

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENNETH P. WEISS

Appeal No. 1997-1117
Application No. 08/300,703¹

ON BRIEF

Before THOMAS, JERRY SMITH, and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-9, 12, 15-33, and 35-37, all of the claims pending in the present application. Claims 10, 11, 13, 14, and 34 have been canceled.

¹ Application for patent filed September 02, 1994. According to appellant, the application is a continuation of Application No. 07/911,208, filed July 9, 1992, now abandoned.

Appeal No. 1997-1117
Application No. 08/300,703

The claimed invention relates to a system for inhibiting unauthorized access to or utilization of a container or other protected device. More particularly, Appellant indicates at pages 7-11 of the specification that the state of a free standing lock or other provided control is varied in response to receipt of a dynamic non-predictable code.

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

1. A free standing locking system for a container, said system permitting access to the container by at least one authorized individual, the system comprising:

means in the possession of each of said authorized individuals for generating a dynamic non-predictable code;

locking means for preventing access to said container;

means for releasing said locking means to permit access to the container, said means for releasing including means operative when an individual desires access to the container for receiving the current non-predictable code for the individual, means responsive to the received non-predictable code for verifying that the individual is authorized to have access to the container, and means responsive to verification that the individual is authorized access for releasing the locking means;

means for recording the time period since each release of said locking means;

means responsive to the recorded time period reaching a predetermined threshold for relocking said locking means; and

Appeal No. 1997-1117
Application No. 08/300,703

means responsive to said means for releasing for automatically opening said container and responsive to the recorded time period reaching said predetermined threshold for automatically closing said container.

The Examiner relies on the following prior art:

Tolson 1967	3,337,992	Aug. 29,
Elliot 1983 Mauer 14, 1989	4,366,595 4,803,902	Jan. 04, Feb.
Weiss 1991	5,023,908	Jun. 11,
Fumanelli 11, 1992	5,087,107	Feb.
Harder et al. (Harder) 1993	5,196,841	Mar. 23,
		(Filed May 29, 1990)
Warren 1993	5,225,825	Jul. 06,
		(Filed Oct. 17, 1990)

Claims 1, 2, 4, 6-9, 12, 15-33, and 35-37 stand finally rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Weiss, Harder, Elliot, Fumanelli, and Warren. Claim 3 stands finally rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Weiss, Harder, Elliot, Fumanelli, and Warren and further in view of Tolson. Claim 5 stands finally rejected under 35 U.S.C. § 103 as being

Appeal No. 1997-1117
Application No. 08/300,703

unpatentable over the combination of Weiss, Harder, Elliot, Fumanelli, and Warren and further in view of Mauer.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Brief² and Answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Brief along with the Examiner's

² The original non-compliant Appeal Brief was filed July 17, 1996 and was corrected by a Supplemental Appeal Brief filed May 11, 1999. We will refer to the original Appeal Brief as simply the Brief.

Appeal No. 1997-1117
Application No. 08/300,703

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 the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-9, 12, 15-29, 32, 33, and 35-37. We reach the opposite conclusion with respect to claims 30 and 31. Accordingly, we affirm-in-part.

Appellant has indicated (Brief, page 4) that, for the purposes of this appeal, the claims will stand or fall together in the following groups: Group I (claims 1-9, 12, and 15-26), Group II (claims 27-29 and 32), Group III (claims 30 and 31), Group IV (claims 33, 35, and 36) and Group V (Claim 37). Consistent with this indication, Appellant has made no separate arguments with respect to any of the claims within each group. Accordingly, we will consider the claims separately only to the extent that separate arguments are of record in this appeal. Dependent claims 2-9, 12, 15-26, 28, 29, 32, 35, and 36 have not been argued separately and, accordingly, will stand or fall with their base claim.

Appeal No. 1997-1117
Application No. 08/300,703

As a general proposition in an appeal involving a rejection under 35 U.S.C. § 103, an Examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to Appellant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

In making the obviousness rejection of representative independent claim 1 from Group I, the Examiner has pointed out the teachings of Weiss, Harder, Elliot, Fumanelli, and Warren, has reasonably indicated the perceived differences between this prior art and the claimed invention, and has provided reasons as to how and why the prior art references would have been modified and/or combined to arrive at the claimed invention (Answer, pages 2-6). In our view, the Examiner's analysis is sufficiently reasonable that we find that the

Appeal No. 1997-1117
Application No. 08/300,703

Examiner has at least satisfied the burden of presenting a prima facie case of obviousness. The burden is, therefore, upon Appellant to come forward with evidence or arguments which persuasively rebut the Examiner's prima facie case of obviousness. Arguments which Appellant could have made but elected not to make in the Brief have not been considered in this decision (note 37 CFR § 1.192).

