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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TOMER FISHAIMER

Appeal 2015-007448
Application 13/692,228
Technology Center 2100

Before JOHN A. JEFFERY, BRADLEY W. BAUMEISTER, and
DENISE M. POTHIER, *Administrative Patent Judges*.

BAUMEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's rejections of claims 1–8, 12–19, and 23–30. *See* Ans. 2 (withdrawing the rejection of claims 9–11, 20–22, and 31–33).

We reverse.

STATEMENT OF THE CASE

Claims 1–8, 12–19, and 23–30¹ stand rejected under 35 U.S.C. § 102(b) as anticipated by Nandigama (US 2004/0015975 A1; published Jan. 22, 2004). Ans. 2–6.²

We have jurisdiction under 35 U.S.C. § 6(b). We review the appealed rejections for error based upon the issues identified by Appellant, and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential).

SUMMARY OF THE INVENTION

Appellant’s invention is a system and method for testing application code. Spec. ¶ 22. One embodiment associates a test agent with an application server. *Id.* In Appellant’s invention, a client does not need to know how to communicate directly with this application server to test the code. *Id.* ¶ 25. For example, a quality-assurance engineer can use the server’s test agent to interact with testable code through a web browser associated with a client. *See id.* ¶¶ 22, 25. The test agent discovers portions of each software component that can be tested. *Id.* ¶ 25. The client’s user interface then presents this information. *Id.* ¶ 26. As part of its operation, the client sends requests and receives information through a remote test orchestrator, instead of to the application servers directly. *Id.* ¶ 25.

¹ Claim 30 recites “The computer program product *m . . .*” (emphasis added). But the claims do not provide an antecedent basis for a “product *m.*” We leave this issue to the Examiner.

² Throughout this opinion, we refer to (1) the Appeal Brief filed March 12, 2015 (“App. Br.”); (2) the Examiner’s Answer mailed June 11, 2015 (“Ans.”); and (3) the Reply Brief filed August 10, 2015 (“Reply Br.”).

Independent claim 1, reproduced below with our emphasis, is illustrative:

1. A method for testing testable code of an application comprising:

sending a request, from a computer-implemented client to a remote test orchestrator, for a list identifying any test agents registered with the remote test orchestrator, said any test agents each configured to provide access to respective associated testable code and said remote test orchestrator configured to provide the computer-implemented client with access to said any test agents; and

receiving, by the computer-implemented client from the remote test orchestrator, the list identifying said any test agents registered with the remote test orchestrator.

CONTENTIONS

Appellant contends that Nandigama does not anticipate claim 1 because Nandigama does not send or receive the recited list of registered test agents. App. Br. 10–12; Reply Br. 4–5. According to Appellant, Nandigama’s user does not request or know the identity of any test computer. App. Br. 11. So in Appellant’s view, Nandigama’s user does not need to have the recited list because the system controller—not the user—selects the test computer. *Id.* at 11.

Despite finding that Nandigama anticipates claim 1 (Ans. 3), the Examiner acknowledges that Nandigama does not disclose explicitly “limitations identical to the claim.” *Id.* at 7. Instead, the Examiner finds that Nandigama’s Distributed Processing Framework (DPF) chooses an agent based on user-submitted parameters, which is said to be “functionally equivalent” to choosing the agent directly from a list. *Id.* at 9. Restated,

claim 1, in the Examiner's view, recites manually performing what Nandigama does automatically. *Id.* at 10.

ANALYSIS

We do not sustain the Examiner's anticipation rejection of claim 1. We are persuaded by Appellant's position that Nandigama does not send or receive the recited list of registered test agents. *See* App. Br. 10–12; Reply Br. 4–5.

The Examiner's rejection relies upon Nandigama's embodiment where a distributed test framework (DTF) chooses a test agent. *See* Ans. 8–9 (discussing submitting requirements to the DPF³); *see also* Ans. 3 (citing Nandigama ¶ 40). For example, Nandigama's test systems—i.e., the systems that run the software tests—contain agents. Nandigama ¶¶ 39, 40. These agents register the corresponding test system's characteristics with a look-up service. *Id.* ¶ 40. To fulfill a specific test execution request, the DTF finds the appropriate test system based on user-submitted requirements. *Id.* ¶ 41. Notably, these requirements do not identify the agents. *See id.* Rather, Nandigama matches the user-submitted requirements to the registered characteristics—i.e., platform, operating system, and other software and hardware characteristics. *See id.* ¶ 35 (describing registered characteristics); *id.* Fig. 4C (showing the selectable requirements). That is, the user and system exchange these characteristics, not a list of agents. *See id.* ¶¶ 35, 41, Fig. 4C.

³ Nandigama discloses that the DPF can be a DTF (Nandigama ¶ 25), which is the embodiment cited by the Examiner. *See* Nandigama ¶ 35.

In fact, the Examiner acknowledges that exchanging characteristics is not the same as choosing from a list of agents. *See* Ans. 9 (stating that submitting requirements is “not explicitly the same” as choosing from a list). Although the end result may be the same—i.e., some agent is selected—claim 1 is anticipated only if the act of sending and receiving the recited list is found, either expressly or inherently described, in Nandigama. *See In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Because Nandigama does not describe these features, we are persuaded that the Examiner erred in rejecting claim 1 as anticipated by Nandigama.

Because an obviousness rejection is not before us, we will not speculate whether it would have been obvious to arrive at the claimed invention by manually performing Nandigama’s automatic process or by combining that process with embodiments described in the background section (Nandigama ¶¶ 6–7, *cited in* Ans. 9–10). Nor will we speculate whether modifying Nandigama in this way would address every element of claim 1, including the remote test orchestrator.

Accordingly, we do not sustain the rejections of (1) independent claim 1; (2) independent claims 12 and 23, which also require sending and receiving a list identifying test agents; or for similar reasons, (3) dependent claims 2–8, 13–19, and 24–30.

DECISION

The Examiner’s decision rejecting claims 1–8, 12–19, and 23–30 is reversed.

REVERSED