

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MISKIA HILTUNEN and HEIKKI TUOMINEN

Appeal 2007-2752
Application 10/363,742
Technology Center 2600

Decided: January 28, 2008

Before ANITA PELLMAN GROSS, ROBERT E. NAPPI, and MARC S. HOFF,
Administrative Patent Judges.

NAPPI, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 6(b) (2002) of the final rejection of claims 1 through 19. We affirm.

INVENTION

The invention is directed to a portable radio phone system where one device can make use of the Subscriber Identification Module (SIM) in another device

without removing the SIM. See pages 1 and 2 of Appellants' Specification. Claim 1 is representative of the invention and reproduced below:

1. A system comprising a first device and a second device having an electronic data card associated therewith, information on the electronic data card being usable by and accessible by the first device; a wireless link for enabling communication between the first device and the second device; wherein the first device is arranged to control the operating characteristics of the electronic data card of the second device via the wireless link.

REFERENCES

Ritter	US 6,859,650 B1	Feb. 22, 2005
Beaujard	US 6,557,753 B1	May 6, 2003
Hohle	US 6,101,477	Aug. 8, 2000

REJECTIONS AT ISSUE

Claims 1, 6 through 13, and 16 through 18¹ stand rejected under 35 U.S.C. § 102(e) as being anticipated by Ritter. The Examiner's rejection is set forth on pages 3 and 4 of the Answer.

Claims 2, 3, 14, and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ritter in view of Beaujard. The Examiner's rejection is set forth on pages 5 and 6 of the Answer.

¹ The statement of the rejection only includes claims 1 and 11 through 13; however the analysis supporting the rejection identifies claims 6 through 10 and 16 through 18 as being included in the rejection. Appellants' Brief, page 9 also identifies that claims 16 through 18 are included in the anticipation rejection based upon Ritter.

Claims 4 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ritter in view of Hohle. The Examiner's rejection is set forth on page 6 of the Answer.

Claim 19 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ritter in view of Beaujard and Hohle. The Examiner's rejection is set forth on pages 7 and 8 of the Answer.

Throughout the opinion, we make reference to the Brief (received September 19, 2006), Reply Brief (received February 13, 2007), and the Answer (mailed December 13, 2006) for the respective details thereof.

ISSUES

Rejection under 35 U.S.C. § 102(e) based upon Ritter.

Appellants' arguments on pages 10 and 11 of the Brief, directed to the claims rejected under 35 U.S.C. § 102(b) as being anticipated by Ritter, address the claims as one group (i.e., Appellants' arguments do not address the individual claims separately). Thus, in accordance with 37 C.F.R. § 41.37 (c)(1)(vii) we group claims 1, 6 through 13, and 16 through 18 together and select claim 1 as representative of the group.

Appellants contend, on pages 10 and 11 of the Brief, that the Examiner's rejection of claim 1 is in error. Appellants reason that Ritter teaches two way transmission of data and programs to or from a chip card in a mobile apparatus, but that Ritter does not teach that the first device is arranged to control the operating characteristics of the electronic data card of a second device. Brief 10. Appellants

assert that operating characteristics are different than data. Brief 11. Appellants further state:

[O]ne skilled in the art would understand that controlling the "operating characteristics of the electronic data card" as claimed would be controlling how the electronic data card "operates" or functions. This understanding that the "invention is directed [to] how the data card functions rather than the content of the information read to or from the data card" is clarified in the specification in lines 11-20 on page 2 of the specification:

Some examples of the operating characteristics that may be controlled by the first device are: the power supply of the electronic data card (e.g. power up/down, voltage etc); the resetting of the electronic data card; the clock rate of the electronic data card; the baud rate of the electronic data card; the stopping of the clock to the electronic data card; this can also be viewed as the operational characteristics of the card reader associated with the electronic data card. The operating characteristics relate to the operation/function of the electronic data card... This invention is directed [to] **how the data card functions rather than the content of the information read to or from the data card.**

Reply Brief 2.

Thus, Appellants' contentions directed to the Examiner's anticipation rejection based upon Ritter present us with the issue of whether the Examiner erred in finding that Ritter teaches a first device arranged to control the operating characteristics of the electronic data card of a second device via the wireless link as claimed.

