

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JUNG-GUN BYLIN

Appeal No. 2002-1280
Application 08/995,996¹

HEARD: September 11, 2003

Before HAIRSTON, BARRETT, and GROSS, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1, 3-5, 8, 9, 12, and 13.

Claims 2, 6, 7, 10, 11, and 14 have been canceled.

¹ Application for patent filed December 22, 1997, entitled "Remote Control System Operating With User Defined Code Signal And The Method Of Controlling The Same," which claims the foreign filing priority benefit under 35 U.S.C. § 119 of Republic of Korea Application 69879/1996, filed December 21, 1996.

We reverse.

BACKGROUND

The invention relates to a remote control system for controlling an apparatus exclusively among a plurality of the same types of apparatus at a given location, such as controlling one television among several televisions as shown in Fig. 1.

Claim 1 is reproduced below.

1. A remote control system for controlling an apparatus exclusively among a plurality of a same type of apparatuses at a given location, said system comprising:

a transmitter including a keypad having a code setting key, a control function key and a plurality of data input keys, said transmitter being responsive to user operation of said code setting key for establishing a user defined code setting mode in which said transmitter is responsive to user entry into the transmitter by means of such data input keys of a user defined code for setting and storing the user defined code in the transmitter and for transmitting the user defined code, and said transmitter being responsive to user operation of said control function key for establishing a control function mode in which said transmitter is responsive to user entry into the transmitter by means of said data input keys of a control function for transmitting a coded signal that includes the user defined code and a scan code representing the control function entered by the user; and

a receiver incorporated into the apparatus and having a user defined code setting mode responsive to reception of the user defined code transmitted by the transmitter for setting and storing the user defined code in the receiver, said receiver receiving and responding to the coded signal generated by the transmitter;

wherein, once the user defined code is stored in both the transmitter and receiver, the received user defined code in the received coded signal is compared to the user defined

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code set in the receiver, and the control function is carried out only when the received user defined code matches the user defined code stored in the receiver.

The examiner relies on the following references:

Karasawa et al. (Karasawa)	4,786,900	November 22, 1988
Drori	5,146,215	September 8, 1992

Claims 1, 3-5, 8, 9, 12, and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Drori and Karasawa.

We refer to the final rejection (Paper No. 17) (pages referred to as "FR__") and the examiner's answer (Paper No. 23) (pages referred to as "EA__") for a statement of the examiner's rejection, and to the brief (Paper No. 22) (pages referred to as "Br__") and reply brief (Paper No. 28) (pages referred to as "RBr__") for a statement of appellant's arguments thereagainst.

OPINION

Grouping of claims

The examiner finds that appellant has not provided separate arguments supporting the statement that the claims do not stand or fall together (EA2). Appellant responds that separate arguments are provided in the sub-section entitled "Grouping of Claims" appearing in section VIII of the appeal brief (RBr2).

The rules provide that "[m]erely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable." 37 C.F.R. § 1.192(c)(7) (2000). The discussion in the "Grouping of Claims" in section VIII of the

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brief merely points out what the claims cover and does not separately argue the patentability of the claims. Accordingly, pursuant to § 1.192(c)(7), we treat the claims as falling together with claim 1, but exercise our judgment in determining whether the claims stand together with claim 1.

The examiner's statement that "[a] finding that the appellant's arguments do not overcome the rejection of claim 1 for example would also be a finding that the appellant's arguments fail to overcome the rejection of the other claims" (EA3) is incorrect as a general proposition since, for example, dependent claims add limitations which may make the subject matter patentable. However, since only claim 1 is at issue, the examiner's statement is harmless error.

Obviousness

Contents of Drori and Karasawa

Drori teaches an electronically programmable remote control for a vehicle security system. In the prior art, transmitters and receivers operated on a permanently encoded security code (col. 1, lines 49-68). If a transmitter was lost it was necessary to obtain another transmitter and have it coded for that particular receiver, which was beyond the expertise of most users (col. 1, line 63 to col. 2, line 19). More importantly, if the user wanted to change the code because of a lost or stolen

transmitter, the receiver had to be sent to the manufacturer (col. 2, lines 19-23). The invention in Drori allows the receiver to be electronically programmed by the user without opening the transmitter and without coding the transmitter or changing or encoding the receiver (col. 2, lines 34-41).

