

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ASIL T. GOKCEBAY  
and YUCEL K. KESKIN

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Appeal No. 2000-2194  
Application No. 08/705,843

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ON BRIEF

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Before FLEMING, RUGGIERO, and DIXON, Administrative Patent Judges.  
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-15, which are all of the claims pending in the present application.

The claimed invention relates to a mechanical key device formed as a solid unit and fitted for insertion into the cylinder of a lock. The key head of the mechanical key device includes a microprocessor, a memory and battery, and a contact point for a one-wire bus connection with the lock. On insertion of the key

into the lock, an electronic identification code of the lock is read and compared with identification information stored in the key head memory to determine whether the lock is authorized to be opened.

Claim 1 is illustrative of the invention and reads as follows:

1. A mechanical key device formed as a solid unit and fitted for insertion into a lock cylinder, comprising;

(a) a key blade with mechanical bitting to fit a pattern of a lock cylinder,

(b) a key head fixed to the key blade,

(c) the key head including electrical contact means for engaging with a contact of a lock cylinder, leading to electronics in the lock cylinder and to an electrically-operated blocking device in the lock cylinder, in a one-wire bus connection, and a battery in the key head,

(d) microprocessor means in the key head, powered by the battery, and data storage means connected to the microprocessor means,

(e) a keypad on the key head with means for data entry,

(f) the battery being connected to power the microprocessor means and keypad and data storage means, and

(g) the microprocessor means and data storage means having means for reading an electronic ID code of a lock when the one-wire bus connection is made, and for looking up the read ID code in the data storage means and for making a yes or no decision, based on the content of the data storage means, as to whether the lock is authorized to be opened, and if so, for sending a prescribed data signal to the lock electronics and power from the battery to the lock's blocking device, to allow opening of the lock.

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The Examiner relies on the following prior art:

Gelhard et al. (Gelhard)	4,663,952	May 12 1987
Seckinger et al. (Seckinger)	4,686,358	Aug. 11, 1987
Clarkson et al. (Clarkson)	4,712,398	Dec. 15, 1987
Larson et al. (Larson)	4,727,368	Feb. 23, 1988
Hyatt, Jr. et al. (Hyatt)	5,140,317	Aug. 18, 1992

Claims 6-12, 14, and 15 stand finally rejected under 35 U.S.C. § 112, first paragraph, as being based on an inadequate disclosure. Claims 1-5 and 13 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Hyatt taken in combination with Gelhard, Larson, Clarkson, and Seckinger.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs<sup>1</sup> and Answer for the respective details.

#### OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, the arguments in support of the rejections, and the evidence of obviousness relied upon by the Examiner as support for the obviousness rejection. We have, likewise, reviewed and taken into consideration, in reaching our

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<sup>1</sup> The Appeal Brief was filed December 2, 1999 (Paper No. 19). In response to the Examiner's Answer dated February 29, 2000 (Paper No. 20), a Reply Brief was filed April 24, 2000 (Paper No. 21), which was acknowledged and entered by the Examiner as indicated in the communication dated May 25, 2000 (Paper No. 22).

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decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that Appellants' specification in this application describes the invention set forth in claims 6-12, 14, and 15 in a manner which complies with the requirements of 35 U.S.C. § 112. We are also of the conclusion that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims 1-5 and 13. Accordingly, we reverse.

We consider first the Examiner's rejection of claims 6-12, 14, and 15 under the written description requirement of the first paragraph of 35 U.S.C. § 112. The function of the written description requirement of the first paragraph of 35 U.S.C. § 112 is to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him. In re Wertheim, 541 F. 2d 257, 262, 191 USPQ 90, 96 (CCPA 1976).

The genesis of the Examiner's 35 U.S.C. § 112, first paragraph, rejection was an amendment filed November 23, 1998 during prosecution which added the language "... since the coin

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counter is separate and independent and not connected to the lock electronics" to page 13, line 5 of the specification. This portion of the specification relates to the parking meter coin counter embodiment of the invention, and similar amendatory language was also added to independent claim 6 before us on appeal.

The Examiner has taken the position (Answer, pages 3, 4, 8, and 9) that the independent relationship of the coin counter and infrared transmitter to the lock electronics is not supported by any description in the specification as originally filed. Upon careful review of the language in question in claim 6 in light of Appellants' disclosure, we are in agreement with Appellants' position as stated in the Briefs.

