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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MARC JARVIS, SHAOFEI CHEN,
KEVIN HANES, and JEFFERSON RALEY

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Appeal 2010-008471
Application 10/952,073[1]
Technology Center 2100

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Before MARC S. HOFF, STANLEY M. WEINBERG, and
JOHN A. EVANS, *Administrative Patent Judges*.

HOFF, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from a Final Rejection of claims 1-17. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

Appellants' invention is a system and method for data migration integration. A data migration application is integrated with an image copied at manufacture of a replacement information handling system along with rules for performing the data migration so that the replacement information

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[1] The real party in interest is Dell Products L.P.

handling system ships to an end user prepared to accept data migrated from an existing information handling system (Spec. 3).

Claim 1 is exemplary of the claims on appeal:

1. A system for coordinating data migration from an existing information handling system to a replacement information handling system, the system comprising:

an image management network site associated with an information handling system manufacturer and operable to accept customer component selections that define an image for copying to manufactured information handling systems;

an image engine associated with the image management network site operable to compile the selected components into an image, the selected components including a data migration application; and

a data migration engine associated with the image management network site and operable to accept customer rule definitions for the data migration application to migrate data from the existing information handling system to the replacement information handling system, the rule definitions incorporated in the image, the data migration application operable to initiate at the replacement information handling system to migrate data from the existing information handling system according to the rule definitions.

The Examiner relies upon the following prior art in rejecting the claims on appeal:

| | | |
|---|---|---|
| Henrickson '622 | US 6,625,622 B1 | Sept. 23, 2003 |
| Henrickson '281 | US 2005/0125281 A1 | June 9, 2005 |
| Sexton | US 7,072,919 B2 | July 4, 2006 |
| Matsunami | US 7,124,143 B2 | Oct. 17, 2006 |

Claims 1-5, 10, 12, 13, 16, and 17 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Henrickson '281.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Henrickson '281 in view of Sexton.

Claims 7 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Henrickson '281 in view of Matsunami.

Claims 8, 9, 14, and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Henrickson '281 in view of Henrickson '622.

## ISSUES

Appellants argue, *inter alia*, that Henrickson '281 fails to disclose "a data migration engine . . . operable to accept customer rule definitions for the data migration application . . . the rule definitions incorporated in an image" (Suppl. Br. 3).

With respect to claim 12, Appellants argue that Henrickson does not teach automatically initiating the data migration application on initial power up (Suppl. Br. 4).

With respect to claim 15, Appellants assert that the Examiner has not indicated where Henrickson '281 or Henrickson '622 teaches excluding the transfer of MP3 files (Suppl. Br. 4).

Appellants' contentions present us with the following issues:

1. Does Henrickson '281 teach a data migration engine associated with the image management network site and operable to accept customer rule definitions, the rule definitions incorporated in the image, the data migration application operable to initiate at the replacement information handling system to migrate data?

2. Does Henrickson '281 teach automatically initiating the data migration on initial power up?

3. Does the combination of Henrickson '281 and Henrickson '622 teach or fairly suggest excluding MP3 files from the data migration?

PRINCIPLES OF LAW

A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference." *See In re Buszard,* 504 F.3d 1364, 1366 (Fed. Cir. 2007) (quoting *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994)).

> Section 103(a) forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'

*KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407, ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.")

## ANALYSIS

### CLAIM 1

The Examiner finds that Henrickson '281 teaches a data migration engine operable to accept customer rule definitions, the rule definitions incorporated in the image (Ans. 5).

We do not agree with the Examiner's finding. We note that claim 1 also recites that the "image" is copied to "manufactured [replacement] information handling systems." Henrickson '281 discloses a Replacement Assistant that creates a replacement plan on a *source* computer ("existing information handling system," in the language of Appellants' claims) that can be later accessed by activating an icon on the *source* computer display (¶ [0051]). While Henrickson '281 does disclose that the Replacement Assistant is pre-installed on a new computer, the rule definitions recited in the claim have not been incorporated in the image on the *replacement* system (¶¶ [0038], [0047]).

