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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PAUL PONIATOWSKI

Appeal 2014-007989
Application 13/559,194
Technology Center 2600

Before KRISTEN L. DROESCH, JOHN P. PINKERTON, and
MONICA S. ULLAGADDI, *Administrative Patent Judges*.

PINKERTON, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Pursuant to Appellant’s Request for Rehearing (“Request” or “Req. Reh’g”) under 37 C.F.R. § 41.52, Appellant requests a rehearing of our Decision of June 23, 2016 (“Decision” or “Dec.”) in which we affirmed the Examiner’s rejection of claims 1–9 and 11–13 under 35 U.S.C. § 103(a) and reversed the Examiner’s rejection of claim 15 under 35 U.S.C. § 103(a).

INTRODUCTION

Appellant argues “factual evidence was disclosed in [the] reply brief and was overlooked by the Board.” Req. Reh’g 2. Appellant also argues the Board overlooked the fact that Appellant is a “pro se individual with no

formal education or training in the complex field of IP law and/or Patent Office procedures and regulations and that the applicant had no knowledge or ability to correctly conduct himself in such complex[] proceedings.” *Id.*

On September 22, 2016, Appellant filed a paper entitled Rehearing Supplementary (“Supplement” or “Supp.”). In the Supplement, Appellant argues the evidence in the Reply Brief should be considered because it “is **directly responsive** to arguments raised by the examiner and covers all three bullet points in section B of examiners response.” *See* Supp. 1–2 (citing 37 C.F.R. § 41.41(b)(2)) (“Any argument raised in the reply brief which . . . is not responsive to an argument raised in the examiner’s answer . . . will not be considered . . . unless good cause is shown.”). Appellant requests reconsideration by the Board, alleging the Board did not address Appellant’s arguments submitted in both briefs. *Id.* at 2. Appellant further presents arguments regarding the “first remark” and “second remark” in the Decision. *Id.* at 2–4.

ANALYSIS

A request for rehearing “must state with particularity the points believed to have been misapprehended or overlooked by the Board.” 37 C.F.R. § 41.52(a)(1). After quoting this requirement as set forth in MPEP § 1214.03, Appellant stated “that factual evidence was disclosed in the reply brief and was overlooked by the Board” and that he was a “pro se individual” with no formal training in patent law or Patent Office procedures and regulations. *See* Req. Reh’g 2. Appellant’s statement that evidence was disclosed in the reply brief that was overlooked by the Board is conclusory and fails to specifically identify the evidence believed to have been

overlooked. *See id.* Regarding Appellant's pro se appearance, we recognize, and fully appreciate, that Appellant is representing himself in this appeal. The fact of Appellant's pro se appearance, however, is not a point of evidence or law that can properly support a request for rehearing, even if it is misapprehended or overlooked. Similarly, Appellant's argument that he is not trained in patent law or Patent Office procedure is not a point of evidence or law to properly support a request for rehearing. Thus, because Appellant failed to state with "particularity" the points believed to have been overlooked by the Board as required by § 41.52(a)(1), we deny Appellant's Request for Rehearing.

Regarding the Supplement, 37 C.F.R. § 41.52(a)(1) provides that "Appellant may file a single request for rehearing within two months of the date of the original decision of the Board." Although the Request was timely filed on August 22, 2016, within two months of the Decision on June 23, 2016, the Supplement was not filed until September 22, 2016, one day short of three months of the date of the Decision. Thus, because the Supplement was not timely filed, it is not properly before us and, therefore, will not be considered.

Even assuming *arguendo* that the points addressed in the Supplement were properly before us, we would nevertheless find Appellant's arguments that we overlooked evidence regarding claim 1 unpersuasive. In the Decision regarding what Appellant refers to as "the first remark by the Board" (*see* Supp. 2), we found Appellant's arguments that Swartz does not teach the "optical input" and "network hub" limitations were not persuasive because claim 1 does not recite, as Appellant argued, that the mobile phone communicates with the commercial establishment about "prices of goods."

See Dec. 4. We noted that claim 1 instead recites a mobile phone with “an optical input for receiving information concerning prices of goods.” *See id.* (citing App. Br. 15 (Claims App’x.)). Appellant argues in the Supplement that “[i]t is irrelevant whether the phone has optical input or not;¹ data can be entered manually” and “[t]he phone however must be equipped with a dedicated actuator initiating a connection with [the] store’s network hub.” Supp. 3. According to Appellant, Swartz’s “[m]obile phone 706 is not equipped with dedicated actuator and provides only audio/telephony support architecture and does not handle computing/exchange of any hub data.” *Id.*

The term “actuator” appears in the limitation of claim 1 reciting “a mobile phone equipped with a dedicated actuator for initiating a commercial transaction.” *See* App. Br. 15 (Claims App’x.). This limitation was not argued in the Appeal Brief, nor was the term “actuator” mentioned in the “Arguments” section of the Appeal Brief. *See* App. Br. 5–10. Instead, the argument that Swartz does not disclose a “phone equipped with an actuator initiating commercial transaction” was raised for the first time in the Reply Brief. *See* Reply Br. 5.

We find nothing in the Answer that would necessitate a new argument focused on the “actuator” limitation. In other words, we see no reason why this new argument in the Reply Brief could not have been presented in the Appeal Brief. In the absence of a showing of good cause by Appellant, an argument raised for the first time in the Reply Brief is untimely and waived, unless it was necessitated by the Examiner’s arguments. *See* 37 C.F.R.

¹ Because claim 1 expressly recites “an optical input for receiving information concerning prices of goods,” this limitation is relevant and cannot be ignored, notwithstanding Appellant’s argument.

§ 41.41(b)(2); *Ex parte Borden*, 93 USPQ2d 1473, 1477 (BPAI 2010) (informative) (“Properly interpreted, the Rules do not require the Board to take up a belated argument that has not been addressed by the Examiner, absent a showing of good cause.”); *see also* Decision 5. If we were to automatically consider such newly raised arguments, “[r]ather than reviewing a record for error, the Board would be considering, in the first instance, findings of fact proposed by the Appellants, but not weighed by the Examiner [in the Examiner's Answer] against the other evidence of record.” *Borden*, 93 USPQ2d at 1475. We also find there was no shift in the Examiner’s reasoning or evidence in the Answer that would have necessitated Appellant’s new argument regarding the “actuator” limitation.

Even though this argument was not considered in the Examiner’s Answer, we note the Examiner finds in the Non-Final Action that “Hammad discloses that the apparatus (see [mobile communication device] unit 30 from Figure 1) engages in wireless commercial transactions, said apparatus equipped with an actuator for initiating (from column 6, see initiate the transaction) a commercial transaction.” Non-Final Act. 6; *see also* Hammad, col. 6, ll. 50–60. The Examiner further finds “it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the combination of Swartz and Medamana wherein the apparatus engages in wireless commercial transactions, said apparatus equipped with an actuator for initiating a commercial transaction as taught by Hammad . . . [to improve] system’s flexibility by enabling any suitable form of communication such as a text message, a multimedia message, a phone call, a voice message, a voicemail message, an instant messaging message, an email message, etc. as suggested by Hammad (see column 4).”

Non-Final Act. 6–7; *see also* Hammad col. 4, ll. 44–59. For the reasons stated by the Examiner, and based on our review of the cited portions of Hammad, we agree with these findings and find the combined teachings of Swartz, Medamana, and Hammad teach or suggest the limitation “a mobile phone equipped with a dedicated actuator for initiating a commercial transaction.”

In the Decision regarding what Appellant refers to as “the second remark by the Board” (*see* Supp. 3), we agreed with, and adopted as our own, the Examiner’s findings that Swartz teaches or suggests the disputed limitations of claim 1—“an optical input for receiving information concerning prices of goods” and “a network hub for wireless exchange of information between a commercial establishment and said mobile phone within the boundaries of the establishment.” Dec. 4–5. In the Appeal Brief and Reply Brief, Appellant’s argued the telephone 706 in the portable terminal 70 shown in Figures 2 and 3 of Swartz “is only used for audio/conversation purposes and does not handle any hub data computing/exchange concerning prices of goods with the commercial establishment.” *See* App. Br. 7–10; Reply Br. 6 (emphasis added). As discussed in the Decision, claim 1 does not recite a phone that handles “any hub data computing/exchange concerning prices of goods with the commercial establishment.” Dec. 4. In the Supplement, Appellant argues the bar code scanner 704 is connected with the CPU 701, rather than the telephone 706, in the portable terminal of Swartz, and again argues the telephone 706 only provides telephony support—“talk/listen ability.” Supp. 3–4.

To the extent Appellant’s arguments in the Briefs and the Supplement raise an issue regarding the features or functionality of the mobile phone in connection with the properly construed “network hub” limitation, we are not persuaded of Examiner error because, as discussed *supra*, the Examiner relies on Hammad as teaching a wireless communication device, such as a wireless phone, equipped with an actuator for initiating a commercial transaction, that has the capability to communicate information to other entities in any suitable form. *See* Non-Final Act. 6; *see also* Hammad, col. 4, ll. 44–59, col. 6, ll. 50–60. Thus, we agree with these findings and find the combination of Hammad and Swartz teaches or suggests the telephone functionality that Appellant argues is missing from Swartz for the network hub of Swartz to wirelessly exchange information between a commercial establishment and the mobile phone within the boundaries of the establishment. Appellant has not provided persuasive evidence or argument to show that modifying Swartz to use the wireless mobile phone features and functionality of Hammad was “uniquely challenging or difficult for one of ordinary skill in the art.” *See Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 419 (2007)). Absent such evidence or argument, we “take account of the inferences and creative steps that a person of ordinary skill in the art would employ,” and find combining the wireless phone capabilities of Hammad with the portable terminal of Swartz would have been within the level of ordinary skill in the art. *See KSR*, 550 U.S. at 418; *see also id.* at 421 (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”). Thus, Appellant’s arguments regarding the “second remark of the Board” do not persuade us the Examiner erred in finding the

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combined teachings of Swartz and Hammad teach or suggest “a network hub for wireless exchange of information between a commercial establishment and said mobile phone within the boundaries of the establishment.”

DECISION

Accordingly, we deny Appellant’s Request; and, upon granting the Request to the extent we have reconsidered the Decision in view of the arguments presented in the Supplement, as well as related arguments in the Briefs, we deny the Request and make no changes to the Decision.

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).

REHEARING DENIED