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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOSUE NEGRON, JONATHAN BLAKE BRANNON, and
VARUN MURTHY

Appeal 2019-000149¹
Application 14/723,838
Technology Center 2400

Before CARL W. WHITEHEAD JR., JASON V. MORGAN, and
JAMES B. ARPIN, *Administrative Patent Judges*.

ARPIN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant² appeals under 35 U.S.C. § 134(a), the rejections of claims 1–20, all of the pending claims. Final Act. 2. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

¹ In this Decision, we refer to Appellant’s Appeal Brief (“App. Br.,” filed July 3, 2018) and Reply Brief (“Reply Br.,” filed October 8, 2018); the Final Office Action (“Final Act.,” mailed January 12, 2018); the Examiner’s Answer (“Ans.,” mailed August 8, 2018); and the originally filed Specification (“Spec.,” filed May 28, 2015). Rather than repeat the Examiner’s findings and determinations and Appellant’s contentions in their entirety, we refer to these documents.

² We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party-in-interest as AirWatch LLC. App. Br. 2.

STATEMENT OF THE CASE

Appellants' recited computer-readable media, methods, and systems "relate[] to a remotely-hosted auto-discovery service." Spec. ¶ 10. As noted above, claims 1–20 are pending. Claims 1, 8, and 15 are independent. App. Br. 22, 24, 26 (Claims App'x). Claims 2–7 depend directly or indirectly from claim 1, claims 9–14 depend directly or indirectly from claim 12, and claims 16–20 depend directly or indirectly from claim 15. *Id.* at 22–27.

Claim 1 recites "[a] non-transitory computer-readable medium embodying a program executable in at least one computing device comprising at least one hardware processor, the program, when executed by the at least one computing device, being configured to cause the at least one computing device to" perform methods recited in claim 8. *Id.* at 22, 24. Claim 15 recites "[a] system, comprising: at least one computing device in data communication with a client device over a network; and program code that, when executed by the at least one computing device, causes the at least one computing device to:" perform methods recited in claim 8. *Id.* at 24, 26. The Examiner relies on the same rejection and substantially the same arguments in challenging claims 1, 8, and 15. Therefore, we focus our analysis on the disputed and overlapping limitations of these independent claims. *See Accenture Global Servs. GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1341 (Fed. Cir. 2013) ("Although *CLS Bank* issued as a plurality opinion, in that case a majority of the court held that system claims that closely track method claims and are grounded by the same meaningful limitations will generally rise and fall together." (citation omitted)); *Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208, 226–227 (2014) ("Put another way, the system claims are no different from the method claims in substance.").

Claim 8, reproduced below with disputed limitations emphasized, is illustrative.

8. A computer-implemented method, comprising:

accessing an auto-discovery request received from a client device over a network to identify a domain associated with the auto-discovery request;

identifying a digital certificate from a data store corresponding to the domain;

accessing a configuration file for a web server application that creates at least one virtual host for a uniform resource locator (URL) identified in the auto-discovery request, the digital certificate being bound to the at least one virtual host to operate a secure connection with the client device; and

generating an enrollment response for communication to the client device over the network.

Id. at 24 (emphases added).

REJECTIONS

Claims 1–20 stand rejected as unpatentable under 35 U.S.C. § 112(a) as failing to comply with the enablement requirement. Namely, the claims allegedly contain subject matter not described in the Specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention. Final Act. 3–4.

Claims 1–20 also stand rejected as unpatentable under 35 U.S.C. § 112(b) as indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor regards as the invention. *Id.* at 4–7. Finally, claims 1–20 stand rejected as unpatentable under 35 U.S.C. § 101 as lacking patentable utility. *Id.* at 7–8.

Because we determine that the reversal of the rejections of the independent claims is dispositive with respect to the dependent claims,

except for our ultimate decision, we do not discuss the merits of the rejections of claims 2–7, 9–14, and 16–20 further herein. We review the appealed rejections to the independent claims 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). We address each rejection below.

ANALYSIS

1. *Enabling Disclosure*

35 U.S.C. § 112(a) provides that “[t]he specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as *to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.*” (Emphasis added.) The Examiner determines that the Specification fails to provide such an enabling disclosure with respect to claim 8. Final Act. 3; Ans. 3. In particular, the Examiner finds:

Claim 1³ recites the limitation “access a configuration file for a web server application that creates at least one virtual host for a uniform resource locator (URL) identified in the auto-discovery request” in lines 8-9. Paragraph [0057] of the specification describes “The one or more virtual hosts 155 can be created by dynamically **generating a configuration file** 300 for a web server application (e.g., Apache.RTM.), or by accessing a configuration file and/or add new entries to the configuration file”. *However, a configuration file must be*

³ Although the Examiner refers to claim 1, the Examiner’s arguments apply equally to claim 8. Final Act. 4 (“Claims 8 and 15 are rejected for the same reason as for claim 1. All associated dependent claims are rejected too as having the same deficiencies as the claims they depend from.”).

generated or obtained before the configuration file can be accessed. Besides, the abstract clearly indicates that a configuration file is generated for a web server application that creates at least one virtual host for a uniform resource locator (URL) identified in the auto-discovery request. Therefore, the limitation is not enabled.

