UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES BUCKLEY, JOSEPH JAY FOSS,
and BENJAMIN ASHER SHORT

Appeal 2007-3617
Application 09/941,329
Technology Center 2100

Decided: July 31, 2008

Before JAMES D. THOMAS, HOWARD B. BLANKENSHIP, and CAROLYN D. THOMAS, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-26, which are all the claims in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellants' invention provides a method and system for accessing a console device during a shared session. (Spec. 1: 7-9.) Claim 1 is illustrative.

1. A method for managing a plurality of console devices over a network, comprising the steps of:

providing a plurality of console devices interconnected over a hardwired network;

checking an availability of one of the console devices;

requesting a shared session from a current user of the checked console device;

starting the shared session; and

accessing the console device on a peer to peer basis over the hardwired network during the shared session,

wherein both the hardware and software layer of the console device can be accessed without the requirement for an additional hardware dongle or a signal device transmitter,

and wherein the method is adapted to access the console device in the case that the console device has failed.

The Examiner relies on the following references as evidence of unpatentability.

Chang	US 5,444,850	Aug. 22, 1995
Isfeld	US 5,483,640	Jan. 9, 1996
Partridge	US 6,160,819	Dec. 12, 2000
Thompson	US 2002/0075303 A1	Jun. 20, 2002 (filed Dec. 18, 2000)
Powderly	US 6,560,641 B1	May 6, 2003 (filed Mar. 29, 2000)

Paroz	US 6,587,125 B1	Jul. 1, 2003 (filed Aug. 1, 2000)
Zhu	US 6,691,154 B1	Feb. 10, 2004 (filed Feb. 29, 2000)

Sunil Sarin et al. (Sarin), *Computer-based real-time conferencing systems*, vol. 18, Issue 10, IEEE Computer Society Press, 33-45, (Oct. 1985).

Claims 1-26 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Claims 1-26 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 1 and 3-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zhu, Chang, and Sarin.

Claims 2 and 7-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zhu, Chang, Sarin, and Isfeld.

Claims 9-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zhu, Chang, Isfeld, and Thompson.

Claims 12, 15-18, 20-22, and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zhu, Chang, and Partridge.

Claims 13, 14, and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zhu, Chang, Partridge, and Isfeld.

Claims 19, 25, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zhu, Chang, Partridge, Powderly, Isfeld, Sarin, and Thompson.[1]

[1] Appellants' Brief (at 7) does not state the correct references applied in the grounds numbered 9, 10, 16, and 17, but then, neither does the statement of rejection in the Final Rejection or Answer. In view of Appellants'

Claims 1 and 3-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Paroz, Chang, and Sarin.

Claims 2, 7, and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Paroz, Chang, Sarin, and Isfeld.

Claims 9-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Paroz, Chang, Isfeld, and Thompson.

Claims 12, 15-18, 20-22, and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Paroz, Chang, and Partridge.

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Claims 19, 25, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Paroz, Chang, Partridge, Powderly, Isfeld, Sarin, and Thompson.

Section 112 rejections

Claims 1 through 26 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement and failing to comply with the written description requirement. An earlier rejection under § 112, second paragraph has been withdrawn by the Examiner. (Ans. 37.)

We will decide the appeal with respect to the § 112 rejections on the basis of claim 1. Appellants do not separately argue claims in response to the rejections. *See* 37 C.F.R. § 41.37(c)(1)(vii). Moreover, each of the other independent claims contains the claim 1 language that is in controversy.

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arguments in the Brief in response to the § 103(a) rejections, the error is harmless.

