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EXAMINER	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROBERTO GABRIEL YEPEZ, JOSH GRAESSLEY, PAUL CHINN, and ANAND DALAL

Appeal 2016-003878
Application 12/729,157
Technology Center 2100

Before ALLEN R. MacDONALD, AARON W. MOORE, and MICHAEL J. ENGLE, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 1–25. Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

Exemplary Claim

Claim 1 under appeal reads as follows (emphasis/brackets added):

1. A method, comprising:

[(A)] executing each of the following at a host device ***while said host device remains communicatively coupled to a peripheral device*** through a local interconnect, said peripheral device not mechanically integrated with said host device, said local interconnect being a point-to-point connection between said host device and said peripheral device:

[(i)] issuing a first query to said peripheral device for a suggested configuration, said suggested configuration initiated at said peripheral device, and wherein said suggested configuration is a selection from a plurality of possible configuration settings of said peripheral device;

[(ii)] receiving from said peripheral device said peripheral device's suggested configuration;

[(iii)] issuing a second query to said peripheral device, the second query to detect an updated suggested configuration, said updated suggested configuration initiated at said peripheral device; and

[(iv)] reconfiguring an interface to said peripheral device based on said updated suggested configuration.

Rejections

The Examiner rejected claims 1, 4–6, 11, 12, 15, 17–19, 23, and 25 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Scales et al. (US 2002/0152348 A1, published Oct. 17, 2002) and Topp et al. (US 7,877,788 B1, issued Jan. 25, 2011).[1]

[1] Separate patentability is not argued for claims 4–6, 11, 12, 15, 17–19, 23, and 25. Rather, these claims are grouped with claim 1. Thus, the rejection of these claims turns on our decision as to claim 1. Except for our ultimate decision, these claims are not discussed further herein.

The Examiner rejected claims 2, 3, 7–10, 13, 14, 16, 20–22, and 24 under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Scales, Topp, and other references.[2]

Appellants' Contentions

1. Appellants contend that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a) because:

> [I]n the Topp system, the interface connector is initially coupled to the interface controller for authentication and then, when authentication is successful, the interface connector **is switched to being coupled to the interface circuit** to enable subsequent communication with the peripheral device.

App. Br. 10.

2. Appellants contend that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a) because:

> Topp is limited to a security module in a device that controls the connectivity of an **interface circuit** in the same device (*e.g.*, OHC 206) to an interface connector in the device using a switch based on device descriptor **information collected from the interface circuit**. As described above, the interface connector is **switched** from being connected to an interface controller to being connected to an interface circuit, and thus **does not remain communicatively coupled** to either of the interface controller or the interface circuit.

App. Br. 11.

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[2] Separate patentability is not argued for claims 2, 3, 7–10, 13, 14, 16, 20–22, and 24. These claims are argued by virtue of their dependence from claim 1 or other claims grouped with claim 1. App. Br. 12. Thus, the rejections of these claims turns on our decision as to claim 1. Except for our ultimate decision, the rejections of these claims are not discussed further herein.

Issue on Appeal

Did the Examiner err in rejecting claim 1 as being obvious?

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellants' arguments (Appeal Brief) that the Examiner has erred. We disagree with Appellants' conclusions. Except as noted herein, we 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 set forth by the Examiner in the Examiner's Answer in response to Appellants' Appeal Brief. We concur with the conclusions reached by the Examiner. We highlight the following additional points.

As to Appellants' above contention 1, we disagree. Appellants' argument references "initial switching" discussed in Topp at column 3, lines 13–32. However, as the Examiner correctly points out, "[t]he initial switching alleged by the appellant's remarks does not relate to the embodiment cited by the Office Action; in the cited portion (col. 9, lines 25–35) Topp describes an[] '**active enquiry**'." Ans. 4.

As to Appellants' above contention 2, Appellants quote Topp column 9, lines 15–37:

> The security module 208 provides methods for configuring the USB state controller of the OHC 206 using a device policy configuration signal 254. In one embodiment, the device policy configuration signal 254 is a read/write-accessible register interface to configuration and operational registers of the OHC 206 ... **the security module 208 performs active enquiry of device qualifications. In one embodiment, the security module 208 periodically requests device descriptor information such as device class or subclass, etc**. In another

> embodiment, device descriptor information is requested after a wake-up event ... In one embodiment, the security module 208 provides active intervention when violating devices are detected. For example, the device policy configuration signal 254 may force the premature termination of a transfer or endpoint descriptor. As another example, the release of a port may be forced.

App. Br. 11. Appellants then argue "the interface connector is **switched** from being connected to an interface controller to being connected to an interface circuit, and thus **does not remain communicatively coupled** to either of the interface controller or the interface circuit." App. Br. 11. We disagree.

We agree with Appellants that Topp's initial authentication process explicitly "switches a port from the AHC 204 [authentication host controller] to the OHC 206 [operational host controller]" (Topp col. 8, ll. 55–56). Until the peripheral is initially authenticated by the AHC, the peripheral is not communicatively coupled to the OHC. That is, at the start of the initial process the peripheral is only coupled to the AHC and is decoupled from the OHC.

However, as we noted above, this initial switching does not relate to the embodiment cited by the Office Action. We find no support in Topp for Appellants' argument that Topp column 9, lines 15–37 is directed to the peripheral connection being communicatively decoupled from the OHC while the security module 208 performs active enquiry of device qualifications. Instead, our reading of Topp is that the OHC 206 remains communicatively coupled to the peripheral while the security module 208 performs active enquiry. In particular, lines 27–36 of column 9 indicate the security module 208 performs active enquiry of device qualifications, the

security module 208 provides active intervention when violating devices are detected, and the device policy configuration signal 254 forces the premature termination of a transfer (i.e., communicatively decouples the OHC). Under Appellants' theory, forcing premature termination of the OHC would be unnecessary, as the OHC would have already been communicatively decoupled while the security module 208 performs active enquiry of device qualifications.

CONCLUSIONS

(1) The Examiner has not erred in rejecting claims 1–25 as being unpatentable under 35 U.S.C. § 103(a).

(2) Claims 1–25 are not patentable.

DECISION

The Examiner's rejections of claims 1–25 are affirmed.

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[3]

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[3] As the Examiner has shown that all the claims are unpatentable, we do not further reject Appellant's claims 25–29 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. However, should there be further prosecution of these claims, the Examiner's attention is directed to our following concerns.

On June 11, 2014, Appellants filed an amendment adding similar language to each of claims 1–25. Essentially, the word "remains" was substituted for the word "is." All pending claims now include language requiring "while said host device ***remains*** communicatively coupled" (Claim 1, emphasis added). We construe the term "remains" to mean "to

continue in the same state" (The Random House Dictionary of the English Language; 2nd Ed.; 1983). We have reviewed Appellants' Specification as filed and have not seen either the term "remains" or, alternatively, other sufficient support for a "continues in the same state" limitation.

Appellants' Specification does recite "when the peripheral device ***is*** communicatively coupled to the host" (¶¶ 8, 33) and "while the peripheral ***is*** communicatively coupled to the host" (¶¶ 26, 27), but these circumstances may differ from the "remains" limitation. While the "remains" limitation may be obvious in view of the "is" description, "a description that merely renders the invention obvious does not satisfy the [written description] requirement." *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1352 (Fed. Cir. 2010).