



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/315,046	12/22/2005	Mujianto Rusman	DC-10335	8445
33438	7590	05/03/2010	EXAMINER	
HAMILTON & TERRILE, LLP P.O. BOX 203518 AUSTIN, TX 78720			MEYERS, MATTHEW S	
			ART UNIT	PAPER NUMBER
			BPAI	
			NOTIFICATION DATE	DELIVERY MODE
			05/03/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

tmunoz@hamiltontertile.com

1 UNITED STATES PATENT AND TRADEMARK OFFICE

2
3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7
8 *Ex parte* MUJIANTO RUSMAN, DAVID MICHAEL,
9 and KATHERINE REICHERT
10

11
12 Appeal 2009-005789
13 Application 11/315,046
14 Technology Center 3600
15

16
17 Decided: April 29, 2010
18
19

20
21 *Before* MURRIEL E. CRAWFORD, HUBERT C. LORIN, and JOSEPH A.
22 FISCHETTI, *Administrative Patent Judges*.

23
24 CRAWFORD, *Administrative Patent Judge*.

25
26
27 DECISION ON APPEAL

1 STATEMENT OF THE CASE

2 Appellants appeal under 35 U.S.C. § 134 (2002) from a Final
3 Rejection of claims 1, 3-7, and 9-12. We have jurisdiction under 35 U.S.C.
4 § 6(b) (2002).

5 Appellants invented systems and methods for activating licenses for
6 software preloaded onto information handling systems (Abstr.).

7 Independent claim 1 under appeal reads as follows:

- 8 1. A method for a manufacturer of an
9 information handling system to pay royalties for
10 software preloaded onto an information handling
11 system comprising:
12 determining when software that is preloaded
13 onto the information handling system is executed
14 by a user;
15 paying a royalty for the software when the
16 software is executed by the user so as to make the
17 royalty payment based upon a point of use of the
18 software; and,
19 determining when a component needed to
20 use the software is not present in the information
21 handling system and if the component is not
22 present, then not paying the royalty.
23

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

26 Cheston US 7,143,067 B1 Nov. 28, 2006

27 The Examiner rejected claims 1, 3-7, and 9-12 under 35 U.S.C.
28 § 102(b) as being anticipated by Cheston.

29 We REVERSE.

1 The system and method has the advantage that a listing of the users
2 and their respective software is maintained so that upgrades can be managed
3 and computers with particular combinations of loaded software can be
4 generated if needed. The listing of software installed for use on computers
5 can also be used for generating a list of machines on which royalties are to
6 be paid, which can serve as both a listing of royalties due and a “receipt”
7 showing the computers on which a royalty for the listed software has been
8 paid (col. 3, l. 63 through col. 4, l. 5).

9 Once the software for a particular personal computer has been
10 selected at block 160, then the selected software is converted from unusable
11 form into usable form (col. 7, ll. 54-56).

12 The concept is that any given software is converted into usable form
13 only when there is a mechanism to provide for the payment of royalties for
14 the particular software (col. 8, ll. 15-18).

15

16

PRINCIPLES OF LAW

17

Inherency

18

19

20

21

To establish inherency, the extrinsic evidence must make clear that
the missing descriptive matter is necessarily present in the thing described in
the reference, and that it would be so recognized by persons of ordinary
skill. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999).

22

23

ANALYSIS

24

25

26

We are persuaded that the Examiner erred in asserting that the
conversion of selected software from unusable form into usable form in
Cheston inherently corresponds to “determining when software that is

1 preloaded onto the information handling system is executed by a user,” as
2 recited in independent claims 1 and 7 (App. Br. 3-5). Specifically, we
3 disagree with the Examiner that “[i]f a user of Cheston was to convert a
4 program, it would be inherent within the reference that the program would
5 also be executed” (Exam’r’s Ans. 9). Conversion can occur in the absence
6 of execution, and it certainly does not follow that execution *necessarily*
7 follows conversion as required for inherency. Indeed, the Specification
8 makes distinctions between preloading, activation, and execution of software
9 (Spec. 5:24-26, 6:20-23).

10 Moreover, even if execution necessarily follows conversion, the cited
11 portions of Cheston only disclose determining *when conversion occurs*, by
12 placing the computers with converted software on a list for royalties, and not
13 *when execution occurs* as recited in independent claims 1 and 7. As the
14 cited portions of Cheston do not determine when execution occurs, only that
15 execution will occur on a particular machine some indeterminate time in the
16 future because conversion has occurred, we will not sustain this rejection.

17
18 **CONCLUSION OF LAW**

19 The Examiner did err in rejecting claims 1, 3-7, and 9-12 under 35
20 U.S.C. § 102(b).

21
22 **DECISION**

23 The decision of the Examiner to reject claims 1, 3-7, and 9-12 is
24 reversed.

25
26 **REVERSED**

Appeal 2009-005789
Application 11/315,046

1 hh

2

3

4 HAMILTON & TERRILE, LLP

5 P.O. BOX 203518

6 AUSTIN, TX 78720

7