

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* HEIKE HECKER and THOMAS HECKER

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Appeal 2008-1158  
Application 09/950,439  
Technology Center 2600

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Decided: July 14, 2008

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Before JOSEPH F. RUGGIERO, ROBERT E. NAPPI, and JOHN A. JEFFERY, *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 6(b) of the final rejection of claims 1 through 7, 9, and 11 through 13.

We affirm the Examiner's rejections of these claims.

## INVENTION

The invention is directed to a method and device for initiating communications from a non-local device to a local device. The communication initiating device includes an interface with the local communication device (a local computer) and generates a control signal for the local device to communicate with the non-local device. See pages 5 and 6 of Appellants' Specification. Claim 1 is representative of the invention and reproduced below:

1. A device for initiating a transmission of data from a non-local computer to a local computer, the local computer being connected via a network to the non-local computer, the transmission-initiating device comprising:

an interface with the local computer;

at least one information storage medium containing locally and non-locally relevant information; and

a control element;

said interface being disconnectable and, when said control element is being operated, the transmission-initiating device serving for generating at least one control signal for the local computer, and for transmitting locally and non-locally relevant information from the transmission-initiating device to the local computer.

## REFERENCES

Morris	US 6,460,138 B1	Oct. 1, 2002 (filed Oct. 5, 1998)
Grant	US 6,618,039 B1	Sep. 9, 2003 (filed Jun. 19, 1998)
D'Souza	US 6,625,649 B1	Sep. 23, 2003 (filed Jun. 8, 1998)

### REJECTION AT ISSUE

Claims 1 through 7 and 11 through 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over D'Souza in view of Grant. The Examiner's rejection is on pages 3 through 6 of the Answer.

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over D'Souza in view of Grant and Morris. The Examiner's rejection is on pages 6 and 7 of the Answer.

Throughout the opinion, we make reference to the Brief (received November 8, 2006) and the Answer (mailed January 18, 2007) for the respective details thereof.

### ISSUE

Appellants argue on pages 5 through 9 of the Brief that the Examiner's rejection of independent claims 1 and 13 is in error. Appellants reason that D'Souza does not disclose that a transmission initiation device has an information storage medium. Br. 7. Further, Appellants argue that Grant does not teach or suggest that a transmission initiation device has an information storage medium. Appellants reason that the translator item 44 is not disclosed as containing a memory and that it appears that Grant's device works in the same way as D'Souza's device. Br. 7, 8.

Thus, Appellants' contentions with respect to independent claims 1 and 13, present us with the issue of whether the Examiner erred in finding that the combination of D'Souza in view of Grant teaches that a transmission initiation device has an information storage medium.

## PRINCIPLES OF LAW

On the issue of obviousness, the Supreme Court has recently stated that “[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.

The standard for review of factual findings by the PTO is substantial evidence. *In re Gartside* 203 F.3d 1305, 1312 (Fed Cir. 2000). Our reviewing court has said:

Substantial evidence is something less than the weight of the evidence but more than a mere scintilla of evidence. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion. In reviewing the record, we must take into account evidence that both justifies and detracts from the factual determinations. We note that the possibility of drawing two inconsistent conclusions from the evidence does not prevent the Board's findings from being supported by

substantial evidence. Indeed, if a reasonable mind might accept the evidence as adequate to support the factual conclusions drawn by the Board, then we must uphold the Board's determination.

*In re Kahn*, 441 F.3d 977, 985 (Fed. Cir. 2006) (citing *In re Gartside, Consol. Edison Co. v. NLRB*, 305 U.S. 197, 229-30 (1938)).

37 C.F.R. § 41.37 (c)(1)(vii) states:

For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. 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.... A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

#### FINDINGS OF FACT

1. D'Souza teaches a keyboard for a computer which has keys that produce unique Internet access signals (i.e., depressing one key causes the computer to launch a program for the user to interact with an Internet site and to access the site). Abstract.

2. With D'Souza's device, there is an encoding circuit which encodes the identity of the key depressed. At the computer there is an interface controller which provides the identity to the control logic (in the computer). The control logic unit then uses the identity of the key to instruct the CPU to determine which program to launch and which site to access. Col 4, ll. 38-54, and col. 7, ll. 15-35.

3. Grant teaches a user interface for an Internet browser or other terminals. Abstract.

4. Grant's device includes a keypad item 30 which communicates with a computer through a translator box 44 which provides signals that are usable by the computer item 40. These signals are application-specific commands. Col. 4, ll. 37-41, col. 11, ll. 29-34.

