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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/890,867	05/09/2013	Chris Casilli	2013P03140US	2415

28524 7590 02/13/2018
SIEMENS CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
3501 Quadrangle Blvd Ste 230
Orlando, FL 32817

EXAMINER

HUNTLEY, MICHAEL J

ART UNIT	PAPER NUMBER
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2121

NOTIFICATION DATE	DELIVERY MODE
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02/13/2018

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHRIS CASILLI, DAVID A. HINGOS,
MARTIN OTTO, SAMUEL NEGRON, and
MITHUN VAIDHYANATHAN¹

Appeal 2017-008321
Application 13/890,867²
Technology Center 2100

Before ROBERT E. NAPPI, ERIC S. FRAHM, and
JOHN D. HAMANN, *Administrative Patent Judges*.

NAPPI, *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 through 21.

We affirm.

¹ According to Appellants, the real party in interest is Siemens Industry Inc. App. Br. 1.

² We note that Appellants misrepresented the status of related appeals. *See* 37 CFR 41.37(c)(1)(ii). Despite Appellants filing an Appeal Brief in co-pending application no. 13/890,868 having substantially the same arguments as presented here, Appellants failed to identify the co-pending application. Further, both Appeal Briefs were signed by the same attorney.

INVENTION

The invention is directed to an approach for configuration of a building automation system controller where the system is accessed without a network connection. Abstract and paragraphs 12 through 14 of Appellants' Specification. Claim 1 is illustrative of the invention and is reproduced below:

1. A device for configuration of a mobile device for controlling a building automation system, comprising:

a memory;

a display;

a processor coupled to the memory; and

an input device able to read a code coupled to the processor, where the processor decodes the code into a data associated with building automation that includes authentication data and at least a portion of the data is used to configure an application executed by the processor.

REJECTIONS AT ISSUE

The Examiner provisionally rejected claims 1, 8, and 17 under non-statutory obviousness-type double patenting over claims 2, 9, and 16 of co-pending Application No. 13/890,898. Final Act. 7–9.³

The Examiner rejected claims 3, 12, and 21 under 35 U.S.C. §112 (d) for failing to further limit the subject matter of the claim upon which it depends. Final Act. 11.

³ Throughout this Opinion, we refer to the Appeal Brief, filed October 14, 2016 (“App. Br.”); the Examiner’s Answer, mailed November 28, 2016 (“Ans.”); the Final Office Action, mailed March 1, 2016 (“Final Act.”); and Appellants’ Specification filed May 9, 2013 (“Spec.”).

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The Examiner rejected claims 1 through 21 under 35 U.S.C. §103(a) as unpatentable over Hilbrink (US 8,918,719 B2; Dec. 23, 2014) in view of Jayaprakash (US 2014/0061293 A1; Mar. 6, 2014).

Final Act. 12–24.

ANALYSIS

We have reviewed Appellants’ arguments in the Brief, the Examiner’s rejections and the Examiner’s response to Appellants’ arguments.

Appellants’ arguments have not persuaded us of error in the Examiner’s a) provisional double patenting rejection of claims 1, 8, and 16; b) rejection of claims 3, 12, and 21 under 35 U.S.C. §112 (d); or c) rejection of claims 1 through 21 under 35 U.S.C. § 103(a).

Initially, we note Appellants have not addressed the Examiner’s provisional double patenting rejection or the rejection under 35 U.S.C. §112 (d). Thus, Appellants have not identified an error in these rejections, and we sustain them *pro-forma*.

Appellants argue on pages 8 and 9 of the Appeal Brief, that the application on appeal is a continuation-in-part of application no. 13/218,132 (published as application US 2013/0054033) and as such should be afforded the priority date of that application (August 25, 2011).

The Examiner determined that the claims of the application on appeal are not entitled to the priority of Application no. 13/218,132, as that application does not demonstrate Appellants had possession of the current claims when the earlier application was filed. Specifically, the Examiner finds that the recitation directed to the code with data associated with building automation that includes authentication data is not disclosed in the 13/218,132 Application. Final Act. 10, Ans. 3.

Appellants argue that the Examiner erred in not granting the priority date as the prior application provides support for the claim on appeal. App. Br. 8, 9 (citing paragraphs 0063 and 0075 of the published application). Specifically, Appellants state that the prior application discusses that the building information includes security information and though it does not use the term authentication it does identify security information is included. *Id.* (citing paragraph 63 of the published information). Further, Appellants argue that paragraph 75 of the published application identifies indicia that is processed to determine a unique identifier which is used with “additional data” and as such supports the indicia having two types of data. *Id.* at 9.

The Examiner has provided a comprehensive response to Appellants’ argument on pages 3 through 5 of the Answer comparing the relevant disclosures of application no. 13/218,132, and of the Specification in the application on appeal. 35 USC § 120 “expressly requires an earlier application to disclose the claimed subject matter in compliance with 35 USC §112, first paragraph [35 USC §112(a)].” *In Re Scheiber*, 587 F.2d 59, 62 (CCPA 1978). We have reviewed the specification of application no. 13/218,132, Appellants’ argument, the Examiner’s findings, and the Examiner’s response to Appellants’ argument. We find that the Examiner has shown that the disclosure of application no. 13/218,132 does not demonstrate Appellants had possession of the claimed code which when decoded contains data associated with the building automation system and authentication data, where the codes are then used to configure a computer application as recited in representative claim 1. Accordingly, we find no error in the Examiner’s failure to grant the claims of this case the August 25, 2011, priority date of the 13/218,132 Application.

With respect to the obviousness rejection, Appellants argue:

The *Hilbrink, et al.* patent fails to teach or describe authentication data being included in the code as discussed above and also indicated on page 13 of the Final Office Action. Furthermore, *Jayaprakash, et al.* publication has a filing date of September 4, 2012 that is well after the priority date of August 25, 2011 of parent application 13/218,132 of the current application.

App. Br 10.

This argument has not persuaded us of error in the Examiner's obviousness rejection. As discussed above, we agree with the Examiner's determination that the claims are not entitled to the August 25, 2011, priority date. As such, we find no error in the Examiner's reliance on Jayaprakash to teach the claimed authentication data. Further, we note that the Examiner has found that Hilbrink also teaches the claimed authentication data. *See* Answer 5, 6 (citing Hilbrink Figure 6, and Cols. 5 and 6). Appellants have not addressed these findings. Thus, Appellants have not persuaded us of error in the Examiner's obviousness rejection of representative claim 1. Accordingly, we sustain the Examiner's rejection of claim 1 and claims 2 through 21 grouped with claim 1.

DECISION

The decision of the Examiner to reject claims 1 through 21 is 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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED