UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/932,087	10/31/2007	Thomas P. SAWYERS	82227890	2003

22879 7590 03/01/2013
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
3404 E. Harmony Road
Mail Stop 35
FORT COLLINS, CO 80528

EXAMINER
RAMADAN, RAMY O

ART UNIT	PAPER NUMBER
2859	

NOTIFICATION DATE	DELIVERY MODE
03/01/2013	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JERRY.SHORMA@HP.COM
ipa.mail@hp.com
brandon.serwan@hp.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte THOMAS P. SAWYERS

Appeal 2010-008788
Application 11/932,087
Technology Center 2800

Before ALLEN R. MacDONALD, JASON V. MORGAN, and LYNNE E. PETTIGREW, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Introduction

Appellant appeals under 35 U.S.C. § 134 from a final rejection of claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b).

Exemplary Claim

Exemplary claim 1 under appeal reads as follows:

> 1. A method, comprising:
>
> dynamically updating a register in a battery pack to include a value that is indicative of a present capacity of the battery pack;
>
> reading the value from the register; and
>
> setting a charge current level at initiation of a charge cycle to charge the battery pack based on the value read from the register.

Rejections

The Examiner rejected claims 1, 2, 8, 11, 13, 15, and 16, under 35 U.S.C. § 103(a) as being unpatentable over the combination of Bourilkov (US 2008/0238357 A1; Oct. 2, 2008) and Eguchi (US 6,495,989 B1; Dec. 17, 2002).[1]

The Examiner rejected claims 5, 6, 12, 19, and 20 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Bourilkov and Eguchi.[2]

---

[1] Separate patentability is not argued for claims 2, 8, 11, 13, 15, and 16. Except for our ultimate decision, these claims are not discussed further herein.

[2] Separate patentability is not argued for claims 5, 12, 19, and 20. Except for our ultimate decision, these claims are not discussed further herein.

The Examiner rejected claims 3, 4, 9, 10, 17, and 18 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Bourilkov, Eguchi, and Lampe-Onnerud (US 2007/0029972 A1; Feb. 8, 2007).[3]

The Examiner rejected claims 7 and 14 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Bourilkov, Eguchi, and Montero (US 2006/0085204 A1; Apr. 20, 2006).[4]

Appellant's Contentions

1. Appellant contends that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a) because "[m]odifying Bourilkov as suggested by the Examiner would render it unsatisfactory for its stated purpose of rapidly charging a battery." (App. Br. 12).

2. Appellant contends that the Examiner erred in rejecting claim 6 under 35 U.S.C. § 103(a) because:

> Claim 6 requires "setting the charge current level at initiation of a charge cycle comprises setting a different charge current multiple times at initiation of multiple charge cycles during the life of the battery pack." Neither Bourilkov nor Eguchi has any such teaching. In Bourilkov, the ID resistor has a fixed resistance which is cross-referenced to a charge current. Because the resistance of the ID resistor does not change, the charge current in Bourilkov does not change during the life of the battery pack. Eguchi also does not teach changing the initial

[3] The patentability of dependent claims 3, 4, 9, 10, 17, and 18 rejected under 103(a) are not separately argued from that of their base claims rejected on a separate basis under 103(a). Except for our ultimate decision, these claims are not discussed further herein.

[4] The patentability of dependent claims 7 and 14 rejected under 103(a) are not separately argued from that of their base claims rejected on a separate basis under 103(a). Except for our ultimate decision, these claims are not discussed further herein.

> charge current during the life of a battery pack. For this additional reason, the Examiner erred in rejecting claim 6.

(App. Br. 12).

Issue

Has the Examiner erred in determining that Bourilkov and Eguchi disclose each limitation of claims 1 and 6?

ANALYSIS

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

We disagree with Appellant's conclusions as to all rejections. 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 Appellant's Appeal Brief. We concur with the conclusions reached by the Examiner. We highlight the following arguments for emphasis.

As to Appellant's above contention 1, "unsatisfactory for its stated purpose" is an argument that the reference teaches away from modifying because it "would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984). Appellant's argument fails for two reasons. First, it does not acknowledge the impact of the Court's explicit rejection in *KSR* of the rigid requirement that the art suggest a modification. *KSR Int'l Inc. v. Teleflex Inc.*, 550 U.S. 398, 415 (2007) ("We begin by rejecting the rigid approach of the Court of Appeals.").

Second, beyond advocating a rigid requirement that an artisan cannot use the Bourilkov as a teaching of anything but rapid charging, Appellant does not explain what in Bourilkov meets the requirements of a teaching away from the invention claimed. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference . . . would be led in a direction divergent from the path that was taken by the applicant." *In re Haruna*, 249 F.3d 1327, 1335, 58 USPQ2d 1517, 1522 (Fed. Cir. 2001). A reference does not teach away if it merely expresses a general preference for an alternative invention from amongst options available to the ordinarily skilled artisan, and the reference does not discredit or discourage investigation into the invention claimed. *In re Fulton,* 391 F.3d 1195, 1201 (Fed. Cir. 2004). We do not find teaching away in the situation before this Board.

Further, we find that being more or less effective is not a teaching away. "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994)*; see also In re Mouttet*, 686 F.3d 1322, 1334 (Fed. Cir. 2012) (no teaching away when Appellant failed "to cite any reference suggesting that the claimed invention would be unlikely to work using electrical circuitry . . . only that it may be inferior for certain purposes.") While Bourilkov may disclose the advantages of rapid charging, it does not discredit or discourage the use of other forms of charging. Therefore Appellant's argument that Bourilkov teaches away from the asserted combination is not persuasive of Examiner error.

CONCLUSIONS

(1) The Examiner has not erred in rejecting claims 1-20 as being unpatentable under 35 U.S.C. § 103(a).

(2) Claims 1-20 are not patentable.

DECISION

The Examiner's rejections of claims 1-20 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

ke