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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CSR PLC  
Requester and Appellant

v.

SKULLCANDY, INC.  
Patent Owner and Respondent

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Appeal 2012-012690  
Reexamination Control 95/001,369  
Patent 7,395,090 B2  
Technology Center 3900

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Before HOWARD B. BLANKENSHIP, ROBERT E. NAPPI, and  
STEPHEN C. SIU *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*

DECISION ON APPEAL

Appeal 2012-012690  
Reexamination Control 95/001,369  
Patent 7,395,090 B2

Third Party Requester/Appellant CSR plc appeals under 35 U.S.C. §§ 134(c) and 315(b) the Examiner's decision not to reject claims 1-74. We have jurisdiction under 35 U.S.C. §§ 134(c) and 315(b).

### STATEMENT OF THE CASE

This proceeding arose from a request by CSR plc for an inter partes reexamination of U.S. Patent 7,395,090 B2, titled "Personal Portable Integrator for Music Player and Mobile Phone," and issued to Richard P. Alden on July 1, 2008 (the '090 patent). We heard oral arguments on January 23, 2013.

The '090 patent describes integration of services provided by a personal music player and a mobile phone (col. 1, ll. 20-23).

Claim 1 reads as follows:

1. A portable apparatus for integrating a two-way communication device and an audio delivery device, wherein the portable apparatus is configured in size and shape to be portably carried in either a hand of a user or an article of clothing during use of the portable apparatus, the apparatus comprising:

a first electrical connector configured to receive a first audio signal from a substantially arbitrarily selectable audio delivery device;

a second electrical connector configured to receive a second audio signal from a substantially arbitrarily selectable two-way communication device;

a coupling device independent from the audio and two-way communication devices, the coupling device connected to receive the first and second audio signals, and to transmit a third audio signal comprising at least one of the first or second audio signals; and

an acoustic device adapted to convert the third audio signal to an acoustic wave having an audio range corresponding to a hearing range of a user;

wherein:

the coupling device comprises at least two physically separate devices; and

the at least two physically separate devices comprise means for enabling wireless communication between the at least two physically separate devices.

Appellant appeals the Examiner's refusal to adopt the proposed rejections of claims 1, 2, 4, 5, 7-10, 17, 18, 20, 22, 24, 25, 27, 29, 31-33, 35, 59-66, and 71-74 under 35 U.S.C. §§ 102(a) and 102(b) as anticipated by GB 2357663A ("Smith"); claim 23 under 35 U.S.C. § 103(a) as unpatentable over Smith; claims 6, 11-14, 21, 26, 28, 34, 36-38, 40-46, and 49-58 under 35 U.S.C. § 103(a) as unpatentable over Smith and U.S. Patent No. 6,006,115 ("Wingate"); claims 15 and 47 under 35 U.S.C. § 103(a) as unpatentable over Smith, Wingate, and GB 2296157A ("TCC"); claims 16, 30, and 48 under 35 U.S.C. § 103(a) as unpatentable over Smith, Wingate, and U.S. Patent No. 4,882,745 ("Silver"); claim 19 under 35 U.S.C. § 103(a) as unpatentable over Smith and EP 1068997 A2 ("Ford"); claim 3 under 35 U.S.C. § 103(a) as unpatentable over Smith and WO 00/70779 ("Lee"); claim 39 under 35 U.S.C. § 103(a) as unpatentable over Smith, Wingate, and Lee; claims 59-70 under 35 U.S.C. § 102(b) as anticipated by Wingate; claims 59-66 and 71-74 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,873,862 B2 ("Reshefsky"); claims 67-70 under 35 U.S.C. § 103(a) as unpatentable over Ban and one of Smith, Wingate, or Reshefsky; claims 59-74 under 35 U.S.C. § 103(a) as unpatentable over one of Smith,

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Wingate, and/or Reshefsky and one of U.S. Patent No. 6,985,592 B1 (“Ban”), EP 1176783 A2 (“Samsung”) and/or D.M. Bakker and Diane McMichael Gilster, “Bluetooth End to End,” M&T Books, 2002 (“Bakker”); and claims 59-74 under 35 U.S.C. § 112, first paragraph as lacking written description support in the original specification.

