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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* WILLIAM FITZGERALD, PETER BIRMINGHAM,  
FRANK HANNIGAN and PAUL PRENDERGAST

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Appeal 2015-004961<sup>1</sup>  
Application 12/203,835  
Technology Center 2600

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Before JEAN R. HOMERE, KEVIN C. TROCK, and NABEEL U. KHAN,  
*Administrative Patent Judges.*

HOMERE, Administrative Patent Judge

DECISION ON APPEAL  
STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134(a) of the Examiner's Final Rejection of claims 1–20. App. Br. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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<sup>1</sup> Appellants identify the real party in interest as YOUGETITBACK, LTD. App. Br. 2.

### APPELLANTS' INVENTION

Appellants' invention is directed to a system for assisting an unauthorized user in returning to its owner a lost or stolen mobile device previously registered with a security authority. Spec. ¶6. In particular, upon being apprised that the mobile device (800) is in the unauthorized user's possession, the security authority (860) sends to the mobile device an authenticable message on behalf of the owner. *Id.* ¶¶ 37–39, Fig. 1. The mobile device authenticates the validity of the received message by computing a message digest, which it compares to a previously stored authorization digest value. *Id.* ¶ 44, Fig. 8. The authenticated message is then displayed on the interface of the mobile device to instruct the unauthorized user how to return the device to its owner. *Id.* ¶ 32, Fig. 11.

### REPRESENTATIVE CLAIM

Independent claim 1 is representative, and reads as follows:

1. A tracking and loss mitigation system comprising:
  - a mobile device, the device comprising:
    - a user interface including a display and a data entry interface; and
    - a communications interface to a security authority, the communications interface configured to provide an authenticatable message from the security authority on behalf of an authorized user of the mobile device;
      - wherein the mobile device is configured to:
        - provide, by the user interface of the mobile device, a notification describing how to return the mobile device to an authorized user;
        - receive and decode a communication from the security authority through the communications interface to the security authority, the communication initiated on behalf of a request from the authorized user of the mobile device to the security authority;

authenticate the validity of the decoded communication  
by one of:

computing a digest of the communication and  
comparing the digest value to a previously stored  
authorization digest value; and

decrypting at least part of the message with a  
public key associated with the sender of the message as  
part of an asymmetric encryption algorithm;

detect, from the decoding of the communication,  
that a security compromise event has occurred; and

determine, from the decoded communication,  
whether the function of the device should be altered in  
response to said security event; and

wherein the security authority comprises one of a  
governmental law enforcement organization, private  
security firm, an insurance agency, and combinations  
thereof.

#### PRIOR ART RELIED UPON

The Examiner relies on the following prior art as evidence of  
unpatentability:

Jonsson	US 6,463,276 B1	Oct. 8, 2002
Kagay	US 6,782,251 B2	Aug. 24, 2004
Henrie	US 6,804,699 B1	Oct. 12, 2004
Chen	US 2007/0139269 A1	June 21, 2007
Creigh	US 7,257,374 B1	Aug. 14, 2007
Madej	US 2007/0252676 A1	Nov. 1, 2007
Chung	US 7,319,397 B2	Jan. 15, 2008
Shaju	US 2008/0076459 A1	Mar. 27, 2008

Symbian Brains Inc. (*Anti-Thief User's Guide*, 01/13/2007)

#### REJECTIONS ON APPEAL

Claims 1, 6, and 12 stand provisionally rejected on the ground of  
nonstatutory double patenting as being unpatentable over claim 1, 3, 5, 6,

and 11 over co-pending application no. 12/060,863 and Symbian Brains, Inc.<sup>2</sup>

Claims 1–3, 8, and 9 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over the combination of Henrie and Symbian Brains.

Claims 4–7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Henrie, Symbian Brains, and Johnson.

Claims 10, 12, and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Henrie, Symbian Brains, and Creigh.

Claims 11, and 13–15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Henrie, Symbian Brains, and Chung.

Claims 17–20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Henrie, Symbian Brains, Creigh and Chen.

#### ANALYSIS

We consider Appellants’ arguments *seriatim*, as they are presented in the Appeal Brief, pages 10–26, and the Reply Brief, pages 2–7.<sup>3</sup> We are

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<sup>2</sup> Because Appellants do not appeal this ground of rejection or present any argument thereagainst in the briefs, we summarily sustain the double patenting rejection. Final Act. 10–13.

<sup>3</sup> Rather than reiterate the arguments of Appellants and the Examiner, we refer to the Appeal Brief (filed October 7, 2014) (“App. Br.”), the Reply Brief (filed March 30, 2015) (“Reply Br.”), and the Answer (mailed January 29, 2015) (“Ans.”) for the respective details. We have considered in this Decision only those arguments Appellants actually raised in the Briefs. Any other arguments Appellants could have made but chose not to make in the Briefs are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2012).

unpersuaded by Appellants' contentions. Except as otherwise indicated hereinbelow, we adopt as our own the findings and reasons set forth in the Examiner's Answer in response to Appellants' Appeal Brief. Ans. 2–14, Final Action 2–32. However, we highlight and address specific arguments and findings for emphasis as follows.

