

October 23, 2001

BOX NON-FEE AMENDMENT
Commissioner for Patents
Washington, DC 20231

AMENDMENT

Sir:

This Response is submitted to respond to the Official Action ("Action") mailed August 13, 2001.

REMARKS

Applicants appreciate the thorough examination of the present application as evidenced by the Action. All the pending claims stand rejected under 35 U.S.C. § 103 as being unpatentable over United States Patent No. 5,708,709 to Rose ("Rose") in view of United States Patent No. 6,182,142 to Win et al. ("Win"). Applicants respectfully submit, however, that the claims are in condition for allowance, which is respectfully requested. In particular, the cited references fail to teach or suggest, alone or in combination, establishing a "user desktop interface at the client associated with the user" where the user associated desktop displays regions associated with "a plurality of application programs at the server for which the user is authorized" as recited, for example, in Claim 1.

The Present Invention:

The present invention provides methods, systems and computer program products for management of application programs on a network including a server supporting client stations. The server provides applications on-demand to a user logging in to a client supported by the server. Mobility is provided to the user and hardware portability is provided by establishing a user desktop interface responsive to a login request that presents to the user a desktop screen through a web browser interface. The desktop accesses and downloads

selected application programs from the server responsive to a request from the user, such as the selection of an icon associated with the application program which is displayed on the user desktop screen at the client. An "instance of the selected" application program is then provided from the server for execution at the client. Thus, the application programs may be maintained at the server and provided to client's when needed for execution.

As defined in the specification of the present application:

the term "application program" generally refers to the code associated with the underlying program functions, for example, Lotus Notes or a terminal emulator program. However, it is to be understood that the application program will preferably be included as part of the application launcher which will further include the code associated with managing usage of the application program on a network according to the teachings of the present invention. Further it is to be understood that, as used herein, the term "application launcher program" may refer to the entire program provided by a software vendor or to merely a portion thereof distributed to a client to perform particular operations. **For example, the application launcher program distributed to initially populate the user desktop preferably does not include the code associated with the underlying application program** and obtaining preferences which may only be distributed to the client later when execution of the application program is requested. The application launcher program distributed to populate the user desktop may only include a URL and an associated ICON and, possibly, code to allow obtaining of user identification and password information. Memory usage on the client stations may thereby be limited.

(Specification, pp. 22-23)(emphasis added). Thus, the "application program" is an application level software program, such as Lotus Notes, while the "application launcher program" is provided to "initially populate the user desktop" and need not include the application program code. In other words, the application launcher program interacts with the desktop, such as a user browser interface, while an instance of the application program is requested through the desktop but executes locally at the client as a separate application from the browser interface. For example, Lotus Notes would not execute within the browser window.

The present invention may, therefore, be used so that a variety of application programs can be maintained at the server, and an instance of a selected one of the application programs may be provided as needed to a user logged onto a client device. The provided instance of the application may then be executed at the client device to process the request of

the user. Thus, individual application programs are provided to the user as needed (on-demand) where they are executed at a client device rather than having the application program execute at the server responsive to a request from a user. Furthermore, a customized user interface desktop is provided at the client device, which displays the applications the user is authorized to access.

Claims 1, 21 and 23 Are Patentable Over the Cited References:

The rejections of independent Claims 1, 21 and 23 assert that Rose teaches all of the recitations of the claims except "the inventive concept of receiving at the server a login request from the user at the client." (Action, p. 3). However, the rejections rely on Win as teaching "receiving at the server a login request from the user at the client." (Action, p. 3). Applicants submit that Rose does not teach or suggest a "user desktop **associated with the user.**" Applicants further submit that Win does not teach or suggest such a user desktop include "a plurality of display regions associated with a set of the plurality of **application programs** installed at the server for which the user is authorized." Furthermore, the Rose and Win references cannot properly be combined to arrive at the present invention in light of the different problems addressed by these references and the lack of motivation for the combination.

