



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.
12/878,827	09/09/2010	Ksatria G. Williams	PD-209032	5712
141451	7590	11/21/2016	EXAMINER	
AT&T Legal Dept. - [HDP]			PARK, JEONG S	
Attention: Patent Docketing, Room 2A-207				
One AT&T Way			ART UNIT	
Bedminster, NJ 07921			PAPER NUMBER	
			2454	
			MAIL DATE	
			DELIVERY MODE	
			11/21/2016	
			PAPER	

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.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KSATRIA G. WILLIAMS and LOREN LEUNG

Appeal 2015-006187
Application 12/878,827
Technology Center 2400

Before JOHN A. JEFFERY, THU A. DANG, and KAMRAN JIVANI,
Administrative Patent Judges.

JEFFERY, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's decision to reject claims 1–6, 8, 10, 12–21, 23, 25–27, and 29–31. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

STATEMENT OF THE CASE

Appellants' invention updates a software image at a client device by the client communicating a device identifier to a server via a network, and providing software images from a server device. *See generally* Title;

Abstract. Claim 1 is illustrative:

1. A method comprising:
storing a software image on a server device;
communicating a check image signal having a client device identifier to the server device through a network, said

client device identifier comprising a client device model identifier, a client device make identifier or a software revision identifier;

communicating a software image identifier to the client device from the server device in response to the check image signal, said software image identifier comprising an image location;

at the client device, requesting the software image from the server device using the image location of the software image identifier;

communicating the software image to the client device through the network based on the image location; and
operating the client device based on the software image.

THE REJECTIONS

The Examiner rejected claims 1–3, 6, 10, 12–18, 21, 25–27, and 29–31 under 35 U.S.C. § 103(a) as unpatentable over Challenger (US 2010/0205375 A1; Aug. 12, 2010), Lee (US 2007/00118617 A1; May 24, 2007) (“Lee ’617”), and Lee (US 2005/0108757 A1; May 19, 2005) (“Lee ’757”). Ans. 3–9.¹

The Examiner rejected claims 4, 5, 19, and 20 under 35 U.S.C. § 103(a) as unpatentable over Challenger, Lee ’617, Lee ’757, and Rothman (US 2006/0143432 A1; June 29, 2006). Ans. 9–10.

The Examiner rejected claims 8 and 23 under 35 U.S.C. § 103(a) as unpatentable over Challenger, Lee ’617, Lee ’757, and Brubacher (US 2004/0249907 A1; Dec. 9, 2004). Ans. 10–11.

¹ Throughout this opinion, we refer to (1) the Appeal Brief filed December 8, 2014 (“App. Br.”); (2) the Examiner’s Answer mailed April 2, 2015 (“Ans.”); and (3) the Reply Brief filed June 2, 2015 (“Reply Br.”).

THE REJECTION OVER CHALLENGER, LEE '617, AND LEE '757

Regarding independent claims 1 and 16, the Examiner finds that Challenger discloses (1) a server device storing a software image therein, and (2) communicating a check image signal having a client device identifier, where the server is said to communicate the software image to the client device through a network, and the client device operates based on the software image. Ans. 3–4. Although the Examiner acknowledges that Challenger does not communicate a check image signal and software image identifier between the client and server devices before requesting the software image, the Examiner cites Lee '617 for establishing a point-to-point connection between a server and user device, where the device sends a request message for software upgrade information, and receives a response message with the latest sequence number (“image identifier”) that is compared with that of the device to determine whether the device needs the update. Ans. 4–6. The Examiner also acknowledges that the Challenger/Lee '617 system lacks any of the three recited client device identifiers, but cites Lee '757 for teaching this feature in concluding that the claim would have been obvious. Ans. 6.

Appellants argue, among other things, that not only does Challenger not communicate a check image signal from a client to a server device, let alone with the recited client device identifier, Lee '617 does not communicate a software image identifier with an image location to a client device responsive to the check image signal as claimed. App. Br. 6–10; Reply Br. 2–7.

ISSUE

Under § 103, has the Examiner erred in rejecting claim 1 by finding that Challenger, Lee '617, and Lee '757 collectively would have taught or suggested a server communicating a software image identifier comprising an image location to a client device responsive to a check image signal communicated to the server from the client device, where the client device requests a software image from the server using the image location?

