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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* DINDO UY, DAVID GOLDMAN, DAVID NIBLER, and  
E. KEITH McQUEEN

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Appeal 2019-000784  
Application 14/728,678  
Technology Center 2100

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Before TREVOR M. JEFFERSON, JAMES B. ARPIN, and  
SCOTT RAEVSKY, *Administrative Patent Judges*.

ARPIN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant<sup>1</sup> appeals under 35 U.S.C. § 134(a), the rejections of claims 1, 6, 15, and 16. Final Act. 2.<sup>2</sup> Claims 2–5 and 7–14 are cancelled.

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<sup>1</sup> “Appellant” here refers to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party-in-interest as Zodiac Pool Systems LLC. Appeal Br. 3.

<sup>2</sup> In this Decision, we refer to Appellant’s Amendment (“Amdt.,” filed February 12, 2018), Appeal Brief (“Appeal Br.,” filed August 9, 2018), and Reply Brief (“Reply Br.,” filed November 7, 2018); the Final Office Action (“Final Act.,” mailed March 12, 2018) and the Examiner’s Answer (“Ans.,” mailed September 27, 2018); and the originally-filed Specification (“Spec.,” filed June 2, 2015). Rather than repeat the Examiner’s findings and determinations and Appellant’s contentions in their entirety, we refer to these documents.

Amdt. 2–3. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

#### STATEMENT OF THE CASE

Appellant’s claimed subject matter relates to methods for controlling one or more components of a recreational water circulation system or modifying one or more characteristics of the water contained within a vessel such as a pool or spa. The invention relates more particularly to special-purpose controllers which may function without need to receive instructions from any master controller.

Spec., 1:9–13. In particular, the claimed subject matter relates to methods for controlling spas or pools, “in which a device may communicate wirelessly with pool and spa control equipment both (1) via the Internet (or router as part of a local area network [LAN]) and (2) directly (i.e. point-to-point).” *Id.* at 2:10–12.

As noted above, claims 1, 6, 15, and 16 stand rejected. Claim 1 is independent, and claims 6, 15, and 16 depend directly from claim 1. Appeal Br. 13–14 (Claims App.).

Claim 1, reproduced below with disputed limitation emphasized, is representative.

1. A method of controlling pool or spa equipment, comprising:

a. providing a controller configured to communicate wirelessly in each of the following communication manners: (i) a first communication manner in which the controller communicates directly with a mobile device; and (ii) a second communication manner in which the controller communicates indirectly with the mobile device via the Internet and a router communicatively connected to the Internet;

*b. manually engaging a switch of the controller so as to selectively configure the controller from communicating in the second communication manner to communicating in the first communication manner;*

c. causing a communicative connection between the controller and the pool or spa equipment; and

d. causing transmission of information, from the mobile device to the controller, for further transmission to the pool or spa equipment so as to change an operating characteristic of the pool or spa equipment.

*Id.* at 13 (emphasis added).

#### REFERENCES AND REJECTION

The Examiner relies upon the following references in rejecting the claims:

<b>Name<sup>3</sup></b>	<b>Number</b>	<b>Pub'd</b>	<b>Filed</b>
Keirstead	US 2011/0195664 A1	Aug. 11, 2011	Feb. 7, 2011
Yamasaki <sup>4</sup>	US 2015/0110074 A1	Apr. 23, 2015	Dec. 30, 2014

Specifically, claims 1, 6, 15, and 16 stand rejected as unpatentable under 35 U.S.C. § 103 as obvious over the combined teachings of Keirstead and Yamasaki. Final Act. 2–7.

Appellant contests the obviousness rejection of independent claim 1 and relies on the alleged deficiencies in the rejection of the independent claim to overcome the rejection of the dependent claims. Appeal Br. 12. Because we determine that affirmance of the rejection of independent claim 1 is dispositive, except for our ultimate decision, we do not discuss the

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<sup>3</sup> All reference citations are to the first named inventor only.

<sup>4</sup> Yamasaki claims the benefit of a foreign priority application filed July 2, 2012.

merits of the rejection of claims 6, 15, and 16 further herein. We review the appealed rejection of independent claim 1 for error based upon the issues identified by Appellant, and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential). Arguments not made are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv). Unless otherwise indicated, we adopt the Examiner’s findings in the Final Action and the Answer as our own and add any additional findings of fact for emphasis. We address the rejection of claim 1 below.