Appellant's initial argument in response to the obviousness rejection of claim 1 (Brief, pages 5 and 6) asserts the individual deficiencies of Warren, Elliot, and Fumanelli in disclosing the various limitations of the claim. However, the Examiner has utilized these references in combination with each other along with Harder and Weiss. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In re Keller, 642 F. 2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., Inc., 800 F. 2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Appellant further attacks the Examiner's proposed combination by contending that the applied references are from relatively diverse arts and involve diverse technologies

Appeal No. 1997-1117
Application No. 08/300,703

(Brief, page 6). We do not agree. The test for non-analogous art is first whether the art is within the field of the inventor's endeavor and, if not, whether it is reasonably pertinent to the problem with which the inventor was involved. In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). A reference is reasonably pertinent if, even though it may be in a different field of endeavor, it logically would have commended itself to an inventor's attention in considering his problem because of the matter with which it deals. In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992). As pointed out by the Examiner (Answer, pages 8 and 9), all of the applied prior art references in the present instance are concerned with the security of enclosures or containers and/or the opening and closing of same. In our view, the skilled artisan would logically have consulted the teachings of all of the prior art references considering Appellant's concern with inhibiting unauthorized access to protected devices.

In view of the above discussion, it is our view that

Appeal No. 1997-1117
Application No. 08/300,703

the Examiner has established a prima facie case of obviousness with respect to independent claim 1 which remains un rebutted by any convincing arguments offered by Appellants.

Accordingly, the rejection of claim 1 under 35 U.S.C. § 103 is sustained. Since, as noted above, Appellant has grouped claims 1, 2-9, 12, and 15-26 as standing or falling together, claims 2-9, 12, and 15-26 fall with claim 1 in accordance with 37 CFR § 1.192(c)(7). Thus, it follows that the decision of the Examiner to reject claims 2-9, 12, and 15-26 under 35 U.S.C. § 103 is also sustained.

We now turn to a consideration of independent claim 27 (grouped together by Appellant with dependent claims 28, 29, and 32 as Group II) and independent claim 33 (grouped together with dependent claims 35 and 36 as Group III). After reviewing Appellant's arguments, we sustain the Examiner's obviousness rejection of these claims as well. Appellant's arguments center on the alleged deficiencies of the references in disclosing the claimed limitations requiring two levels of verification before recognizing a message as an authorized message for accessing a protected device. In particular, Appellant attacks the teachings of Warren which the Examiner

Appeal No. 1997-1117
Application No. 08/300,703

has relied on for disclosing the claimed two-level verification feature.

Upon careful review of the Warren reference, we are in agreement with the Examiner's position as stated in the Answer. The disclosure at column 16, lines 1-58 of Warren describes an initial access verification performed by comparing a portion of an input code with a stored access code and a second verification performed by determining whether access is permitted to a selected container by examining a "device" portion of the input code. Additionally, in our view, the description in column 16 of Warren has relevance to independent claim 33 which is directed to the verification of the input of a selected code and additional information. As alluded to by the Examiner at page 11 of the Answer, Warren provides for the enablement of control of a particular device according to the input of an additional "device" code after analysis of the input selected access code. Further, to the extent that Appellant is correct in challenging Warren's use of a dynamic non-predictable code, the disclosure of Weiss, which is included in the Examiner's proposed combination, provides a clear teaching of this feature. For the above

Appeal No. 1997-1117
Application No. 08/300,703

reasons, we sustain the Examiner's 35 U.S.C. § 103 rejection of independent claim 27 and dependent claims 28, 29, and 32 which stand of fall together with claim 27 as well as the rejection of independent claim 33 and claims 35 and 36 dependent thereon.

As to independent claim 37, grouped separately by Appellant, we find Appellant's arguments to be unpersuasive and sustain the Examiner's obviousness rejection of this claim as well. In our view, Warren provides a clear disclosure of the feature of programming and storing access codes providing for different levels of access for different personnel (e.g. Warren, column 5, lines 10-13, column 10, lines 11-20, column 16, lines 28-33, and column 17, lines 60-64).

Turning now to a consideration of dependent claims 30 and 31, grouped and argued separately by Appellant, we note that, while we found Appellant's arguments to be unpersuasive with respect to the obviousness rejection of claims 1-9, 12, 15-29, 32, 33, and 35-37, we reach the opposite conclusion with respect to claims 30 and 31. We agree with Appellant (Brief, page 8) that none of the prior art references provide for the

Appeal No. 1997-1117
Application No. 08/300,703

resetting of a "keep-alive" means in response to a means for verifying as required by the claims. The Examiner, aside from a broad general assertion at page 11 of the Answer, has never attempted to address how any of the limitations are taught or suggested by the references. We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a prior art reference, common knowledge or capable of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a prima facie case. In re Knapp-Monarch Co., 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961); In re Cofer, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966). Accordingly, since all of the limitations are not taught or suggested by the prior art, we do not sustain the obviousness rejection of dependent claims 30 and 31.

In summary, we have sustained the 35 U.S.C. § 103 rejection of claims 1-9, 12, 15-29, 32, 33, and 35-37, but have not sustained the 35 U.S.C. § 103 rejection of claims 30 and 31. Therefore, the Examiner's decision rejecting claims 1-9, 12, 15-33, and 35-37 is affirmed-in-part.

Appeal No. 1997-1117
Application No. 08/300,703

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JERRY SMITH)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	

Appeal No. 1997-1117
Application No. 08/300,703

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Appeal No. 1997-1117
Application No. 08/300,703

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Appeal No. 97-1117
Application No. 08/300,703

APJ RUGGIERO

APJ SMITH, JERRY

APJ THOMAS

DECISION: AFFIRMED-IN-PART
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s):
Prepared: December 5, 2000

Draft Final

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OB/HD GAU

PALM /ACTS 2/BOOK
DISK(FOIA)/REPORT