Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte QING GONG and HUIFANG WANG

Appeal No. 2004-0499
Application No. 09/251,789

ON BRIEF

Before HAIRSTON, KRASS, and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-29, which are all of the claims pending in the present application.

The disclosed invention relates to the distribution and updating of software to a large number of clients using decentralized peer-to-peer client distribution. A first version of a first software application and a second version of a second

software application are run on first and second client information processing systems. A query is made to the second client information processing system to determine whether the version of the software application with the second version is newer than the software application with the first version.

Representative claim 1 is reproduced as follows:

> 1. A system for changing client software on a private network from a first client to a second client using peer-to-peer communications, comprising:
>
> a plurality of client information processing systems interconnected by a private network, wherein the private network is within a gateway linking the private network to other private or public networks, a first client information processing system running a software application, and a second client information processing system running the software application with a second version;
>
> a list of network addresses of the client information processing systems interconnected by the private network with the software application installed, wherein the list of network addresses is available to the first client information processing system; and
>
> means for the software application with the first version to automatically query the software application with the second version over the network to directly communicate with the second client information processing system at the network address in the list using peer-to-peer communications and without the need to communicate through a mediating server so as to determine if the version of software application with the second version is newer than the software application with the first version;

wherein the list of network addresses is automatically assembled from one or more of the following:

one or more e-mails received by the first client processing system from each of the client information processing systems with the software application installed;

one or more responses from a listserver coupled to the network; and

a shared directory for maintenance of the software application.

The Examiner relies on the following prior art:

Bogdan Korel et al. (Korel), "Version Management In Distributed Network Environment," ACM, pp. 161-66 (1991).

Claims 1-29 stand finally rejected under 35 U.S.C. § 112, first paragraph, as being based on an inadequate disclosure. Claims 1-29 stand further finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Korel.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs and Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, the arguments in support of the rejections and the evidence of obviousness relied upon by the Examiner as support for the prior art rejection. We have,

likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that Appellants' specification in this application does not describe the claimed invention in a manner which complies with the requirements of 35 U.S.C. § 112. We are also of the view that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-29. Accordingly, we affirm.

At the outset, we note that although Appellants nominally indicate a suggested grouping (Brief, page 6) for the appealed claims, Appellants' arguments for each of the Examiner's rejections are directed solely to independent claim 1, the claimed features of which are also present in independent claims 9, 14, and 22, the other independent claims on appeal. Accordingly, we will select independent claim 1 as the representative claim for all the claims on appeal, and claims 2-29 will stand or fall with claim 1. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker,

702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed waived (see 37 CFR § 41.37(c)(1)(vii)).

We consider first the Examiner's rejection of claims 1-29 under the "written description" requirement of the first paragraph of 35 U.S.C. § 112. The function of the written description requirement of the first paragraph of 35 U.S.C. § 112 is to ensure that the inventor has possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him. In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976).

In establishing a basis for a rejection under the written description requirement of the statute, the Examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in an applicants' disclosure a description of the invention defined by the claims. Wertheim, 541 F.2d at 265, 191 USPQ at 98. After reviewing the arguments of record, it is our opinion that the Examiner has provided sufficient reasons and evidence to satisfy such burden.

According to the Examiner (Answer, pages 3, 4, 8, and 9), Appellants' original disclosure lacks a description of the automatic operations set forth in the claims as "automatically assembling," in relation to the assembling of a list of network addresses, and "automatically querying," in relation to querying software applications for version information. After reviewing Appellants' original disclosure in light of the arguments of record, we are in agreement with the Examiner's position as stated in the Answer.

Appellants' arguments in response (Brief, pages 6 and 7; Reply Brief, pages 3-5) make reference to the portion of the original disclosure at pages 7, lines 4-21. Although Appellants contend that this cited portion of the specification, which is directed to the querying of peer client applications from a list of IP addresses, supports their position, we do not find this persuasive. In our view, the referenced portion of Appellants' specification merely describes the querying of client applications for version information from a list of addresses which each peer client possesses. We find no disclosure in this cited portion, or elsewhere in Appellants' specification, that would describe the "automatic" querying or assembling recited in the claim language. Further, although the cited portion at page

7 of the specification does suggest various ways in which addresses can be collected, i.e., e-mail, list server, subscription maintenance directories, we find no description of any "automatic" operation associated with the address collection or assembling.

