

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(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT C. BEETCHER,
MICHAEL J. CORRIGAN,
FRANCIS J. REARDON, JR. and
JAMES W. MORAN

Appeal No. 95-1888
Application 08/011,042¹

ON BRIEF

Before THOMAS, KRASS, and CARMICHAEL, Administrative Patent
Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's

¹ Application for patent filed January 29, 1993. According to appellants, this application is a continuation of Application 07/629,295, filed December 14, 1990 (Abandoned).

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final rejection of claims 1-26, which constitute all the claims in the application.

Representative claim 1 is reproduced below:

1. An apparatus for controlling the use of a software module executing on a computer system, said computer system comprising:

means for granting entitlement for said computer system to execute said software module, said software module being a program unit that is discrete and identifiable with respect to compiling, combining with other units, and loading;

a plurality of independent triggering means in said software module for triggering entitlement verification;

entitlement verification means, responsive to each of said plurality of independent triggering means, for verifying that said computer system has entitlement to execute said software module; and

means, responsive to said entitlement verification means, for aborting execution of said software module if said entitlement verification means determines that said computer system lacks entitlement to execute said software module.

There are no references relied on by the examiner.

Claims 1-26 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. As variously expressed by the examiner in the final rejection and subsequent answers, the examiner considers the claims to be directed to mathematical algorithms or merely abstract

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manipulations occurring within a computer.

Rather than repeat the positions of the appellants and the examiner, reference is made to the various briefs and answers,

as well as the final rejection, for the respective details thereof.

OPINION

Generally, for the reasons expressed by appellants in the briefs on appeal, we reverse the outstanding rejection of claims 1-26 under 35 U.S.C. § 101.

At the outset, we do not agree with the examiner's view that the claims are directed merely to mathematical algorithms, per se. To the extent the claims recite any mathematical algorithms or operations, they do so indirectly. We also do not agree with the examiner's characterization that the claims on appeal merely involve abstract manipulations on or within a computer. Each independent claim 1, 9, 16 and 20 on appeal in some way relates to controlling access to software executing on a general purpose digital computer for the purpose of preventing unlicensed persons from executing

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the software. Generally speaking, causing or controlling a computer's operation or execution of programs there within is within the technological arts. Specifically, granting or denying accessibility to data or software within or on a computer system is a practical application within 35 U.S.C. § 101 of any mathematical operations so recited. Between the preamble recitations and the recitations within the body of each independent claim, there is an integration of the operations to control in some way the operation of computer programs within a given machine, namely the computer executing the software.

This reasoning is true even for the article of manufacture-type claims 16-19 involving a program product apparatus including the recitation of at least one software module recorded on recording media.

The examiner's reasoning in part was based upon the so-called Freeman-Walter-Abele test. However, the Court of Appeals for the Federal Circuit recently indicated in State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F.3d 1368, 1374, 47 USPQ2d 1596, 1601 (Fed. Cir. 1998), that "application of the test could be misleading,

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because a process, machine, manufacture, or composition of matter employing a law of nature, natural phenomenon, or abstract idea is patentable subject matter even though a law of nature, natural phenomenon, or abstract idea would not, by itself, be entitled to such protection." In other words, "a claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula, computer program or digital computer." Diamond v. Diehr, 450 U.S. 175, 187, 209 USPQ 1, 8 (1981). Additionally, the Court in State Street indicated that the focus of a statutory subject matter analysis should be "on the essential characteristics of the subject matter, in particular, its practical utility." State Street, 149 F.3d at 1375, 47 USPQ2d at 1602.

In view of the foregoing, the decision of the examiner rejecting claims 1-26 under 35 U.S.C. § 101 is reversed.

REVERSED

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	JAMES D. THOMAS)	
	Administrative Patent Judge)	
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	ERROL A. KRASS)	BOARD OF
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