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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEALS BOARD

Ex parte HOE-WON KIM

Appeal 2011-008680
Application 11/489,014
Technology Center 2600

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

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the final rejection of claims 1-17. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

Appellant's claimed invention is related to a portable terminal with an improved server connecting device and a method of connecting the portable terminal to the server. (Spec. 1.) Independent claim 1, reproduced below, is representative of the subject matter on appeal:

1. A portable terminal comprising:

a communication unit for communicating with a server through an Access Point (AP);

a server connecting unit for initiating a connection to the server; and

a controller for automatically searching for the server using the communication unit via the AP, when the server connecting unit is operated,

wherein when the portable terminal determines that the portable terminal is not authenticated by the server, the portable terminal disconnects from the AP; and

wherein when the portable terminal determines that a service is terminated after authentication by the server, the portable terminal disconnects from the AP and the server.

(disputed limitations emphasized)

REJECTION

The Examiner rejected claims 1-17 under 35 U.S.C. 103(a) as being unpatentable over the combined teachings and suggestions of Kawai (U.S. Pat. App. Pub. No. 2003/0217262 A1) and Kalavade (U.S. Pat. App. Pub. No. 2005/0177515 A1).

GROUPING OF CLAIMS

Based on Appellant's arguments, we decide the appeal of the obviousness rejection on the basis of representative claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

ISSUE

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

wherein when the portable terminal determines that the portable terminal is not authenticated by the server, the portable terminal disconnects from the AP; and

wherein when the portable terminal determines that a service is terminated after authentication by the server, the portable terminal disconnects from the AP and the server,

within the meaning of representative claim 1 (emphasis added)?

ANALYSIS

This appeal turns upon claim construction. Our reviewing court guides that “[i]n the patentability context, claims are to be given their broadest reasonable interpretations . . . limitations are not to be read into the

claims from the specification.” *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citations omitted).

At the outset, we observe that the disputed “wherein” clauses in representative claim 1 are directed to *temporal* limitations regarding *when* disconnect functions are *conditionally* performed by the portable terminal:

wherein *when* the portable terminal determines that the portable terminal is not authenticated by the server, *the portable terminal disconnects from the AP*; and

wherein *when* the portable terminal determines that a service is terminated after authentication by the server, *the portable terminal disconnects from the AP and the server*.

We conclude such conditional claim language broadly covers the temporal state of a wireless connection from a portable terminal to an access point (AP) and thus *does not limit the claimed portable terminal (apparatus) to a particular structure*.¹ (Claim 1). Thus, we conclude the claim scope is not limited by the *conditional* “wherein” clauses.

Even assuming *arguendo* that the aforementioned “wherein” clause limitations may be accorded patentable weight, Appellant’s arguments are not persuasive because we find the weight of the evidence supports the

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, emphasis added).

Examiner's underlying factual findings and ultimate legal conclusion of obviousness regarding representative claim 1. See Examiner's "Response to Argument" (Ans. 6-8).

Regarding the first disputed "wherein" clause, the Examiner finds that Kalavade's teaches authentication (¶¶ [0008], [0009], [0010]; Fig. 13), which is suggestive of authentication failure. (Ans. 7). We find failure of such authentication at least suggests the portable terminal disconnects after it determines it has not been authenticated.² (See Kalavade, Fig. 13). Therefore, we are not persuaded by Appellant's contention that "Kalavade fails to relate a failed authentication attempt to a disconnection from an AP [Access Point], as recited in Claim 1." (App. Br. 7, ¶ 2).

Regarding the second disputed "wherein" clause, we find Kalavade teaches or suggests that a session cannot be initially established unless it is first authenticated. (Kalavade, Fig. 13). We also find Kalavade's session that terminates teaches or at least suggests that a service running in the session is terminated. (¶ [0277]). The same paragraph of Kalavade expressly teaches "the client does an explicit disconnect." (*Id.*).

Appellant avers that "FIG. 13 illustrates a disconnect sent from the client to a Network Access Server (Radius Client). While these transmissions are shown as going through the AP en route to their final destinations, FIG. 13 and the corresponding description fails [to] provide

² "[T]he sources of information for a properly flexible obviousness inquiry . . . include . . . the background knowledge, creativity, and common sense of the person of ordinary skill." *Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1329 (Fed. Cir. 2009). The Examiner's analysis "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." *Id.*

any disclosure relating to a *message* requesting disconnect from the AP or client disconnection from the AP.” (App. Br. 7, emphasis added).

In response, we observe that Appellant’s claim 1 does not recite “a *message* requesting disconnect from the AP.” (*Id.*) We decline Appellant’s invitation to read “a *message* requesting disconnect from the AP” into the claim. (App. Br. 7, emphasis added). *See Van Geuns*, 988 F.2d at 1184.

Similarly, Appellant urges in the Reply Brief that “Kalavade fails to provide any disclosure indicating that the CTDR or the disconnect message includes an *instruction* to disconnect from the AP.” (Reply Br. 3, emphasis added). However, we observe representative claim 1 is silent regarding the argued “*instruction* to disconnect from the AP.” (*Id.*). Thus, Appellant’s arguments are not commensurate with the broader scope of representative claim 1.

Notwithstanding Appellant’s arguments, the Supreme Court guides that “when a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 417 (2007) (quoting *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282 (1976)).

We find this reasoning is applicable here, particularly given that authenticated connections of portable terminals to access points (and associated servers) are well known in the art, as established by the prior art relied on by the Examiner. For these reasons, on this record, we are not persuaded of Examiner error. Accordingly, we sustain the obviousness rejection of representative claim 1. Claims 2-17 (not argued separately) fall therewith. *See* 37 C.F.R. § 41.37(c)(1)(iv).

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Application 11/489,014

DECISION

We affirm the Examiner's rejection under § 103 of claims 1-17.
No time period for taking any subsequent action in connection with this
appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

ORDER

AFFIRMED

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