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EXAMINER
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PAPER

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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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*Ex parte* MARIO COSTA

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Appeal 2014-008427  
Application 12/533,050  
Technology Center 2400

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Before ALLEN R. MacDONALD, DANIEL N. FISHMAN, and  
MICHAEL M. BARRY, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellant requests rehearing under 37 C.F.R. § 41.52 of the Decision mailed June 28, 2016 (“Decision”), in which we affirmed the Examiner’s decision rejecting all pending claims (1–20). Appellant timely filed the Request for Rehearing (“Reh’g Req.”) on August 28, 2016.

We grant-in-part Appellant’s request and modify the Decision as set forth below.

ANALYSIS

*Anticipation*

The Request argues the Decision misapplies the law of anticipation (Reh’g Req. 6–12) and specifically “the Decision . . . appears to fill in the admittedly missing limitation with an improper application of *Kennametal v.*

*Inc. v. Ingersoll Cutting Tool Co.*, 780 F.3d 1376, 1381 (Fed. Cir. 2015)” (Reh’g Req. 8). The Request contends the Decision errs in finding the Covington reference anticipates claim 1 because:

It is simply not *written* anywhere in the cited *Covington et al.* that there is a mobile computing device, as required by the claims. Thus, there is no express or explicit disclosure of a “mobile computing device,” as required. The disclosure of the mobile computing device *must* be *express*. It must be *explicit*. However, in *Covington et al.*, it is non-existent.

(*Id.*)

We disagree. Anticipation “is not an ‘ipsissimis verbis’ test.” *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990); *see also Standard Havens Prods., Inc. v. Gencor Indus., Inc.*, 953 F.2d 1360, 1369 (Fed. Cir. 1991) (a reference “need not duplicate word for word what is in the claims”); *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009) (the reference need not satisfy an *ipsissimis verbis* test). Moreover, “in considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom.” *In re Preda*, 401 F.2d 825, 826 (CCPA 1968) (affirming an anticipation rejection). As the Federal Circuit clarified in *Gleave*:

As long as the reference discloses all of the claim limitations and enables the “subject matter that falls within the scope of the claims at issue,” the reference anticipates . . . . *Schering Corp. v. Geneva Pharms., Inc.*, 339 F.3d 1373, 1380–81 (Fed. Cir. 2003); *see In re Donohue*, 766 F.2d 531, 533 (Fed. Cir. 1985). This is so despite the fact that the description provided in the anticipating reference might not otherwise entitle its author to a patent. *See Vas–Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562 (Fed. Cir. 1991) (discussing the “distinction between a written description adequate to *support* a claim under § 112 and a

written description sufficient to *anticipate* its subject matter under § 102(b).”).

560 F.3d at 1334.

The Decision adopted the Examiner’s finding that Covington’s express preference for using the IEEE 802.11a wireless network protocol discloses a wireless network that mobile devices pervasively use. (*See* Decision 6 (citing Covington ¶ 14).) The Request counters that:

Applicants’ representatives have access to the engineers familiar with the underlying system of *Covington et al.*, who have confirmed that *Covington et al.*’s system was not mobile devices [sic]. The engineers also pointed to the short range bi-directional RF link in *Covington et al.* as one way a technical person would know that it is a stationary computer.

(Reh’g Req. 18.)

This is unpersuasive and specifically inconsistent with the examples in Covington of computers in a vehicle and an elevator (i.e., that are mobile) and that communicate over the wireless link (*see* ¶ 12). We also find unpersuasive the Request’s argument that because stationary computers can use 802.11a, Covington therefore does not disclose mobile devices. (Reh’g Req. 19.) To the contrary, one of ordinary skill would immediately understand Covington’s disclosure of device-to-device communication using a wireless network protocol well known to be in pervasive used by mobile devices as teaching use of mobile devices. (*See, e.g., Kennametal*, 780 F.3d at 1381.)

Accordingly, we grant Appellant’s Request to the extent we have reconsidered our Decision on the rejection of claim 1 under 35 U.S.C. § 102, but we deny the request to modify our Decision on this issue. Our decision is final for purposes of judicial review. *See* 37 C.F.R. § 41.52(a)(1).

Double Patenting

The Request argues the Decision errs affirming in the statutory double patenting rejection by relying on the standard from *In re Robeson*, 331 F.2d 610, 614 (CCPA 1964). (Reh’g Req. 13–17.) We have reconsidered this issue and agree. Accordingly, we grant Appellant’s Request on this issue and vacate our affirmance of the Examiner’s rejection of claims 1–20 for statutory double-patenting under 35 U.S.C. § 101.

DECISION

We maintain the portion of our Decision that affirms the rejection of claims 1–20 under 35 U.S.C. §§ 102 and 103. We vacate the portion of our Decision that affirms the rejection of claims 1–20 as invalid for double patenting under 35 U.S.C. § 101, and we reverse that rejection.<sup>1</sup> 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 GRANTED-IN-PART

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<sup>1</sup> As the Examiner has shown that all the claims are unpatentable, we do not further reject the claims. However, in the event of further prosecution of claims 1–20 at issue in this Decision, the Examiner should consider a provisional rejection for nonstatutory obviousness-type double patenting over claims 1–20 of co-pending US Application Serial No. 13/080,863 (the “’863 application”) (the only differences between claims 1–20 at issue in this Decision and claims 1–20 of the ’863 application are: (a) the pending claims at issue in this Decision recite a “mobile computing device” whereas the corresponding pending claims of the ’863 application recite a “tablet computing device” and (b) pending claims 1 and 13 in this Decision recite “a keyboard” and “a mouse” whereas pending claims 1 and 13 of the ’863 patent do not).