## ISSUE

Did the Examiner err in refusing to reject claims 1-74?

## PRINCIPLES OF LAW

Under the written description requirement of 35 U.S.C. § 112, the disclosure of the application relied upon must reasonably convey to the artisan that, as of the filing date of the application, the inventor had possession of the later claimed subject matter. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991).

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted).

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”  
*KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007).

## ANALYSIS

### Claims 59-74

Requester argues that the Specification fails to disclose the coupling device being **“portable with the audio and two-way communication devices by the same user during use of the coupling device”** (App. Br. 33). Claim 59, for example, recites the coupling device is portable with the audio delivery device and the two-way communication device by the same user during use of the coupling device. However, we agree with the Examiner that the Specification discloses this claimed feature for at least the reasons set forth by the Examiner (RAN 18-19).

For example, the Specification discloses an “audio device”<sup>1</sup> and a “two-way communication device”<sup>2</sup> in communication with a “coupling device”<sup>3</sup> that can “route the signals . . . to an acoustic device, such as headphones.”<sup>4</sup> The audio device and two-way communication device are both “portable” devices<sup>5</sup> and both communicate<sup>6</sup> with the coupling device

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<sup>1</sup> E.g., element 16, Fig. 2 or Fig. 8.

<sup>2</sup> E.g., element 18, Fig. 2 or Fig. 8.

<sup>3</sup> E.g., element 28, Fig. 1 or element 28a (and element 28b), Fig. 8.

<sup>4</sup> E.g., col. 4, ll. 1-2; see also, Figs. 2 and 8.

<sup>5</sup> E.g., col. 3, l. 37 – a “mobile phone 18” and col. 3, ll. 38-39 – “a portable MP3 player or CD player.”

using “wireless technology such as Bluetooth”<sup>7</sup>. In other words, the Specification discloses the disputed claim features of a portable audio device and a portable two-way communication device communicating wirelessly with a coupling device, the audio and two-way communication device being used by a user during use of the coupling device.

One of skill in the art would have also understood that a “portable” device is “portable” with a user during use since one of skill in the art would have understood that a “portable” device does not cease being portable when being used and that the coupling device transmitting signals to one acoustic device (e.g., headphones) as illustrated in Figs. 2 and 8 would be used by a “same user.”

Requester also argues that claims 59, 60, and 62 (and, presumably, claims 61 and 63-74) each recites only features that “cannot properly be accorded patentable weight” (p. 38). It is unclear what statutory ground of rejection Requester proposes for claims 59, 60 and 62 (and, presumably claims 61 and 63-74) since Requester has not stated a specific statutory ground of rejection associated with these arguments.

Since Requester provides these arguments immediately following arguments pertaining to the proposed rejection under 35 U.S.C. § 112, first paragraph as lacking written description, one possibility is that Requester proposes claims 59, 60, and 62 (and claims 61 and 63-74) should be rejected as unpatentable under 35 U.S.C. § 112, first paragraph as lacking written

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<sup>6</sup> E.g., col. 3, ll. 49-53: “the connector **12** may . . . receive an audio signal . . . from the audio device **16** . . . [and] may receive an audio signal **15** from the communication device **18**”

<sup>7</sup> E.g., col. 3, ll. 58-59.

description because claims 59, 60, and 62 allegedly fail to recite features that can be accorded patentable weight. However, even assuming that claims 59, 60, and 62 recite features that cannot be accorded patentable weight, Requester has not demonstrated that reciting features that cannot be accorded patentable weight would indicate a lack of written description in the Specification under 35 U.S.C. § 112, first paragraph.

Even assuming that a claim that recites features not accorded patentable weight would indicate that the claim lacks written description (or should be rejected under some other unspecified ground), we do not agree with Requester that claims 59, 60, and 62 recite only features that cannot be accorded patentable weight for at least the reasons set forth by the Examiner (see, e.g., RAN 19) and Patent Owner (see, e.g., Resp. Br. 14-15). For example, claim 59, which depends from claim 1, for example, recites the coupling device is portable with the audio delivery device and the two-way communication device by the same user during use of the coupling device. Even assuming Requester's statement to be true that "the audio delivery and communication devices simply are not part of that [claimed] apparatus" (p. 36), we note that claim 59 recites specific features of the "coupling device" (i.e., being portable by the same user during use) as opposed to features only associated with either the "audio delivery device" or the "communication device." Claims 60 and 62 recite similar features as claim 59.

