

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JAMES PETER WARD  
and KERRY MALETSKY

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Appeal No. 2002-1695  
Application No. 08/971,386

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ON BRIEF

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Before BARRY, LEVY, and BLANKENSHIP, Administrative Patent Judges.  
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 and 2, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to a method and apparatus for deploying and tracking computers. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced as follows:

1. A method of deploying a workstation computer comprising the steps of:

connecting a dual port RF identification tag to a memory bus of the computer to provide for electrical communication between the RF identification tag and the computer;

storing user information in the dual port RF identification tag using an RF port without unpacking and applying power to the computer;

forwarding the computer to the end user workstation location; and

downloading software and user data to the computer after installing the computer hardware at the end user workstation location to tailor the workstation.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Anders et al. (Anders)	4,656,463	Apr. 7, 1987
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Fuller et al. (Fuller)	5,302,947	Apr. 12, 1994
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Appellants' Admitted Prior Art (APA) specification, pages 1 and 2

Claims 1 and 2 stand rejected under 35 U.S.C. § 103 as being unpatentable over Anders in view of the Admitted Prior Art (APA) and Fuller.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 15, mailed October 13, 2000) for the examiner's complete reasoning in

support of the rejection, and to appellants' brief (Paper No. 14, filed July 26, 2000) for appellants' arguments thereagainst. Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered, and are waived. See 37 CFR 1.192(a).

#### OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejection advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we reverse. Appellants assert (brief, page 4) that for the purposes of this appeal, claims 1 and 2 stand or fall together. Consistent with this assertion, appellants present arguments with respect to claim 1. Accordingly, we consider claim 1 to be representative of the group.

Turning to claim 1, 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. 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. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 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). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument

and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; 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).

The examiner's position (answer, page 4) is that the admitted prior art (APA) discloses that in the prior art, after a workstation has been forwarded to the user, software is downloaded after installing the hardware, and that label tags and serial numbers are used to identify the workstation for inventory purposes. The examiner asserts (id.) that in an analogous art, Anders discloses a system relating to identification for inventory. The examiner notes that Anders' teachings relate to the attachment of passive and active transceivers which can be coded, erased, recorded or altered and attached to various items as "tags," and the use of active transceivers for using and analyzing the information received from the passive transceivers. The examiner notes (id.) that Anders discloses operation of his system in the RF range, and asserts that Anders' passive receiver 90 meets the claimed "dual port RF identification tag." The examiner further asserts (answer, page 5) that Anders discloses various embodiments which locate tags in a multitude of

locations. The examiner specifically refers to the tags located on wires, disclosed in figure 23 of Anders. The examiner asserts (id.) that "[t]o connect the tags to a computer is well within the realm of knowledge gleaned from the Anders reference. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized a passive tag of Anders (connected to a buss[sic,]) for identifying the workstation discussed in the Admitted Prior Art in order to provide easy tracking and monitoring of the movement of workstations for inventory purposes as suggested by Anders." The examiner goes on to assert (id.) that in an analogous art, Fuller shows an RF transceiver which interfaces with a host computer, and that software and identification are downloaded to the host computer's memory to tailor the application. The examiner argues (answer, pages 5 and 6) that "it would have been obvious to one of ordinary skill in the art at the time of the invention to have the RF transceiver device above interface with the host computer to download software to tailor the host computer as suggested by Fuller, since this enables the transceiver to provide the host with software required to operate on a unique bases, thus simplifying the setup of the host computer."

Appellants assert (brief, page 5) that the cited prior art does not teach nor suggest all of the claim limitations of the present invention. Appellants note (id.) that claim 1 recites, inter alia, "'connecting a dual port RF identification tag to a memory bus of the computer to provide for electrical communication between the RF identification tag and the computer.'" Appellants assert (brief, page 6) that:

The Examiner's reliance on the Anders' Figure 23 and its accompanying description to teach connecting a RF identification tag to a computer's memory bus to provide a means for communicating between the tag and the computer is misplaced. Equating wires, without any more clarification or explanation, to a computer's memory bus cannot be logically inferred in light of Anders' Figure 23 and its accompanying description. Furthermore, there is no teachings in Anders to electrically coupled [sic,] the PTs to the wires that they are attached to, as required by the present invention. The PTs in Anders Figure 23 are utilized as they are disclosed to be, a means to identify the items that they are attached to; Anders' PTs are not meant to interact, i.e., communicate, electrically with their attached devices.

It is further argued (id.) that Anders, it appears, teaches attaching a PT to a computer's external components, e.g., the housing, and not to an internal component, such as the memory bus, and that there would be no motivation for one utilizing the teachings of Anders to attach the tag to the computer's memory

bus since the most advantageous placement for tracking the computer would be on the computer's external housing, which would be more readily accessible to an active transceiver.

In view of appellants arguments, the examiner (answer, pages 6 and 7) shifts position and acknowledges that Anders does not itself provide the motivation that appellants are seeking, but instead relies upon Fuller for the motivation to provide Anders with an RF transceiver attached to the memory bus of a computer.

