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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte NELSON LUDLOW, STEVEN ZEHM,
BRIAN BLOOD, and TRISTAN LEONARD

Appeal 2016-002064
Application 12/265,666¹
Technology Center 2600

Before LARRY J. HUME, CATHERINE SHIANG, and
NATHAN A. ENGELS, *Administrative Patent Judges*.

HUME, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the Final Rejection of claims 1, 4–19, and 22–33 which are all the claims pending in the application. Appellants have canceled claims 2, 3, 20, 21, and 34. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ According to Appellants, the real party in interest is Intellicheck Mobilisa, Inc. App. Br. 1.

STATEMENT OF THE CASE²

The Invention

Appellants' disclosed and claimed invention relates to dynamic access control in response to flexible rules. Title.

Exemplary Claim

Claim 1, reproduced below, is representative of the subject matter on appeal (*emphasis* added):

1. A method in a computer system for controlling access to a location based on one or more access rules, the method comprising:

receiving identification information associated with an individual from a piece of identification;

comparing at least some of the received identification information with a first data set to assess the likelihood that the individual is a person of interest,

wherein a person of interest includes an individual who raises heightened concern for security purposes, and

wherein the first data set includes a set of persons of interest;

denying the individual access if the individual is a person of interest;

comparing at least some of the received identification information with a second data set to assess whether the individual is pre-authorized to access the location,

² Our decision relies upon Appellants' Appeal Brief ("App. Br.," filed June 4, 2015); Reply Brief ("Reply Br.," filed Dec. 7, 2015); Examiner's Answer ("Ans.," mailed Oct. 7, 2015); Final Office Action ("Final Act.," mailed Sept. 5, 2014); and the original Specification ("Spec.," filed Nov. 5, 2008).

wherein the second data set includes a set of pre-authorized persons;

allowing the individual access if the individual is a pre-authorized person; and

if the received identification information does not substantially match a person of interest and does not substantially match a pre-authorized person, applying, automatically and without manual input, one or more access rules to at least some of the read identification information to determine whether the individual is to be granted or denied access to the location.

Prior Art

The Examiner relies upon the following prior art as evidence in rejecting the claims on appeal:

Gullman et al. ("Gullman")	US 5,280,527	Jan. 18, 1994
Merkert, SR. ("Merkert")	US 2005/0082365 A1	Apr. 21, 2005
Kinsella	US 6,914,517 B2	July 5, 2005
Zagami	US 2005/0171787 A1	Aug. 4, 2005
Weekes	US 7,147,155 B2	Dec. 12, 2006
Atwood et al. ("Atwood")	US 8,086,525 B2	Dec. 27, 2011 (filed Oct. 31, 2008)

*Rejections on Appeal*³

R1. Claims 1, 4–13, 18, 19, 22–27, 29, and 30–33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Weekes and Zagami. Final Act. 4.

R2. Claims 14 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Weekes, Zagami, and Merkert. Final Act. 9.

R3. Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Weekes, Zagami, and Gullman. Final Act. 10.

R4. Claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Weekes, Zagami, and Kinsella. *Id.*

R5. Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Weekes, Zagami, and Atwood. Final Act. 11.⁴

CLAIM GROUPING

Based on Appellants' arguments (App. Br. 15–19), we decide the appeal of obviousness Rejection R1 of claims 1, 4–13, 18, 19, 22–27, 29, and 30–33 on the basis of representative claim 1.

³ We note the Examiner has withdrawn the rejection of claim 33 under 35 U.S.C. § 101; and the rejection of claims 1, 4–19, and 22–33 under 35 U.S.C. § 112, first paragraph, as lacking written description support. Ans. 2.

⁴ The Examiner omits citation to the Zagami reference in the explicit statement of Rejection R5, but addresses the combination of Weekes, Zagami, and Atwood in the detailed rejection. Final Act. 11.