Claims 61 and 63-74 each recite additional features that Requester does not demonstrate or assert lack written description in the Specification and/or are all features that "cannot be accorded patentable weight."

Claim 1

The Examiner does not adopt the proposed rejection of claim 1 as anticipated by Smith (Right of Appeal Notice (“RAN”) 14-15). Claim 1 recites a coupling device that comprises at least two physically separate devices that comprise means for enabling wireless communication between the physically separate devices and audio and two-way communication devices that are independent from the coupling device.

Smith discloses a “portable version” (p. 8, l. 1) of a “wireless communication adapter or module 2” (p. 6, l. 7; Figs 4-6) that contains a “connector 1c” (p. 6, l. 16; Fig. 4) through which the adapter or module “can be connected to a set of legacy headphones” (p. 7, ll. 21-22; Figs 4-5), can “receive incoming telephone calls from a [mobile] phone” (p. 8, ll. 3-4), and can connect to “several legacy units” (p. 8, ll. 18; Fig. 6) through “several connectors 1c” (p. 8, l. 17; Fig. 4), the “several legacy units” including, for example, a “portable compact disc player 6a, or portable mini disc player 6b, or portable DVD player . . .” (p. 8, ll. 27-28; Fig. 6).

Smith also discloses that the wireless communication adapter or module 2 “can also interface to [a] home hi-fidelity unit 6d or 6e” (p. 8, ll. 32-33; Fig. 6) wirelessly (see, e.g., p. 7, ll. 25-26 – “legacy equipment 6d with a wireless communication adapter or module 2c attached so it could communicate and transfer the signals to the user wireless communication adapter or module”; Fig. 6).

In other words, Smith discloses a portable adapter/module that receives signals from “several legacy units” (e.g., audio delivery devices such as a compact disc player and/or a two-way communication device such

as a mobile phone) and communicates a signal wirelessly with a remote module, or portion of the adapter/module (i.e., a communication adapter or module 2c attached to legacy equipment 6d). We agree with the Requester that Smith discloses the features recited in claim 1.

The Examiner states that “the coupling device [in Smith] would not be ‘independent’ from the audio and two-way (mobile telephone) devices themselves, as required by the claims” (RAN 14). Claim 1 recites that the “coupling device” is “independent from the audio and two-way communication devices.” The Examiner presumably equates the portable compact disc player of Smith, for example, with the “audio delivery device” recited in claim 1 and the mobile telephone of Smith with the “two-way communication device” recited in claim 1. Even assuming the Examiner’s assumptions to be correct, while the mobile telephone and compact disc player of Smith may be connected to the adapter, the Examiner has not demonstrated that the phone and compact disc player are dependent on the adapter. For example, one of skill in the art would have understood that both the phone and the compact disc player of Smith would be individually fully operational (i.e., the compact disc player would still be able to play compact discs and the phone would still be able to enable two-way communication for a user) whether the adapter of Smith was connected or not. We therefore do not agree with the Examiner that the phone and compact disc player of Smith are dependent (i.e., not independent) on the adapter.

Patent Owner argues that Smith fails to disclose an apparatus that is “portable” (Appeal Brief for Respondent-Patentee, filed March 6, 2012

(“Resp. Br.”), p. 10). We disagree with Patent Owner at least because Smith explicitly discloses the adapter/module to be “portable” – e.g., Smith discloses a “portable version” (p. 8, l. 1) of a “wireless communication adapter or module 2” (p. 6, l. 7; Figs 4-6).

While Patent Owner argues that Smith discloses the “home hi-fidelity unit” as being “non portable” (Resp. Br. 10, citing Smith, p. 7, ¶ 4; p. 8, ¶ 2; and p. 3, ¶ 7), Patent Owner does not indicate an explicit definition of the term “portable” in the Specification. Utilizing a plain and customary definition, one of ordinary skill in the art would have understood the term “portable” to indicate that the component was capable of being transported. Since the hi-fidelity unit of Smith is a “home” hi-fidelity unit, the hi-fidelity unit must have been transported into the home. As such the hi-fidelity unit of Smith is capable of being transported and it therefore “portable.”

