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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* SEAN JAMES MARTIN and SIMON LUKE MARTIN

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Appeal 2016-000983  
Application 13/457,925  
Technology Center 2400

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Before THU A. DANG, STEPHEN C. SIU, and  
CARL L. SILVERMAN, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's Non-Final Rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

A. INVENTION

According to Appellants, the invention “generally relates to computer networks, and more specifically, to incremental deployment of computer software program logic on client devices in a network” (Spec. ¶ 2).

## B. REPRESENTATIVE CLAIM

Claim 1 is exemplary:

1. A method for requesting a computer software program logic by a client computing device from a server in a network, the method at the server comprising:

receiving, via at least one processor, a request for computer software program logic from a client computing device along with a first list comprising details about one or more modules running on the client computing device;

determining, via the at least one processor and based at least in part on the first list, a second list comprising details of one or more modules required to deploy the computer software program logic on the client computing device;

checking, via the at least one processor, whether the one or more modules of the second list need to be substituted based on their availability on the server;

updating, via the at least one processor, the second list based at least in part on the check performed;

checking, via the at least one processor, whether the client computing device has permission rights for accessing the one or more modules of the updated second list; and

transmitting, via the at least one processor, an object comprising the one or more modules of the updated second list that are not on the first list to the client computing device based at least in part on the check performed, wherein the updated second list comprises details of the one or more modules required for deployment of computer software program logic on the client computing device such that after transmission of the object begins no further information regarding the modules running on the client computing device are provided.

## C. REJECTIONS

Claims 1–20 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 1–20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the teachings of Hendler et al. (US 2002/0042833 A1; pub. Apr. 11, 2002) and Grey et al. (US 2007/0038520 A1; pub. Feb. 15, 2007).

## II. ISSUES

The principal issues before us are whether the Examiner erred in finding:

1) the Specification, as originally filed, does not have support for newly amended limitation: “after transmission of the object begins no further information regarding the modules running on the client computing device are provided” (claim 1).

2) Hendler, in view of Grey, teaches or suggests “receiving... from a client . . . a first list comprising details about one or more modules running on the client computing device;” “determining, . . . a second list comprising details of one or more modules required to deploy the computer software program logic . . .;” and “*transmitting . . . an object comprising the one or more modules of the updated second list that are not on the first list to the client computing device. . . .*” (claim 1, emphases added).

## III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

### *Hendler*

1. Hendler discloses extracting files from archive and streaming the extracted files from the server to the client (Abstract), wherein, for transmitting modules from a first computer (server) to a second computer (client), a module set is formed at the first computer, each module being associated with an application executing at the second computer, and the

selection being made in accordance with predetermined selection criteria independent of the second computer's execution environment (§ 15).

Streamed files from the server to the client include a streaming control file used by the server to predict modules that will be needed at the client (§ 36).

2. As downloaded modules are executed by the client, the client sends control data to the server which is used to request particular modules from the server (§ 35).

3. If a module is not already available at the client, the server will complete delivery of the module to the client (§ 38).

4. In some scenarios, control data is sent to the server to request needed procedures, and in response, the server halts the current module stream and sends the requested module (§ 62).

#### IV. ANALYSIS

##### *35 U.S.C. § 112, first paragraph.*

The Examiner rejects claims 1–20 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement (Non-Final Rej. 7). In particular, the Examiner finds claim limitation “after transmission of the object beings no further information regarding the modules running on the client computer device are provided” is “new matter” which “was not described in the originally disclosed specification as filed” (Non-Final Rej. 8).

In response, Appellants contend that the Specification, in particular, steps, 540, 542, and 546 “indicate that a complete list of required modules and code libraries is built” and “each of the items on the list is retrieved...,” wherein “[t]he object contains all the software program code necessary to create the evolved client software” (App. Br. 8). Thus, “one of ordinary skill

in the art would clearly understand that no additional information regarding the modules operating on the client is required by the server or provided to the server once the transmission of the object begins” (*id.*).

We do not find Appellants’ contention persuasive.

Here, although Appellants point to support in the Specification for items on the “complete” list being retrieved (*id.*), there is no support in the Specification that *no further* information is provided as recited in the claims. That is, even assuming *arguendo* that the specified sections of the Specification disclose that the complete list is retrieved and thus no additional information is “required” as Appellants contend (*id.*, emphasis added), there is no positive teaching or disclosure that *further* information (required or not) is *not provided*.

The mere absence of a positive recitation of a claim element in the Specification is not basis for its express exclusion in the claims. MPEP § 2173.05(i). Our review court guides “Negative claim limitations are adequately supported when the specification describes a reason to exclude the relevant limitation,” describing disadvantages of the excluded part will suffice. *Inphi Corp. v. Netlist, Inc.*, 805 F.3d 1350, 1355 (Fed. Cir. 2015) (quoting *Santarus, Inc. v. Par Pharmaceutical, Inc.*, 694 F.3d 1344, 1351 (Fed. Cir. 2012)).

Here, however, the Specification fails under these requirements. *See generally, Spec.* In particular, there is no mention of not providing further information, but moreover, the Specification does not discuss any advantage or disadvantage for not providing further information. *Id.* Thus, even if assuming *arguendo* that the Specification discloses that no additional information is “required” because a complete list has already been provided,

as Appellants contend (App. Br. 8), the Specification still does not discuss any advantage/disadvantage for not providing additional information. In fact, as the Examiner points out, “appellant’s specification’s paragraph 69 . . . discloses the client may send similar future request to the server for requesting software modules from the server,” and thus, even Appellants’ Specification discloses sending further information comprised in future requests (Ans. 21).