Remaining claims 14–17 and 28 in rejections R2 through R5, not argued separately, stand or fall with the respective independent claim from which they depend.⁵

ISSUE

Appellants argue (App. Br. 15–17; Reply Br. 2–9) the Examiner's rejection of claim 1 under 35 U.S.C. § 103(a) as being obvious over the combination of Weekes and Zagami is in error. These contentions present us with the following issue:

Did the Examiner err in finding the cited prior art combination teaches or suggests "[a] method in a computer system for controlling access to a location based on one or more access rules" that includes, *inter alia*, the conditional limitation of:

if the received identification information does not substantially match a person of interest and does not substantially match a pre-authorized person, applying, automatically and without manual input, one or more access rules to at least some of the read identification information to determine whether the individual is to be granted or denied access to the location,
as recited in claim 1?

ANALYSIS

In reaching this decision, we consider all evidence presented and all arguments actually made by Appellants. We do not consider arguments

⁵ "Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately." 37 C.F.R. § 41.37(c)(1)(iv).

Appellants could have made but chose not to make in the Briefs, and we deem any such arguments waived. 37 C.F.R. § 41.37(c)(1)(iv).

We disagree with Appellants' arguments with respect to claims 1, 4–19, and 22–33, and we incorporate herein and adopt as our own: (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken, and (2) the reasons and rebuttals set forth in the Examiner's Answer in response to Appellants' arguments. We incorporate such findings, reasons, and rebuttals herein by reference unless otherwise noted. However, we highlight and address specific findings and arguments regarding claim 1 for emphasis as follows.

Appellants contend independent claims 1, 19, and 33 "all recite the 'blacklist' feature, the 'whitelist' feature, and the 'grey area' feature", but the cited prior art, Weekes and Zagami "only disclose the 'whitelist' feature and the 'blacklist' feature." App. Br. 15. "For purposes of this appeal, the primary question to the Board is whether or not such a 'grey area' teaching is found in the applied references." *Id.*

We first note, Appellants' arguments are not commensurate with the scope of the claim, as claim 1 does not recited a "whitelist," a "blacklist," or a "grey area," as pointed out by the Examiner. Ans. 2–3.

Appellants further argue Weekes' teaching of automatically denying access to an individual in the absence of finding the individual on a whitelist or blacklist does not teach or suggest the claimed conditional "applying . . . one or more access rules" when an individual falls within the asserted "grey area." App. Br. 16.

The Examiner finds, "[t]he limitation of the access rule is broadly claimed and does not provide any definition of what the access rule includes . . . [because the] limitation regarding the access rules is broader than argued, the claimed limitations does not include the access rules as argued on page 16 of the Appeal Brief." Ans. 3.

Appellants contend:

An "access rule" as claimed is different than the automatic barring of individuals as taught by Weekes for at least two reasons. First, an access rules makes an additional assessment of circumstances under which an individual may be granted access to a location. That is, application of an access rule inherently has two outcomes—either to deny access or to grant access. Weekes cannot be said to disclose or suggest an access rule, since its sole outcome is to preclude access in all circumstances. To read Weekes otherwise is to ignore the limitation pertaining to granting access to the location in the plain language of the claim.

Second, the "one or more access rules" discussed above each utilize certain objective pieces of information to access the circumstances under which access is granted. For example, an access rule may depend on the individual who wants to access a location (e.g., rules by virtue of an individual's rank), the type of identification document scanned, or the location itself (e.g., rules based on the location of a scanning device). Weekes takes no such objective information into account, and is not in possession of any additional factors on which an access decision can be based. Weekes therefore cannot be said to disclose or suggest an access rule.

App. Br. 16–17.

We note Appellants have not cited to a definition of "access rule" in the Specification that would preclude the Examiner's broader reading.

Ans. 3.^{6, 7}

We agree with the Examiner's factual findings in support of the legal conclusion of obviousness cited above. Moreover, as a matter of claim interpretation in further support of the Examiner's conclusion of obviousness, and using the broadest reasonable interpretation of claim 1, we conclude the conditional step of "applying . . . one or more access rules," may never occur. *See Ex parte Schulhauser*, Appeal No. 2013-007847, at *9 (PTAB, April 28, 2016) (precedential) (holding "[t]he Examiner did not need to present evidence of the obviousness of the remaining method steps

⁶ In particular, the Weekes reference teaches:

verifying the traveler's information before the traveler is allowed to embark and uploading traveler's identification information for verification (col. 5 lines 63–66). Weekes further teaches enhancing the traveler's information with information gathered from immigration, police and national identification authorities (col. 6 lines 5–15) and the examiner consider such enhancements as access rule and allowing access based on substantial matching of data or partial matching of data represents an obvious variation and only requires routine skills in the art.

