EXHIBIT 1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): DeLuca et al.   Case No.: PT01748U

Application No.: 08/522,026   Group Art Unit: 2211

Filed: August 31, 1995   Examiner: W. Wilson

For: Multiple Pager Status Synchronization System And Method

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Name of Applicant, Assignee or Registered Representative

_____   6-20-97
SIGNATURE   DATE

<u>**AMENDMENT UNDER 37 C.F.R. §1.115**</u>

Assistant Commissioner of Patents
Washington, D.C. 20231

Sir:

　　In response to the Office Action dated April 1, 1997, please amend the above
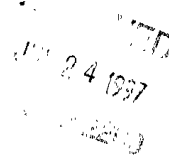identified application as follows:

<u>IN THE SPECIFICATION</u>

　　page 1, line 32 replace "page" with -pager-;

　　page 2, line 17 replace "substantial" with -substantially-;

　　page 4, line 11 replace "signal;" with -signal.-;

　　page 4 ,line 18 replace "block" with -signaling-;

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page 4, line 20 replace "block" with -signaling-;

page 4, line 22 replace "block" with -signaling-;

page 4, line 27 replace "block" with -signaling-;

page 4, line 31 replace "block" with -signaling-;

page 5, line 32 replace "system" with -network-;

page 6, line 1 replace "ReFlex" with -ReFLEX™-;

page 7, line 1 replace "Tango" with -Tango™-;

page 9, line 14 after "be" insert -identified as being-;

page 9, line 14 replace "pagers" with -pager-;

page 9, line 25 replace "pagers 150" with -pager 150-;

page 10, lines 7 replace "FIG. 3, dotted-line" with -FIG. 5,-;

page 10, lines 7-8 replace "and its sequences, dotted-line" with -,-;

page 10, line 9 delete "dotted-line";

page 11, line 26 delete the first appearance of the word -a-;

page 12, line 22 replace "Message 655" with -Referring now to FIG. 5, message 655-;

page 12, line 23 replace "pagers" with -pager-

page 12, line 28 replace "pagers 550 change the their" to -pager 550 changes its-;

page 13, line 2 after "number" insert -of-;

page 13, line 5 replace "he" with -the-;

page 13, line 20 after "because" insert -the-;

page 13, line 21 after "therefore" insert -the-;

page 15, line 15 replace "an other" with -another-.

IN THE ABSTRACT

lines 12-14 delete "This allows a user to own several of the pagers (150 and 550) and switch between their use without having to adjust the status of each pager.".

REMARKS

The specification and abstract are amended. Claims 1-14 remain in the application without amendment. Corrected formal drawings will be submitted upon indication of allowability of the claims.

A Corrected Information Disclosure Statement, including copies of the U.S. Patents and other publications listed therein, is being filed concurrently with this amendment. Applicants respectfully request that the Examiner consider the information referred to in the Corrected Information Disclosure Statement as to the merits. The titles listed in the Corrected Information Disclosure Statement are composed of the titles listed in the Information Disclosure Statement filed with the application plus the one title listed in the Supplemental Information Disclosure Statement filed on June 24, 1996. A corresponding "Corrected Form PTO-1449" is also being filed concurrently with this amendment.

The Examiner has objected to the Abstract of the Disclosure as speculative and suggested that the last sentence be deleted. By this amendment, the last sentence of the Abstract of the Disclosure is deleted.

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Independent claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeLuca '826 in combination with Davis '582. Applicants respectfully disagree with the Examiner's analysis and assert that the Examiner has not established a prima facie case of obviousness. The Examiner not established that the cited references show all the claimed elements of Applicants' invention and has the benefit of Applicant's invention to construct a combination that a person of ordinary skill in the art would not otherwise construct without the benefit of Applicants' invention description.