The operation of the coin counter embodiment of Appellants' invention is illustrated in the flow charts depicted in Figures 15 and 16, along with the accompanying description at pages 12, 13, 37, and 38 of the specification. As described, an operator inserts a key into the lock, reads the data from the cash counter, and stores the read data in the memory of the key. As a part of a secondary audit, the key is inserted into the lock and the previously read cash counter data is fed back into the lock and stored in the lock memory. We find to be compelling Appellants' assertion (Brief, pages 17 and 18; Reply Brief, pages 3 and 4) that

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the skilled artisan would recognize and appreciate that if the connection between the coin counter and lock memory were not independent, a position taken by the Examiner, there would be no need to load the information from the key memory back into the lock device. In other words, if the lock memory already has the coin collecting information through a dependent connection with the coin counter mechanism, the loading of such information from the key back into the lock memory would be unnecessary.

In our opinion, under the factual situation presented in the present case, Appellants have satisfied the statutory written description requirement because they were clearly in possession of the claimed invention at the time of filing of the application. Therefore, the Examiner's rejection of claims 6-12, 14, and 15 based on the "written description" requirement of the first paragraph of 35 U.S.C. § 112 is not sustained.

Turning to a consideration of the Examiner's rejection of appealed claims 1-5 and 13 under 35 U.S.C. § 103(a), we note that in rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v.

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John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to independent claims 1 and 5, Appellants' response to the Examiner's obviousness rejection asserts a failure by the Examiner to set forth a prima facie case since proper motivation for the proposed combination of references has not been established. After careful review of the applied prior art

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references in light of the arguments of record, we are in agreement with Appellants' position as stated in the Briefs.

Initially, we find that the Examiner has not established how and in what manner the skilled artisan would have been motivated and found it obvious to modify Hyatt with Gelhard and Larson. In attempting to cure the deficiencies of the disclosure of Hyatt, which does not include principal electronic components in the key head as presently claimed, the Examiner adds Gelhard as providing a disclosure of disposing key electronics in a key head. As pointed out by Appellants (Brief, page 9; Reply Brief, page 6), however, no decision making operations by the key head microprocessor are disclosed by Gelhard. Further, while Larson discloses a "key" structure which functions to operate a real estate lock box, such disclosed "key" structure is not a mechanical key as defined by Appellants. In our opinion, the solutions to solving a key-lock security and authorization problem by Hyatt, Gelhard, and Larson are so opposite in approach that any attempt to combine them could only come from Appellants' own disclosure and not from any teaching or suggestion in the references themselves.

We have also reviewed the Seckinger and Clarkson references added to the proposed combination by the Examiner as providing teachings of, respectively, a key head located battery and a lock

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cylinder located blocking device. We find nothing in these references which would cure the previously discussed deficiencies in Hyatt, Gelhard, and Larson.

Further, it is our opinion that even assuming, arguendo, that proper motivation was established for the Examiner's proposed modification of references, the resulting combination would not satisfy the requirements of appealed independent claims 1 and 5. Each of claims 1 and 5 requires the powering of the lock's blocking device from the battery located in the key head, a feature lacking in any of the applied prior art references. In Larson, the battery is located in the bodily carried electronics pack, while Gelhard has no disclosure of battery power at all. The Larson reference does disclose a battery in the "key" element, but such battery does not power the lock. Similarly, although Seckinger does teach a battery in a key head, neither Seckinger nor Clarkson disclose the supplying of power to a lock from a battery located in the key head.

For all of the above reasons, it is our opinion that the Examiner has not established a prima facie case of obviousness since all of the limitations of the appealed claims are not taught or suggested by the applied prior art. Accordingly, the Examiner's

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35 U.S.C. § 103(a) rejection of independent claims 1 and 5, as well as claims 2-4 and 13 dependent thereon, is not sustained.

In summary, we have not sustained the Examiner's 35 U.S.C. § 112, first paragraph, rejection of claims 6-12, 14, and 15, nor the 35 U.S.C. § 103(a) rejection of claims 1-5 and 13. Therefore, the decision of the Examiner rejecting claims 1-15 is reversed.

REVERSED

MICHAEL R. FLEMING	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
JOSEPH F. RUGGIERO	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JOSEPH L. DIXON	)	
Administrative Patent Judge	)	

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**JUDGE RUGGIERO**

APPEAL NO. 2000-2194

APPLICATION NO. 08/705,843

APJ RUGGIERO

APJ DIXON

APJ FLEMING

DECISION: **REVERSED**

**PREPARED:** Sep 12, 2003

**OB/HD**

**PALM**

**ACTS 2**

**DISK (FOIA)**

**REPORT**

**BOOK**