The Examiner's reliance on step 412 (Henrickson '281, ¶ [0042]) is also misplaced (Ans. 5). Packing step 412 "involves placing the components to be migrated in a uniquely identified migration file for later migration to the new computer" (Henrickson '281, ¶ [0042]). Any "rule definitions" that may be included in this file are thus contained on the *source* computer, or in "online storage media" (Henrickson '281, ¶ [0042]), "for later migration" to the *replacement* computer.

We find that Henrickson '281 does not teach the claimed data migration engine in which rule definitions are incorporated in an image (on the replacement information handling system). We therefore find that the

Examiner erred in rejecting claim 1 as being anticipated by Henrickson '281, and we will not sustain the rejection.

CLAIMS 2-9, 11, 14, 16, AND 17

Appellants state that they "appeal the rejection of Claims 1, 10, 12, 13, and 15" (Suppl. Br. 2). Taking together this statement and the lack of argument for any claim not listed therein as appealed, we understand Appellants to state that the rejection of claims 2-9, 11, 14, 16, and 17 is not appealed. We therefore affirm *pro forma* the rejection of claims 2-9, 11, 14, 16, and 17.

CLAIM 10

Appellants state that they do not contest the rejection of claim 10 (Suppl. Br. 4). Accordingly, we affirm *pro forma* the rejection of claim 10.

CLAIM 12

We do not agree with the Examiner's finding that Henrickson '281 teaches automatically initiating the data migration application on initial power up (Ans. 7). First, as noted *supra* with respect to claim 1, Henrickson '281fails to teach initiating the data migration application at the replacement system. The Replacement Assistant is accessed by activating a specially created icon on the source computer display (Henrickson '281, ¶ [0051]). Second, Figure 5, steps 502-504, disclose manually loading the Replacement Assistant.

We find that the Examiner erred in rejecting claim 12 under § 102 as being anticipated by Henrickson '281. We will not sustain the rejection.

CLAIM 13

Appellants argue that Henrickson '281 fails to disclose both a data migration application and rules for the data migration application in a

replacement information handling system image (Suppl. Br. 4). As we explained *supra* with respect to claim 1, we find these arguments to be persuasive.

Accordingly, we find that the Examiner erred, and we will not sustain the Examiner's § 102 rejection of claim 13.

CLAIM 15

In his response to Appellants' arguments, the Examiner refers to the rejection of claim 15 as "one of official notice that the exclusion of such files [i.e., MP3 files, as claimed] would be obvious to one of ordinary skill in the art" (Ans. 16-17). For the first time in the Answer, the Examiner relies upon Official Notice to reject claim 15, in addition to the previously cited references. Specifically, the Examiner takes Official Notice that "it was well known in the art to avoid the transfer of 'MP3' files" and that "an ordinary skilled artisan would have found it desirable to avoid copying copyrighted files such as MP3s." Ans. 17:4-5, 14-15. Appellants contend that "[t]he Examiner cannot now claim the use of official notice since the Examiner's office actions failed to provide such notice." Reply Br. 2:9-10.

We agree with Appellants. We view thetaking of Official Notice in the Answer as an improper effort to bring Official Notice in the back door. *See In re Hoch*, 428 F.2d 1341, 1342 n.3 (CCPA 1970) ("Where a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of the rejection.") Accordingly, we consider the rejection under 35 U.S.C. § 103 based solely on the evidence contained in Henrickson '281 and Henrickson '622.

We agree with Appellants that the Examiner has not indicated where Henrickson '281 or Henrickson '622 teaches the exclusion of MP3 files from data migration.

Accordingly, on the record before us we cannot but find that the Examiner has not established the prima facie obviousness of claim 15 over Henrickson '281 in view of Henrickson '622. Therefore, we will not sustain the Examiner's § 103 rejection.

## CONCLUSIONS

Henrickson '281 does not teach a data migration engine associated with the image management network site and operable to accept customer rule definitions, the rule definitions incorporated in the image, the data migration application operable to initiate at the replacement information handling system to migrate data.

Henrickson '281 does not teach automatically initiating the data migration on initial power up.

The combination of Henrickson '281 and Henrickson '622 does not teach or fairly suggest excluding MP3 files from the data migration.

## ORDER

The Examiner's rejection of claims 2-11, 14, 16, and 17 is affirmed. The Examiner's rejection of claims 1, 12, 13, and 15 is reversed.

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)(2010).

AFFIRMED-IN-PART

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