## ANALYSIS

### *1. Obviousness of Claim 1 Over Keirstead and Yamasaki*

As noted above, the Examiner rejects independent claim 1 as obvious over the combined teachings of Keirstead and Yamasaki. Final Act. 4–6. The Examiner finds that Keirstead teaches or suggests limitations (a), (c), and (d), as recited in claim 1. *Id.* at 4 (citing Keirstead ¶¶ 7, 29, 30, 35, 47, Figs. 3, 4A). However, the Examiner acknowledges that Keirstead “does not explicitly teach:

b. manually engaging a switch of the controller so as to selectively configure the controller from communicating in the second communication manner to communicating in the first communication manner.” *Id.* at 4–5.

Nevertheless, the Examiner finds that Yamasaki teaches or suggests this limitation. *Id.* at 5 (citing Yamasaki ¶¶ 68, 73, Fig. 5). Further, the Examiner finds that a person of ordinary skill in the relevant art would have had reason to combine the teachings of Keirstead and Yamasaki to achieve the method recited in claim 1. *Id.* at 5–6 (citing Yamasaki ¶ 6).

Appellant contends that the Examiner erred in rejecting claim 1 as obvious over the combined teachings of Keirstead and Yamasaki for three

reasons. Appeal Br. 6–12; Reply Br. 3–6. For the reasons given below, we are not persuaded of dispositive Examiner error.

*a. Keirstead Does Not Teach Away From the Proposed Combination with Yamasaki*

Appellant contends:

Clear is that the system of the Keirstead application selects the communications means automatically based on proximity, avoiding use of any manually-engageable switch. As stated in the Keirstead application:

If the wireless device 6 is in the proximity of the spa 1 (refer to circle marked A), the wireless device 6 communicates with the spa 1 directly. If the wireless device 6 is not in the proximity of the spa 1 but is in the proximity of the home server 31 (refer to circle marked B), the wireless device 6 communicates with the spa 1 through the home server 31. If the wireless device 6 is not in the proximity of the home server 31, the wireless device communicates with the spa 1 through Internet networks 32.

*See* Keirstead, p. 4, ¶ 0047; *see also id.*, Figs. 4A-B. No manually-engageable switch thus is even contemplated by the Keirstead application, as none is needed. The automatic selection disclosed by the Keirstead application hence teaches away from using a manually-engageable switch to do so, precluding any *prima facie* basis from existing for any obviousness rejection based on its teachings.

Appeal Br. 6–7. We disagree.

Although Keirstead discloses that the wireless device may select a communications manner automatically, Appellant does not show that Keirstead is limited to this selection method. Further, we do not find where Keirstead discloses that it is limited to automatic selection or prohibits manual selection of a communication manner.

“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 Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). “The fact that the motivating benefit comes at the expense of another benefit, however, should not nullify its use as a basis to modify the disclosure of one reference with the teachings of another. Instead, the benefits, both lost and gained, should be weighed against one another.” *Winner Int’l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 n. 8 (Fed. Cir. 2000); *see DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1327 (Fed. Cir. 2009) (“A reference does not teach away . . . if it merely expresses a *general preference* for an alternative invention[.]” (emphasis added)).

Initially, we note that, to the extent an embodiment disclosed in Keirstead implies a preference for automatic, rather than manual, switching; we do not find Keirstead’s teachings limited to a single embodiment. Such a preference does not amount to a teaching away. *Ans. 3* (citing *In re Mouttet*, 686 F.3d 1322, 1334 (Fed. Cir. 2012) (“[J]ust because better alternatives exist in the prior art does not mean that an inferior combination is inapt for obviousness purposes.”)); *see Appeal Br. 8* (“The Examiner does not dispute that systems of the Keirstead application state ‘preferences’ for wholly automatic switching, clearly diminishing any motivation for a skilled artisan to do the opposite.”). Further, we note that Keirstead teaches the use of manual selection means in other contexts, and Appellant does not show Keirstead expressly disparages such means in any context. *See Ans. 4* (citing Keirstead ¶ 38, Fig. 4B(i)).

Here, we are not persuaded that Keirstead’s relative silence regarding the means of selection of a communication manner would have discouraged a person of ordinary skill in the relevant art from following the path set out in Yamasaki or would have led such a person in a direction divergent from the path that was taken by Appellant. *See* Appeal Br. 7 (citing *Polaris Indus., Inc. v. Arctic Cat, Inc.*, 882 F.3d 1056, 1069 (Fed. Cir. 2018)). Consequently, we are not persuaded that Keirstead teaches away from its combination with the teachings of Yamasaki to achieve the method recited in claim 1.<sup>5</sup>

*b. Combining Yamasaki’s “Touch Panel” Teaching With Keirstead’s Teachings Would Lead to “Optimum” Communications Means*

Appellant contends:

Although the Examiner contends that such a skilled person would do so ‘in order to select *optimum* wireless communications means,’ *see* [Final Act. 6 (quoting Yamasaki ¶ 6 (emphasis added by Appellant))], this would not result from adding a manually-engageable touch panel to the system of the Keirstead application. Indeed, that system already automatically selects the optimal communications path based on proximity (presumably as a proxy for signal strength), so any manually-engageable switch necessarily would change the automatic optimal selection to some other non-optimum path.

