
    request to authorize a request by the application to access the resource, the user  
    credentials having been obtained from the user by the application ;  
    authenticating the credentials; and  
    returning an authorization response to the resource with instructions to grant  
    the application's request to access the resource if the credentials are authentic or to  
    otherwise deny the application's request to access the resource.

#### IV. PRIOR ART AND EXAMINER'S REJECTION

The Examiner relies on the following references as evidence of unpatentability:

Mashayekhi	5,818,936	Oct. 6, 1998
Clark	2003/0065792 A1	Apr. 3, 2003 (filed Sep. 28, 2001)
Hartman	6,807,636 B2	Oct. 19, 2004 (filed Feb. 13, 2002)

Claims 4-9, 12-15, and 21-26 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the Examiner relies upon Clark in view of Mashayekhi, further in view of Hartman.

#### V. FINDINGS OF FACT

Appellants' disclosed systems depicted in Figures 1 and 2 comprise various services and a client. This client is disclosed in paragraph [0015] as a software program. The resource access system of Appellants' invention comprises logical components including the earlier-noted services, which comprise any programming for the recited function according to Appellants' Specification paragraph [0020], that have been illustrated in Figures 1 and 2. Additionally, the claimed computer readable medium in independent claims 12 and 14 on appeal is said to comprise signal embodiments that are discussed in Specification paragraph [0029].

## VI. PRINCIPALS OF LAW

### *Statutory Subject Matter*

The subject matter of claims permitted within 35 U.S.C. § 101 must be a machine, a manufacture, a process, or a composition of matter. Moreover, our reviewing court has stated that “[t]he four categories [of § 101] together describe the exclusive reach of patentable subject matter. If the claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful.” *In re Nuijten*, 500 F.3d 1346, 1354 (Fed. Cir. 2007), *reh’g en banc denied*, 515 F.3d 1361 (Fed. Cir. 2008), *cert. denied*, 127 S. Ct. 70 (2008). *Accord In re Ferguson*, 558 F.3d 1359 (Fed. Cir. 2009). Thus, a “signal” cannot be patentable subject matter because it is not within any of the four categories. *In re Nuijten*, 500 F.3d at 1357. Laws of nature, abstract ideas, and natural phenomena are excluded from patent protection. *Diamond v. Diehr*, 450 U.S. 175, 188 (1981). A claim that recites no more than software, logic or a data structure (i.e., an abstraction) does not fall within any statutory category. *In re Warmerdan*, 33 F.3d 1354, 1361 (Fed. Cir. 1994).

## VII. ANALYSIS

### *Rejection under 35 U.S.C. § 103*

We reverse the outstanding rejection of all claims on appeal, claims 4-9, 12-15, and 21-26, as being obvious over the collective teachings of Clark, in view of Mashayekhi, further in view of Hartman. In rendering our decision to reverse this rejection, we assume for the sake of argument that

the three references relied upon by the Examiner in formulating this rejection are properly combinable within 35 U.S.C. § 103.

At the outset, page 3 of the Answer sets forth the Examiner's statement of the rejection beginning with independent claim 4. The Examiner asserts that Clark, in only one paragraph, teaches an authorization service, a resource, and an application, each of which are set forth in the claims on appeal. Additionally, Mashayekhi is asserted by the Examiner to correspondingly teach an authorization service, a resource, an application and user credentials. As noted in both the Brief and Reply Brief, the Examiner has not directly addressed the details of independent claims 6 and 8, each of which are representative other independent claims on appeal. Since the focus of Appellants' arguments beginning at page 8 of the principal Brief on appeal, as well as in the Reply Brief, is upon the teachings in Mashayekhi relied upon by the Examiner, the responsive arguments entail only one paragraph at page 8 of the Answer that respond to these arguments and focuses only on Mashayekhi as well.

Although we recognize that the applied prior art is properly combinable within 35 U.S.C. 103, we are unable to map between Clark and especially Mashayekhi the claimed features of an authorization service, a resource, and an application, as well as a user to the extent necessary to properly determine obviousness within 35 U.S.C. § 103. The Examiner has not detailed correlations of all of these features to each of these references, but has left the reader to do it. Among the various portions of Clark and Mashayekhi, especially, we would necessarily have to speculate as to what the Examiner intends these respective four elements in all claims on appeal to correspond to among the teachings of them that are claimed. We will not

do this and, thus, we will not resort to speculation to do this. Therefore, we must conclude that the Examiner has failed to establish a prima facie case of obviousness of all claims on appeal. As such, the Examiner's rejection under 35 U.S.C. § 103 of all claims on appeal is reversed.

#### VIII. NEW REJECTION UNDER 35 U.S.C. § 101

We reject all claims on appeal, claims 4-9, 12-15 and 21-26 as being directed to non-statutory subject matter. As variously recited among the claims on appeal, the disclosed and claimed "services" are construed to be directed to software entities per se when reviewed in light of the Specification portions that we have identified in our Finding of Fact section in this opinion. The services of the claims on appeal are logical constructs or software abstractions. System claims, independent claims 21 and 26, are directed to software-based systems per se. Additionally, the computer readable mediums recited in the preamble of independent claims 12 and 14 on appeal are directed toward signal-based embodiments when construed in light of the Specification as filed. The earlier-noted case law prohibits patent protection for these claimed features.

#### IX. CONCLUSION AND DECISION

We have shown that the Examiner erred in finding that the combination of Clark, Mashayekhi, and Hartman within 35 U.S.C. §103 teaches or suggests the features of an authorization service, a resource, an application, and a user as recited in illustrative independent claim 4 on appeal without speculation. On the other hand, we have instituted a new

Appeal 2009-004152  
Application 10/229,642

ground of rejection of all claims on appeal, claims 4-9, 12-15, and 21-26, under 35 U.S.C. §101 as being directed to non-statutory subject matter.

37 C.F.R. § 41.50(b) provides that, “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the 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 proceedings (37 C.F.R. § 1.197 (b)) 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 37 C.F.R. § 41.52 by the Board upon the same record ...

REVERSED  
37 C.F.R. § 41.50(b)

nhl

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
3404 E. Harmony Road  
Mail Stop 35  
FORT COLLINS, CO 80528