Rose is directed to managed distribution of licensed application programs stored on a server where the server "maintains control over the program even after the program has been distributed to a client computer." (Rose, Abstract). As described in Rose, for example, with reference to Figure 2, trial versions of application programs may be selected for downloading from the server to a client through a browser interface. (Rose, Col. 4, lines 10-17). In other words, Figure 2 illustrates a display screen at the client showing application programs available for downloading from the server. A selected trial version is then prepared, for downloading to the client, which includes encryption and header information used for license and usage control after delivery to the client. (Rose, Col. 5, lines 19-52).

The rejections of Claim 1 primarily rely on Figure 7 and the associated description in Rose as teaching the present invention. However, as is clearly stated in Rose, Figure 7 displays application programs "downloaded to and stored on client computer 102." (Rose,

Col. 6, lines 41-42). A selection of a program from the display of Figure 7 of Rose is a selection of a locally stored program for execution as contrasted with the selection of an application program for downloading from a server as illustrated in Figure 2 of Rose. Thus, a selection of an application program through Figure 7 of Rose does not result in the server "providing an instance of the selected one of the plurality of application programs to the client for execution" as recited in Claim 1. Furthermore, neither of the displays of Figures 2 or 7 of Rose are "associated with the user responsive to the login request from the user." While the display of Figure 2 of Rose is established at the client by the server responsive to a browser request from the client, it is simply a download options window not specific to a particular user. The download options window is also not established responsive to a login request as acknowledged by the Written Opinion. The display of Figure 7 of Rose is directed to local (client) resident application programs and a selection from the display of Figure 7 does not initiate "providing an instance of the selected one of the plurality of application programs to the client for execution" as the application programs are client resident at the time of the request. Thus, Claims 1, 21 and 23, and the claims that depend therefrom, should be allowed for at least these reasons.

The deficiencies of Rose are not overcome by Win. Win relates to "controlling access to information resources," not client-server environment on-demand application program management. (See Win, Abstract). The managed resources are defined in Win as follows:

A Resource is a source of information, identified by a Uniform Resource Locator (URL) and published by a Web server either in a static file formatted using Hypertext Markup Language (HML) or in a dynamically generated page created by a CGI-based program. Examples of resources include a Web page, a complete Web site, a Web-enabled database, and an applet.

(Win, Col. 5, lines 21-27). Thus, the "resources" managed by Win are not "application programs" as that term is defined in the present application in the excerpt reproduced above. Similarly, no user desktop interface that includes "a plurality of display regions associated with a set of the plurality of application programs" is taught or suggested by Win. It follows that no selection received at the server of such an application program and no "providing an instance of the selected" application program "to the client for execution" is taught or suggested by Win. Instead, the only resource selected and provided in Win is a display for

the user, such as a static HTML file or a "dynamically generated page created by a CGI-based program" of the server. (Win, Col. 5, lines 21-27). Therefore Claims 1, 21, 23 and the claims that depend from them are patentable for at least these reasons.

The rejections should also be withdrawn as the Rose and Win references cannot properly be combined in the manner relied on by the Action. To establish a prima facie case of obviousness, the prior art reference or references when combined must teach or suggest *all* the recitations of the claim, **and** there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. M.P.E.P. § 2143. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. § 2143.01, citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). As recently emphasized by the Court of Appeals for the Federal Circuit, to support combining references, evidence of a suggestion, teaching, or motivation to combine must be **clear and particular**, and this requirement for clear and particular evidence is not met by broad and conclusory statements about the teachings of references. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). In an even more recent decision, the Court of Appeals for the Federal Circuit has stated that, to support combining or modifying references, there must be **particular** evidence from the prior art as to the reason the skilled artisan, with no knowledge of the claimed invention, **would have selected these components for combination in the manner claimed**. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

Respectfully, the Action fails to meet the requirements for a showing of obviousness under § 103. First, as discussed above, the cited combination of references fails to teach all of the recitations of the claims. Furthermore, there is no basis for combining the methods and system for controlled downloading of trial versions of programs described in Rose with the resource access management teachings of Win. This is particularly true as they are both directed to distinct problems from the client-server application management environment of the present invention. Thus, while Rose does relate to application program distribution from a server, such operations are for providing trial versions to be repeatedly executed at a client.

In fact, the encryption and application builder aspects advanced as the invention in

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