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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ANURADHA NARASIMHASWAMY MELKOTE,
DAMIAN PORCARI, and KELLY ANNE SLANK

Appeal 2015-002139
Application 13/679,419
Technology Center 2400

Before JEAN R. HOMERE, CARLA M. KRIVAK, and ERIC B. CHEN, *Administrative Patent Judges*.

CHEN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR RECONSIDERATION

Appellants request a rehearing under 37 C.F.R. § 41.52 of our Decision on Appeal entered June 29, 2016 ("Decision" or "Dec.") in which we affirmed the Examiner's final rejection of claims 1–5, 8–11, and 16–23. (Req. for Reh'g 2.)

The Request for Rehearing is *denied*.

ANALYSIS

Appellants argue that "the Examiner must explain why one of ordinary skill would have recognized that Takano would improve Lemble" and "the Board simply asserts without explanation that one would have recognized that Takano would improve Lemble." (Req. for Reh'g 2 (emphasis in original).) In particular, Appellants argue "[a]n assertion that one would have recognized that incorporating reference A, which includes some functionality, with reference B would improve reference B by providing it with some other functionality does not explain why one would have recognized that A would improve B." (*Id.* (emphasis in original).)

However, page 3, lines 15–23, of our Decision states:

> Takano relates "to a system for preparing patent specifications." (Col. 1, ll. 8–9.) Takano explains that
>
> > An object of the present invention is to provide a system capable of preparing data for patent application documents by the *transmission and reception of draft data via a server computer between a client computer used by an inventor* preparing the draft data for a specification . . . *and another client computer used by patent-application-filing person*s including a patent attorney revising the draft data.

(Dec. 3 (emphases added).) Furthermore, page 3, line 25 to page 4, line 1, of our Decision states:

> A person of ordinary skill in the art would have recognized that incorporating the system of Takano, which includes a server computer for transmitting a patent specification between an inventor computer and a patent attorney computer, with the document system of Lemble would improve Lemble *by*

> *providing it with the ability to efficiently transfer patent application documents.*

(Dec. 3–4 (emphasis added).) Accordingly, contrary to Appellants' argument that "the Board simply asserts without explanation that one would have recognized that Takano would improve Lemble" (Req. for Reh'g 2), our Decision does explain that Takano would improve Lemble by providing the ability to transfer patent application documents between a client computer used by the inventor and another client computer used by patent-application-filing persons via a server computer.

Moreover, "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited by *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007)). The Examiner concludes

> it would have been obvious . . . to implement the invention of Lemble into an invention disclosure environment, by combining the electronic filing document approval system of Lemble with the features of filing an invention disclosure by inventors and patent attorneys as taught by Takano for the purpose of conveniently preparing a patent application via a transmission and reception of application data between the inventor and other patent application-filing users

(Final Act. 5 (emphasis omitted).) Thus, the Examiner has provided the requisite articulated reasoning with some rational underpinning to support a conclusion of obviousness. Appellants have not provided any legal authority to support the requirement that "the Examiner must explain <u>why</u> one of ordinary skill would have recognized that Takano would improve Lemble." (Req. for Reh'g 2 (emphasis in original)), nor have Appellants provided reasoning or arguments as to how or why the Examiner's rational for combining the references is in error.

CONCLUSION

The Request for Rehearing has been considered and *denied*.

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).

REHEARING DENIED