Instant claim 1 recites, "wherein both the hardware and software layer of the console device can be accessed *without the requirement for an additional hardware dongle or a signal device transmitter*" (emphasis added). In the Examiner's view, under the basic rules of grammar the term "additional" modifies only the "hardware dongle," and not the phrase "a signal device transmitter." (Ans. 35.) According to the Examiner, Appellants have failed to teach how both the hardware layer and the software layer can be accessed without the requirement for a signal device transmitter. (*Id.*, 4.) "[I]t would be impossible to access a device remotely without the use of a signal device transmitter because otherwise there would be no exchange of data at all." (*Id.*)

Appellants do not dispute what the Examiner contends to be "impossible," but submit that the Examiner has misinterpreted the language of claim 1. "Specifically the claim language states that the device can be accessed without the requirement for an additional signal device transmitter. To this extent no signal device transmitter other than that which is claimed is needed." (Br. 8.)

We agree with the Examiner that Appellants have drafted a claim for an invention that has not been enabled. A claim must be read in accordance with the precepts of English grammar. *In re Hyatt*, 708 F.2d 712, 714 (Fed. Cir. 1983). An article (*a*, *and*, and *the*) signals that a noun will follow and that any modifiers between the article and the noun refer to that noun. *See, e.g.,* Troyka et al., *Quick Access Reference for Writers*, 5th Ed. § 43, Pearson Education, Inc. (2007). The plain language of claim 1 sets forth that the layers can be accessed without the requirement for a hardware dongle, modified by the adjective "additional." The plain language of claim 1 also

sets forth, however, that the layers can be accessed without the requirement for a signal device transmitter.

In determining whether claim 1 meets the statutory requirements for enabled subject matter, we cannot pretend that the claim recites something that it does not. "An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process." *In re Zletz*, 893 F.2d 319, 322 (Fed. Cir. 1989).

"A claimed invention having an inoperable or impossible claim limitation may lack utility under 35 U.S.C. § 101 and certainly lacks an enabling disclosure under 35 U.S.C. § 112." *EMI Group North America Inc. v. Cypress Semiconductor Corp.*, 268 F.3d 1342, 1348 (Fed. Cir. 2001) (citing *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 956 (Fed. Cir. 1983)). We thus sustain the Examiner's rejection of claim 1 for lack of enabling disclosure. Claims 2 through 26 fall with claim 1.

To comply with the "written description" requirement of 35 U.S.C. § 112, first paragraph, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the "written description" inquiry, whatever is now claimed. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991).

We also sustain the Examiner's rejection of claim 1 for lack of written description support. Appellants' response to the rejection is based on the same erroneous claim interpretation submitted in response to the rejection for lack of enablement. Claims 2 through 26 fall with claim 1.

Prior Art Rejections

Appellants advance three arguments in response to the rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Zhu, Chang, and Sarin.

First, Appellants submit that column 5, lines 42 through 47 of Zhu does not teach or suggest that the remote experts access the desktop application on a peer-to-peer basis. Appellants do not deny that, in the instant invention, a server is used to connect to the remote console device, but submit that the accessing of the device is performed on a peer to peer basis after the session is begun. According to Appellants, Zhu "teaches against" a peer-to-peer basis by citing advantages of using a client-server architecture rather than a peer-to-peer architecture, citing column 2, line 63 through column 3, line 8 of the reference. (Br. 10.)

The Examiner responds that Appellants do not use the term "peer-to-peer" in the traditional sense of a connection formed between two client devices without an intermediary server. The Examiner contends that in each embodiment of Appellants' invention all connections and data required for accessing the console devices must pass through a central server. In the Examiner's view, Zhu provides for the functionality associated with the "peer-to-peer" connection described by the Specification, such that a user remotely controls a console device as if he or she were actually sitting in front of the device. (Ans. 37-38.)

We agree with the Examiner that Appellants have failed to show that the claim 1 recitation of accessing the console device "on a peer to peer basis" distinguishes over the teachings of Zhu. Appellants have not identified any description in the Specification of an embodiment where a

server is not in the data path for remote access to the console device. Moreover, in the "peer-to-peer" topology of instant Fig. 1, users or administrators 22 are connected to system server 11, which in turn connects to terminal concentrator (TC) server 28, multiplexor 30, and the accessed console device 32. Connections 34 between users 22 and system server 11, and connection 34 between system server 11 and TC server 28, may be direct hardwired connections. (*See* Spec. 7: 15 - 8: 9.)