In one embodiment, Applicants' invention describes a method whereby a user having a plurality of pagers will have status changes the user has made on a message on one pager automatically made on other pagers of the user. This results in an advantage that the status of message on all pagers of the user are synchronized. For example, a message is sent to a user who has two pagers, a first carried by the user and a second to be used later. The first pager could be fashioned for use in a professional environment with a more formal dignified styling. The second pager could be used after working hours in sporting events, the second pager having a bright yellow color and perhaps improved moisture resistance, less suitable for use in a professional environment. During working hours the user receives the message, decides the message is very important and changes the status of the message to "protect" it from possible deletion. This status change is made by the user on the first pager because it is the one currently being carried by the user. According to the invention, the first pager would send a signal to the infrastructure that the status of the message has been changed to "protected". The infrastructure then broadcasts the status change. Upon receiving the status change signal the second pager changes the status of the message to "protected". Thus the status of the message in both pagers is synchronized, or the same, as "protected", even though the user made the status change on only the first pager. The user may then switch to using the second pager without having to manually change the status of the message on the second pager. Alternate embodiments of Applicants' invention include synchronization of alarm times, key word status or message threshold value status between multiple pagers.

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DeLuca '826 describes a pager that changes the status of a message on the basis of information received in the message or a manual input. In DeLuca, a message is received with status information included in the message which is to have its status changed at various times (FIGS. 2 & 3), or the status is changed in response to a manual input using time of day (FIG. 9). Davis '582 shows a sending a message with a limited set of responses included in the message (FIG. 3 and column 5, line 37 to column 6, line 65). This allows a user to read a message and respond to the sender with a limited number or replies selected by the sender. The reasonable combination of DeLuca and Davis by one of ordinary skill in the art would be a message having a limited number of responses included in the message, that also would change its status in response to signals included in the message or a manual input. For example the message "WHAT TIME TO YOU WANT TO MEET MR. JONES FOR DINNER? 6PM; 7PM; 8PM; CALL BACK" of Davis FIG. 3 when considering DeLuca FIG, 2, would be HELD until 12:25 PM at which time it would be alerted and the user would then read the message select from one of the limited responses which would then be forwarded to the sender (Mr. Jones presumably). Then at 1:30 PM the message would be DELETED.

With respect to claim 13, the Examiner has not established that either DeLuca or Davis describes Applicants' claimed means *to produce a synchronizing signal for signaling the infrastructure of the current state of the status category*, as recited in claim 13, lines 11-12. With respect to claim 14, the Examiner has not established that either DeLuca or Davis describes Applicants' claimed software element *for controlling transmission of a synchronizing signal by the transmitter after a change of state of a status category*. See claim 14, lines 13-14. DeLuca shows changing the status of messages based upon information received in the message or a manual input and Davis shows a user selecting from a limited set of responses included in a message. The Examiner has not suggested how either reference would indicate to the infrastructure the current state of a status category. Applicants assert that the Examiner has not established that the cited references show all of the elements of the claimed invention, and further, has not established a reason a person of ordinary skill in the art would combine elements of the cited references in such a way that would result in a system for synchronizing a status category of a plurality of communications devices, as in claim 13, or a system for synchronizing messages among a multiplicity of

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selective call transceivers, as in claim 14. Consequently Applicant's respectfully assert that the obviousness of the invention of claims 13 and 14 has not been established and request removal of the rejection of claims 13 and 14.

Claims 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable in view of DeLuca '826 in combination with Davis '582. The Examiner has extended the analysis of the rejection of claim 13 above to claims 8-12 noting that claims 8-12 recite a method of operation corresponding to the apparatus of claim 13. With respect to claim 8, Applicants respectfully disagree with the Examiner's analysis and, as in claim 13, assert that the Examiner has not established a prima facie case of obviousness. Furthermore, the Examiner has not established that either DeLuca or Davis describes Applicants' claimed *transmitting a first message indicative of the second status* (see claim 8, line 17) in the first transceiver, nor *changing the status of the second transceiver to the second status in response thereto* (see claim 8, lines 24-25). And the examiner has not established why a person of ordinary skill in the art would combine elements of the cited references in such a way that would result in a method for synchronizing a status of a plurality of transceivers. Consequently, Applicants respectfully assert that the obviousness of the invention of claim 8 has not been established and request removal of the rejection of claim 8. Claims 9-12 are dependent upon claim 8 are also believed allowable for the above reasons.

Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable in view of DeLuca '826 in combination with Davis '582. The Examiner has extended the analysis of the rejection of claim 14 above to claims 4-7 noting that claims 4-7 recite a method of operation corresponding to the apparatus of claim 14. With respect to claim 4, Applicants respectfully disagree with the Examiner's analysis and, as in claim 14, assert that the Examiner has not established a prima facie case of obviousness. Furthermore, the Examiner has not established that either DeLuca or Davis describes Applicants' claimed *transmitting a second message indicative of the second status* (see claim 4, line 7-8) in one transceiver, nor *changing the status of the message to the second status* (see claim 4, line 14) in at least one other transceiver. Furthermore, the Examiner has not established why a person of ordinary skill in the art would combine elements of the cited references in such a way that would result in a method of synchronizing message information among a plurality of transceivers.

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Consequently, Applicants respectfully assert that a the obviousness of the invention of claim 4 has not been established and request removal of the rejection of claim 4. Claims 5-7 are dependent upon claim 4 are also believed allowable for the above reasons.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell '318 in combination with DeLuca '826. Applicants respectfully disagree with the Examiner's analysis and assert that the Examiner has not established a prima facie case of obviousness. The Examiner has not established that the cited references show the processes of Applicants' claimed invention and furthermore has used the benefit of Applicant's invention to construct a combination of processes which a person of ordinary skill in the art would not otherwise construct without the benefit of Applicants' invention description. While Mitchell shows multiple messages being transmitted from a pager, the functionality of the messages do not compare with the functionality of Applicants' claimed messages. Mitchell in FIG. 7 shows a method of replying to multiple messages received by a pager based upon the priority of the reply assigned by the user. Referring to FIG. 7, Reply to #1 is a user response to Message #1 and is sent immediately because the user prepared a high priority reply. The user then prepared a low priority Reply #2 in response to receiving Message #2. Contrary to Reply to #1 being sent immediately, Reply #2 is delayed until high priority message #4 is received, then Reply #2 is added to ACK #4. The reasonable combination of Mitchell and DeLuca by a person of ordinary skill in the art would be making each message of Mitchell, Message #1 to Message #4 of FIG. 7, a message that also would change its status in response to signals included in the message or a manual input as described in DeLuca FIGS. 2, 3 and 9. High or low priority replies to each message could be prepared, grouped and transmitted, according to the teaching of Mitchell. With respect to claim 1, the Examiner has not established that either Mitchell or DeLuca describes Applicants' claimed process step of wirelessly transmitting a message having *information indicative of the status change of the received message*, as recited in claim 1, lines 10-12. Nor has the Examiner indicated why a person of ordinary skill in the art would transmit this kind of information in view of the cited references. Applicants assert that the Examiner has not established that the cited references show all the processes of the claimed invention and further, has not established a reason a person of ordinary skill in the art would combine processes of the cited

references in such a way that would result in the synchronization of multiple pager benefits of Applicants' invention. Consequently Applicants respectfully disagree that the obviousness of the invention of claim 1 has not been established and request removal of the rejection of claim 1. Claims 2-4 are dependent upon claim 1 are also believed allowable for the above reasons.
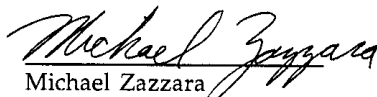
The remaining references made of record by the Examiner: DeLuca '751, Cannon '227, Fawcett '258 and Minami '848 have been considered and are not believed applicable to Applicants' claimed invention.

The Commissioner is hereby authorized to charge any fees which may be required or credit any overpayment to deposit account # 13-4778.

In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration of the rejections is requested. However, should the Examiner disagree with applicant's attorney in any respect, it is respectfully requested that the Examiner telephone applicant's attorney in an effort to resolve such differences.

Respectfully submitted,
DELUCA ET AL.

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