Drori states (col. 7, lines 52-58):

The transmitter 10 generally comprises the encoder 16 which may be suitably encoded by the manufacturer so that the user is not required to encode the same. For this purpose, small switches may be provided on the encoder, or other means known in the art could be provided on the encoder for specifically generating an encoded signal.

One of ordinary skill in the art, reading this passage in conjunction with the background of the invention, would appreciate that this refers to the security code or "signature" code and that although, for simplicity, the user is not required to encode the transmitter, the user is not precluded from defining the code. The passage indicates that any means known in the art could be used to encode the transmitter, where we find that the "signature" code, when set by a user, corresponds to the claimed "user defined code" set during a "user defined code setting mode." Drori teaches that when the user desires to match a transmitter 10 to a receiver 14, the receiver is placed in the program mode (col. 17, lines 8-17), which we find corresponds to the claimed "user defined code setting mode." The receiver stores the "signature code" from the transmitter, which

corresponds to the claimed "user defined code." In use, the transmitter also transmits a "channel" code to perform a control function (col. 7, lines 19-27 & 44-49; col. 3, lines 31-37), which corresponds to the claimed "scan code." In the use mode, when the received "signature" code matches the stored signature code and the channel code matches the channel, a control function is carried out, such as arming or disarming the security system (col. 17, lines 32-52). Drori does not teach the specific code setting scheme recited in claim 1.

Karasawa teaches an electronic key apparatus in the form of a wristwatch which transmits a code (i.e., the key) for unlocking an electronic lock (abstract). A password is required before the code is transmitted (abstract). After properly entering the password, the code can be updated or set by pressing switch S1 in mode-selection mode m6 to enter item/code-update/set mode m10 and set the code with the keypad 3 (col. 8, line 56 to col. 9, line 47; col. 14, lines 16-40). In the mode-selection mode m6 the electronic lock can be released by pressing switch s5 (col. 9, lines 20-21). Thus, the transmitter in Karasawa has both a code setting mode and a control function mode.

The rejection

The examiner finds that Drori teaches sending a signature code and a function code to perform functions in a receiver, but

"does not specifically teach a user defined code setting function in the transmitter, where the user actually sets the codes from a key input" (FR3; EA4), but "Karasawa et al. teach (see column 14 lines 16-41 and fig. 21) setting user defined codes (in the transmitter) for locking devices in order to perform control operation from a key input or keypad" (FR3; EA4). "Therefore it would have been obvious to one of ordinary skill in the art to use user defined codes in the transmitter and receiver to control an apparatus remotely by inputting user defined code setting function as evidenced by Karasawa in the transmitter, in order to provide a security system and to set or update codes in the receiver for the purpose of controlling access permission as discussed by Drori, to control locking devices remotely to increase security" (FR4; EA4).

Analysis

After consideration of appellant's arguments, we agree with the examiner that it would have been obvious to set the signature code in the transmitter of Drori by a user with a keypad as taught by Karasawa. The motivation is found in Drori's express teaching that "other means known in the art could be provided on the encoder for specifically generating an encoded signal" (col. 7, lines 56-58) and, thus, it is not necessary to decide whether the examiner's stated motivation would be sufficient.

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The question remains whether the examiner is correct in assuming that the combination of Drori and Karasawa teaches all the features of the claimed invention. This requires us to address appellant's arguments. In particular, in the last argument, we find one claim limitation to be missing.

Appellant argues that it is not necessary for the user in Drori to know the specific code that is transmitted from the transmitter to the receiver, which is opposite to, and amounts to a teaching away from, the present invention where the user programs in the code (Br7-8; RBr4-5).

