

the opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte WINSLOW SCOTT BURLESON, DAVID JUN LU, and  
JOHN MARTIN MULLALY

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Appeal No. 2006-3093  
Application No. 10/754,306

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ON BRIEF

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Before JERRY SMITH, BARRY, and HOMERE, Administrative Patent Judges.  
JERRY SMITH, Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-4, 7, 16-19 and 66-69. Claims 5, 6, 8-15, and 20-65 have been cancelled.

## THE INVENTION

The disclosed invention pertains to a system and method for dynamic feedback projection from a hand-held pointing device.

Representative claims 1, 16 and 66 are illustrative:

1. A hand-held pointing device, comprising:
  - a processor;
  - a transmitter coupled to the processor;
  - a receiver coupled to the processor; and
  - a memory coupled to the processor, wherein the transmitter sends a signal to a remote device and the receiver receives a response signal from the remote device, the received response signal including remote device information identifying the remote device and available functions that may be performed by the remote device, and wherein the processor stores the remote device information in the memory.
  
16. A method of storing information in a hand-held pointing device, comprising:
  - sending a signal to a remote device;
  - receiving a response signal from the remote device, the received response signal including remote device information identifying the remote device and available functions that may be performed by the remote device; and
  - storing the remote device information in a memory.

66. A method of using a hand-held pointing device in cooperation with a remote device, comprising the steps of:
- sending, by the hand-held pointing device, a signal to the remote device;
- receiving, by the remote device, the signal from the hand-held device;
- sending, by the remote device, a response signal; and
- receiving, by the hand-held pointing device, the response signal from the remote device, the response signal received by the hand-held pointing device including remote device information identifying the remote device and available functions that may be performed by the remote device.

### **THE REFERENCES**

The examiner relies upon the following references:

Shintani	5,646,608	Jul. 8, 1997
Kitao et al. (Kitao)	6,160,491	Dec. 12, 2000 (filed Sep. 9, 1998)
Burleson et al. (Burleson)	6,717,528	Apr. 6, 2004 (filed Feb. 17, 2000)

### **THE REJECTIONS**

The following rejections are on appeal before us:

1. Claims 1 and 16 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 11 of U.S. Pat. No. 6,717,528 to Burleson.

2. Claims 1-4, 7, 16-19 and 66-69 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Shintani in view of Kitao.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the 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, the 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. 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 briefs have not been considered and are deemed to be waived. See 37 CFR § 41.37(c)(1)(vii)(2004). See also In re Watts, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

It is our view, after consideration of the record before us, that the evidence relied upon supports the examiner's rejection of the claims on appeal.

Accordingly, we affirm.

### **Nonstatutory obviousness-type double patenting rejection**

We agree that the examiner's nonstatutory obviousness-type double patenting rejection of claims 1 and 16 (as being unpatentable over claims 1 and 11 of U.S. Pat. No. 6,717,528 to Burleson) is appropriate on this record. However, we note that appellants have rendered this issue moot by filing a terminal disclaimer on May 18, 2006. The terminal disclaimer was accepted by the paralegal and entered in the record on May 25, 2006.

### **GROUPING OF CLAIMS**

We consider the obviousness of the following logical groups of claims, as defined under separate subheadings and argued separately by appellants in the briefs.

GROUP A: Claims 1-3, 7, 16-18 and 66-68 [brief, page 9].

GROUP B: Claims 4, 19, and 69 [brief, page 17].

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). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343, 61 USPQ2d at 1433-34. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the

prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). See also In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. See 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 and the relative persuasiveness of the arguments. 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).

**GROUP A**, claims 1-3, 7, 16-18 and 66-68

We consider first the examiner's rejection of claims 1-3, 7, 16-18 and 66-68 as being unpatentable over the teachings of Shintani in view of Kitao. We note that appellants have specifically designated claim 1 as the representative claim for this group [brief, page 9].

