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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/515,516	10/16/2014	Brent Rector	355626.01	8974

39254 7590 09/26/2019

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EXAMINER	
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ART UNIT	PAPER NUMBER
2194	

NOTIFICATION DATE	DELIVERY MODE
09/26/2019	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BRENT RECTOR, LAWRENCE WILLIAM OSTERMAN, and TASSADUQ WILLIAM BASU

Appeal 2018-007289
Application 14/515,516
Technology Center 2100

Before MICHAEL J. STRAUSS, HUNG H. BUI, and PHILLIP A. BENNETT, *Administrative Patent Judges.*

STRAUSS, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant[1] appeals from the Examiner's decision to reject claims 1–23. Non-Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.[2]

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[1] We use the word "Appellant" to refer to "Applicant" as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as Microsoft Technology Licensing, LLC. Appeal Br. 2.

[2] We refer to the Specification, filed October 16, 2014 as amended on December 31, 2014 ("Spec."); the Non-Final Office Action, mailed June 16,

CLAIMED SUBJECT MATTER

The claims are directed to application programming interface ("API") versioning that is independent of product releases. Spec., Title. Claim 1, reproduced below, reformatted and with a dispositive limitation emphasized in *italics*, is illustrative of the claimed subject matter:

> 1. A method performed on a computing device that includes at least one processor and memory, the method for programmatically providing a feature to a contract application via an application programming interface ("API") contract, the method comprising:
>
> hosting, by the computing device, the API contract that is configured for programmatically providing the feature to the application, where the API contract comprises
>
> identification information for the API contract,
>
> version information for the API contract and the feature,
>
> definition information that defines aspects of the feature, and
>
> *executable code configured for responding to queries about the API contract*.

REFERENCES[3]

The prior art relied upon by the Examiner is:

Hare et al.	US 2007/0209043 Al	Sept. 6, 2007
Barnett et al.	US 2009/0164973 Al	June 25, 2009
Kishan et al.	US 2011/0154378 Al	June 23, 2011
Rector et al.	US 2013/0042258 Al	Feb. 14, 2013

2016 2016 ("Non-Final Act."); Appeal Brief, filed January 5, 2018 ("App. Br."); Examiner's Answer, mailed May 9, 2018 ("Ans."); and Reply Brief, filed July 9, 2018 ("Reply Br.").

[3] All citations herein to these references are by reference to the first named inventor only.

REJECTIONS

Claims 1, 2, 4, 5, 8, 9, 11, 12, 15, 16, 18, and 21–23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Barnett and Rector. Non-Final Act. 3–6.

Claims 3, 10, and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Barnett, Rector, and Kishan. Non-Final Act. 7.

Claims 6, 7, 13, 14, 19, and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Barnett, Rector, and Hare. Non-Final Act. 7–9.

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellant's arguments the Examiner has erred. We agree with Appellant's conclusions as to the rejections of the claims.

The Examiner finds Barnett teaches an API contract hosted by a computing device, the contract including definition information that defines aspects of a feature provided to a contract application. Non-Final Act. 3. The Examiner relies on Rector for teaching the remaining elements of the API contract of claim 1, including the disputed executable code configured for responding to queries about the API contract. *Id.* at 3–4. In connection with the executable code, the Examiner finds the limitation is taught by Rector's disclosure that an "application can dynamically determine what APIs are available through reading metadata files, an application can determine if later versions of functionality are present, what parameters an API takes, what functionality is present at runtime, API descriptions." *Id.* at 4 (citing Rector ¶ 63).

Appellant argues Rector's metadata includes information contents identified by the Examiner but fails to teach the disputed executable code

element of the API. App. Br. 16–17. The Examiner responds, finding Rector's teaching of programmatically/dynamically determining API availability based on reading/querying metadata to return associated API related information including API methods and properties teaches the disputed executable code configured for responding to queries about the API contract. Ans. 5–6 (citing Rector ¶¶ 28, 34, 40, 63). Appellant replies, arguing:

> [E]ven assuming, *arguendo*, that Rector describes that applications dynamically determine what APIs are available by reading metadata files and that metadata files may be access[ed] programmatically to determine API related information, this is [sic.] no way indicates that metadata files include executable code as asserted by the Examiner. Rather, at best, this description of Rector provides that metadata files include text that is searchable by executable code, but the metadata files do not include the executable code, unlike the API contracts in Claim 1 which requires that each API contract include such executable code.

Reply Br. 2.

Appellant's argument is persuasive of reversible Examiner error. The Examiner fails to explain what Rector's metadata is or how Rector's metada teaches executable code or provide sufficient evidence or explanation of why it would have been obvious to include functionality for responding to queries about the API contract *as part of the API contract itself* as required by claim 1. Because we agree with at least one of the arguments advanced by Appellant, we need not reach the merits of Appellant's other arguments. Accordingly, on the record before us, we do not sustain the rejection of independent claim 1 or, for the same reason, the rejection of independent claims 8, 15, and 21–23 under 35 U.S.C. § 103 over

Barnett and Rector or the rejection of dependent claims 2, 4, 5, 9, 11, 12, 16, and 18. Furthermore, we do not sustain the rejection of claims 3, 6, 7, 10, 13, 14, 17, 19, and 20 under 35 U.S.C. § 103, as the Examiner's applications of the Kishan and Hare references fail to cure the deficiency in the base rejection addressed above.

DECISION

We reverse the Examiner's rejections under 35 U.S.C. § 103.

Claims Rejected	Basis	Affirmed	Reversed
1, 2, 4, 5, 8, 9, 11, 12, 15, 16, 18, 21–23	35 U.S.C. § 103 Barnett, Rector		1, 2, 4, 5, 8, 9, 11, 12, 15, 16, 18, 21–23
3, 10, 17	35 U.S.C. § 103 Barnett, Rector, Kishan		3, 10, 17
6, 7, 13, 14, 19, 20	35 U.S.C. § 103 Barnett, Rector, Hare		6, 7, 13, 14, 19, 20
Overall Outcome			1–23

REVERSED