Rejection under 35 U.S.C. § 103(a) based upon Ritter in view of Beaujard.

Appellants' arguments on pages 12 and 13 of the Brief directed to the claims rejected under 35 U.S.C. § 103(a) as being unpatentable over Ritter in view of Beaujard address the claims as one group. While Appellants' arguments do

identify the individual claims, they merely identify the limitations of each claim. Such statements are not considered separate arguments under 37 C.F.R. § 41.37 (c)(1)(vii). Thus, we group claims 2, 3, 14, and 15 together and select claim 2 as representative of the group.

Appellants contend that the Examiner's rejection is in error for the same reasons discussed above with respect to the rejection of claim 1. Further, Appellants argue that while Beaujard discloses commands such as switching a card on or off, "nothing in Beaujard discloses any of the features of claims 2-3 or 14-15 wherein the operating characteristics are controlled via a wireless link." Brief 12. Additionally, on page 13 of the Brief, Appellants assert that the Examiner's rejection lacks motivation provided by either Ritter or Beaujard to combine the references.

Thus, Appellants' contentions directed to the rejection based upon Ritter in view of Beaujard present us with the same issue discussed with respect to claim 1 and, in addition, whether Beaujard teaches that the additional limitation of representative claim 2 is an obvious modification of Ritter.

Rejection under 35 U.S.C. § 103(a) based upon Ritter in view Hohle

Appellants' arguments on pages 13 through 16 of the Brief directed to the claims rejected under 35 U.S.C. § 103(a) as being unpatentable over Ritter in view of Hohle address the claims in one group. While Appellants' arguments do identify the individual claims they merely identify the limitations of each claim, such statements are not considered separate arguments under 37 C.F.R. § 41.37 (c)(1)(vii). Thus, we group claims 4 and 5 together and select claim 5 as representative of the group.

Appellants contend that the Examiner's rejection is in error for the same reasons discussed above with respect to the rejection of claim 1. Further, Appellants argue that while Hohle discloses physical connections for a clock, "nothing in Hohle discloses any of the features of claims 4-5 wherein the operating characteristics are controlled via a wireless link." Brief 14. Appellants argue that the disclosure of connections for a clock does not disclose, teach, or suggest altering a clock rate or baud rate of an electronic data card. Additionally, on page 15 of the Brief, Appellants assert that the Examiner's rejection lacks the motivation provided by either Ritter or Hohle to combine the references. Thus, Appellants' contentions directed to the rejection based upon Ritter in view of Hohle present us with the same issue discussed with respect to claim 1 and, in addition, whether Beaujard teaches that the additional limitation of representative claim 5 is an obvious modification of Ritter.

Rejection under 35 U.S.C. § 103(a) based upon Ritter in view of Beaujard and Hohle.

Appellants argue on page 15 of the Brief that "for at least the reasons listed above with respect to independent claims 1 and 11-13, Applicants submit that Ritter does not teach, disclose or suggest at least this feature [changing the operating characteristic of a card from another device] of independent claim 19." Appellants argue that Beaujard and Hohle do not make up for this argued deficiency. Further, on page 16 of the Brief, Appellants argue that the Examiner has not presented proper motivation to combine the references as discussed with respect to the other rejections under 35 U.S.C. § 103(a).

Thus, Appellants' contentions with respect to the rejection of claim 19 present the same issues as presented with respect to the other rejections based upon 35 U.S.C. § 103(a).

FINDINGS OF FACT

1. Ritter teaches a system with a mobile device (i.e. telephone), including a SIM chip card which has data processing means which stores information including data identifying a subscriber in a GSM mobile radio network. The telephone has a wireless interface, separate from the GSM system, through which the SIM card can communicate. Abstract.

2. Ritter's system allows the two way transmission of data and programs to or from the chip card in the telephone. Col. 2, ll. 61-64; col. 7, l. 65- col. 8, l. 9.

3. Ritter teaches that the data on the SIM card may include an amount of money, and that the wireless interface may be used to interact with a point of sale (POS) device. Col. 9, ll. 7-20.