Even assuming the “hi-fidelity unit” of Smith is not “portable” as Patent Owner asserts, Patent Owner has not sufficiently demonstrated that the adapter/module of Smith is also not portable (note that claim 1 recites a “portable apparatus” but does not require a “portable hi-fidelity unit”). In fact, as described above, Smith explicitly discloses that the adapter/module is portable.

Patent Owner also argues that Smith fails to disclose “a substantially arbitrarily selectable two-way communication device” because the adapter is not disclosed by Smith as being ‘capable of working with any one of a number of phones” or permitting “the user to arbitrarily select between . . . phones” (Resp. Br. 10). We disagree with Patent Owner.

Smith discloses that the adapter/module contains a “connector 1c” (see, e.g., p. 6, l. 16) that may “be changed to that required to interface to the desired legacy equipment” (p. 6, ll. 20-21). Hence, the adapter/module may be changed to accommodate any type of equipment or device to communicate with the equipment or device (by, for example, modifying the connector 1c to a corresponding device). Smith does not disclose any specific limitations in modifying the interface to accommodate different devices or which devices may communicate with the adapter/module – e.g., any “desired” legacy equipment may interface with the adapter/module, as described above.

Patent Owner does not provide additional arguments in support of claims 3, 4, 6, 7-11, 14-21, and 23, or arguments with respect to Wingate, Lee, TCC, Silver, or Ford.

Claim 25

The Examiner does not adopt the proposed rejection of claim 25 as anticipated by Smith. The Examiner states that Smith fails to disclose that the portable apparatus communicates at least two of the first, second, and third audio signals wirelessly because “the hi-fidelity amplifier must read upon the claimed audio delivery device” but the “hi-fidelity amplifier” of Smith is “non-portable” (RAN 17). Patent Owner concurs with the Examiner (Resp. Br. 11-12).

We disagree with the Examiner and Patent Owner’s contention that Smith fails to disclose a “portable” device for reasons already discussed.

Patent Owner argues that Smith fails to disclose a “substantially arbitrarily selectable” device (Resp. Br. 12). We disagree with Patent Owner for at least the reasons previously discussed.

Patent Owner argues that “there is no disclosure [in Smith] that the adapter/module 2a receives the alleged ‘second signal’ from a telephone wirelessly” (Resp. Br. 12). As described above, Smith discloses an adapter/module (e.g., Fig. 4) in communication connected with legacy equipment (e.g., headphones (Fig. 5), compact disc player, mini disc player, etc.), a mobile telephone, and/or a hi-fidelity amplifier (e.g., component 6d or 6e in Fig. 6). Smith also discloses that the devices “communicate as a group” via “Bluetooth [that] allows a so called piconet to have . . . units communicating with each other” (p. 7, last paragraph). One of ordinary skill in the art would have understood that devices that communicate in a piconet via Bluetooth would be communicating “wirelessly” since one of ordinary skill in the art would have understood “Bluetooth” to be a brand name for a type of wireless network technology and because Smith confirms that Bluetooth is, in fact, a wireless standard explicitly disclosing “wireless standards, such as Bluetooth . . .” (p. 2, l. 8).

Patent Owner does not provide additional arguments in support of claims 26, 28, 30, 32, or 35, which depend from claim 25, or arguments with respect to Wingate or Silver.

Claims 36-58, 62, 66, and 70

The Examiner does not adopt the proposed rejection of claims 36-38, 40-46, and 49-58 as obvious over the combination of Smith and Wingate;

claim 39 as obvious over the combination of Smith, Wingate, and Lee; claim 47 as obvious over the combination of smith, Wingate, and TCC; claim 48 as obvious over the combination of Smith Wingate, and Silver; claims 62 and 66 as anticipated by Smith; or claim 70 as obvious over the combination of Smith, Wingate, Reshefsky, and Ban.

Patent Owner argues that the combination of Smith and Wingate fails to disclose or suggest “a substantially arbitrarily selectable two-way communication device” and does not disclose or suggest that “adapter/module 2a receives a signal from the phone ‘wirelessly’” (Resp. Br. 13). We are not persuaded by Patent Owner’s arguments for at least the reasons stated above.