In view of the above discussion, it is our opinion that, under the factual situation presented in the present case, the statutory written description requirement has not been satisfied because Appellants were clearly not in possession of the claimed invention at the time of filing of the application. Therefore, we sustain the Examiner's rejection of claims 1-29 under the first paragraph of 35 U.S.C. § 112.[1]

Turning to a consideration of the Examiner's rejection of claims 1-29 under 35 U.S.C. § 103(a) as being unpatentable over Korel, we sustain this rejection as well. With respect to representative independent claim 1, Appellants' arguments in response to the Examiner's 35 U.S.C. § 103(a) rejection assert a

[1] Appellants filed a declaration under 37 CFR § 132 in support of their position as to the adequacy of the disclosure along with the Reply Brief. This declaration has not been entered into the record by the Examiner as not being timely filed (Paper No. 19, mailed June 2, 2003) and, accordingly, has not been considered by us in this appeal.

failure to establish a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied prior art references.

Initially, Appellants contend (Brief, page 8; Reply Brief, page 7) that, unlike the present claimed invention, Korel provides no indication as to how network addresses are maintained by a peer computer. From the evidence of record, however, we find no error in the Examiner's line of reasoning that in peer-to-peer networks such as disclosed by Appellants and by Korel, it is inherent that client computers know the addresses of other client computers on the network. It is noteworthy that Appellants have admitted as such in their arguments stating (Brief, page 7) that "[i]t should be noted that it is widely known in the art that a typical client or peer in a peer-to-peer network is in possession of the IP addresses of other clients or peers in the network."

We also find to be unpersuasive Appellants' arguments (Brief, pages 11 and 12; Reply Brief, pages 6 and 7) that attempt to distinguish over Korel by asserting that Korel requires the manual searching by users for software versions over a network. It is apparent from our review of Korel that the manual searching described therein is a problem existing in the prior art. It is

precisely this manual searching problem that is addressed by Korel's described DVCS system which provides, inter alia, for automatic searching which provides client users access to other network computers in a transparent manner.

We also find that the "automatic" nature of Korel's DVCS system is explicitly described at various portions of Korel. For example, Korel (page 164, left column, first paragraph) describes the automatic checking of the network computers for the existence of inconsistent software application versions which, in our view, corresponds to the claimed "automatic querying" feature. As disclosed by Korel (id.), "[i[f the inconsistency is detected, it is corrected automatically . . . . "

Similarly, we find that Korel's description (page 164, left and right column bridging paragraph) of the compilation of software modules by automatically identifying their location in the network, i.e., by automatic identification of network addresses, corresponds to the claimed "automatic assembling" feature. Further, we agree with the Examiner that Appellants' statements at page 7, lines 9-11 serve as an admission that the particular claimed alternative methods of assembling addresses are well known in the art. Although Appellants contend (Brief, page 11; Reply Brief, page 6) that the stated admission is

limited to an acknowledgment that e-mail, list servers, or subscription maintenance directories are well known methods for distributing information in a network, we do not find this contention to be persuasive. For example, it is our view that the skilled artisan would recognize and appreciate that the precise purpose of communication with a network list server would be to distribute address information throughout the associated network.

In summary, we have sustained the Examiner's 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 103(a) rejections of all of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-29 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv)(effective September 13, 2004; 69 Fed. Reg. 49960 (August 12, 2004); 1286 Off. Gaz. Pat. and TM Office 21 (September 7, 2004)).

AFFIRMED

KENNETH W. HAIRSTON Administrative Patent Judge	)
ERROL A. KRASS Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
JOSEPH F. RUGGIERO Administrative Patent Judge	)

JFR:hh

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