Final Act. 3 (italics added). Further, the Examiner finds that

the enrollment response is not connected to other limitations (i.e., the enrollment response has nothing to do with other subject matters in the claim (e.g., auto-discovery request, domain, digital certificate, or virtual host)) and appears being generated out of nothing. As a result, claims 1, 8, and 15 are not enabled.

Ans. 3.⁴ We disagree.

Appellant contends that the claim need not recite that the “configuration file” is *created* before it recites that the configuration file is *accessed*. App. Br. 10. Initially, Appellant contends, “‘configuration files’ for ‘web server applications,’ and how to program ‘configuration files,’ are known in the art. As but one example, an ‘httpd.conf’ file is known in the art as a configuration file for Apache® web server applications.” Reply Br. 5; *see* App. Br. 10. In addition, the Specification’s Figure 3 depicts an example of a suitable configuration file (*see* Spec. ¶ 7), and the Specification further includes a written description of a how to generate the configuration file of Figure 3 (*see id.* ¶¶ 43–45). App. Br. 11–12; Reply Br. 4–5; *see* Spec. ¶ 27 (“The auto-discovery request 121 can be generated to obtain e-mail settings data 124, enrollment data, or other data from the remote auto-discovery service 133 with which the client device 106 can be automatically configured.”). Appellant concludes that a person of ordinary skill in the

⁴ The Examiner did not raise this alleged deficiency as part of the enablement rejection in the Final Action. *See* Final Act. 2–4.

relevant art would understand how to create a configuration file or access a known configuration file from the claim language in view of the disclosure in the Specification. *See* App. Br. 10; *see also* MPEP⁵ § 2164.01 (“Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention.”). Consequently, Appellant asserts that the disputed claim recitation is adequately enabled. We agree.

With respect to the Examiner’s finding that the enrollment response is not connected to other recited limitations and, in particular, that the enrollment response “has nothing to do with” the auto-discovery request, we are persuaded that the Examiner erred. Ans. 3. The Specification states:

Generally, the remote auto-discovery service 133 can provide e-mail settings data 124, enrollment data, or other data to a client device 106 in response to receiving an auto-discovery request 121 from the client device 106. Further, the remote auto-discovery service 133 can present multiple digital certificates 118 on the same IP address and port number, which allows multiple secure connections (e.g., HTTPS) to be served using the same IP address. The enrollment endpoint 136 can validate digital certificates 118 provided by enterprise administrators or other suitable users. Additionally, the enrollment endpoints can return certificate policies, device root certificates, email settings data 124, enrollment data, client configuration data, or other data to the client device 106 in response to an appropriate request.

Spec. ¶ 21 (emphasis added). Thus, Appellant asserts it is clear from the language of the independent claims and from the disclosure of the

⁵ All Manual of Patent Examining Procedure (“MPEP”) citations herein are to MPEP, Rev. 08.2017, January 2018.

Specification that the “enrollment response” is provided to “the client device” using “a domain associated with the auto-discovery request.” *See* App. Br. 13–14 (responding to the indefiniteness rejection). Again, we agree with Appellant.

For the reasons given above, we agree with Appellant that the Examiner erred, and we do not sustain the enablement rejection of the independent claims or of the claims depending therefrom. *See* App. Br. 12.

2. *Definiteness*

The Examiner also rejects claims 1–20 as allegedly indefinite. For the reasons given below, we disagree.

First, the Examiner finds that claim 8’s recitation of “accessing a configuration file for a web server application that creates at least one virtual host for a uniform resource locator (URL) identified in the auto-discovery request, the digital certificate being bound to the at least one virtual host to operate a secure connection with the client device” is “wordy and grammatically incorrect (e.g., access...to), thus unclear exactly what the purpose for accessing the configuration file is, or what action is performed after accessing the configuration file (i.e., access the configuration file to do what).” Final Act. 4–5 (omission in original). The Examiner explains that claim 8 recites that the “configuration file” causes a “web server application” to “create at least one virtual host for a URL identified in the auto-discovery request.” Ans. 4 (omissions in original). Thus, the limitation’s use of “access...for,” rather than “access...to,” is grammatically incorrect. *Id.* (omissions in original).

Appellant contends the Specification makes clear that the configuration file, not the web server application, creates the virtual host.

App. Br. 13 (citing Spec. ¶¶ 43–45); *see* Spec. ¶ 30 (describing virtual host 155 created by remote computing environment 127, including client configuration data 148), Fig. 1B. Although the Examiner is correct that we do not read limitations from the Specification into the claims (*see* Ans. 4), we understand the claims as construed in light of the Specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (en banc) (“[I]t is fundamental that claims are to be construed in light of the specifications and both are to be read with a view towards ascertaining the invention.”); quoting *United States v. Adams*, 383 U.S. 39, 49 (1966)). Here, we understand the disputed limitation to recite clearly that a configuration file *for* the web server application is accessed, and the accessed configuration file creates at least one virtual host. Reply Br. 6–7; *see* MPEP § 2173.

