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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BEHRAM DACOSTA

Appeal 2010-008040
Application 10/782,345
Technology Center 2400

Before: JOSEPH L. DIXON, ST. JOHN COURTENAY III, and
CARLA M. KRIVAK, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the rejection of claims 10-13 and 30. We have jurisdiction under 35 U.S.C. § 6(b).

We Affirm.

INVENTION

Appellant's claimed invention is generally related to home entertainment systems. (Spec. 1) Independent claim 10, reproduced below, is representative of the subject matter on appeal:

10. A *home* entertainment system, comprising:

at least one wireless system server having at least a primary communication system; and

at least one wireless component having at least a primary communication system configured for communicating with the primary communication system of the server, wherein the component sends configuration information to the server using a secondary communication system that is out-of-band with the primary systems, *wherein the configuration information is exchanged between the server and component only when the distance between them is within a communication distance and a user manipulates at least one button on at least one of the server, and the component.*

(disputed limitations emphasized)

REJECTION

Claims 10-13 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sayers (U.S. Pat. App. Pub. No. 2005/0083882 A1, Apr. 21, 2005, filed Oct. 15, 2003) in view of Official Notice.

GROUPING OF CLAIMS

Based on Appellant's arguments, we decide the appeal of the rejection of claims 10, 12, and 30 on the basis of representative claim 10. *See* 37 C.F.R. § 41.37(c)(1)(iv). We address the rejection of claims 11 and 13 separately, *infra*.

APPELLANT'S CONTENTIONS

Appellant contends, *inter alia*, that

[T]he rejection unfortunately and, more importantly to this appeal, erroneously descends into mischaracterizations of select portions of Sayers to support hypothetical conjectures about what is well known, followed by an inept attempt to demonstrate the allegation of what is "well known" by reference to an inapposite reference ([J]o).

(App. Br. 3). In particular, Appellant contends that Sayers and Official Notice would not have rendered obvious the following limitations recited in claim 10:

A home entertainment system, comprising: . . .

“wherein the configuration information is exchanged between the server and component *only when* the distance between them is within a communication distance and *a user manipulates at least one button on at least one of the server, and the component.*” (Claim 10, emphasis added; *see also* App. Br. 3-5).

ISSUE

Under § 103, did the Examiner err in finding that the cited references, either alone or in combination, would have taught or suggested the following disputed limitations:

A home entertainment system, comprising: . . .

“wherein the configuration information is exchanged between the server and component *only when* the distance between them is within a communication distance and *a user manipulates at least one button on at least one of the server*, and the component,” within the meaning of independent claim 10? (emphasis added).

ANALYSIS

CLAIMS 10, 12, AND 30

We observe the Examiner takes “Official Notice” that the disputed limitations would have been obvious over Sayers and knowledge well known in the art:

Sayers does not specifically teach that the user must manipulate at least one button on at least the server or the component for the communication to take place, as claimed. Sayers teaches that the base station and the configuration transmitter may be placed behind a guard desk, or also in a home, as examples (0029, 0031). In such cases, *it is well known in the art for the user to press a button to effectuate the communication between the server and the wireless component*. This can constitute pressing “OK” on the GUI of one of the devices, for example. Without such a mechanism, any user within range of the base station could receive the secondary communication, thus defeating the purpose of the security measures of the invention. Therefore, the pressing of a button on one of the server or component to establish secondary communication would have been known by one of ordinary skill to at least achieve this security purpose. *The pressing of a button to effectuate communication is eminently well known in the art, and an example is shown in Jo (U.S. 2002/0087351), paragraph 0046*. Therefore, such a pressing of a button does not constitute a patentable distinction.

(Ans. 4-5. emphasis added).

In the “Response to Arguments” portion of the Answer, the Examiner more particularly clarifies that:

However, even if Sayers did not teach the placement of the inventive system in a home, it is respectfully asserted that the claimed limitation of a "home entertainment system" takes place in the preamble, and is not given patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67,190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150,152, 88 USPQ 478, 481 (CCPA 1951).

(Ans. 6).

As a matter of claim construction, we agree with the Examiner’s interpretation of the disputed limitation of a "home entertainment system" which is recited only in the preamble. Assuming *arguendo* that the “home” preamble limitation may be given weight, Sayers teaches that “[t]he secure setup described herein may be particularly useful to implement a secure wireless network access for businesses or *families* where some control over either the network users, potential eavesdroppers, or both, is desired.” (¶ [0029], emphasis added). Sayers also expressly teaches accessing a network in a *home*:

[0032] After the network user has received the configuration information, the user's wireless device may be initialized 430 to access the network. The user is then free to roam 440 anywhere in or nearby the business or *home* while maintaining the network connection.

(Sayers, ¶ [0032], emphasis added).

Given these teachings, we find Sayers would have suggested to the artisan that a family *home* network would benefit from Sayers' secure wireless network access.

Nor do we find persuasive Appellant's contentions that exchanging "configuration information . . . between the server and *component only when the distance between them is within a communication distance and a user manipulates at least one button on at least one of the server, and the component*" would be unobvious over Sayers and the knowledge of an artisan. (Claim 10; *see also* App. Br. 3-5; Reply Br. 1-4).

