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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte THOMAS J. GILG, LARRY MULL,
JUN GU, and TAMMY FUCHIGAMI

Appeal 2018-008919
Application 14/235,261¹
Technology Center 3600

Before CARL W. WHITEHEAD JR., JON M. JURGOVAN, and
MICHAEL M. BARRY, *Administrative Patent Judges*.

JURGOVAN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

On May 27, 2020, Appellant timely filed a Request for Rehearing under 37 C.F.R. § 41.52 following our Decision on Appeal mailed April 2, 2020, in which we affirmed the Examiner’s rejection under 35 U.S.C. § 103 of claims 1 and 3–17. We have jurisdiction under 35 U.S.C. § 6(b).

We have considered Appellant’s arguments in the Request for Rehearing, but we are not persuaded any points were misapprehended or overlooked by the Board in issuing the Decision. We have provided herein

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. According to Appellant, the real party in interest is Hewlett-Packard Development Company, LP. Appeal Br. 1.

additional explanations, but decline to change our Decision in view of Appellant's arguments.

ANALYSIS

Appellant requests rehearing for the following reasons:

(1) the Board's reasoning supports the prior art teaches only "completely qualifying" content, and does not teach the claimed "partially qualifying" content (Req. Reh'g 1-2); (2) the prior art allegedly does not teach that "completely qualifying" content is not desired at an earlier step (Req. Reh'g 2); and (3) the legal precedent cited by the Board in its Decision does not support performing partial qualification upfront but still performing complete qualification later (Reh'g 2-3).

A request for rehearing is not an opportunity to rehash or reargue points merely because Appellant does not agree with the result of the Board's decision. The proper course for an appellant dissatisfied with a Board decision is to seek judicial review. *See* 35 U.S.C. §§ 141, 145. We deny the Request for Rehearing for this reason.

Even if we could reconsider Appellant's arguments presented in their Request for Rehearing, we would not be persuaded of Examiner error. We address Appellant's arguments in order below.

Argument (1)

Appellant contends "the reasoning provided in the decision does not support 'that Herrington's content feed must be in a [partially] qualified format before it is formatted according to individual needs and demands into a completely qualified format to present to the user.'" Req. Reh'g 1; Dec. 13.

As we stated in the Decision, Herrington teaches that “[t]he content feed for each distribution partner can be formatted according to individual needs and demands.” Dec. 13; Final Act. 9–10; Herrington ¶ 133. We further stated “Herrington’s content feed must be in a partially qualified format before it is formatted according to individual needs and demands into a completely qualified format to present to the user.” Dec. 13. Thus, we find the partially qualified format is Herrington’s content feed before formatting according to individual needs and demands, and the completely qualified format is Herrington’s content feed after formatting.

Although Appellant argues that Appellant’s reason for partially qualifying content is that it is less computationally intensive, we find so too is Herrington’s content feed, which requires less computation before formatting than afterward. And, although Herrington’s reason for partially qualifying is that it does not yet have the individual needs and demands, whereas Appellant’s reason is avoiding computational expenditure before knowing content has been ordered by a consumer, Herrington nonetheless teaches the claimed “partially qualifying” of content.

Thus, Appellant’s argument does not persuade us that we misapprehended or overlooked any points in rendering the Decision.

Argument (2)

Appellant argues the prior art does not teach or suggest that complete qualification is not desired at an earlier step. Req. Reh’g 2. We disagree because Herrington teaches formatting is not performed until individual needs and demands are made available. Herrington ¶ 133. Herrington’s content feed before formatting according to individual needs and demands is partially qualified content. Accordingly, Appellant’s argument does not

persuade us of any misapprehended or overlooked points in rendering the Decision.

Argument (3)

Appellant argues the cases we cited in our Decision do not pertain to fact scenarios analogous to performing *partial* qualification upfront but still performing *complete* qualification later. Req. Reh’g 2; Dec. 14; MPEP § 2144.04; *Ex parte Wu*, 10 USPQ2d 2031 (BPAI 1989); *In re Larson*, 340 F.2d 965 (CCPA 1965); *In re Kuhle*, 526 F.2d 553 (CCPA 1975). We disagree. The cited cases hold that omitting an element and its function is obvious if the function of the element is not desired. The rationale is that since the entire apparatus or process is taught by the prior art, merely leaving out a component or step that is not needed is obvious.

In this case, Herrington teaches formatting for a distribution partner is not performed until their individual needs and demands are known. Herrington ¶ 133. The content feed thus remains “partially qualified” until Herrington’s system receives the individual needs and demands and formats the content feed accordingly, thereby producing “completely qualified” content. *Id.* As we stated in the Decision, performing “partially qualifying” because part of what constitutes “completely qualifying” is not desired at an earlier step in the method fails to render the claim nonobvious. Dec. 14.

DECISION

We have considered Appellant’s Request for Rehearing but we decline to make any change to our Decision on the arguments presented. The Examiner’s decision to reject claims 1 and 3–17 under 35 U.S.C. § 101

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remains reversed, and the Examiner's rejection of claims 1 and 3-17 under 35 U.S.C. § 103 remains affirmed.

CONCLUSION

Outcome of Decision on Rehearing:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Denied	Granted
1, 3-17	103	Katz, Boenau, Herrington	1, 3-17	

Final Outcome of Appeal after Rehearing:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 3-17	101	Eligibility		1, 3-17
1, 3-17	103	Katz, Boenau, Herrington	1, 3-17	
Overall Outcome			1, 3-17	

DENIED