Second, the Examiner finds that although claim 8 recites, “generating an enrollment *response* for communication to the client device over the network,” “there is no enrollment *request* recited in the claim[, and it] is unclear to what the enrollment response is responding.” Final Act. 5 (emphases added); Ans. 5. Appellant disagrees and asserts that the enrollment response is clearly responding to the auto-discovery request. App. Br. 14. We agree with Appellant that the claim language is not unclear and the Specification makes the correspondence between the auto-discovery *request* and the enrollment *response* abundantly clear. *See, e.g.*, Spec. 1, 10, 11, 21.

Further, the Examiner alleges that it is unclear how the disputed limitation responds to the auto-discovery request or does anything with it. Final Act. 5. The Examiner also suggests that some steps may be missing from the claim. *Id.* (citing Spec., Fig. 5 (step 521 describing parsing the

enrollment URL to identify domains and subdomains)). Nevertheless, the Specification describes the generation of the enrollment response in detail, including the parsing of domains and subdomains. *See* Spec. ¶¶ 23, 26–29. Moreover, the dependent claims provide additional detail regarding the content to the auto-discovery request, including how it is associated with domains. *See, e.g.*, App. Br. 22–23 (Claims App’x) (claims 2–7); Spec., Claims 2–7. The Examiner appears to conflate breadth with indefiniteness. *See, e.g., In re Miller*, 441 F.2d 689, 693 (CCPA 1971). We agree with Appellant that, read in view of the Specification, both the meaning and scope of this limitation are clear. *See* App. Br. 14–15; Reply Br. 9.

For the reasons given above, we are not persuaded that the Examiner has shown the independent claims to be indefinite, and we do not sustain this rejection.

3. *Utility*

Finally, the Examiner finds that claims 1–20 lack utility. In particular, with respect to independent claim 8, the Examiner finds:

The enrollment response is not connected to other limitations (i.e., the enrollment response has nothing to do with other subject matters in the claim (e.g., auto-discovery request, domain, digital certificate, or virtual host)) and appears **being generated out of nothing**. It is not apparent why the invention is “useful” because applicant has failed to identify any specific and substantial utility and there is no well-established utility.

Final Act. 7; *see* Ans. 7–8. Thus, the Examiner finds that the limitations of independent claim 8, and, in particular, the “generating” limitation are not connected to each other.

As discussed above, the enrollment response may include elements created by the configuration file and is generated in response to the auto-

discovery request. Further, as Appellant explains, each limitation of claim 8 is connected to the next. App. Br. 18–20 (citing Spec. ¶¶ 10–13); Reply Br. 11–14. In particular, Appellant notes that the first “accessing” limitation recites, “identify[ing] **a domain** associated with the auto-discovery request.” App. Br. 18. The subsequent step, the “identifying” limitation, recites, “identifying *a digital certificate* from a data store corresponding **to the domain.**” *Id.* at 19 (italics added). The second “accessing” limitation recites “accessing a configuration file . . . that creates at least one virtual host for a uniform resource locator (URL) identified in the auto-discovery request, **the digital certificate** being bound to the at least one virtual host *to operate a secure connection with the client device.*” *Id.* (italics added). Finally, the “generating” limitation recites that the “enrollment response,” which is responsive to the auto-discovery request, allows “for communication to the client device over the network.” *Id.* at 22 (Claims App’x). The relationships between the “at least one virtual host for a uniform resource locator (URL) identified in the auto-discovery request” and the domains and subdomains and the digital certificates are explained in detail in the Specification (*see* Spec. ¶¶ 10–13) and recited in further detail in the dependent claims. Thus, we are persuaded that the claims adequately recite appropriate connections between the various limitations.

As noted above, although we do not read limitations from the Specification into the claims (*see* Ans. 7), we understand the claims in light of the Specification. Here, the Specification describes a specific and substantial utility for the computer-readable media, methods, and systems, as recited in the claims. *E.g.*, Spec. ¶¶ 1, 10–14; *see* MPEP § 2107(II) (“Office personnel are reminded that they must treat as true a statement of fact made

by an applicant in relation to an asserted utility, unless countervailing evidence can be provided that shows that one of ordinary skill in the art would have a legitimate basis to doubt the credibility of such a statement.”). We conclude the nature of these connections and the utility of the methods recited in claim 8 (and similarly recited in claims 1 and 15) would be understood by a person of ordinary skill in the relevant art in view of the disclosure in the Specification.

As noted above, the limitations of independent claims 1 and 15 are substantially similar to those of independent claim 8. Further, the Examiner relies on the rejection of these independent claims to justify the rejection of the dependent claims. Final Act. 8. Because the Examiner erred in rejecting independent claim 8, as well as independent claims 1 and 15, for lack of utility, we do not sustain the utility rejection of the independent claims. For that reason alone, we also do not sustain the utility rejections of claims 2–7, 9–14, and 16–20.

CONCLUSION

We reverse the rejections of claims 1–20.

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed
1–20	112(a)	Lack of enabling disclosure		1–20
1–20	112(b)	Indefiniteness		1–20
1–20	101	Lack of utility		1–20
Overall Outcome				1–20

REVERSED