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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte WILLIAM J. BEYDA and RAMI CASPI

Appeal 2010-007504
Application 10/957,143
Technology Center 2400

Before ALLEN R. MacDONALD, KALYAN K. DESHPANDE, and
TREVOR M. JEFFERSON, *Administrative Patent Judges*.

JEFFERSON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 1-21. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Introduction

The claims are directed to system and method for historical presence map. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A telecommunications system, comprising:
 - a network;
 - a plurality of client devices operably coupled to said network, said plurality of client devices adapted to select one or more of others of said plurality of client devices as contacts on a contact list;
 - a presence server coupled to said network and adapted to monitor presence status of selected ones of said others;
 - wherein said presence server maintains aggregated records of past presence data for said selected ones and is configured to provide a historical presence and a prospective schedule for respective one from said aggregated records to a requesting other one of said plurality of client devices, said prospective schedule indicating a predicted availability for said respective one on a future day.

References

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Curbow	US 2003/0206619 A1	Nov. 6, 2003
Horvitz	US 2004/0003042 A1	Jan. 1, 2004
Doss	US 2004/0064585 A1	Apr. 1, 2004
Adkins	US 2004/0243844 A1	Dec. 2, 2004

Rejections

The Examiner made the following rejections:

Claims 1-21 stand provisionally rejected under judicially created doctrine of non-statutory obvious-type double patenting over pending application serial No. 10/957,141 in view of Curbow. Ans. 3-4.

Claims 1-8 and 10-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Horvitz and Doss. Ans. 5-13.

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Horvitz, Doss, and Adkins. Ans. 13-14.

ANALYSIS

Claims 1-21 – Non-statutory obvious-type double patenting

Issue: Did the Examiner err by using a co-pending application in the non-statutory obvious-type double patenting rejection?

Appellants contend that the Examiner's citation of Curbow in the non-statutory obvious-type double patenting rejection was improper, because it is not a commonly owned application or patent and "[d]ouble patenting over a copending application *in combination with* another unrelated reference(s) is improper and against a clear statement of public policy." App. Br. 6.

Appellants' argument that it is improper to use Curbow with Appellants' copending application in the provisional non-statutory obvious-type double patenting rejection is based on an incorrect statement of the law. The Federal Circuit stated the appropriate procedure for a double-patenting rejection as follows: "we start by examining the claims of the . . . patent, and by assessing the prior art references in order to ascertain whether the

PTO made out a *prima facie* case of obviousness.” *In re Longi*, 759 F.2d 887, 895-96 (Fed. Cir. 1985); *see also In re Aldrich*, 398 F.2d 855, 863 (CCPA 1968) (examining a secondary reference for its teachings in a double patenting rejection).

Based on the foregoing, the Examiner did not err in rejecting claims 1-21 under the judicially created doctrine of non-statutory obviousness-type double patenting over pending application 10/975,141 and Curbow.

Claims 1-21 – 35 U.S.C. § 103(a) rejections

Issue: Did the Examiner err because the combination of Horvitz and Doss would change the principle of operation of each reference and teaches away from their combination?

Appellants argue that the cited references in the 35 U.S.C. § 103(a) rejection teach away from their combination because you cannot combine Doss’s rules based prediction approach and Horvitz’s “probabilistic approach without destroying the crux of one at the cost of using the other,” changing the principle of operation of each reference. App. Br. 11.

We are not persuaded by Appellants’ arguments that Doss and Horvitz teach away from their combination. “[I]n general, a reference will teach away if it suggests that the line of development flowing from the reference’s disclosure is unlikely to be productive of the result sought by the applicant.” *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). Such is not the case here.

We agree with the Examiner’s findings that Horvitz and Doss are both in the same field of endeavor. Horvitz “forecast[s] the presence and availability of a user based on the analysis of user’s past data and observations.” Ans. 18 (citing Horvitz ¶¶ 48, 72, 76, 126, 127). Doss “is

also directed toward predicting the availability of a user for a particular future day based on the analysis of user's historical calendar data, wherein the analysis is to compute the patterns of the historical presence and make the prediction." Ans. 19 (citing Doss ¶¶ 21, 30, 63). Prior art does not teach away from claimed subject matter merely by disclosing a different solution to a similar problem unless the prior art also criticizes, discredits, or otherwise discourages the solution claimed. *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). We find that Doss and Horvitz propose different solutions to similar problems in the same field of predicting user availability.

Based on the foregoing, we sustain the Examiner's rejection of claims 1-8 and 10-21 under 35 U.S.C. § 103(a) as being unpatentable over Horvitz and Doss, and claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Horvitz, Doss, and Adkins.

DECISION

For the above reasons, the Examiner's rejection of claims 1-21 is 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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