Appellants contend that the combination of Henrie and Symbian Brains does not render claim 1 unpatentable. App. Br. 10–14, Reply Br. 3–5. First, Appellants argue that Henrie does not teach a communication interface for providing an authenticable message from a security authority on a behalf of a user. App. Br. 10. According to Appellants, although Henrie makes a general reference that websites can contain security features, it does not specify a security authority of any kind having an interface to the mobile device. *Id.* at 11 (citing Henrie 10:32–44). This argument is not persuasive.

Henrie discloses a server (30) containing a website (40) with which an authorized user can register a mobile device by serial number such that the website can track the mobile device, disable it, and instruct an unauthorized user how to return the device to its rightful owner. Abstr., col. 10:41–44. Because the disclosed website serves as a security gatekeeper that helps restrict the use of a lost mobile device, and that helps restore the device to its rightful owner, we agree with the Examiner that the website teaches a private or public security authority. Ans. 3–4.

Second, Appellants contend that the proposed combination of references does not teach decoding a received message. App. Br. 11. In particular, Appellants argue that Henrie's disclosure of automatically processing a received signal without regard for its authenticity teaches away

from authenticating the message. *Id.* at 12–13 (citing Henry 11:53–65). This argument is not persuasive.

We agree with the Examiner that, in communications systems, signals are routinely encoded prior to being sent, and decoded upon receipt. Ans. 4–5. Therefore, even though Henrie processes the received signal automatically, such signal processing encompasses decoding. *Id.* Further, the teaching away argument is misplaced because Henrie’s failure to authenticate the received signal is not a criticism against authenticating received signals.<sup>4</sup> Furthermore, the Examiner relies upon Symbian Brains’ disclosure of activating an anti-thief feature remotely on a phone upon authenticating a received text message from an authorized user to complement the cited teaching of Henrie.<sup>5</sup> Final Act. 16. Additionally, because Appellants’ Specification defines authentication digest as any value, number, code, or identifier that is used to identify a message as being valid from a security authority,<sup>6</sup> we agree with the Examiner that Symbian Brains’ disclosure of comparing the signature of a received text message with a pre-stored signature teaches using a digest/text to authenticate the message

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<sup>4</sup> The Federal Circuit has held “[a] reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Kahn*, 441 F.3d 977, 990 (Fed. Cir. 2006) (quoting *In re Gurley*, 27 F.3d 551, 553 (Fed.Cir.1994)).

<sup>5</sup> One cannot show non-obviousness by attacking the references individually where the rejections are based on combinations of references. *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). *See also In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

<sup>6</sup> Spec. ¶ 44.

received from the security authority. Ans. 6–7. Accordingly, Appellants’ argument to the contrary is not persuasive. App. Br. 13–14, Reply Br. 3–4.

Last, Appellants argue that there is insufficient rationale to combine Henrie and Symbian Brains. App. Br. 8, Reply Br. 5. This argument is not persuasive. The Supreme Court instructs that an obviousness analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). As discussed above, we find the Symbian Brains’ disclosure of incorporating into Henrie’s mobile device an authentication mechanism for authenticating a message received from a security authority is no more than a simple arrangement of old elements with each performing the same function it had been known to perform, yielding no more than one would expect from such an arrangement. *Id.* at 416. The ordinarily-skilled artisan, being “a person of ordinary creativity, not an automaton,” would be able to fit the teachings of Henrie and Symbian Brains together like pieces of a puzzle. *Id.* at 420–21. Because Appellants have not demonstrated that the Examiner’s proffered combination would have been “uniquely challenging or difficult for one of ordinary skill in the art, we agree with the Examiner that the proposed modification would have been within the purview of the ordinarily skilled artisan. *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418).

Accordingly, we are not persuaded of error in the Examiner’s obviousness rejection of claim 1.

Regarding the rejection of claims 2–20, to the extent Appellants have either not presented separate patentability arguments or have reiterated substantially the same arguments as those previously discussed for patentability of claim 1 above, those claims fall therewith. See 37 C.F.R. § 41.37(c)(1)(vii). Further, to the extent Appellants have raised additional arguments for patentability of these claims, we find that the Examiner has rebutted in the Answer each and every one of those arguments by a preponderance of the evidence. Answer 7–15. We adopt the Examiner’s findings and underlying reasoning, which we incorporate herein by reference. Because Appellants have failed to persuasively rebut the Examiner’s findings regarding the rejections of claims 2–20, Appellants have failed to show error in the Examiner’s rejection of these claims.

#### DECISION

We affirm the Examiner’s nonstatutory double patenting rejection of claims 1, 6, and 12. We also affirm the Examiner’s rejections under 35 U.S.C. § 103(a) of claims 1–20.

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).

AFFIRMED