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Appeal 2013-000463
Application 11/170,655

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARTIN YU-WEN CHEN and FU-YING HUANG

Appeal 2013-000463¹
Application 11/170,655
Technology Center 2100

Before JEAN R. HOMERE, CARLA M. KRIVAK, and
CATHERINE SHIANG, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–15, 18–23, and 26–28. Claims 16, 17, 24, and 25 have been canceled. App. Br. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

¹ Appellants identify the real party in interest as Hitachi Global Storage Technologies. App. Br. 1.

Appellants' Invention

Appellants invented a personal portable storage device (PPSD) contained in a housing (201) enclosing an energy source (330) and a storage medium (340) coupled to a wireless component (310) and transfer management electronics (320) to thereby allow host devices to wirelessly and simultaneously access data in the storage medium while the PPSD remains in a stowed location. Spec. ¶¶8, 20–22, Fig. 3.

Representative Claim

Independent claim 1 is representative. It reads as follows:

1. A personal portable storage device (PPSD) comprising:
 - a storage medium;
 - a wireless component coupled to said storage medium, said wireless component having multiple simultaneous connection capabilities;
 - a transfer management electronics coupled to said storage medium for allowing a plurality of host devices to access said PPSD simultaneously through said wireless component, without requiring physical connections between said PPSD and said plurality of host devices, said PPSD remaining in a stowed location during said access;
 - a self-contained energy source coupled to said transfer management electronics; and
 - a housing of a size and shape well-suited to being carried on a person, said housing at least partially enclosing said storage medium, said wireless component, said transfer management electronics, and said self-contained energy source, such that said PPSD is easily transported.

Prior Art Relied Upon

Sackner

US 2003/0135127 A1

July 17, 2003

Appeal 2013-000463
Application 11/170,655

Minnear	US 2005/0146836 A1	July 7, 2005
Gurevich	US 2005/0174962 A1	Aug. 11, 2005
Ram	US 2006/0007151 A1	Jan. 12, 2006

Rejections on Appeal

The Examiner rejects the claims on appeal as follows:

Claims 1–6, 8, and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Ram, Gurevich, and Sackner.

Claims 7, 11–15, 18, 19, 21–23, 26, and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Ram, Gurevich, Sackner, and Minnear.

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Ram, Gurevich, Sackner, and IBM '99.

Claims 20 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Ram, Gurevich, Sackner, Minnear, and IBM '99.

ANALYSIS

We consider Appellants' arguments *seriatim* as they are presented in the Appeal Brief, pages 7–23, and the Reply Brief, pages 2–12.²

² Rather than reiterate the arguments of Appellants and the Examiner, we refer to the Appeal Brief (filed February 7, 2012), the Reply Brief (filed June 26, 2012), and the Answer (mailed April 27, 2012) for the respective details. We have considered in this decision only those arguments Appellants actually raised in the Brief. Any other arguments Appellants could have

Dispositive Issue: Under 35 U.S.C. § 103, did the Examiner err in finding the disclosures of Ram, Gurevich, and Sackner are properly combined to teach or suggest *a plurality of devices simultaneously accessing data in PPSD while the PPSD remains in a stowed location*, as recited in claim 1?

Appellants argue the proposed combination of references relied upon by the Examiner to reject claim 1 is improper because modifying the mouse of Ram with Sackner's teaching would result in the mouse being used in a stowed location. According to Appellants, such a proposed utilization of the mouse would render the mouse unsatisfactory for its intended purpose. App. Br. 5–7, Reply Br. 2–4. That is, the mouse would not be available for its intended use as an input device if stowed in a pocket or a belt as in Sackner. *Id.*

In response, the Examiner finds being stowed would not inhibit the mouse from communicating with other devices. Ans. 13–14. We do not agree with the Examiner.

Ram discloses a mouse having a housing enclosing an internal memory, a power supply, and a wireless adapter (Fig. 16) to wirelessly communicate with a host device (Fig. 11 and 41). Although the mouse includes a storage device, the Examiner has not shown that the storage device is capable of being accessed by host devices outside of the mouse for storing or retrieving data. Therefore, on this record, the sole intended use of

made but chose not to make in the Briefs are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appeal 2013-000463
Application 11/170,655

the mouse does not depart from its conventional purpose as an input device. Thus, we agree with Appellants modifying the mouse with Sackner's teaching to be stowed would not comport with its intended use as an input device, and would thereby render the mouse unsatisfactory for its intended purpose.³ Because Appellants have shown at least one reversible error in the Examiner's obviousness rejection, we need not reach the merits of Appellants' remaining arguments.

Because claims 2-5, 7-14, 16-24, 26-32, and 43-45 recite commensurate limitations as those of claim 1 deemed to be improperly rejected over the combination of Ram, Gurevich, and Sackner, as discussed above, Appellants have shown error in the Examiner's rejections of those claims for the foregoing reasons.

DECISION

We reverse the Examiner's rejections of claims 1-15, 18-23, and 26-28 as set forth above.

REVERSED

kme

³ In the event of further prosecution, the Examiner should consider modifying Sackner's microprocessor (3) with the teachings of Gurevich and Ram to reject claim 1.