Based on the evidence before us, we are not persuaded that the connections taught by Zhu cannot be considered a "peer to peer basis" under the broadest reasonable interpretation of the term.

Even were we to assume that the "peer to peer" recitation set forth in claim 1 required an architecture that contrasted with a client-server architecture, as the terms are used in Zhu, we would not be persuaded that Zhu "teaches against" such a topology.

"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." *Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.*, 73 F.3d 1085, 1090 (Fed. Cir. 1995) (quoting *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)).

Zhu, in the paragraph bridging columns 2 and 3, does not warn the artisan against using a peer-to-peer architecture. Zhu instead notes a "key advantage" of using a client-server architecture as opposed to a peer-to-peer architecture (as those terms are used in the context of the reference). We are thus not persuaded that Zhu "teaches away" from the instant invention. At most, the reference teaches an advantage in using a client-server

architecture, but does not say there are not other instances in which a peer-to-peer architecture would be indicated.

Moreover, Appellants do not allege they have invented a new type of peer-to-peer architecture, nor demonstrated any architecture that would be unexpected to the artisan in its use. A person having ordinary skill in the art uses known elements for their intended purpose. *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.,* 396 U.S. 57 (1969) (radiant-heat burner used for its intended purpose in combination with a spreader and a tamper and screed). "[W]hen a patent 'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement, the combination is obvious." *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740 (2007) (quoting *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282 (1976)).

For Appellants' second argument in response to the rejection of claim 1, Appellants submit that firmware to which the Examiner refers in Chang constitutes "a hardware dongle," thus not meeting the recitation of "without the requirement for an additional hardware dongle." (Br. 11.) We refer to the Examiner's reasonable findings as to why Chang meets the argued limitation. (Ans. 38-39.) Moreover, as the Examiner notes, under the broadest reasonable interpretation of the claim the "hardware dongle" may be read as optional. (*Id*., 39.) Unpatentability under § 103(a) may be demonstrated without accounting for the full scope of the claim. "What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103." *KSR*, 127 S. Ct. at 1742.

In Appellants' final argument in response to the rejection of claim 1, Appellants contend that the last "wherein" clause is not taught or suggested

by the references: "wherein the method is adapted to access the console device in the case that the console device has failed." Appellants contest the Examiner's finding that Chang teaches remotely controlling a console device where both the hardware and software layers of the console device can be accessed during device failure. (*See* Ans. 6.) *See also* Chang col. 2, ll. 43-55 and 60-67. According to Appellants, Chang teaches that access occurs during a boot sequence of a device. "To this extent, the device to which access is occurring must be booting, and, as such, can not have failed." (Br. 11.)

However, we agree with the Examiner's reasoning in response at pages 39 and 40 of the Answer. The recitation of "in the case that the console device has failed" is sufficiently broad to cover the case described by Chang, in which there is less than a complete failure of hardware or software systems in the console device.

Being not persuaded of error in the rejection of claim 1, we sustain the Examiner's § 103(a) rejection over Zhu, Chang, and Sarin.

In view of Appellants' arguments in the Brief, we decide the § 103(a) aspect of the appeal on the basis of claim 1 alone. *See* 37 C.F.R. § 41.37(c)(1)(vii) ("Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately."). Moreover, the rejection of claims 1 through 26 under 35 U.S.C. § 103(a) over Paroz in combination with the other references can be summarily sustained, as Appellants' Brief provides substantive arguments in response

to a ground of rejection that includes Zhu but not for the grounds that apply Paroz rather than Zhu.

CONCLUSION

The rejection of claims 1-26 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement is affirmed.

The rejection of claims 1-26 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement is affirmed.

The rejection of claims 1-26 under 35 U.S.C. § 103(a) 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).

AFFIRMED

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