5. The translator may be separate from the keypad and computer (as depicted in figure 2), or be part of the keypad, or be part of the computer. Grant, col. 4, ll. 41-44.

6. Grant's keypad includes a display which, among other things, can display a URL address. Col. 5, l. 5, col. 7, l. 45.

7. In several embodiments, Grant teaches that one key on the keypad can be used to launch a search feature of a browser, and another key to launch a user's email software. Thus, actuation of the keypad identifies to the computer which application to launch. Col. 5, ll. 49-51, Col. 7, ll. 15-25 and 43-54.

8. Grant teaches one embodiment where there is a touchpad over a display (i.e. touch screen display). Fig. 9, col. 10, ll. 53-67.

9. Grant teaches that the user can program some of the switches to make shortcuts to specific web pages. Col. 5, ll. 62-67, col. 10, ll. 32-33.

10. Grant does not discuss where the user programming for the switches resides. However, one skilled in the art would recognize that since the translator issues application-specific commands based upon actuation of a key (Fact 4), the programming for the switches resides (is stored) within the translator.

#### ANALYSIS

Appellants' arguments have not persuaded us of error in the Examiner's rejection of independent claims 1 and 13. Initially we note that since Appellants argue claims 1 and 13 together and do not identify a reason why they are separately patentable, Appellants have grouped claims 1 and 13 together and we select claim 1 as representative of the group.

Appellants' arguments have not persuaded us that Grant does not teach or suggest that a transmission-initiation device has an information storage medium. Claim 1 recites a transmission-initiating device which includes an information storage medium containing locally and non-locally relevant information. Appellants' Specification identifies that one example of a transmission initiating device is a device with a switch, joystick etc, which generates a control signal when operated. (Spec. 14:4-6). An example of locally relevant information includes the application to be launched, and an example of non-locally relevant information is the identity of a remote server. *See* Specification page 15.

The Examiner has found that Grant teaches a user interface which comprises an information storage medium. We find substantial evidence supports the Examiner's finding. Specifically, we find that Grant teaches a keypad that allows a user to issue application specific commands to a computer. Facts 3 and 4. These commands include locally relevant information, identifying specific applications to be launched, e.g., browser, e-mail. Fact 7. These commands also include non-locally relevant information, e.g., the address of the site to be visited. Fact 9. The key pad can include the translator, item 44, which generates these commands. Fact 5. As some of the keys are programmable, the information transmitted as part of the command when the key is actuated is necessarily stored on the keypad. Fact 10.

We are not persuaded by Appellants' argument, on page 8 of the Brief, that the rejection is improper as Grant operates like D'Souza, in that the commands are stored at the computer. While this may be the case in the embodiment where translator 44 is part of the computer, it is not the case in Grant's embodiment where the translator is incorporated into the keypad. Fact 5. Further, Appellants' argument, on page 9 of the Brief, that Grant's embodiment of Figure 6, is inapplicable to the embodiment of Figure 5 as it "serves only for addressing different local device, such as bank terminals or credit card terminals, but not local computers as unambiguously clearly claimed in the instant application" is not persuasive. Grant states that the Figure 6 embodiment is essentially the previously-described (Figure 5) embodiment and may include more modes. Col. 7, ll. 11-15.

For the aforementioned reasons, Appellants have not persuaded us that the Examiner erred in finding that the combination of D'Souza and

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Grant teaches a transmission initiation device that has an information storage medium containing locally and non-locally relevant information.

Appellants have not separately argued the Examiner's rejection with respect to dependent claims 2 through 7, 11, and 12. Nor have Appellants separately argued independent claim 13. Thus, in accordance with 37 C.F.R. § 41.37 (c)(1)(vii), claims 2 through 7, and 11 through 13 are grouped with claim 1.

Appellants argue on pages 9 and 10 of the Brief that the Examiner's rejection of claim 9 is in error for the reasons discussed with respect to claim 1. As we are not persuaded of error in the Examiner's rejection of claim 1, we sustain the Examiner's rejection of claim 9 for the reasons discussed with respect to claim 1.

#### CONCLUSION

For the foregoing reasons, we sustain the Examiner's rejection of claims 1 through 7, 9, and 11 through 13 under 35 U.S.C. § 103(a).

#### ORDER

The decision of the Examiner is affirmed.

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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

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