From our review of Anders, we find that Anders is directed to a Location, Identification, measurement of the Movement of, Inventory and analytical, control guidance and sorting Systems (LIMIS), for system monitoring and control. The system relates to the use of passive transceivers (PTs) which can be coded, erased, recorded or altered and attaches to various items as "tags" (col. 1, lines 5-12). The system uses, inter alia, radio frequency, and uses both PTs and active transceivers (ATS) (col. 4, lines 1 and 2). The PTs are adhered to or embedded within the item to be identified (col. 4, lines 4-8). PTs can be adhered to numerous items including computers (col. 4, lines 22-30). ATs are designed to detect the PT within the useful limits of the PT's transmitter range (col. 4, lines 44-46). Anders further discloses (col. 8, lines 41-43) that some PTs will be connectable

to other system components. An example is when the PTs replace electronic components in test instruments and computers. Figure 5 depicts a flow diagram of AT 50 which conducts location, identification, inventory, motion detection and measurement and system functions (col. 22, lines 50-52). Shown in figure 8 is a drawing of a two room building surrounded by a fence 111. Taut wire 112 on fence 111 has PTs 135, which are embedded into fence 111. Numerous items in the drawing have PTs attached to them. Also shown is active transceiver 126-AT. In the system depicted, someone climbing over the fence will move wire 112 and displace chips 135. This position change is noted by AT 126 and an alarm is forwarded to a security service through automatic telephone dialer 120, or will broadcast an alarm at the building location. Similarly, if someone opens doors 128 or breaks window pane 132, the chips (PTs) 135 change position and an alarm is sounded (col. 27, lines 23-63).

Turning to Fuller, we find that the reference is directed to an apparatus and method for loading a software program from a radio modem to an external computer. As shown in figure 1, radio modem 100, includes an antenna 102 which receives RF signals (col. 2, lines 63-66). The radio modem has an interface which connects to an external computer through a PCMCIA bus 120 (col.

3, lines 35-37). When the modem is inserted into a PCMCIA slot 304 of external computer 302, the modem and computer are electrically coupled, as shown in figure 3 (col. 4, lines 1-6). Following coupling 402 of the modem 100 to computer 302, a data exchange takes place, in which microprocessor 108 of modem 100 receives an identification signal from the computer. In response, microprocessor 108 accesses non-volatile memory 122 of the modem to locate an identifier 126 that matches the identifier signal received from computer 302. If a matching identifier has been found, the microprocessor accesses the non-volatile memory and transmits the corresponding software driver program 124 to computer 302 through interface 118. When the compatible software driver program has been loaded into the computer, microprocessor 108 communicates further with the computer and enables the computer to access and execute a selected application program 128, after which microprocessor 108 ends its involvement in the process (col. 4, lines 7-54).

From the teachings of the prior art, we find that Anders is directed to providing PT tags on items to be identified and located by ATs in an inventory system. We agree with appellants that the disclosure in figure 23 of Anders of providing PTs on wires does not suggest attaching the PTs to the memory bus of a

computer. In addition, with respect to Fuller, we find the RF modem of Fuller to be a dual ported RF identification tag, that is connected to the memory bus of a computer, because of the dual inputs through the antenna and the interface 118 that connects to the memory bus of the computer. However, because Fuller is directed to using the radio modem to install software drivers and application programs after identifying a computer, we find no teaching or motivation to add the radio modem of Fuller to the inventory control system of Anders. In addition, as the examiner (answer, pages 6 and 7) has acknowledged that figure 23 of Anders does not suggest connecting the PTS of Anders to the bus of a computer, it is unclear as to which portion of Anders the examiner is relying upon.

From our review of Anders, we find that figure 14 of Anders is directed to a PT 187 and test unit 186 connected to an electronic component 185. Anders discloses (col. 32, lines 16 and 17) that the component could be a microcomputer or a mainframe computer. In addition, Anders discloses that part of the logic, testing, switching and checking circuitry of computer 185 includes "test unit" 186, and that unit 186 is connected to PT 187 through chip wiring. PT 187 has two functions, the first is to respond when interrogated by an AT. The second is to

broadcast an alarm signal when unit 186 indicates a substantial malfunction of computer 185. Units 187 and 186 utilize computer 185's logic circuits, which are part of the arithmetic logic unit of PT 187 (col. 32, lines 19-33). From this disclosure of Anders, taken with the disclosure that some PTs will be connected to other system components, when the units replace electronic components in computers (col. 8, lines 40-44) we find that Anders suggests that the PT 187 is connected through logic circuitry, either directly or through test unit 186, to the bus of computer 185. However, we find no suggestion to replace the PT of Anders with a RF modem of Fuller because doing so would destroy the operability of Anders, as the RF modem would not respond to the AT in an inventory system as a PT would, rendering Anders' system inoperable. In addition, we find no motivation to replace the PT with a RF modem because, although both devices are dual ported, an RF modem for adding software to a computer is vastly different from a passive transceiver (PT) in an inventory control system. The only motivation we find is from appellants' disclosure through the improper use of hindsight. "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed.

Cir. 1995) (citing W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983)). "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (citing In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991)).

In addition, we note that the RF modem of Fuller does not meet the claims because even though Fuller discloses connecting a dual port RF identification tag to the memory bus of a computer, and stores information in the RF tag before unpacking the computer by preloading program information into the modem, there is no disclosure of storing user information in the RF modem of Fuller. Although Fuller does download information into the computer, the information only includes downloaded software, and there is no disclosure of downloading user data to the external computer 302 of Fuller.

From all of the above, we find that the examiner has failed to establish a prima facie case of obviousness of claims 1 and 2. Accordingly, the rejection of claims 1 and 2 under 35 U.S.C. § 103(a) is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 and 2 under 35 U.S.C. § 103(a) is reversed.

REVERSED

LANCE LEONARD BARRY	)	
Administrative Patent Judge	)	
	)	
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	)	
	)	BOARD OF PATENT
STUART S. LEVY	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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HOWARD B. BLANKENSHIP	)	
Administrative Patent Judge	)	

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