Claims 59-74

The Examiner does not adopt the proposed rejection of claims 59-66 as anticipated by Smith or the proposed rejection of claims 67-64 as obvious over at least one of Smith, Wingate, and/or Reshefsky in combination with at least one of Ban, Samsung, and Bakker.

Patent Owner argues that Smith fails to disclose “a portable audio delivery device” (Resp. Br. 13) because Smith discloses “home hi-fidelity unit[s]” that “are ‘**non portable**’” (*id.*) and the phone embodiment of Smith “is also part of a ‘non portable’ system” (*id.* at 14). We disagree with Patent Owner. As stated above, Smith discloses a portable adapter/module that receives signals from “several legacy units” (e.g., audio delivery devices such as a compact disc player and/or a two-way communication device such as a mobile phone). Smith discloses that the compact disc player, for

example, is a “portable compact disc player.” One of ordinary skill in the art would have understood a “portable compact disc player,” for example, to be “portable” since the compact disc player is explicitly disclosed as being “portable.” In addition, one of ordinary skill in the art would have understood that a compact disc player delivers audio signals to a user and is therefore an “audio delivery device.”

Patent Owner also argues that Smith fails to disclose that “the coupling device [is] ‘portable with the audio and two-way communication devices *by the same user during use of the coupling device*’” (Resp. Br. 14). However, since Smith discloses that the audio delivery device is portable (e.g., a “portable compact disc player” or “portable mini disc player” or “portable radio receiver”) and the adapter module in communication with the portable audio delivery device is also portable (e.g., a “portable version” (p. 8, l. 1) of a “wireless communication adapter or module 2” (p. 6, l. 7; Figs 4-6)), one of ordinary skill in the art would have understood that the different portable devices in communication with each other would be portable by the same user during use. Patent Owner does not sufficiently demonstrate or assert that two portable devices would each somehow become non-portable when used at the same time.

Claims 2, 33, 34, 38, and 63-66

The Examiner does not adopt the proposed rejection of claims 2, 33, and 63-66 as anticipated by Smith and claims 34 and 38 as obvious over the combination of Smith and Wingate.

Patent Owner argues that Smith discloses ‘automatically switching between signals’ but fails to disclose “switching between the first and second audio signals, *so that a user has the ability to choose the signal*” (Resp. Br. 15). Claims 2, 38, 63, and 66 recite “a first switch . . . to selectively switch between the first and second audio signals” and claims 33, 34, 64, and 65 recite “selectively switching between the first and second audio signals.” We note that none of claims 2, 33, 34, 38, and 63-66 recite “a user has the ability to choose the signal.” We are therefore not persuaded by Patent Owner’s argument that Smith fails to disclose this feature.

Claim 5

The Examiner does not adopt the proposed rejection of claim 5 as anticipated by Smith. Patent Owner argues that Smith fails to disclose the features of claim 5 (Resp. Br. 15). Appellant does not appear to address the features recited in claim 5.

Claim 5 recites that the first or second electrical connector is physically detached from the coupling device and wirelessly communicates with the coupling device.

As Requester points out and as described above, Smith discloses a “wireless communication adapter or module 2” (p. 6, l. 7; Figs 4-6) that contains a “connector 1c” (p. 6, l. 16; Fig. 4) through which the adapter or

module connects with devices. Appellant does not demonstrate that Smith discloses that the “connector 1c,” for example, is “physically detached from the coupling device and wirelessly communicates with the coupling device” as required by claim 5. Instead, “connector 1c” of Smith appears to be connected to (and not detached from) the adapter or module.

Claims 22 and 24

The Examiner does not adopt the proposed rejection of claims 22 and 24 as anticipated by Smith.

