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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,232	05/21/2001	Greg Arnold	82594819	9948
22879	7590	01/30/2013	EXAMINER	
HEWLETT-PACKARD COMPANY Intellectual Property Administration 3404 E. Harmony Road Mail Stop 35 FORT COLLINS, CO 80528			SHIN, KYUNG H	
			ART UNIT	PAPER NUMBER
			2443	
			NOTIFICATION DATE	DELIVERY MODE
			01/30/2013	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GREG ARNOLD and DAN TORRES

Appeal 2010-005159
Application 09/863,232
Technology Center 2400

Before ALLEN R. MacDONALD, ROBERT E. NAPPI, and
BRYAN F. MOORE, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Introduction

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 1-24. We have jurisdiction under 35 U.S.C. § 6(b).

Exemplary Claim

Exemplary claim 1 under appeal reads as follows:

Claim 1. A method of transferring information comprising the steps of:

a) at a remote server, responsive to receiving a signal from a first mobile computing device, accessing an account stored on said remote server, said account reserved for a second mobile computing device, said account describing information that is not stored in said second mobile computing device;

b) modifying said account to identify an information that resides on said remote server but not on said second mobile computing device;

c) responsive to establishing a connection with said second mobile computing device, said remote server automatically determining from said account that said information is new to said second mobile computing device, and in response to said determining, automatically downloading said information to said second mobile computing device.

Rejections

The Examiner rejected claims 1-24 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Multer (US 6,757,696 B2) and Coppinger (US 2001/0046862 A1).¹

¹ Separate patentability is not argued for claims 3, 5, 7-11, 14, and 16-24. Except for our ultimate decision, these claims are not discussed further herein.

Appellants' Contentions

1. Appellants contend that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a) because Multer teaches away from an account stored on a server and Coppinger merely teaches creation of an account. (App. Br. 12-14).²

2. Appellants further contend that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a) because Coppinger fails to teach or suggest that the account describes information that is not stored in the second mobile computer device and has absolutely no teaching of a second wireless device. (App. Br. 14 and 17-19).

3. Appellants also contend that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a) because Coppinger fails to teach synchronization between a wireless device and a server; and actually teaches away from the present invention. (App. Br. 15-16).

4. Appellants contend that the Examiner erred in rejecting claim 2 under 35 U.S.C. § 103(a) because the Examiner improperly equates Multer's taught datapack with the recited token. (App. Br. 22-23).³

5. Appellants contend that the Examiner erred in rejecting claim 4 under 35 U.S.C. § 103(a) because Multer does not teach a version of an application program. (App. Br. 24).⁴

² Appellants also contend that the Examiner erred in rejecting claim 12 for the same reasons as set forth in contentions 1-4. (App. Br. 26-30).

³ Appellants also contend that the Examiner erred in rejecting claim 13 for the same reason. (App. Br. 31).

⁴ Appellants also contend that the Examiner erred in rejecting claim 15 for the same reason. (App. Br. 33).

6. Appellants contend that the Examiner erred in rejecting claim 6 under 35 U.S.C. § 103(a) because neither Multer nor Coppinger teaches or suggests authority to download to said second mobile computing device. (App. Br. 25).

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellants' arguments (Appeal Brief and Reply Brief) that the Examiner has erred.

We disagree with Appellants' conclusions. We adopt as our own (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken and (2) the reasons set forth by the Examiner in the Examiner's Answer in response to Appellants' Appeal Brief. We concur with the conclusions reached by the Examiner.

Separately, we note that Appellants repeatedly argue that the references teach away from the invention. However, Appellants fail to set forth appropriate reasoning to support these arguments. A reference "teaches away" when it suggests that the developments flowing from its disclosures are unlikely to produce the objective of the Appellants' invention. *See In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). Appellants fail to present any persuasive arguments as to how the teachings of Multer combined with the teachings Coppinger would be unlikely to produce the objective of Appellants' invention.

Further as to Appellants' above contentions, we note that Appellants repeatedly attack one or the other of the references individually for lack of a teaching where in fact the Examiner has relied on the other reference (or the combination of references) for that teaching. Appellants point out certain

deficiencies in each reference rather than challenging the conclusion based upon their combined teachings. The fact that neither reference individually disclose or suggest a particular limitation of the claimed method does not rebut the obviousness conclusion reached by the Examiner based upon the combined teachings of those references. The test for obviousness is what the combined teachings of the prior art would have suggested to the hypothetical person of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

Further regarding above contention 2, as to the claim requirement of describing information that is not stored in a wireless device, we particularly note that the Examiner's rejection points to paragraph 60 of Coppinger which teaches sending a request so that the wireless device receives software in accordance with the request. We agree with the Examiner's reasoning that an artisan would understand this to be the identification of software that is not stored in the wireless device.

We note that Appellants' Reply Brief presents an argument based on a reading of *In re Ratti*, 270 F. 2d 810 (CCPA 1959). We have reviewed that venerable case of the CCPA, and find that much of its holding must be updated by further developments in the law guided by the Supreme Court as expressed in *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007). Rather than expressing obviousness as the physical placement of structure from one reference within the confines of the structure from another reference as in *Ratti*, the Supreme Court viewed the prior art as a combination of teachings from different sources, and the use of those teachings by a practitioner in the art. Appellants' reasoning based on *Ratti* is not consistent with the Court's reasoning in *KSR*.

CONCLUSIONS

- (1) The Examiner has not erred in rejecting claims 1-24 as being unpatentable under 35 U.S.C. § 103(a).
- (2) Claims 1-24 are not patentable.

DECISION

The Examiner's rejections of claims 1-24 are affirmed.

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

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