

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VINAY DEO and NEIL S. FISHMAN

Appeal No. 1997-4220
Application No. 08/394,659¹

ON BRIEF

Before HAIRSTON, KRASS, and FLEMING, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1, 3 through 7, 9 through 14, 16 and 18. Claims 8, 15 and 17 have been indicated by the examiner in the answer as

¹ Application for patent filed February 22, 1995.

being directed to allowable subject matter and are no longer before us on appeal.

The invention is directed to the remote management of memory in a portable information device, such as a wristwatch, from an external computer.

Representative independent claim 1 is reproduced as follows:

1. A method for remotely managing a watch memory in a programmable watch from a computer external to the watch, the computer having a memory, the method comprising the following steps:

mapping the watch memory into a portion of the computer memory to create a virtual watch memory within the computer memory;

manipulating the computer memory to modify the virtual watch memory therein; and

downloading the memory modification made in the virtual watch memory from the computer to the watch memory.

The examiner relies on the following reference:

Yokozawa 4,534,012 Aug. 6, 1985

Claims 1, 3 through 7, 9, 11 through 14 and 16 stand rejected under 35 U.S.C. 102(e) as anticipated by Yokozawa.

Claims 10 and 18 stand rejected under 35 U.S.C. 103 as unpatentable over Yokozawa.

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Reference is made to the briefs and answer for the
respective positions of appellants and the examiner.

OPINION

We will sustain the rejection of claims 1, 3, 4 and 16 under 35 U.S.C. 102(e) but we will not sustain either the rejection of claims 5 through 7, 9 and 11 through 14 under 35 U.S.C. 102(e) or the rejection of claims 10 and 18 under 35 U.S.C. 103.

Turning first to the rejection of claims 1, 3, 4 and 16, independent claims 1 and 16, in our view, are broader in scope than contended by appellants.

Throughout various sections of the brief and reply brief, appellants argue that whereas the instant invention is concerned with externally managing a virtual copy of a portable device's memory and downloading *only* memory modifications to the portable device, Yokozawa teaches that the entire program must be recompiled by the external computer and then the entire program is downloaded to the memory of the portable device. We agree with appellants that this, indeed, is the difference between the instant *disclosed* invention and the disclosure of Yokozawa. However, we find the language of instant independent

claims 1 and 16 to be much broader in scope than appellants' argument.

First, since the external computer in Yokozawa programs the portable device and data is exchanged between the two devices, with memories of the external computer corresponding to memories in the portable device, we think it is reasonable to conclude that there is a "mapping" in Yokozawa between the watch (i.e., the portable device) memory and the external computer memory. It is also clear that the external computer in Yokozawa manipulates its memory to modify information therein during processing. Yokozawa then downloads the entire program to the memory of the portable device. When the entire program, including any updated information, is downloaded to the portable device in Yokozawa, so too are any memory modifications downloaded at that time, from the computer memory to the watch memory. It is true that Yokozawa does not download *only* the memory modifications, since even the unmodified memory is downloaded, but claims 1, 3, 4 and 16 do not require that *only* the memory modifications be downloaded to the exclusion of unmodified memory. Thus, appellants'

arguments in this regard are directed to unclaimed features and are, as such, not persuasive.

Accordingly, we will sustain the rejection of claims 1, 3, 4 and 16 under 35 U.S.C. 102(e).

We reach the opposite result with regard to claims 5 through 7, 9 through 14 and 18. Each of independent claims 5, 9, 11 and 18 requires a determination of what "memory transactions are effective to change the virtual memory from its initial arrangement to its modified arrangement" and then those memory transactions are transferred from the computer to the portable information device where the information device memory is updated using the memory transactions. While these claims do not use the word "only" to modify the memory modifications downloaded, it is clear that Yokozawa makes no determination of what memory transactions are effective to change the virtual memory from an initial arrangement to its modified arrangement because, in Yokozawa, the entire program, including modified and unmodified memory, is downloaded. Thus, Yokozawa has no need to determine what memory transactions are effective to change the virtual device memory from an initial arrangement to a modified arrangement. We read the quoted

claim language "determining what memory transactions are effective..." and the subsequent language, consistent with appellants' argument, as requiring *only* memory modifications, and not the entire program, to be downloaded to the portable device from the external computer.

The examiner argues that Yokozawa "inherently" teaches the determination of what memory transactions or the least number of transactions are effective to change the virtual device memory from its initial arrangement to a modified arrangement because Yokozawa teaches programming the portable device from the external computer. The examiner contends that "in writing a program to modify the external station's memory from one arrangement to another, the user/computer must determine what memory modifications are required effective to change the virtual device memory from one arrangement to another arrangement" [answer-page 6]. We disagree and find no such "inherency" in Yokozawa's teachings. Yokozawa does not deal, at all, with determining what memory transactions or least number of transactions are effective to change the virtual memory from an initial arrangement to a modified arrangement because Yokozawa merely downloads the entire program.

Accordingly, we will not sustain the rejection of claims 5 through 7, 9 and 11 through 14 under 35 U.S.C. 102(e) nor will we sustain the rejection of claims 10 and 18 under 35 U.S.C. 103.

The examiner's decision is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR 1.136(a).

AFFIRMED-IN-PART

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ERROL A. KRASS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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MICHAEL R. FLEMING)	
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