Patent Owner argues that Smith discloses that “‘home hi-fidelity unit[s]’ . . . are ‘**non portable**’” but fails to disclose “that the audio delivery device or the telephone [or the “home hi-fidelity unit”]. . . are also integrated into the belt during use” (Resp. Br. 16). As described above, Smith discloses a “portable version” of an adapter/module (e.g., Figs. 4-6) that connects to various “desired” legacy devices (including a portable compact disc player, for example – Fig. 6) and a mobile telephone. Since, according to Smith, the “portable version” of the adapter/module is carried “within an article of clothing” (see, e.g., Fig. 5 that illustrates the adapter/module being carried on a user’s belt, the belt being an article of clothing), one of ordinary skill in the art would have understood that a “*portable* compact disc player,” for example, is also carried within an article of clothing, the compact disc player being *portable*. Also, one of skill in the art would have understood that a “mobile telephone” (being “portable”) is also carried in an “article of clothing” of a user.

Claim 27

The Examiner does not adopt the proposed rejection of claim 27 as anticipated by Smith.

Patent Owner argues that Smith fails to disclose “selectively controlling the volume of at least one of the first or second audio signals” (Resp. Br. 16). Smith discloses that the adapter/module has “an integrated keypad 2r to allow the user to transmit control message[s] . . . to control certain functions” of connected devices (p. 7, ll. 31-33). One of ordinary skill in the art would have understood that a portable compact disc, for example, has a volume control feature. Since the adapter/module allows a user to control connected devices, such as the portable compact disc, one of ordinary skill in the art would have understood that the adapter/module (with control keypad) controls the volume of audio received from the portable compact disc player, the volume being a known controllable feature of the compact disc player.

Claims 29, 31, and 71-74

The Examiner does not adopt the proposed rejection of claims 29, 31, and 71-74 as anticipated by Smith.

Patent Owner argues that Smith fails to disclose “swapping an ‘audio delivery device’ for another ‘audio delivery device’ or a ‘two-way communication device’ for another ‘two-way communication device’” (Resp. Br. 16). As described above, Smith discloses a “connector 1c” (see, e.g., p. 6, l. 16) that may “be changed to that required to interface to the desired legacy equipment” (p. 6, ll. 20-21). In other words, Smith discloses

changing devices connected to the adapter/module. Patent Owner does not point out sufficient differences between Smith and the disputed claim feature.

Claims 12, 13, 37, 44, and 67-70

The Examiner does not adopt the proposed rejection of claims 12, 13, 37, and 44 as obvious over the combination of Smith and Wingate or the proposed rejection of claims 67-70 as obvious over the combination of Smith, Wingate, Reshefsky, Ban, Samsung, Bakker.

Patent Owner argues that Wingate discloses “mixing the audio alert [with or] without a decrease in programming volume” but fails to disclose “being able to adjust between them . . . [or the ability “*to choose* one of them]” (Resp. Br. 17). Claim 12, for example, recites “selectably adjusting and controlling a mixing weight of the first or second audio signals.” We agree with Appellant that the combination of Smith and Wingate discloses or suggests this feature. For example, as pointed out by Appellant, Wingate discloses receiving “an incoming phone call on the audio programming being played” and “decreasing the volume of the programming” in response (col. 4, ll. 34-36). Patent Owner does not sufficiently demonstrate a difference between adjusting the volume of audio programming being played with respect to an incoming phone call of Wingate and adjusting a “mixing weight” of two audio signals since in both cases, the relative weight of two signals is being adjusted.

Other Proposed Rejections

Reversing the Examiner's decision not to reject the above-referenced claims and applying rejections based upon the Smith reference renders it unnecessary to reach the propriety of the Examiner's decision not to reject those claims on a different basis. *Cf. In re Gleave*, 560 F.3d 1331, 1338 (Fed. Cir. 2009). As such, we need not reach the propriety of the rejection of claims 59-70 under 35 U.S.C. § 102(b) as anticipated by Wingate; claims 59-66 and 71-74 under 35 U.S.C. § 102(b) as anticipated by Reshefsky; claims 67-70 under 35 U.S.C. § 103(a) as unpatentable over Smith, Wingate, and Reshefsky and Ban; claims 59-66 and 71-74 under 35 U.S.C. § 103(a) as unpatentable over one of Smith, Wingate, Reshefsky, Ban, Samsung, and Bakker.

CONCLUSION

The Examiner erred in refusing to reject claims 1-4 and 6-74 but did not err in refusing to reject claim 5.