Any claim containing a negative limitation which does not have basis in the original disclosure is correctly rejected under 35 U.S.C. § 112(a) or pre-AIA 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. *See* MPEP § 2173.05(i). For the above reasons, we find that the preponderance of evidence supports the Examiner's determination that the claims are not adequately supported by a written description under 35 U.S.C. § 112, first paragraph.

*35 U.S.C. § 103*

Appellants contend “Hendler states that control data may be used to request particular modules from the server” and “the requested module is streamed to the client” (App. Br. 11). However, according to Appellants, for the control data of Hendler to be analogous to the claimed “first list,” “the server would not stream the requested modules to the client” (*id.*). That is, Appellants contend the claims require that “none of the modules listed on the first list are included in the object transmitted to the client” and thus for the control data of Hendler to be analogous to the “first list” “the modules streamed to the client would not include any module identified by the control data” (App. Br. 10). Accordingly, “Hendler fails to teach or suggest

that the object transmitted to the client comprises one or more modules of the updated second list that are not on the first list,” as recited (App. Br. 12).

Appellants further contend Hendler also does not disclose or suggest that “after transmission of the object begins no further information regarding the modules running on the client computing device are provided” (App. Br. 14–15). Appellants then contend Grey fails to cure the deficiencies of Hendler (*id.*).

We have considered all of Appellants’ arguments and evidence presented. However, we disagree with Appellants’ contentions regarding the Examiner’s rejections of the claims. We agree with the Examiner’s findings, and are unpersuaded of error with the Examiner’s conclusion that the claimed subject matter would have been obvious over the combined teachings.

As an initial matter of claim construction, we give the claims their broadest reasonable interpretation consistent with the Specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). We note that although Appellants contend the claims require that “*none* of the modules listed on the first list are included in the object transmitted to the client” (App. Br. 10, emphasis added), such contention is not commensurate in scope with the language of the claims. That is, the claims do not require that “none” of the modules on the first list are included in the transmitted object, but rather the object comprises “*one or more modules* of the updated second list that are not on the first list” (claim 1, emphasis added).

Hendler discloses that the server predicts/determines modules required at the client independent of the client’s environment (FF 1), the client sends control data to the server (FF 2), and if a module is not available

at the client or a procedure is needed from the server, the server completes delivery of the module to the client (FF 3–4). In other words, Hendler discloses that a server receives control data from the client with details about modules running on the client (FF 2), the server having predicted modules that will be needed at the client independent of the client’s environment (FF 1), determines that if the module is not already available at the client or if further procedures are needed, and the server transmits a data stream to the client comprising module(s) or procedures not already available at the client (FF 3–4).

We agree with the Examiner’s interpretation that “Hendler’s control data is analogous to the claimed first list” wherein Hendler’s “control data” comprises “details about one or more modules running on the client device” (Ans. 22). As the Examiner finds and we agree, in Hendler, “[b]ased on the information in the received control data” which includes “details about current software modules running on the client device and software modules available at the client device,” the server will “use a streaming control file/information to determine the particular modules that will be needed at the client device” and then “send the particular modules, which will be needed but not already present at the client device’s local storage, to the client device” (Ans. 22–23). That is, the server sends “one or more modules” that will be needed but that are not identified in the control data as running on the client device (*id.*).

Thus, we find no error with the Examiner’s reliance on Hendler for disclosing or at least suggesting “receiving... from a client... a first list comprising details about one or more modules running on the client computing device;” “determining, ... a second list comprising details of one

or more modules required to deploy the computer software program logic...;” and “transmitting... an object comprising the one or more modules of the updated second list that are not on the first list to the client computing device...,” as required by claim 1.

As to Appellants’ contention that Hendler also does not disclose or suggest that “after transmission of the object begins no further information regarding the modules running on the client computing device are provided” (App. Br. 14–15), as discussed above, we find there is no basis in the cited section of Appellants’ Specification for adding the negative limitation and therefore, we give no patentable weight to the limitation at issue.

Nevertheless, assuming *arguendo* our reviewing court may give full patentable weight to the aforementioned contested, but unsupported, negative limitation, we agree with the Examiner that Hendler at least suggests this contested limitation (Ans. 23–24). In particular, as the Examiner explains, similar to Appellants’ invention, in Hendler, “[a]ny module that will be needed but not available at the client will be determined and completely transmitted to the client” wherein the server “does not require[sic] the client to provide further information regarding the modules running on the client after the transmission of the file containing the particular modules” (*id.*).

Although Appellants also contend that “one of ordinary skill in the art would not be motivated to combine Hendler with another reference” such that “after transmission of the object begins no further information regarding the modules running on the client computing device are provided” (App. Br. 15–17), Appellants are viewing the references from a different perspective than that of the Examiner. Here, we agree with the Examiner’s reliance on

Hendler (rather than “Hendler with another reference”) for disclosing and suggesting the negative limitation (Ans. 23–24). Further, although Appellants contend that Hendler teaches away from the claimed invention (App. Br. 15), Appellants provides no argument or showing how Hendler actually criticizes, discredits, or otherwise discourages investigation into the claimed invention. *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004).

On this record, we find no error with the Examiner’s finding the combination of Hendler and Grey teaches or suggests the contested limitations recited in claim 1 and claims 8 and 14 falling therewith (App. Br. 19). Appellants do not provide substantive arguments for the dependent claims depending therefrom (*id.*). Accordingly, we also affirm the rejections of these claims.

#### V. CONCLUSION AND DECISION

We affirm the Examiner’s rejections of claims 1–20 under 35 U.S.C. § 112, first paragraph, and under 35 U.S.C. § 103(a).

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