ANALYSIS

Independent claim 1 recites, in pertinent part, (1) communicating a check image signal having a client device identifier to a server; (2) communicating a software image identifier comprising an *image location* to the client device from the server responsive to the check image signal; (3) at the client device, requesting the software image from the server *using the image location*; and (4) communicating the software image to the client device *based on the image location*. Our emphasis underscores the key role that the image location has in this process: it is not only *communicated* from the server to the client, but is also then *used by the client* to request the software image.

Given this functionality, we find the Examiner's position problematic on this record. In the rejection, the Examiner acknowledges that a software image identifier is not communicated between server and client before requesting a software image in Challenger, but nonetheless refers to a software image location in paragraph 48 of that reference. Ans. 4. But this paragraph refers to database 300 which, although including a software image location 315, is located at the server 120—not the client. *See Challenger*

¶ 47. To the extent that the Examiner's position is premised on this image location data being somehow sent to the client, there is no reasonable suggestion to do so on this record, let alone that the client would then use this communicated location data to request the image, as claimed. *Accord* Reply Br. 3 (noting this point).

Nor does Lee '617 cure this deficiency. In Lee '617, a point-to-point communication link is established between a server and user device, where the device sends a request message for software upgrade information to the server, the message including the device's software identification (ID) and a sequence number. Lee '617 ¶ 38. Then, the server sends a response message with the latest sequence number for the device's software which is compared with the device's sequence number. *Id.*

Even assuming, without deciding, that the device's software ID and sequence number in Lee '617 is a software image identifier as the Examiner indicates (Ans. 13), the Examiner has still not shown that this identifier also includes an *image location*, let alone that this communicated location is used by the client to request the image, as claimed.

Notably, the Examiner finds that when Lee '617's client device downloads the updated software from the server, the image location is said to be "inherently known to the client device." Ans. 13. But as Appellants indicate (Reply Br. 4–5), that is not necessarily the case, for a server can update a client's software regardless of whether the client knows the location of the associated image. In claim 1, the image's location is a key element that is communicated from the server to the client, which the client then uses to request the image. None of the cited prior art reasonably teaches or suggests this location-based functionality.

So even if we were to accept the Examiner's finding that Lee '757 teaches at least one of the three recited client device identifiers (Ans. 6), the Examiner has still not shown that the cited prior art teaches or suggests communicating an image location to the client device in the recited manner, where the client uses the image location to request the software image from the server, as claimed.

Therefore, we are persuaded that the Examiner erred in rejecting (1) independent claim 1; (2) independent claim 16 which recites commensurate limitations;² and (3) dependent claims 2, 3, 6, 10, 12–15, 17, 18, 21, 25–27, and 29–31 for similar reasons. Because this issue is dispositive regarding our reversing the rejection of these claims, we need not address Appellants' other arguments.

² We note in passing that independent claim 16 recites a system comprising, among other things, a server device that *stores* a software image therein, and *communicates* a software image identifier and software image to a client device. The claim also recites that the client device *communicates* a check image signal to the server device. Our emphasis underscores the active method steps that are recited in connection with these limitations. But apparatus claims reciting active method steps have been held indefinite under § 112(b), for such claims raise the question of whether they are infringed by devices that are merely capable of performing the recited function, or that they must actually perform that function. *See IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377, 1384 (Fed. Cir. 2005); *see also Rembrandt Data Technologies, LP v. AOL, LLC*, 641 F.3d 1331, 1339 (Fed. Cir. 2011) (data transmitting device held indefinite for reciting transmitting method step). Nevertheless, the Examiner did not reject claim 16 on this basis, nor will we speculate in that regard here in the first instance on appeal. Rather, we leave this question to the Examiner to consider after our decision.

THE OTHER OBVIOUSNESS REJECTIONS

Because the Examiner has not shown that the cited prior art cures the foregoing deficiencies regarding the rejection of the independent claims, we will not sustain the obviousness rejections of dependent claims 4, 5, 8, 19, 20, and 23 (Ans. 9–11) for similar reasons.

CONCLUSION

The Examiner erred in rejecting claims 1–6, 8, 10, 12–21, 23, 25–27, and 29–31 under § 103.

DECISION

The Examiner's decision rejecting claims 1–6, 8, 10, 12–21, 23, 25–27, and 29–31 is reversed.

REVERSED