DECISION

We affirm the Examiner's decision not to adopt the rejection of claim 5 as anticipated by Smith and the Examiner's decision not to adopt the rejection of claims 59-74 under 35 U.S.C. § 112, first paragraph as lacking written description support in the Specification.

We reverse the Examiner's decision not to adopt the following proposed rejections, each of which is denominated as a new ground of rejection pursuant to our authority under 37 C.F.R. § 41.77(b):

- 1) claims 1, 2, 4, 5, 7-10, 17, 18, 20, 22, 24, 25, 27, 29, 31-33, 35, 59-66, and 71-74 under 35 U.S.C. §§ 102(a) and 102(b) as anticipated by Smith;
- 2) claim 23 under 35 U.S.C. § 103(a) as unpatentable over Smith; claims 6, 11-14, 21, 26, 28, 34, 36-38, 40-46, and 49-58 under 35 U.S.C. § 103(a) as unpatentable over Smith and Wingate;
- 3) claims 15 and 47 under 35 U.S.C. § 103(a) as unpatentable over Smith, Wingate, TCC;
- 4) claims 16, 30, and 48 under 35 U.S.C. § 103(a) as unpatentable over Smith, Wingate, and Silver;
- 5) claim 19 under 35 U.S.C. § 103(a) as unpatentable over Smith and Ford;
- 6) claim 3 under 35 U.S.C. § 103(a) as unpatentable over Smith and Lee;
- 7) claim 39 under 35 U.S.C. § 103(a) as unpatentable over Smith, Wingate, and Lee; and
- 8) claims 67-70 under 35 U.S.C. § 103(a) as unpatentable over Smith, Wingate, Reshefsky, Ban, Samsung, Bakker.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.77(b) which provides that “[a]ny decision which includes a new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Correspondingly, no portion of the decision is final for purposes of judicial review. A requester may also request rehearing under 37 C.F.R. § 41.79, if appropriate, however, the Board may elect to defer

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issuing any decision on such request for rehearing until such time that a final decision on appeal has been issued by the Board.

For further guidance on new grounds of rejection, see 37 C.F.R. § 41.77(b)-(g). The decision may become final after it has returned to the Board. 37 C.F.R. § 41.77(f).

37 C.F.R. § 41.77(b) also provides that the Patent Owner, WITHIN ONE MONTH FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* The owner may file a response requesting reopening of prosecution before the examiner. Such a response must be either an amendment of the claims so rejected or new evidence relating to the claims so rejected, or both.

(2) *Request rehearing.* The owner may request that the proceeding be reheard under § 41.79 by the Board upon the same record. ...

Any request to reopen prosecution before the examiner under 37 C.F.R. § 41.77(b)(1) shall be limited in scope to the "claims so rejected." Accordingly, a request to reopen prosecution is limited to issues raised by the new ground(s) of rejection entered by the Board. A request to reopen prosecution that includes issues other than those raised by the new ground(s) is unlikely to be granted. Furthermore, should the patent owner seek to substitute claims, there is a presumption that only one substitute claim would be needed to replace a cancelled claim.

A requester may file comments in reply to a patent owner response. 37 C.F.R. § 41.77(c). Requester comments under 37 C.F.R. § 41.77(c) shall

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be limited in scope to the issues raised by the Board's opinion reflecting its decision to reject the claims and the patent owner's response under paragraph 37 C.F.R. § 41.77(b)(1). A newly proposed rejection is not permitted as a matter of right. A newly proposed rejection may be appropriate if it is presented to address an amendment and/or new evidence properly submitted by the patent owner, and is presented with a brief explanation as to why the newly proposed rejection is now necessary and why it could not have been presented earlier.

Compliance with the page limits pursuant to 37 C.F.R. § 1.943(b), for all patent owner responses and requester comments, is required.

The examiner, after the Board's entry of a patent owner response and requester comments, will issue a determination under 37 C.F.R. § 41.77(d) as to whether the Board's rejection is maintained or has been overcome. The proceeding will then be returned to the Board together with any comments and reply submitted by the owner and/or requester under 37 C.F.R. § 41.77(e) for reconsideration and issuance of a new decision by the Board as provided by 37 C.F.R. § 41.77(f).

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

AFFIRMED-IN-PART  
37 C.F.R. § 41.77(b)

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