4. Ritter describes the point of sale transaction as one where a) the POS transmits an amount of money to be deducted from the SIM card, b) the SIM card saves the transmitted amount, c) the SIM card executes a routine so that the amount to be paid is indicated on the display of the apparatus, and d) when the user agrees to the charge by pressing a key to acknowledge the charge, the SIM card transmits a confirmation command to the POS terminal. Col. 9, ll. 24-40.

5. Beaujard teaches a mobile device, telephone, which includes two smart cards. Abstract.

6. Beaujard teaches that one of the commands that can be applied to a smart card is to turn off. Col. 2, ll. 43-44, col. 3, ll. 58-60.

7. Hohle teaches a smart card which can integrate travel related applications into one card. Abstract.

8. Hohle teaches that one of the commands that can be issued to a card is a reset. Col. 25, ll. 27-29.

9. Another command Hohle teaches can be issued to the card is to modify the baud rate. Col. 26, ll. 25-30.

PRINCIPLES OF LAW

Office personnel must rely on Appellants' disclosure to properly determine the meaning of the terms used in the claims. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995). “[I]nterpreting what is *meant* by a word in a claim ‘is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.’” *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1348, (emphasis in original) (citing *Intervet Am., Inc. v. Kee-Vet Labs., Inc.*, 887 F.2d 1050, 1053 (Fed. Cir. 1989)).

However, the Examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84, (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, (Fed. Cir. 2004) and our decision in *Ex parte Curry*, 84 USPQ2d 1272 (BPAI 2005).

On the issue of obviousness, the Supreme Court has recently stated that “[t]he obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). Further, the Court stated “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more

than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007).

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. . . . [A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

Id. at 1740. “One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of the invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” *Id.* at 1742.

ANALYSIS

Rejection under 35 U.S.C. § 102(e) based upon Ritter.

Appellants’ arguments have not persuaded us that the Examiner erred in rejecting representative claim 1. Claim 1 recites “wherein the first device is arranged to control the operating characteristics of the electronic data card of the second device via the wireless link.” Appellants assert that we should interpret the term “operating characteristics” as limited to “how the electronic data card ‘operates’ or functions.” Reply Brief 2. We note that the examples given in Appellants’ Specification of these operations or functions includes not just settings which control operations (e.g. setting baud rate) but also commands that control operation (i.e. initiating a power down or a reset). Thus, we find that in the context

of the claim, the scope of the limitation “control[ing] the operating characteristics” includes controlling the electronic data card to execute commands.

We find that Ritter teaches a system where a device can control the SIM card in another device. Fact 4. Ritter’s system makes use of a wireless link between the two devices to execute this control. Facts 1 and 3. Ritter teaches that the system can be used to transfer data and programs. Fact 2. We find that one skilled in the art would recognize, based upon Ritter’s disclosure of the operation with the POS terminal, that the data or programs transferred do control an operating characteristic of the SIM card. In the example of the POS terminal, the transmission of a sum of money to be deducted from the SIM card (step a of Fact 4) is an event that changes how the electronic data card is operating or functioning in that it causes (commands) the SIM card to execute operations to prompt the user (steps c and d of Fact 4). Thus, we find that Ritter teaches the first device (for example the POS terminal) is arranged to control the operating characteristics of the electronic data card of the second device via the wireless link. Appellants’ arguments have not persuaded us that the Examiner erred. We therefore affirm the Examiner’s rejection of claims 1, 6 through 13, and 16 through 18.

Rejection under 35 U.S.C. § 103(a) based upon Ritter in view of Beaujard.