Ans. 3.

⁷ Further, any special meaning assigned to a term "must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention." *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998); *see also Helmsderfer v. Bobrick Washroom Equip., Inc.*, 527 F.3d 1379, 1381 (Fed. Cir. 2008) ("A patentee may act as its own lexicographer and assign to a term a unique definition that is different from its ordinary and customary meaning; however, a patentee must clearly express that intent in the written description.").

of claim 1 that are not required to be performed under a broadest reasonable interpretation of the claim (e.g., instances in which the electrocardiac signal data is not within the threshold electrocardiac criteria such that the condition precedent for the determining step and the remaining steps of claim 1 has not been met"); *see also Ex parte Katz*, Appeal No. 2010-006083, 2011 WL 514314, at *4–5 (BPAI Jan. 27, 2011).⁸

Here, we apply the precedential guidance of *Schulhauser*. Therefore, the Examiner need not present evidence establishing the obviousness of the conditional "applying" step of claim 1, because it is not required to be performed under the broadest reasonable interpretation of the claim, e.g., instances when the received identification information *does* substantially match a pre-authorized person, such that the condition precedent for the applying step, i.e., "if the received identification information does not substantially match a person of interest and does not substantially match a pre-authorized person," is not met.

Therefore, we find Appellants' argument that Weekes fails to teach or suggest the conditional applying step of claim 1 to be unavailing, because it is not commensurate with the broadest reasonable interpretation of claim 1. *See In re Schulhauser*, Appeal 2013-007847, at *9.

⁸ *See, also e.g., Applera Corp. v. Illumina, Inc.*, 375 Fed. Appx. 12, 21 (Fed. Cir. 2010) (unpublished) (affirming a district court's interpretation of a method claim as including a step that need not be practiced if the condition for practicing the step is not met); *Cybersettle, Inc. v. Nat 'l Arbitration Forum, Inc.*, 243 Fed. Appx. 603, 607 (Fed. Cir. 2007) (unpublished) ("It is of course true that method steps may be contingent. If the condition for performing a contingent step is not satisfied, the performance recited by the step need not be carried out in order for the claimed method to be performed.").

Accordingly, based upon the findings above, on this record, we are not persuaded of error in the Examiner's reliance on the combined teachings and suggestions of the cited prior art combination to teach or suggest the disputed limitation of claim 1, nor do we find error in the Examiner's resulting legal conclusion of obviousness. Therefore, we sustain the Examiner's obviousness rejection of independent claim 1, and grouped claims 4–13, 18, 19, 22–27, 29, and 30–33 which fall therewith. *See Claim Grouping, supra.*

§ 103(a) Rejections R2 through R5 of Claims 14–17 and 28

In view of the lack of any substantive or separate arguments directed to obviousness Rejections R2 through R5 of claims 14–17 and 28 under § 103 (*see App. Br. 18*), we sustain the Examiner's rejections of these claims. Arguments not made are waived.⁹

REPLY BRIEF

To the extent Appellants may advance new arguments in the Reply Brief (Reply Br. 2–9) not in response to a shift in the Examiner's position in the Answer, we note arguments raised in a Reply Brief that were not raised in the Appeal Brief or are not responsive to arguments raised in the Examiner's Answer will not be considered except for good cause (*see 37 C.F.R. § 41.41(b)(2)*), which Appellants have not shown.

⁹ Appellants merely argue, "Weekes and Zagami fail to disclose all the claimed features of claims 1 and 19. Neither Merkert, Gullman, Kinsella, nor Atwood cures the deficiency of Weekes and Zagami described above." App. Br. 18.

CONCLUSION

The Examiner did not err with respect to obviousness Rejections R1 through R5 of claims 1, 4–19, and 22–33 under 35 U.S.C. § 103(a) over the cited prior art combinations of record, and we sustain the rejections.

DECISION

We affirm the Examiner's decision rejecting claims 1, 4–19, and 22–33.

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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED