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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RICHARD G. HYATT, JR. and DOUGLAS E. TRENT

Appeal 2011-000850
Application 10/440,304
Technology Center 3600

Before JENNIFER D. BAHR, BENJAMIN D. M. WOOD, and
PATRICK R. SCANLON, *Administrative Patent Judges*.

SCANLON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE¹

Richard G. Hyatt, Jr. et al. (Appellants) seek our review under 35 U.S.C. § 134 of the Examiner's decision rejecting claims 1 and 35-50. Claims 2-34 have been cancelled. Previously maintained rejections of claims 1 and 41-47 on various grounds of nonstatutory, obviousness-type double patenting, as well as a previously maintained provisional rejection of claims 41-46, have been withdrawn by the Examiner.² Ans. 3.

Appellants' representative presented oral argument on January 8, 2013. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

THE INVENTION

Appellants' invention relates to "manually operated, electronically keyed locks and locking processes suitable for retrofitting existing appliances." Spec. II, para. [0001].³ Independent claim 41, reproduced below, is illustrative of the subject matter on appeal.

41. An electronic locking system, comprising:
 - a cylinder rotatably received between interior walls of a shell;
 - a detent disposed between said cylinder and said shell, said detent engaging the shell while

¹ We note that this appeal appears to be related to Appeal No. 2009-011943 (Application No. 08/720,070) and Appeal No. 2011-006302 (Application No. 10/440,308).

² As a result of these withdrawn rejections, there is no ground of rejection as to claims 1 and 47. We accordingly confine our decision to claims 35-46 and 48-50.

³ As used herein, "Spec. II" refers to the Substitute Specification and Abstract filed December 24, 2009 and acknowledged by the Examiner on October 15, 2010.

hindering rotation of said cylinder within said shell;

a key engaging surface provided by a face of said cylinder;

a memory borne by said cylinder, storing a code corresponding to said cylinder;

an electrical operator borne by said cylinder and rotating with said cylinder within said shell, said operator responding to a data signal conforming to said code upon reception of said data signal from a key engaging said surface, by releasing said detent to move relative to both said cylinder and the shell when said detent accommodates said rotation upon application of a torque applied by a user manipulating a key while said key engages said surface; and

an anti-tamper mechanism selectively resisting said rotation in response to application of a force to said locking system in an absence of a coincidence between said data signal and said code.

THE REJECTIONS

The Examiner maintains the following rejections:

The rejection of claims 35-46 and 48-50 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

The rejection of claims 41-46 and 48-50 under 35 U.S.C. § 102(b) as being anticipated by Gokcebay (US 5,552,777, iss. Sep. 3, 1996).

ANALYSIS

Enablement

The Examiner rejects claims 35-46 and 48-50 as lacking enablement because the claimed terms “anti-tamper mechanism” and “anti-tamper

member” are not found in the Specification and thus do not have clear support in the Specification. Ans. 4. In response, Appellants note that their Specification discloses a sphere 630, which “blocks direct access to circuit board 139 and, among other advantages, deters efforts to defeat locking device 600 by drilling for example with a rotating bit inserted into keyway 118.” App. Br. 48 (citing Spec. I, p. 20, ll. 10-12 (*see also* Spec. II, para. [0140])).⁴ Appellants argue that the phrase “deters efforts to defeat” is synonymous with “anti-tamper,” and Appellants’ Specification thus describes how to make and use the claimed anti-tamper mechanism. App. Br. 48-49.

The test for compliance with the enablement requirement is whether the disclosure, as filed, is sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). Further, when rejecting a claim for lack of enablement, the PTO bears the initial burden of setting forth a reasonable explanation as to why the scope of the claim is not adequately enabled by the description provided in the specification. *In re Wright*, 999 F.2d 1557, 1561-62 (Fed. Cir. 1993). Factors that may be considered in determining whether a disclosure would require undue experimentation include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the

⁴ As used herein, “App. Br.” refers to the Fourth Substitute Appeal Brief filed May 12, 2010 and “Spec. I” refers to Appellants’ original Specification filed May 19, 2003.

predictability or unpredictability of the art, and (8) the breadth of the claims. *Wands*, 858 F.2d at 737.

We agree with Appellants that the phrase “deters efforts to defeat” is synonymous with “anti-tamper.” In concluding there is no enabling disclosure, the Examiner has not addressed the *Wands* factors or otherwise explained why one of ordinary skill in the art would have to engage in undue experimentation to practice the claimed invention. *See* Ans. 4, 6.

For the above reasons, the Examiner has failed to establish a prima facie case of non-enablement of claims 35-46 and 48-50, and we are constrained to reverse the rejection.

Anticipation based on Gokcebay

The Examiner finds that Gokcebay discloses an electromechanical cylinder lock comprising a shell 46, a cylinder 24, a key engaging surface 26/28, a memory 32, 34, 40 borne by the cylinder 24, an electrical operator 36, and a detent 38 disposed between the cylinder 24 and the shell 46. Ans. 5. The Examiner further finds that the tumblers in cylinder 24 of Gokcebay “resist rotation when in the locked position” and comprise an anti-tamper mechanism. *Id.*

Contrary to Appellants’ assertion (App. Br. 50), we find that Gokcebay does disclose tumblers as averred by the Examiner. For instance, as noted by the Examiner, Gokcebay discloses “a series of bores for conventional pin tumblers.” Ans. 6 (citing Gokcebay, col. 5, ll. 9-13). *See also* Gokcebay, col. 6, ll. 60-62. However, we agree with Appellants’ argument that there is no evidence the tumblers of Gokcebay anticipate the claimed anti-tamper mechanism. App. Br. 51.

Independent claim 41 requires the anti-tamper mechanism to resist rotation of the cylinder within the shell “in an absence of a coincidence between said data signal and said code.” The tumblers of Gokcebay function in a conventional manner. Gokcebay, col. 6, ll. 60-62. As such, these tumblers would resist rotation of the cylinder within the shell until proper alignment of a key having a matching key cut is established with the tumblers. Gokcebay, col. 1, ll. 44-52. The Gokcebay tumblers are not controlled by a data signal from an electrical operator or a code stored in a memory and do not function in any particular manner in the absence of coincidence of a data signal and a code. Gokcebay thus fails to disclose the anti-tamper mechanism as recited in claim 41.

Independent claim 46 recites an anti-tamper member that resists movement of a lock member in response to longitudinal movement of the cylinder. The lock member is recited in claim 46 as being a component of an electrically powered locking mechanism and movable between open and locked positions. Although the Examiner does not specifically identify which element of Gokcebay corresponds to the claimed lock member, it is presumably considered to be met by Gokcebay’s electrically controlled blocking pin 38 because the Examiner does indicate that the detent of claim 41, which is very similar to the lock member of claim 46, is met by the blocking pin 38.⁵ The tumblers of Gokcebay do not resist movement of the blocking pin 38; they only resist rotation of the cylinder 24. As such, the

⁵ Gokcebay’s cylinder 24 cannot correspond to the lock member of claim 46 because the lock member is part of the electrically powered locking mechanism that is placed in the cylinder. It would be impossible to place the cylinder within itself.

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tumblers do not resist movement of a lock member as claimed, and Gokcebay fails to disclose the anti-tamper member as recited in claim 46.

For the above reasons, we cannot sustain the rejection of independent claims 41 and 46, and of claims 42-45 and 48-50 depending therefrom, under 35 U.S.C. § 102(b) as being anticipated by Gokcebay.

DECISION

We reverse the decision of the Examiner rejecting claims 35-46 and 48-50.

REVERSED

JRG