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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MASAKI ICHIHARA

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Appeal 2010-009870  
Application 11/004,814  
Technology Center 2600

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*Before* THU A. DANG, JAMES R. HUGHES, and  
GREGORY J. GONSALVES, *Administrative Patent Judges.*

GONSALVES, *Administrative Patent Judge.*

DECISION ON APPEAL

## STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the final rejection of claims 1-4, 6-8, 10, 11, 13-19, 23 and 25 (App. Br. 4). Claims 5, 9, 12, 20-22 and 24 were cancelled (*id.*). We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

### *The Invention*

Exemplary Claim 1 follows:

1. A server for sending/receiving data from/to a plurality of mobile communication terminals and a computer through a network, the server comprising:

a database for storing data used by the respective mobile communication terminal for each mobile communication terminal; and

a controlling unit for controlling the server and for controlling communication between the server and the mobile communication terminal and communication between the server and the computer,

wherein the controlling unit inputs data transmitted from the computer to the database and transmits the data stored in the database to the mobile communication terminal in response to a request from the mobile communication terminal, the server further comprising:

a WEB page database for storing a plurality of WEB pages respectively corresponding to plural kinds of mobile communication terminals;

changing means for changing a format of a WEB page to be sent to a respective mobile communication terminal based on mobile communication terminal model information of the respective mobile communication terminal that is provided by a

user of the computer during a login state between the computer and the server; and

means for sending a data upload program to the mobile communication terminal along with the WEB page,

wherein the format of the WEB page is changed to a format suitable for the respective mobile communication terminal, and is sent to the respective mobile communication terminal.

Claims 1-4, 6-8, 10, 11, 13-19, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hall (U.S. Patent No. 6,356,543 B2) in view of Granade (U.S. Patent Publication No. 2002/0103881 A1) and Mahajan (U.S. Patent Publication No. 2004/0127205 A1) (Ans. 3-8).

Claim 23 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hall in view of Bridges (U.S. Patent Publication No. 2003/0186695) and Granade (Ans. 8-10).

## ISSUES

Appellant's responses to the Examiner's positions present the following issues:

1. Did the Examiner err in concluding that the combination of Hall, Granade, and Mahajan teaches "sending a data upload program to the mobile communication terminal along with the WEB page," as recited in independent claim 1, and as similarly recited in independent claims 8 and 16?
2. Did the Examiner err in concluding that the combination of Hall, Granade, and Mahajan teaches "data retrieved from the server and provided to the mobile communication terminal is compared to data

currently stored in the mobile terminal database prior to retrieving of the data from the server, to determine whether or not any of the data currently stored in the mobile terminal database is to be overwritten with the data retrieved from the server”, as recited in dependent claim 25?

3. Did the Examiner err in concluding that the combination of Hall, Bridges, and Granade teaches that an email received from a server “identifies a URL to access a WEB page by which the user of the mobile communication terminal can access the data stored at the server,” as recited in independent claim 23?

#### ANALYSIS

*Rejection of Claims 1-4, 6-8, 10, 11, 13-19, and 25 As Obvious Under 35 U.S.C. § 103(a) Over Hall, Granade, and Mahajan*

Appellant contends that independent claim 1 is not obvious because the combination of Hall, Granade, and Mahajan does not disclose the claim limitation from claim 1 quoted above (App. Br. 16). In support of this contention, Appellant argues that Mahajan does not disclose “the sending of a data upload program to the mobile communication terminal along with the WEB page” (*id.* (emphasis omitted)).

The Examiner, however, reasoned that the combination of references teaches this claim limitation because Granade discloses that a server uploads “a web page to be displayed in a mobile device” (Ans. 11) and Mahajan “clearly explains that data upload to a mobile station is not limited to a single data type, but that other applications and programs can be uploaded” (*id.*). In response to the Examiner’s reasoning, Appellant argues that in Mahajan “the application programs are not data upload programs, but rather they are ‘games, ring tones, etc.’” (App. Br. 18).

We conclude, however, that Appellant's arguments urging patentability are predicated on non-functional descriptive material, *i.e.*, the content of a program that is sent and received. The *informational content* of non-functional descriptive material is not entitled to weight in the patentability analysis. *See In re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir. 1994) (“Lowry does not claim merely the information content of a memory. . . Nor does he seek to patent the content of information resident in a database.”). *See also Ex parte Nehls*, 88 USPQ2d 1883, 1887-90 (BPAI 2008) (precedential); *Ex parte Curry*, 84 USPQ2d 1272 (BPAI 2005) (informative) (Federal Circuit Appeal No. 2006-1003, *aff'd*, Rule 36 (June 12, 2006)); *Ex parte Mathias*, 84 USPQ2d 1276 (BPAI 2005) (informative), *aff'd*, 191 Fed. Appx. 959 (Fed. Cir. 2006).

This reasoning is applicable here. Accordingly, we will sustain the Examiner's rejection of representative claim 1, and independent claims 8 and 16 that fall therewith. *See* 37 C.F.R. § 41.37(c)(1)(vii). We will also sustain the Examiner's rejection of dependent claims 2-4, 6, 7, 10, 11, 13, 14, and 17-19 because Appellant did not set forth any separate patentability arguments for those claims (*see* App. Br. 16-19). *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellant also contends that the Examiner erred in rejecting dependent claim 25 as obvious because the combination of Hall, Granade, and Mahajan does not teach the claim limitation emphasized above (App. Br. 19-20). In support of this contention, Appellant argues that “the fact that Hall teaches a URL locator functionality, and the fact that Granade teaches mobile communication terminals with e-mail capability, and the fact that

Mahajan teaches OTAF user's data overwriting/updating a database, falls well short of the specific features recited in claim 25” (*id.* at 20).

The Examiner concluded, however, that

[w]hether the data retrieved from the server and provided to the mobile communication terminal is compared to data currently stored in the mobile terminal database prior to retrieving of the data from the server, to determine whether or not any of the data currently stored in the mobile terminal database is to be overwritten with the data retrieved from the server, as argued by the appellant constitutes the intended use of the product's structural invention elements

(Ans. 12). We disagree with the Examiner. Claim 25 does not merely recite a purpose or intended use for a structure but rather, positively recites comparing the data received at the mobile with the data stored at the mobile. Accordingly, we find error in the Examiner’s rejection of claim 25.

*Rejection of Claim 23 As Obvious Under 35 U.S.C. § 103(a) Over Hall, Bridges, and Granade*

Appellant argues that the Examiner erred in rejecting independent claim 23 as obvious because the combination of Hall, Bridges and Granade does not teach that “the e-mail identifies a URL to access a WEB page by which the user of the mobile communication terminal can access the data stored at the server” (App. Br. 21 (emphasis omitted)). We conclude, however, that Appellant’s arguments urging patentability of claim 23 are predicated on non-functional descriptive material that is not entitled to weight in a patentability analysis, *i.e.*, the content of an email that is sent and received. Accordingly, we find no error in the Examiner’s rejection of independent claim 23.

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Application 11/004,814

DECISION

We affirm the Examiner's decision rejecting claims 1-4, 6-8, 10, 11, 13-19 and 23 under 35 U.S.C. § 103(a) and reverse the rejection of claim 25 under 35 U.S.C. § 103(a).

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-IN-PART

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