

COPY OF PAPERS
ORIGINAL LED



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Gp/2122
Revised
#17
Chavris
5/10/02

In re Application of:)	Examiner: J.Q. CHAVIS
YASSER ALSAFADI ET AL.)	Group Art Unit: 2122
Appl. No.: . 09/343,607)	
Filed: JUNE 30, 1999)	
For: RECONFIGURATION MANAGER FOR CONTROLLING UPGRADES...)	
)	April 26, 2002

RECEIVED
MAY 10 2002
Technology Center 2100

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

SIR:

RESPONSE

This is in response to the Office Action dated February 14, 2002, for the above-identified application.

REMARKS

Claims 1-21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over

Carrol et al. (U.S. Patent No. 6,301,707).

Applicants respectfully submit that the pending claims are patentable for at least the following reasons.

Independent claim 1 recites a processor-implemented method for controlling the reconfiguration of an electronic device, the method comprising the steps of receiving information representative of a reconfiguration request relating to the electronic device, determining at least one device component required to implement the reconfiguration request, comparing the determined component and information specifying at least one additional component currently implemented in the electronic device with at least one of a list of known acceptable configurations for the electronic device and a list of known unacceptable configurations for the electronic device; and generating information indicative of an approval or a denial of the reconfiguration request based at least in part on the result of the comparing step. Independent claims 11 and 21 recite similar limitations.

Carrol, as read by the Applicants, relates to a software system that is selectively installed from a source into a target system according to a profile. The software system comprises a plurality of components. Only selected components are needed by the target system. A profile of the target system is created when the target system is defined; the profile defines the components needed by the target system. To configure the target system, an installation process installs in the target system only components from the source that are defined in the profile for the target system. The source may be a storage medium or a separate installation system.

Carrol fails to teach at least the limitations of (1) receiving information representative of a reconfiguration request relating to the electronic device and (2) comparing the determined component and information specifying at least one additional component currently implemented in the electronic device with at least one of a list of known acceptable configurations for the electronic device and a list of known unacceptable configurations for the electronic device.

The structure recited in claim 1, enables efficient techniques for incrementally upgrading or otherwise reconfiguring electronic devices. The invention ensures that upgrades are compatible with the configuration of a given device before they are implemented in that device, thereby avoiding problems associated with inconsistent upgrades, as further described on page 4, lines 13-16. Applicants can find nothing in Carrol that shows, teaches or describes the above-discussed limitations.

The Office Action indicates that the limitation of receiving information representative of a reconfiguration request is inherently shown in Carrol in col. 4, lines 37-49. Applicants disagree. In this section, Carrol teaches an apparatus for performing the operation of the invention and that the "apparatus may be specially constructed for the required purpose or it may comprise a general-purpose computer as selectively activated or reconfigured by a computer program stored in the computer." Reconfiguring a general-purpose computer to perform the Carrol invention does not teach, suggest or imply the limitation of receiving information representative of a reconfiguration request relating to the electronic device.

Although, as the Office Action indicates, Carrol teaches the use of a profile comparison to install software, applicants respectfully disagrees with the Office Action's

conclusion that this suggests, imply or teaches the claimed limitation of comparing the determined component and information specifying at least one additional component currently implemented in the electronic device with at least one of a list of known acceptable configurations for the electronic device and a list of known unacceptable configurations for the electronic device. Carrol, in fact, teaches away from the claimed invention, via Carrol specific reliance on the use of a profile approach. Moreover, the Office Action does not provide a rationale for the modification (only that there may be a common result). In In re Lee, Slip Op. 00-1158 (Fed. Cir. Jan. 18, 2002) the court indicated that:

The determination of patentability on the ground of unobviousness is ultimately one of judgment. In furtherance of the judgmental process, the patent examination procedure serves both to find, and to place on the official record, that which has been considered with respect to patentability. In finding the relevant facts, in assessing the significance of the prior art, and in making the ultimate determination of the issue of obviousness, the examiner and the Board are presumed to act from this viewpoint. Thus when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

Accordingly, Applicants respectfully submit that there would have been no motivation for one of ordinary skill to attempt to such a modification.

Applicants further respectfully note that it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the

Examiner is expected to make the factual determinations set for in Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Applicants respectfully submit the Office Action has failed to make a prima facie case of obviousness.

A review of the other art of record has failed to reveal anything which, in Applicants' opinion, would remedy the deficiencies of the art discussed above, as a reference against the independent claims herein. These claims are therefore believed patentable over the art of record.

The other claims in this application are each dependent from the independent claim discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual consideration of the patentability of each on its own merits is respectfully requested.

The applicants submit that the claims, as they now stand, fully satisfy the requirements of 35 U.S.C. 103. In view of the foregoing amendments and remarks,

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.