Appellants argue the proposed combination of Shintani and Kitao does not teach nor suggest the claimed feature of: "the received response signal including remote device information" [brief, page 9]. Appellants argue that claim 1 requires that the transmitter of the hand-held pointing device send out a signal to a remote device and, in response, the remote device sends a response signal to the hand-held pointing device [brief, page 10]. Appellants assert that the claimed response signal contains the remote device information identifying the remote device and available functions that may be performed by the remote device [id.]. Appellants argue that Shintani does not teach nor suggest this feature because Shintani does not teach nor suggest that the remote devices send out a response signal [id.]. Appellants also assert that Kitao is devoid of any disclosure regarding this claimed feature [id.].

The examiner disagrees [answer, page 8]. The examiner asserts that Shintani's remote control unit 51 receives a response signal that includes information identifying a remote device [id.]. The examiner notes that Shintani's light emitter 15E of electronic device 15 (see fig. 1, CD player) radiates infrared ID signals into the room space and remote control unit 51 detects the infrared ID signals and determines whether or not a control signal corresponding to the detected ID signal has been read from the memory [id.]. The examiner further notes that the CPU of remote control unit 51 controls the display information required to selectively operate the electronic device 15 that corresponds to the detected ID signal (col. 5 lines 12 to 38; see figs. 1 to 8) [id.]. The examiner concludes that one skilled in the art would have understood that remote control device 51 identifies the remote device 15 by the detected ID signal [id.] Thus, the examiner corresponds the ID signal that includes information identifying the remote device 15 to the claimed remote device information [id.].

In addition, appellants argue that because Shintani has no need to store the device codes and control codes of any electronic device, the examiner's proffered motivation fails to show how one of ordinary skill would have been led to combine the references [brief, page 14, reply brief, page 4, ¶3].

The examiner disagrees [answer, pages 10-12]. The examiner notes that Shintani is relied upon to teach the controlled device sending remote device information to the remote control and Kitao is relied upon to teach the controlled device is responding to a signal (i.e., a trigger signal) sent from the remote control where the response signal transmitted from the controlled device includes device and function information [answer, page 10, cont'd page 11]. The examiner maintains that it would have been obvious to a person of ordinary skill in the art to modify Shintani to receive Kitao's control code table from a remote control interface of an electronic device to eliminate the memory space required to store numerous device code and associated control code tables onboard the remote control [answer, page 12].

At the outset, we do not agree with appellants' assertion that Shintani fails to teach or suggest the remote (i.e., controlled) devices send out a response signal (i.e., to the remote control) where the received response signal includes remote device information [see brief, page 9]. We find that appellants arguments have narrowly focused on a single (i.e., passive) embodiment disclosed by Shintani. In particular, we note the language of Shintani's claim 3 (as copied in appellants'

brief on page 11) that specifically discloses a response signal that includes identification signals (i.e., remote device information) that is sent in response to a remote control presence signal:

3. The system of claim 2 further comprising room remote control unit presence detecting means for causing said plurality of devices to transmit their respective identification signals in response to a remote control presence signal [emphasis added].

Likewise, we further note that Shintani's claim 9 (col. 9, lines 4-9) specifically discloses the transmission of a response signal that includes device identification signals (i.e., remote device information) that is sent in response to the transmission of a device identification roll call signal by the remote control unit:

9. A method according to claim 8, wherein said step of causing the electronic devices to output signals comprises the step of causing the electronic devices to output infrared radiations as said device identification signals in response to transmission of a device identification roll call signal by said remote control unit [emphasis added].

Accordingly, we find that the examiner's proffered combination of Shintani and Kitao teaches all that is claimed with respect to representative claim 1.

Furthermore, we do not agree with appellants that the examiner has failed to provide a proper motivation for combining the references. We note that the Court

of Appeals for the Federal Circuit has determined that the motivation to combine under §103 must come from a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor. Ruiz v. A.B. Chance Co., 234 F.3d 654, 665, 57 USPQ2d 1161, 1167 (Fed. Cir. 2000) [emphasis added]. In the instant case, we agree with the examiner that it would have been obvious to an artisan to modify Shintani to receive Kitao's control code table from a remote control interface of an electronic device to eliminate the memory space required to store numerous device code and associated control code tables onboard the remote control.