Assuming *arguendo* that the second disputed "wherein" clause may be given weight, we agree with the Examiner (Ans. 5-9) that Sayers would have taught or suggested the aforementioned limitations, taking into account knowledge which was within the level of ordinary skill in the art at the time Appellant's invention was made.¹ Our reviewing court guides that an Examiner's reasoning "may include recourse to logic, judgment, and common sense available to a person of ordinary skill that do not necessarily require explication in any reference or expert opinion." *See Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1328-29 (Fed. Cir. 2009); *In re*

¹ *See* MPEP §2111.04 regarding "wherein" clauses:

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

- (A) "adapted to" or "adapted for" clauses;
- (B) "wherein" clauses; and
- (C) "whereby" clauses.

(MPEP §2111.04 Eighth Edition, Rev. 9, Aug. 2012).

Bozek, 416 F.2d 1385, 1390 (CCPA 1969) (an examiner may rely upon "common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference"). See also *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. 398, 420-21 (2007).

Therefore, we are not persuaded of error regarding the Examiner's legal conclusion of obviousness. (Ans. 5-10). We also observe that Sayers expressly teaches *pressing a button* in a manner that we find is at least suggestive of the disputed "wherein" clause of Appellant's claim 10:

[0039] For example, a coffee shop could sell, for a selected fee, a configuration device that provides free wireless access in the store and the ability to purchase goods worth the selected fee. To make a purchase, *a customer initiates communication between the configuration device and the cash register*. From the customer's point of view, establishing communication may be accomplished, for example, *simply by pointing the configuration device at the cash register and pressing a button*. Using the configuration device, the customer may purchase coffee *and may also obtain configuration information for wirelessly accessing the network*. Upon returning to his or her table, the customer may connect the configuration device to the wireless device in order to access the wireless network.

(Sayers, ¶ [0039], emphasis added).

Notwithstanding Appellant's attempt to discredit the extrinsic evidence the Examiner provides in support of Official Notice (App. Br. 3-6), we find no unequivocal statement in Appellant's Briefs that the contested limitations were *not considered to be common knowledge or well-known in the art*. See MPEP § 2144.03(C):²

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's

² MPEP, Eighth Edition, August 2001, Rev. 9, August 2012.

action, *which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art.* See 37 CFR 1.111(b).

Here, because Appellant has not met the requisite burden, and for the reasons discussed above, we are not persuaded of Examiner error. Therefore, we sustain the Examiner's rejection of representative claim 10 as being obvious over Sayers and Official Notice. Claims 12 and 30 (not separately argued) fall therewith. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Dependent claim 11

Regarding dependent claim 11, Appellant contends that "Sayers does not appear to contemplate the use of PANs [Personal Area Networks]." (App. Br. 5).

However, we find the IR (infrared) secondary communication system of Sayers is at least suggestive of the claimed PANs (Claim 11):

[0036] As shown in FIG. 5B, The IR configuration device 510 and the customer's wireless device 530 establish a communication link 540 between the IR transceivers 534, 512 of the wireless device and the IR configuration device. The configuration information is transmitted from the IR configuration device 510 to the wireless device 530.

Moreover, Appellant expressly admits in the Specification that PANs are *known in the art*: "the secondary communication system 18 may use personal area network (PAN) principles *known in the art* to transfer information between the server 12 and the components discussed" (Spec. 6, ¶2, emphasis added).

Having acknowledged that certain claimed elements are taught by the prior art, Appellant cannot now defeat an obviousness rejection by asserting

that the cited references fail to teach or suggest these elements. *See Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1570 (Fed. Cir. 1988) (“A statement in a patent that something is in the prior art is binding on the applicant and patentee for determinations of anticipation and obviousness.”); *In re Nomiya*, 509 F.2d 566, 571 n.5 (CCPA 1975) (It is a “basic proposition that a statement by an applicant, whether in the application or in other papers submitted during prosecution, that certain matter is ‘prior art’ to him, is an admission that that matter is prior art for all purposes . . .”).

This reasoning is applicable here. On this record, we are not persuaded of Examiner error. Therefore, we sustain the Examiner’s rejection of claim 11 as being obvious over Sayers and Official Notice.

Dependent claim 13

Regarding dependent claim 13, Appellant contends:

The allegation in the Office Action on page 4, lines 8-13 that it is well known to swap the set-top box of Claim 13 for the personal computer of Sayers is without evidentiary basis. Additionally, set-top boxes are used for different purposes than are computers and manifestly the two disparate device[sic] are not known as interchangeable equivalents. The rejection of Claim 13 is further reversible for resting on a conjecture of what is “well known” without evidentiary support or logical basis in fact.

(App. Br. 6).

We find no unequivocal statement in Appellant’s Briefs that the contested limitations were *not considered to be common knowledge or well-known in the art*. *See* MPEP § 2144.03(C). Because Appellant has not met the requisite burden, and for essentially the same reasons articulated by the

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Examiner (Ans. 10), we sustain the Examiner's rejection of claim13 as being obvious over Sayers and Official Notice.

DECISION

We affirm the Examiner's § 103 rejection of claims 10-13 and 30.

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1) (iv).

ORDER

AFFIRMED

Vsh