

# **EXHIBIT E**

2010 WL 2800803 (Bd.Pat.App. & Interf.)

Board of Patent Appeals and Interferences  
Patent and Trademark Office (P.T.O.)

\*1 Ex Parte Chet Birger, David C. Douglas, Steven Rosenthal, and Kenneth R. Traub

Appeal 2009-006556  
Application 10/372,399 Technology Center 2400

July 13, 2010

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Before JAMES D. THOMAS, MAHSHID D. SAADAT, and CARL W. WHITEHEAD, JR.  
Administrative Patent Judges  
THOMAS  
Administrative Patent Judge

DECISION ON APPEAL<sup>[FN1]</sup>

STATEMENT OF THE CASE

This is an appeal under [35 U.S.C. § 134](#)(a) from the Examiner's final rejection of claims 1 through 60. We have jurisdiction under [35 U.S.C. § 6](#)(b).

We vacate the rejections before us under [35 U.S.C. § 103](#) and institute a new ground of rejection within the provisions of [37 C.F.R. § 41.50](#)(b).

*Invention*

A computer architecture for enterprise device applications provides a real-time, bi-directional communication layer for device communication. An identity-based communications layer provides for secure, end-to-end telemetry and control communications by enabling mutual authentication and encryption between the devices and the enterprise. The identity-based communications layer is situated between a network layer and an application layer and transmits a message between two devices identified by a global address. The global address specifies a protocol, a network, and an address meaningful for the combination of the protocol and the network.  
(Abstract, Spec. 84; Figures 3-6.)

*Representative Claim*

1. A method for communicating between two endpoints connected to a network, the method comprising having a first endpoint use a global address of a second endpoint to communicate with the second endpoint, wherein:

the global address specifies a protocol, a network identifier, and an address meaningful for the combination of the protocol and a network identified by the network identifier,

an application sends messages directed to the second endpoint through an identity-based communication layer that is situated between a network layer and an application layer, the messages being independent of the protocol, and

the identity-based communication layer transmits the messages to the second endpoint using the protocol, the network, and the address specified by the global address.

#### *Prior Art and Examiner's Rejections*

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

Ivanoff	5,517,622	May 14, 1996
Traversat	2002/0188657 A1	Dec. 12, 2002 (filed Jan. 22, 2002)
Cabrera	2003/0101284 A1	May 29, 2003 (filed Nov. 27, 2001)
Raciborski	6,836,806 B1	Dec. 28, 2004 (filed Sept. 18, 2000)

\*2 All claims on appeal, claims 1-60, stand rejected under [35 U.S.C. § 103](#). As evidence of obviousness as to claims 1, 2, 19, 30-35, 37, 38, 41-44, 47, 49, 50, 52, 53, 56, 58, and 59, the Examiner relies upon Ivanoff in view of Raciborski. This combination of references is utilized by the Examiner to reject claims 5-8, 46, and 55, further in view of Cabrera. Lastly, the initial combination of references of Ivanoff in view of Raciborski is utilized, further in view of Traversal, to reject claims 3, 4, 9-18, 20-29, 36, 39, 40, 45, 48, 51, 54, 57, and 60.

#### ANALYSIS

We vacate the prior art rejections encompassing all claims on appeal because we conclude that all claims on appeal, claims 1 through 60, are “barred at the threshold by § 101.” [In re Comiskey, 554 F.3d 967, 973 \(Fed. Cir. 2009\)](#) (citing [Diamond v. Diehr, 450 U.S. 175, 188 \(1981\)](#)). Therefore, the following new ground of rejection is set forth in this Opinion within the provisions of [37 C.F.R. § 41.50\(b\)](#).

#### NEW REJECTION UNDER [35 U.S.C. § 101](#)

##### PRINCIPLES 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 \(Fed. Cir. 2007\)](#); accord [In re Ferguson, 558 F.3d 1359 \(Fed. Cir. 2009\)](#). This latter case held that claims directed to a “paradigm” are nonstatutory under [35 U.S.C. § 101](#) as representing an abstract idea. 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. at 185](#). 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 Warmerdam*, 33 F.3d 1354, 1361 (Fed. Cir. 1994). Significantly, “Abstract software code is an idea without physical embodiment.” *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437, 449 (2007). The unpatentability of abstract ideas was confirmed by the U.S. Supreme Court in *Bilski v. Kappos*, No. 08-964, 2010 WL 2555192 (June 28, 2010).

\*3 With this background in mind, all claims on appeal, claims 1-60, are rejected under [35 U.S.C. § 101](#) as being directed to nonstatutory subject matter. Consistent with our earlier-noted invention statement from Appellants' disclosed Abstract, the disclosed and claimed invention is directed to software per se, abstract ideas, abstract concepts, and the like, including data per se, data items, messages, addresses, identities, data structures, software layers, software applications, software protocols, and the abstract intellectual processes associated with them within the claims on appeal.

This brief analysis is clearly seen from representative independent method claim 1 on appeal as well as a variation of it recited in independent method claim 37 on appeal. In like manner, independent claims 43 and 49 recite computer-readable mediums in the preamble, which in turn embody a computer program said to comprise one or more code segments configured to perform the processing corresponding to the subject matter of representative independent claim 1 on appeal. This computer-readable medium is plainly directed to internet communications as disclosed in addition to the intent to directly claim software per se. Thus, the medium includes and encompasses signals per se, and because it is disclosed to be directed to internet-based communications media, these medium claims are inclusive of transitory signaling embodiments, which are proscribed by the earlier-noted case law. Note also the analysis provided by *Subject Matter of Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010).

From our earlier remarks, it is clearly seen that the system of claims 52 and 58 recite features in the body of these claims corresponding to the features actually recited in the body of representative independent method claim 1 noted earlier. The network of the preamble of these claims is correspondingly directed to the electronic signaling environment just discussed. Moreover, the claimed system appears to be directed to the abstract “system architecture” noted within Appellants' Abstract we reproduced in our invention statement earlier in this opinion, which in turn recites a real-time bi-directional communication layer which is a software or abstract construct itself. Based on the manner in which claim 52, for example, recites the claimed processor, it is not necessarily hardware or a computer itself, and no computer is directly claimed either in the preamble of this claim or the body of the claim. Significantly as well, as disclosed at Specification page 11, line 10, the expansive scope of the term “device” is intended to encompass data objects themselves, such as objects of data associated with or within a software environment, or software objects as well. Thus, a “device” is a nonce word of substantially broad scope having an optional meaning intended to be attributed to it as disclosed and, in fact, amounts to an abstraction in its own sense. A “device” in this application is not necessarily a physical device.

#### CONCLUSION and DECISION

\*4 We have *pro forma* reversed the outstanding rejections over applied prior art of all claims on appeal, claims 1-60. We have instituted a new ground of rejection within [37 C.F.R. § 41.50\(b\)](#). This new rejection of all claims on appeal is based upon [35 U.S.C. § 101](#) since these claims are directed to non-statutory subject matter.

A new ground of rejection is pursuant to [37 C.F.R. § 41.50\(b\)](#). [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 re-

cord ....

No time period for taking any subsequent action in connection with this appeal may be extended under [37 C.F.R. § 1.136\(a\)\(1\)\(iv\)](#).

VACATED [37 C.F.R. § 41.50\(b\)](#)

FN1. The two-month time period for filing an appeal or commencing a civil action, as recited in [37 C.F.R. § 1.304](#), or for filing a request for rehearing, as recited in [37 C.F.R. § 41.52](#), begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

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