Appeal Br. 8–9; *see* Reply Br. 5–6. Appellant, however, misunderstands the Examiner’s combination of Keirstead’s and Yamasaki’s teachings.

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<sup>5</sup> Generally, replacing a manual activity with an automatic or mechanical means is not sufficient to distinguish over the prior art. MPEP § 2144.04(III) (citing *In re Venner*, 262 F.2d 91, 95 (CCPA 1958)). The converse also seems generally true.

Yamasaki discloses:

[I]t is expected that electronic appliances having a wireless communication function in conformity with a conventional wireless LAN standard and a wireless communication function in conformity with a WiGig standard will come into use in future. As a result, a technology of selecting optimum wireless communication means will be required in the wireless communication apparatus which has a plurality of wireless communication means. . . . In this case, the communication control unit switches over the priority based on the information about a location to use the wireless communication apparatus input from the user operation unit and controls the communication means selecting unit according to the priority after the switch-over process.

Yamasaki ¶ 6; *see* Final Act. 6; Ans. 5. Thus, Yamasaki teaches that the switch from one communication manner to another may be achieved by the “communication control unit,” and, referring to step S1 of Figure 5, Yamasaki further teaches that this switching may be achieved by input and output unit 280 that may include a touch panel. Yamasaki ¶¶ 68, 73; *see* Final Act. 5; Ans. 5. Therefore, the Examiner persuades us that a person of ordinary skill in the relevant art would have understood Yamasaki to teach that a touch panel, e.g., a manual switching means, may be used to achieve desirable switching to an optimum communication means.

*c. Yamasaki Is Analogous Art*

In order to rely on a reference as a basis for rejection of the applicant’s invention, the reference must either be in the field of the applicant’s endeavor *or*, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.

*In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992) (emphasis added).

Appellant contends that Yamasaki is neither in the same field of endeavor

nor reasonably pertinent to the problem with which claim 1 is concerned. Appeal Br. 9–10. We disagree.

The Examiner finds that Keirstead, Yamaguchi, and the instant application are related to the field of communicating using multiple communication protocols and the teachings of Yamasaki are reasonably pertinent to the particular problem with which Keirstead and the instant application are related, namely, “selecting a wireless communication means among multiple wireless communication means.” Ans. 6. Although we agree with Appellant that the Examiner’s identification of the field of endeavor may be somewhat broad, we are persuaded that the Examiner is correct in finding that the teachings of Yamasaki are reasonably pertinent to the problem with which claim 1 and Keirstead are concerned. *See* Yamasaki ¶¶ 6, 17, 58; Keirstead ¶¶ 29, 30, 47; Spec., 1:19–2:7. Thus, we are persuaded that Yamasaki is analogous art.

We are not persuaded that the Examiner erred in rejecting claim 1, as obvious over the combined teachings of Keirstead and Yamasaki. Consequently, we sustain the obviousness rejection of claim 1.

## 2. *Dependent Claims 6, 15, and 16*

Each of claims 6, 15, and 16 depends directly from independent claim 1. Appeal Br. 13–14 (Claims App.). As noted above, Appellant challenges the rejection of dependent claims 6, 15, and 16 for the same reasons as their base claim. *See id.* at 12. Because we are not persuaded the Examiner erred with respect to the obviousness rejection of claim 1, we also are not persuaded the Examiner erred with respect to the obviousness rejection of claims 6, 15, and 16. For this reason, we sustain the rejection of those claims.

DECISIONS

1. The Examiner did not err in rejecting claims 1, 6, 15, and 16 as obvious over the combined teachings of Keirstead and Yamasaki.
2. Thus, on this record, claims 1, 6, 15, and 16 are unpatentable.

CONCLUSION

For the above reasons, we affirm the Examiner's decision rejecting claims 1, 6, 15, and 16.

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>References</b>	<b>Affirmed</b>	<b>Reversed</b>
1, 6, 15, 16	103	Keirstead, Yamasaki	1, 6, 15, 16	

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