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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARIO COSTA, STEVEN GEFFIN, and CHARLES PETERS

Appeal 2014-008809
Application 13/080,863
Technology Center 2400

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

BARRY, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants request 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). Appellants timely filed the Request for Rehearing (“Reh’g Req.”) on August 28, 2016.

We grant-in-part Appellants’ Request and modify the Decision as set forth below.

ANALYSIS

Anticipation

The Request argues the Decision misapplies the law of anticipation (Reh’g Req. 6–14) and specifically:

the Decision . . . appears to attempt to fill in the gap of the missing limitations and claim terms by stating that ‘mobile and tablet computing devices have been notoriously well known since long before Applicants’ filing date,’ but Applicants respectfully submit that this is not a proper application of the law of anticipation – the issue is if Covington et al. explicitly and expressly discloses mobile and tablet computers, which it clearly does not.

(Reh’g Req. 8). The Request contends:

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

(*Id.*)

This does not persuade us. Anticipation “is not an ‘ipsissimis verbis’ test.” *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990); *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 protocol discloses a wireless network that mobile devices, including tablets, 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 (or tablets) [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. 20.)

This is unpersuasive and specifically inconsistent with the examples in Covington of “target computers” that are mobile, such as in a vehicle or an elevator (*see* Covington ¶ 12). We also find unpersuasive the Request’s argument that because stationary computers can use 802.11a, Covington therefore does not disclose mobile or tablet devices. (Reh’g Req. 21.)

Covington discloses its “remote stations” provide “KVM” (keyboard-video-mouse) functionality that “enables an operator at a remote station to control aspects of a so-called target (or local) computer” (*see, e.g.*, ¶¶ 2–5). Covington also discloses its “remote stations” for controlling “target computers” may or may not include a keyboard and mouse (*see* ¶ 10). One

of ordinary skill thus understands Covington’s disclosure as encompassing a typical tablet device configuration. In view of the totality of Covington’s disclosure, one of ordinary skill would immediately understand the alternative disclosure of remote stations without keyboards or mice and that communicate using a wireless network protocol well known to be in pervasive use by mobile devices as disclosing use of tablet computers as claimed. (*See, e.g., Kennametal, Inc. v. Ingersoll Cutting Tool Co.*, 780 F.3d 1376, 1381 (Fed. Cir. 2015).)

Accordingly, we grant Appellants’ 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 in affirming the statutory double patenting rejection by relying on the standard from *In re Robeson*, 331 F.2d 610, 614 (CCPA 1964). (Reh’g Req. 15–19.) We have reconsidered this issue and agree. Accordingly, we vacate our affirmance of the Examiner’s double-patenting rejection under 35 U.S.C. § 101.

Pursuant to 37 C.F.R. § 41.50(b), we enter, a new, provisional ground of rejection for claims 1–20 for nonstatutory obviousness-type double patenting over claims 1–20 of co-pending US Application Serial No. 12/533,050 (the “’050 application”). The only differences between pending claims 1–20 at issue in this Decision and pending claims 1–20 of the ‘050 application are (a) the pending claims in the ‘050 application recite a “mobile device” whereas the pending claims in this Decision recite a “tablet computing device” and (b) pending claims 1 and 13 in the ‘050 application

recite a keyboard and a mouse whereas pending claims 1 and 13 in this Decision do not. These differences do not render the two applications patentably distinct, because one of ordinary skill in the art at the time of the invention would have understood that (a) a tablet computing device is obviously a type of mobile device and (b) a keyboard and a mouse are user input mechanisms that obviously have analogous user input mechanisms in tablet computing devices (i.e., a touch-screen that provides keyboard and mouse functionality).

A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) or (d) can overcome this provisional nonstatutory double patenting rejection provided the '050 application (or a patent that issues from it) either is shown to be commonly owned with the application at issue in this Decision (or claims an invention made as a result of activities undertaken within the scope of a joint research agreement).

DECISION

We have granted Appellants' Request and reconsidered our Decision. We maintain the portion of our Decision that affirms the rejection of all pending claims under 35 U.S.C. §§ 102 and 103. We vacate the portion of our Decision affirming the rejection of all claims under 35 U.S.C. § 101.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." Section 41.50(b) also provides:

When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to

the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

REHEARING GRANTED-IN-PART

37 C.F.R. § 41.50(b)