

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MICHAEL I. RACKMAN

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Appeal 2008-1893  
Reexamination Control 90/007,353  
United States Patent 4,670,857  
Technology Center 3900

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Decided: January 5, 2009

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Before FRED E. MCKELVEY, *Senior Administrative Patent Judge*, and  
SALLY C. MEDLEY, and KEVIN F. TURNER, *Administrative Patent  
Judges*.

TURNER, *Administrative Patent Judge*.

DECISION ON APPEAL

Patent Owner (Appellant) appeals under 35 U.S.C. §§ 134(b) and 306  
from a final rejection of claims 1-8. We have jurisdiction under 35 U.S.C.  
§§ 134(b) and 306.

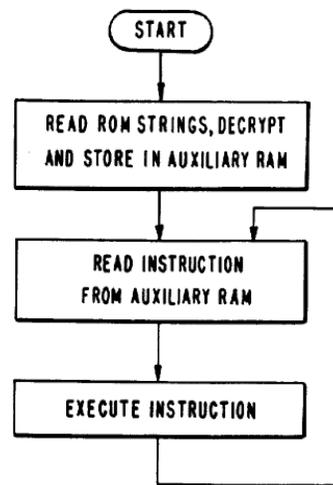
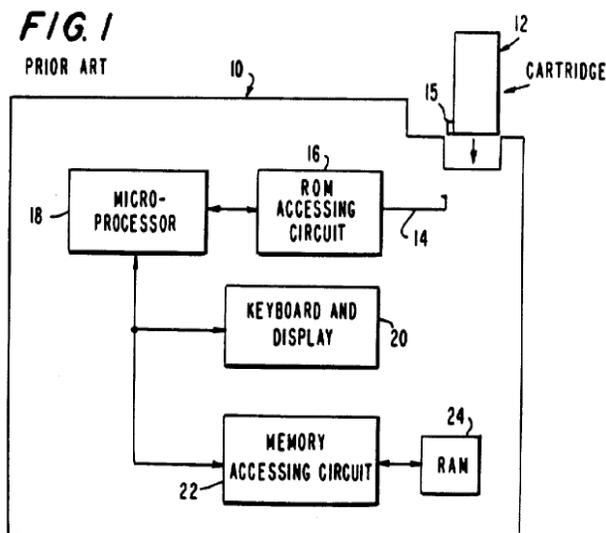
We AFFIRM.

STATEMENT OF THE CASE

This proceeding arose from a third party request for *ex parte* reexamination filed by Microsoft Corporation, (Requester), Redmond, WA, on December 22, 2004, of United States Patent 4,670,857 (hereinafter the '857 Patent), entitled "Cartridge-Controlled System Whose Use is Limited to Authorized Cartridges" and issued to Michael I. Rackman on June 2, 1987. The real party in interest is Michael I. Rackman as patent owner and patentee. (App. Br. 1).

Requester states that the '857 Patent is involved in patent infringement litigation and that it is the defendant in *Rackman v. Microsoft Corp.*, CV-97-0003 (E.D. N.Y.) (Request for Reexamination at 2).

The invention relates to "cartridge-controlled systems, and more particularly to such a system whose use is limited to authorized cartridges" (col. 1, ll. 5-7). The claimed invention is best illustrated in Figs. 1 and 4, reproduced below:



**FIG. 4**

Fig. 1 of the '857 Patent depicts a prior art cartridge-controlled system, having a microprocessor (18) controlling a memory accessing circuit (22) coordinating access to individual locations in random access memory (RAM; 24). Instructions are read from the cartridge (12) and executed, allowing for user interaction, for example with a video game. (Col. 3, ll. 22-64). The '857 Patent describes a process, illustrated in Fig. 4, where encrypted instructions on a cartridge are decrypted by the system and stored, to be executed thereafter. Through the use of public-key encryption, the encryption algorithm is known only to the machine manufacturer and it is not practically possible for unauthorized persons to manufacture original cartridges which will work with the machine. (Col. 2, ll. 35-38).

Claim 1 on appeal, which is representative, reads as follows:

1. A plurality of mass-produced identical systems each comprising data processing means for generating memory-accessing address signals and for executing memory-furnished instructions; and means for interfacing said data processing means with an insertable cartridge having a read-only-memory contained therein; characterized by a read-write memory; said data processing means further controlling generation of memory-accessing address signals to allow accessing of blocks of encrypted instructions from the read-only-memory of an inserted cartridge, decryption of the blocks of encrypted instructions thus accessed, and generation of memory-accessing address signals to allow storage of the decrypted blocks of instructions in said read-write memory, and thereafter executing instructions furnished by said read-write memory in response to generated memory-accessing address signals; said blocks of instructions being stored in encrypted form in said read-only-memory in accordance with a private key which is associated with a public key of a public-key cryptosystem pair, and said data processing means controlling the decryption of said blocks of encrypted instructions in accordance with said public key; each of said identical systems controlling said decryption and

thereafter execution of instructions furnished by its read-write memory in the identical manner responsive to insertion of the same cartridge.

A Final Office Action was mailed March 26, 2007.<sup>1</sup> The prior art references relied upon to reject the claims on appeal are:

Best	4,278,837	Jul. 14, 1981
Flies	4,297,569	Oct. 27, 1981
Weinstein	4,453,074	Jun. 5, 1984

The Examiner rejected claims 1-8 under 35 U.S.C. § 103(a) as unpatentable over Weinstein in view of either Flies or Best. (Final Office Action 2). Appellant has indicated that dependent claims 2, 4, 6, and 8 are not separately argued, (App. Br. 10), and no particular elements of claims 1, 3, 5, and 7 are specifically argued. Thus, consistent with Appellant's arguments, we confine our discussion to the Examiner's rejection of claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Weinstein is directed towards a protection system for intelligent cards having encrypted codes, where the system uses public-key encryption. In the rejection, the Examiner found that Weinstein teaches all elements of claim 1 except that the encrypted data stored on the cartridge are "instructions", i.e. program code, or that the terminal's microprocessor executes those instructions. The Examiner relies on either of Flies and Best, to cure these deficiencies, with motivations supplied in the rejection (Final Office Action 2-12).