While Drori states that "the user is not required to encode the [transmitter]" (col. 7, lines 54-55), this is for the user's convenience because, as discussed in the background, most users do not have the skill to set codes. One of ordinary skill in the art would not interpret Drori to teach that the user cannot set the code. Thus, Drori does not teach away from the user setting the signature code. See In re Gurley, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994) ("A reference may be said to teach away when a person of ordinary skill, upon [examining] 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.").

At the oral hearing, it was argued that it would not make sense to allow the user to set the signature code because this

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would permit thieves to try to break into automobiles. This is not a technical reason indicating nonobviousness. See Orthopedic Equipment Co. v. United States, 702 F.2d 1005, 1013, 217 USPQ 193, 200 (Fed. Cir. 1983) ("[T]he fact that the two disclosed apparatus would not be combined by businessmen for economic reasons is not the same as saying that it could not be done because skilled persons in the art felt that there was some technological incompatibility that prevented their combination. Only the latter fact is telling on the issue of nonobviousness."); In re Farrenkopf, 713 F.2d 714, 718, 219 USPQ 1, 4 (Fed. Cir. 1983). Moreover, presumably the signature code is long enough to discourage such attempts.

Appellant disagrees with the examiner's statement that Karasawa teaches a method in which the user can set codes in a convenient manner because Karasawa requires the user to manually set the code in each device to be controlled by the user, which can hardly be considered a convenient technique (Br10; Br13). It is argued that the "receiver" of Karasawa does not have dual modes of code setting and control function (Br13).

The examiner only relies on Karasawa to teach the method of setting a code in the transmitter, not for everything that Karasawa teaches. It is agreed that the code has to be set manually in the receiver of Karasawa. Drori teaches a receiver having a code setting and control function mode.

Appellant argues that there is no motivation in the references to modify Drori, a single receiver in a vehicle receiving control signals from multiple transmitters, in view of Karasawa, which teaches controlling multiple receivers with a single transmitter (Br15-16; RBr8).

Drori teaches that "other means known in the art could be provided on the encoder for specifically generating an encoded signal" (col. 7, lines 56-58). This provides express motivation for using known ways of setting a code in Drori, such as the keypad input taught in Karasawa.

Appellant argues that a distinction between the present invention and Drori is that the transmitting unit, upon reception of the user defined code from the user, not only sets that code in the transmitting unit but also automatically transmits the code to the receiver to set the code (Br11; Br12; Br14; Br20).

The limitation in question is: "a user defined code setting mode in which said transmitter is responsive to user entry into the transmitter by means of such data input keys of a user defined code for setting and storing the user defined code in the transmitter and for transmitting the user defined code." The limitation that a user defined code is set and stored in the transmitter is clearly met by the combination. However, it does not appear that combination meets the limitation of "transmitting the user defined code" in a user defined code setting mode. The

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setting of the user defined code in the transmitter is not related to storing the user defined code in the receiver in either Drori or Karasawa. The examiner's rejection does not address the limitation of "transmitting the user defined code" in a user defined code setting mode even though appellant has argued the limitation several places. Although it may seem like a minor difference, every limitation must be considered in addressing obviousness. See In re Wilder, 429 F.2d 447, 450, 166 USPQ 545, 548 (CCPA 1970) ("every limitation positively recited in a claim must be given effect in order to determine what subject matter that claim defines"). Because the rejection does not address how the limitation of "transmitting the user defined code" in a user defined code setting mode in claim 1 is met by the combination, the examiner has failed to establish a prima facie case of obviousness. This limitation is also found in claims 9 and 12. Claim 5 does not recite "transmitting the user defined code" in a user defined code setting mode, but recites "transmitting the user defined code to the receiver, thereby activating a user defined code setting mode in the receiver" (emphasis added), which is not addressed by the rejection.

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In summary, we find that the examiner has failed to establish a prima facie case of obviousness as to the independent claims. The rejection of claims 1, 3-5, 8, 9, 12, and 13 is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS
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