Appellants’ arguments have not persuaded us that the Examiner erred in rejecting representative claim 2. Claim 2 is dependent upon claim 1 and recites “wherein the first device is operable to control the power supply to the electronic data card.” Thus, the scope of claim 2 includes that the operating characteristic controlled includes the power supply to the card (i.e. whether the card is on or off). As discussed *supra*, we find that Ritter teaches the first device (for example, the

POS terminal) is arranged to control the operating characteristics of the electronic data card of the second device via the wireless link. Ritter does not discuss that one of the commands issued to the electronic data card is to turn off. However, we find that Beaujard teaches that one of the commands issued to a data card can be to turn on or off. Fact 6. We note that Appellants' argument, that the rejection does not provide motivation from Ritter and Beaujard, is not persuasive as the Supreme Court has stated that obviousness cannot be confined to the concept of motivation. Rather, we must look to see if the claim is a combination of familiar elements. *KSR Int'l Co. v. Teleflex Inc.*, at 1739 (2007). In this case, Beaujard teaches that it was known in the art that one of the commands that can be given to devices with data cards is to turn the data card on or off. In combination with Ritter, this merely provides another command which can be executed, with the predictable result of allowing the card to be turned on or off. Thus, we consider the combination to have been obvious as it is nothing more than the combination of familiar elements that yields predictable results. In summary, we find that Ritter teaches the first device (for example, the POS terminal) is arranged to control the operating characteristics of the electronic data card of the second device via the wireless link; Beaujard teaches the additional limitation of representative claim 2; and the combination would have been obvious as it would yield predictable results. Thus, Appellants' arguments have not persuaded us that the Examiner erred. We therefore affirm the Examiner's rejection of claims 2, 3, 14, and 15.

Rejection under 35 U.S.C. § 103(a) based upon Ritter in view of Hohle

Appellants' arguments have not persuaded us that the Examiner erred in rejecting representative claim 5. Claim 5 is dependent upon claim 1 and recites "wherein the first device is operable to change the baud rate of the electronic data

card in the second device.” We note that Appellants’ arguments address the “clock rate” limitation of claim 4. However, as discussed *supra*, Appellants’ arguments directed to this rejection group claims 4 and 5, and we select claim 5, which does not contain the clock rate limitation. As such, Appellants’ arguments directed to Hohle’s teachings concerning clock rate are moot as they are not commensurate in scope with the representative claim.

As discussed *supra*, we find that Ritter teaches that the first device (for example, the POS terminal) is arranged to control the operating characteristics of the electronic data card of the second device via the wireless link. Ritter does not discuss that one of the commands issued is a command to adjust the baud rate of the data card. Hohle teaches that it was known in the art that one of the commands that can be given to devices with data cards is to adjust the baud rate of the data card. Fact 9. In combination with Ritter, this merely provides another command which can be executed, with the predictable result of allowing the baud rate of the data card to be adjusted. Thus, we consider the combination to have been obvious as it is nothing more than the combination of familiar elements that yields predictable results. In summary, we find that Ritter teaches that the first device (for example, the POS terminal) is arranged to control the operating characteristics of the electronic data card of the second device via the wireless link; Hohle teaches the additional limitation of representative claim 5; and the combination would have been obvious as it would yield predictable results. Thus, Appellants’ arguments have not persuaded us that the Examiner erred. We therefore affirm the Examiner’s rejection of claims 4 and 5.

Rejection under 35 U.S.C. § 103(a) based upon Ritter in view of Beaujard and Hohle.

Appellants' arguments have not persuaded us that the Examiner erred in rejecting claim 19. As discussed *supra*, we find that Ritter teaches the first device (for example, the POS terminal) is arranged to control the operating characteristics of the electronic data card of the second device via the wireless link. Further, as discussed *supra*, the combination of Beaujard and Hohle is nothing more than the combination of familiar elements that yields predictable results. Thus, Appellants' arguments have not persuaded us that the Examiner erred. We therefore affirm the Examiner's rejection of claim 19.

CONCLUSION

Appellants' arguments have not persuaded us of error in the Examiner's rejections of claims 1, 6 through 13, and 16 through 18 under 35 U.S.C. § 102(e) and claims 2 through 5, 15, and 19 under 35 U.S.C. § 103(a).

DECISION

The Examiner's decision to reject claims 1, 6 through 13, and 16 through 18 under 35 U.S.C. § 102(e) and claims 2 through 5, 14, 15, and 19 under 35 U.S.C. § 103(a) is affirmed.

The decision of the Examiner 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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

Appeal 2007-2752
Application 10/363,742

AFFIRMED

eld

BANNER & WITCOFF, LTD.
1100 13th STREET, N.W.
SUITE 1200
WASHINGTON, DC 20005-4051