

IN RE ENHANCED SECURITY RESEARCH, LLC Appeal No. 2013-1114 (Fed. Cir. January 13, 2014). Before Dyk, O'Malley, and Taranto. Appealed from PTAB.

Background:

Enhanced Security Research, (ESR) appealed to the Federal Circuit after a finding of obviousness by the Board of Patent Appeals and Interferences ("the Board," now PTAB) during a third-party-requested *ex parte* re-examination of the ESR Patent.

The patent claims "a computer security device and method for preventing unauthorized individuals from gaining access to a local computer network." The patent specification describes an intelligent network security device ("INSD") that is capable of balancing the desire for network security against the need for network accessibility protecting the local network by: (1) monitoring the data packets flowing into and out of the network in order to detect suspicious patterns of communications, (2) assigning weighted values to any threatening activity it detects, and (3) blocking communications based on their assigned weight using a firewall. The applied prior art included a manual which describes a *configurable* software product that purportedly discloses the *capability* to perform each feature recited in the independent claims excepting the limitation of assigning and/or performing its functions based on weighted values, which the Examiner asserted was disclosed by Liepins. The Board found that the prior art substantially supported a conclusion of obviousness.

Issue/Holding:

Did the Board err in its conclusion of obviousness? No, affirmed.

Discussion:

The Federal Circuit found that the weighting function disclosed by Liepins, in conjunction with the systematic network security decisions and criterion disclosed in the manual provided ample support for the finding of obviousness by the Board. The Federal Circuit further found that the manual was prior art, despite arguments based on lack of availability to non-purchasing consumers and "missing pages." Notably, the Federal Circuit found that, in contrast to *Panduit*, which explains that §103 "does not permit a court to stitch together an obviousness finding from discrete portions of prior art references without considering the references as a whole," that "the MPEP contemplates *partial* submissions of prior art documents," noting that only the "pertinent parts" of foreign language documents are routinely required for examination, and finding ultimately that "the PTO's own rules permit the consideration of selected portions of prior art references so long as the missing portions are not necessary to fully understand the submitted portions."

Judge O'Malley dissented, pointing to a "suspect record" of the requestor, and more specifically citing factors such as the manual "missing all of the even pages," "entire sections" (in some instances) and bearing "indicia of being [solely] a draft document". In summary, Judge O'Malley dissented on the grounds that the Board should never have reached a determination of obviousness.