In particular, we note that appellants have admitted in the reply brief: "Shintani does state that data needed to control the remote devices are stored in the NVRAM 74 of the remote controller" [reply brief, page 4, ¶1]. We further note Kitao explicitly discloses that downloading control tables to the built-in memory of remote controller 100 "eliminates the necessity of storing control code tables of many electronic devices in a memory of the remote controller 100 in advance" [and therefore] "remote controller 100 does not require a large memory in order to

control many types of electronic devices” [col. 8, lines 49-53]. We find that the advantage of conserving memory space would have been well within the general knowledge of a person of ordinary skill in the field of the invention, in addition to being explicitly taught by the Kitao reference at col. 8, lines 49-53. Therefore, we find that the examiner has met his/her burden of establishing a prima facie case of obviousness. Accordingly, we will sustain the examiner’s rejection of representative claim 1 as being unpatentable over Shintani in view of Kitao.

We further note that appellants have not presented any substantive arguments directed separately to the patentability of dependent claims 2, 3, 7, 16-18 and 66-68. In the absence of a separate argument with respect to the dependent claims, those claims stand or fall with the representative independent claim. See In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). See also 37 CFR § 41.37(c)(1)(vii)(2004). Therefore, we will sustain the examiner’s rejection of these claims for the same reasons set forth by the examiner in the rejection.

**GROUP B**, claims 4, 19 and 69

Lastly, we consider the examiner's rejection of dependent claims 4, 19 and 69 as being unpatentable over the teachings of Shintani in view of Kitao. We note that appellants have specifically designated claim 4 as the representative claim for this group [brief, page 17].

Appellants argue that neither Shintani nor Kitao show or suggest the claimed feature of: "the new remote device information is appended to the remote device information in the memory" [brief, page 17]. Appellants also restate their previous argument that there is no motivation to modify Shintani with the teachings of Kitao [brief, page 18].

The examiner disagrees [answer, page 13]. The examiner notes that Shintani discloses if the detected ID signal is not registered in NVRAM 74, then CPU 71 reads a control signal corresponding to the detected ID signal from ROM 72 and registers the control signal in NVRAM 74 (col. 5, lines 20-24) [id.]. The examiner concludes that a new response signal has new remote device information that is registered to the NVRAM [id.].

In addition, the examiner notes that Kitao's remote controller 100 downloads a control code table from the electronic device and stores the table in a built-in memory of the remote controller (e.g., see col. 8, lines 23-30) [id.]. The examiner notes that Kitao's design eliminates the necessity of storing many control code tables for numerous electronic devices in a memory of remote controller 100 [id.]. The examiner further notes that if an electronic device adopts a new control code table, remote controller 100 can download the new control code table from the device (col. 8, lines 53-56) [id.]. Thus, the examiner concludes that Kitao discloses new remote device information is appended to the control code table RAM 203 of remote controller 100 [id.].

After carefully reviewing all of the evidence before us, we will sustain the examiner's rejection of representative claim 4 for essentially the same reasons argued by the examiner in the answer. We note that Kitao explicitly discloses downloading a control table from a new electronic device to the memory of remote controller 100 [col. 8, lines 46-57]. Thus, we find that Kitao teaches the new electronic device control table is appended to the existing "plurality of control code tables" stored in the memory of remote controller 100 [see col. 8, lines 41-43: i.e.,

“plural control code tables which define the relationship between functions of a plurality of electronic devices,” emphasis added]. We note that we have fully addressed supra appellants’ argument that the examiner has failed to provide a proper motivation to combine the references. Therefore, we agree with the examiner that the subject matter of representative claim 4 is unpatentable over Shintani in view of Kitao.

We further note that appellants have not presented any substantive arguments directed separately to the patentability of dependent claims 19 and 69. In the absence of a separate argument with respect to the dependent claims, those claims stand or fall with the representative independent claim. See In re Young, 927 F.2d at 590, 18 USPQ2d at 1091. See also 37 CFR § 41.37(c)(1)(vii)(2004). Therefore, we will sustain the examiner’s rejection of these claims for the same reasons set forth by the examiner in the rejection.

In summary, we have sustained the examiner’s rejection of all the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-4, 7, 16-19 and 66-69 is affirmed.

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.

JERRY SMITH  
Administrative Patent Judge

LANCE LEONARD BARRY  
Administrative Patent Judge

JEAN R. HOMERE  
Administrative Patent Judge

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