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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CSR PLC
Requester and Appellant

v.

SKULLCANDY, INC.
Patent Owner and Respondent

Appeal 2013-000114
Reexamination Control 95/001,305
Patent 7,187,948 B2
Technology Center 3900

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

SIU, *Administrative Patent Judge*

DECISION ON APPEAL

Appeal 2013-000114
Reexamination Control 95/001,305
Patent 7,187,948 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 1-6. 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 7,187,948 B2, titled "Personal Portable Integrator for Music Player and Mobile Phone," and issued to Richard P. Alden on July 1, 2008 (the '948 patent). We heard oral arguments on January 23, 2013.

The '948 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 and wireless apparatus for wirelessly integrating a two-way communication device and an audio delivery device, wherein the portable and wireless 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 and wireless apparatus, the portable and wireless apparatus comprising:

means for wirelessly receiving a first audio signal from a substantially arbitrarily selectable audio delivery device;

means for wirelessly receiving 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, wherein the second audio signal is characterized by a threshold value, the second audio signal is accorded priority relative to the first audio signal, and the second audio signal interrupts the first audio signal upon reaching the threshold value, the coupling device comprising said

means for receiving said first and second audio signals, said coupling means further comprising:

means for transmitting a third audio signal comprising at least one of the first or second audio signals to an acoustic device adapted to convert the third acoustic wave to an audio range corresponding to a hearing range of a user.

Appellant appeals the Examiner's refusal to adopt the following proposed rejections:

- 1) claims 1 and 4 under 35 U.S.C. §§ 102(a) and 102(b) as anticipated by GB 2357663A ("Smith");
- 2) claims 2, 3, 5, and 6 under 35 U.S.C. § 103(a) as unpatentable over Smith and U.S. Patent No. 6,006,115 ("Wingate"); and
- 3) claims 4-6 under 35 U.S.C. § 112, first paragraph as failing the written description requirement.

ISSUE

Did the Examiner err in refusing to reject claims 1-6?

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 4-6

Appellant argues that newly added claims 4-6 recite a coupling device that is “**portable with the audio and two-way communication devices by the same user during use of the coupling device**” but that such a limitation “was not previously contained in the ‘948 patent” (App. Br. 25). Respondent argues that the Specification discloses this claimed feature. We agree with Respondent.

As Respondent points out, the Specification discloses an “audio device”¹ and a “two-way communication device”² in communication with a “coupling device”³ that can “route the signals . . . to an acoustic device, such

¹ E.g., element 16, Fig. 2 or Fig. 8.

² E.g., element 18, Fig. 2 or Fig. 8.

³ E.g., element 28, Fig. 2 or element 28a (and element 28b), Fig. 8.

as headphones.”⁴ The audio device and two-way communication device are both “portable” devices⁵ and both communicate⁶ with the coupling device using “wireless technology such as Bluetooth”⁷. 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.”

Appellant argues that the Specification fails to disclose the disputed claim features because “Figs. 1 and 2 have nothing to do with the *wireless* embodiment” (App. Br. 26). However, as described above, the Specification explicitly discloses that both the audio device and the two-way communication device communicate with the coupling device via “wireless technology.” Appellant has not explained how devices communicating wirelessly “have nothing to do with” a wireless embodiment.

⁴ E.g., col. 3, ll. 66-67; see also, Figs. 2 and 8.

⁵ E.g., col. 3, l. 35 – a “mobile phone 18” and col. 3, ll. 36-37 – “a portable MP3 player or CD player.”

⁶ E.g., col. 3, ll. 47-51: “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**”

⁷ E.g., col. 3, ll. 56-57.

Appellant also argues that claim 4 fails to provide a “further limitation on the coupling device” (App. Br. 29). Claim 4 recites a coupling device that not only receives the first and second audio signal but also is “portable with the audio and two-way communication devices by the same user during use of the coupling device.” As described above, the written description requirement requires that the disclosure of the application relied upon must reasonably convey to the artisan that the inventor had possession of the later claimed subject matter. *Vas-Cath Inc.*, 935 F.2d at 1563. Appellant has not demonstrated that the written description requirement also requires that an independent claim provide a “further limitation on the coupling device.”

In any event, even assuming that the written description requirement required that claim 4 (an independent claim) provide a “further limitation on the coupling device,” as Appellant appears to contend, we disagree with Appellant’s contention that claim 4 fails to provide a “further limitation on the coupling device” for at least the reasons set forth by the Examiner (RAN 9). For example, claim 4 recites the feature of being “portable with the audio and two-way communication devices by the same user during use of the coupling device,” which Appellant has not demonstrated to be recited in other claims.

The Examiner did not err in refusing to adopt the proposed rejection of claims 4-6 under 35 U.S.C. § 112, first paragraph as failing the written description requirement.

Claims 1-6

Respondent argues that Smith fails to disclose that “the second audio signal interrupts the first audio signal upon reaching the threshold value” (Resp. Br. 9). Claim 1 recites a means for receiving a first audio signal and a means for receiving a second audio signal and that the second audio signal is characterized by a threshold value and interrupts the first audio signal upon reaching the threshold value. We agree with Respondent.

Smith discloses that “a user . . . could also receive incoming telephone calls from a phone . . . [the calls being] directed to the user’s portable wireless communication adapter or module and alter the user to the incoming call . . . [such that] the other signal (music in this example) would be stopped so the user and the person on the other end of the phone would not hear the music” (p. 8, ll. 1-10). In other words, Smith discloses a user receiving a phone call while listening to an audio signal (i.e., music) via an adapter, the adapter stopping the music in response to receiving the phone call. While Smith discloses stopping an audio signal responsive to receiving a phone call, Appellant does not demonstrate that Smith also discloses the signal from the phone call “reaching the threshold value.” In fact, Smith does not appear to disclose a “threshold value” at all.

Appellant does not adequately argue or demonstrate that Wingate provides this claim feature.

The Examiner did not err in refusing to adopt the proposed rejections of claims 1 and 4 under 35 U.S.C. §§ 102(a) and 102(b) as anticipated by Smith or claims 2, 3, 5, and 6 under 35 U.S.C. § 103(a) as unpatentable over Smith and Wingate.

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CONCLUSION

The Examiner did not err in refusing to reject claims 1-6.

DECISION

We affirm the Examiner's decision not to adopt the rejections of claims 1 and 4 under 35 U.S.C. §§ 102(a) and 102(b) as anticipated by Smith; claims 2, 3, 5, and 6 under 35 U.S.C. § 103(a) as unpatentable over Smith and Wingate; and claims 4-6 under 35 U.S.C. § 112, first paragraph.

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

cu

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Reexamination Control 95/001,305
Patent 7,187,948 B2

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