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12/698,733	02/02/2010	Rema Ananthanarayanan	IN920090109US1 (790.045)	4585
89885	7590	05/09/2016	EXAMINER	
FERENCE & ASSOCIATES LLC 409 BROAD STREET PITTSBURGH, PA 15143			TAYLOR, BROOKE JAZMOND	
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**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.

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* REMA ANANTHANARAYANAN,  
VINATHA CHATURVEDI, VIJIL E. CHENTHAMARAKSHAN,  
PRASAD M. DESHPANDE, RAGHURAM KRISHNAPURAM, and  
SHAJEER K. MOHAMMED

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Appeal 2014-007525  
Application 12/698,733  
Technology Center 2100

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Before ALLEN R. MacDONALD, JOHN F. HORVATH, and  
AMBER L. HAGY, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a Final Rejection of claims 1–12 and 25–27. We have jurisdiction under 35 U.S.C. § 6(b).

We Affirm-In-Part.

### *Exemplary Claims*

Exemplary claims 1 and 27 read as follows (emphasis and formatting added):

1. An apparatus comprising:

[(a)] one or more processors; and

[(b)] a computer readable storage medium having computer readable program code embodied therewith and executable by the one or more processors, the computer readable program code comprising:

[(i)] computer readable program code configured to ***extract a file system structure*** corresponding to a software product;

[(ii)] computer readable program code configured to ***identify***, from the file system structure, ***candidate subtrees*** that are likely to be subtrees of more than one directory across at least two software products; and

[(iii)] computer readable program code configured to ***indicate common components*** across at least two software products.

*Rejections on Appeal*

The Examiner rejected claims 1–8, 10, 11, 25, and 26 under 35 U.S.C. § 102(b) as being anticipated by Gupta et al. (US 2006/0026157 A1; Feb. 2, 2006).<sup>1</sup>

The Examiner rejected claims 9 and 12 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Gupta and Applicant’s Admitted Prior Art.<sup>2</sup>

The Examiner rejected claim 27 under 35 U.S.C. § 112, second paragraph, as being indefinite.

The Examiner rejected claim 25 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.<sup>3</sup>

*Appellants’ Contentions*

1. Appellants contend that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 102(b) because:

Independent Claims 1 and 25 recite identification, from a file system structure, of candidate subtrees that are likely to be subtrees of more than one directory across at least two **software products**, and further recite an indication of common components across at least **two software products**. Applicants

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<sup>1</sup> Separate patentability is not argued for claims 2–8, 10, 11, 25, and 26. Except for our ultimate decision, as to this rejection these claims are not discussed further herein.

<sup>2</sup> As to the rejection of claims 9 and 12, separate patentability is not argued. Rather, the rejection of these claims turns on our decision as to the underlying § 102 rejection. Except for our ultimate decision, these claims are not further addressed herein.

<sup>3</sup> Appellants do not appeal this rejection. (“**GROUND OF REJECTION TO BE REVIEWED ON APPEAL**” App. Br. 10). Therefore, we affirm *pro forma*. Except for our ultimate decision, this rejection is not discussed further herein.

respectfully submit that Gupta, at the very least, does not teach or suggest these features.

App. Br. 11, emphases added.

2. Appellants also contend that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 102(b) because:

Gupta does not disclose the *extraction of file system structures relative to software products* . . . as broadly claimed by Claims 1 and 25.

App. Br. 13, emphasis added.

3. Appellants contend that the Examiner erred in rejecting claim 27 under 35 U.S.C. § 112, second paragraph, because:

[I]t is stated in para. 0038 of the instant application as filed that “among the advantages associated with at least one embodiment of the present invention is the possibility of identifying dependent products (of a given software product) just by processing the install image. It is not necessary to install the product itself, in other words.”

App. Br. 15.

[I]t is respectfully submitted that Claim 27 is more than sufficiently definite for conveying the features claimed and encompassed thereby, with clear support in the instant application, and thus easily fulfills the requirements of Section 112, second paragraph.

App. Br. 16.

#### *Issues on Appeal*

Did the Examiner err in rejecting claim 1 as being anticipated under 35 U.S.C. § 102(b) because Gupta fails to describe the argued limitations?

Did the Examiner err in rejecting claim 27 as being indefinite?

## ANALYSIS

We have reviewed the Examiner's rejections in light of Appellants' arguments that the Examiner has erred.

As to above contentions 1 and 2, Appellants' arguments are essentially that as to "software products" the Examiner's rejection fails to sufficiently explain how the Gupta reference teaches each of the claimed extracting a file system structure, identifying candidate subtrees, and indicating common components. We agree. The Examiner's minimal explanation (Final Act 3-4 and Ans. 7-8) of the rejection is insufficient to support a final conclusion of anticipation based on the Gupta reference.

As to above contention 3, we agree. We agree with Appellants that claim 27 meets the requirement of 35 U.S.C. § 112, second paragraph.

## CONCLUSIONS

(1) Appellants have established that the Examiner erred in rejecting claims 1-8, 10, 11, 25, and 26 as being anticipated by Gupta under 35 U.S.C. § 102(b).

(1) Appellants have established that the Examiner erred in rejecting claims 9 and 12 as being unpatentable under 35 U.S.C. § 103(a).

(3) Appellants have established that the Examiner erred in rejecting claim 27 as being indefinite under 35 U.S.C. § 112, second paragraph.

(2) The Examiner did not err in rejecting claim 25 under 35 U.S.C. § 101, as failing to be within one of the four statutory categories.

(3) On this record, claims 1-12, 26, and 27 have not been shown to be unpatentable.

(4) Claim 25 is not patentable.

DECISION

The Examiner's rejection of claims 1–8, 10, 11, 25, and 26 as being anticipated under 35 U.S.C. § 102(b) is reversed.

The Examiner's rejection of claims 9 and 12 as being unpatentable under 35 U.S.C. § 103(a) is reversed.

The Examiner's rejection of claim 27 as being indefinite under 35 U.S.C. § 112, second paragraph, is reversed.

The Examiner's rejection of claim 25 under 35 U.S.C. § 101, as failing to be within one of the four statutory categories, is affirmed.

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).

AFFIRMED-IN-PART