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<sup>1</sup> The Appeal Brief (App. Br.) was filed May 7, 2007, an Examiner's Answer (Ans.) was mailed June 6, 2007, a Reply Brief (Reply Br.) was filed on June 21, 2007, a Supplemental Examiner's Answer (Supp. Ans.) was mailed August 13, 2007, and a Supplemental Reply Brief (Supp. Reply Br.) was filed August 31, 2007.

Appellant contends that the references are not combinable on the basis that the Examiner has asserted, and even if the references were combined as indicated, they would not give rise to the apparatus and method of the claims of the '857 Patent. (App. Br. 10). According to Appellant, Weinstein does not address executable instructions and Weinstein, Best and Flies all have opposite objectives from the invention. (App. Br. 13-16). Appellant also argues that one of ordinary skill in the art would not have combined Weinstein with either of Best or Flies and cites reasons why such ordinary artisans would not combine those references. (App. Br. 17-22).

### ISSUES

Thus, the issues arising from the Examiner's rejection, and Appellant's contentions responding to the rejection, are:

Has Appellant shown that the Examiner erred in finding that a person having ordinary skill in the art would have combined Weinstein with Best or combined Weinstein with Flies according to the rationales supplied in the rejection of the claims of the '857 Patent?

If not, has Appellant shown that the Examiner erred in concluding that combinations of references would have provided the functionalities specified in the claims of the '857 Patent?

### FINDINGS OF FACT

#### BACKGROUND:

1. Oral arguments were heard on September 17, 2008, a transcript of which is entered into the record.

2. The '857 Patent discusses the prior art as follows (col. 1, ll. 8-20):

There are many microprocessor-controlled systems which operate in accordance with a series of instructions stored in interchangeable read-only memories (ROM). Typical among such systems are the video game units which are sold for home use. Such a unit is connected to a television receiver, and a cartridge, containing a ROM, is inserted in a slot provided for this purpose. The cartridge furnishes the instructions for controlling the microprocessor operation which, in turn, controls the television display, reading of a keypad, etc. A common use for such systems is the playing of games. For each game which may be played, a different cartridge is provided.

3. The '857 Patent then states the problems with such prior art systems to include (col. 1, ll. 30-35):

There is often no way to prevent the marketing of "compatible" cartridges, that is, cartridges which will control the machine operation using the same set of instructions (albeit in different sequences to control different games or programs), by a competing "software" supplier.

4. The '857 Patent states that different methods of cryptography were also known in the art (col. 4, l. 64 – col. 5, l. 7):

For many years, attention has been focused on the transmission of sensitive or secret messages over a communications channel. Attention has also been focused on techniques for authenticating message transmission, that is, to verify that a message incoming over a data channel indeed originated with the purported sender. Public-key cryptography is now recognized as a possible solution to both the privacy and authentication problems. One of the earliest works on the subject is that of Diffie and Hellman, "New Directions in

Cryptography", IEEE Transactions on Information Theory, November, 1976.

5. During the prosecution of the application that matured into the '857 Patent and the instant reexamination proceeding, reference has been made to the paper by Diffie and Hellman simply as "New Directions."
6. The '857 Patent explains the application of public-key cryptography to the problems associated with the prior art systems (col. 6, ll. 51-66):

The present invention is based upon the principles of public-key cryptography which relate to the authentication of messages. If a message is decrypted with the public key of a public-key cryptosystem pair and the decryption is intelligible, then it follows that the original message must have been encrypted with the associated private key of the transmitter. What is of concern in the present invention is the decryption of a "message" into "intelligible text" in the sense that the intelligible text comprises a sequence of instructions which can control the microprocessor operation. If the encryption of blocks of instructions is done in accordance with the manufacturer's private key, decryption with the public key will result in a sequence of instructions capable of controlling the microprocessor as originally contemplated by the software designer.

#### THE WEINSTEIN REFERENCE:

7. Weinstein discloses the concept of storing data that has been encrypted using public-private key encryption on an insertable storage medium, i.e., a credit card. (Abstract, Col. 4, ll. 14-32).
8. The encrypted data is subsequently read from the insertable storage medium and decrypted, with the decrypted result being

used to authenticate that the storage medium is from an authorized source. (Col. 4, ll. 14-57).

9. Weinstein discloses a plurality of mass-produced transaction terminals that are used for decryption and authentication. (Col. 8, ll. 40-45).
10. Weinstein fails to disclose the encryption of multiple executable instructions, but instead discloses the decryption and authentication of a stored code, where that code is the encryption of a concatenation of a user secret password and a common reference text. (Abstract).

**THE FLIES REFERENCE:**

11. Flies discloses an insertable storage medium on which encrypted instructions are stored. Based on an encryption/decryption code entered by a user, the contents will be decrypted into plain text or 'garbage.' (Abstract; Col. 13, l. 55- col. 14, l. 32).
12. The contents of the insertable storage medium may contain an executable program or routine for the microprocessor. (Col. 13, ll. 4-5).
13. Flies discloses that the encryption/decryption methods that are employed may be any acceptable method. (Col. 14, ll. 33-34).

THE BEST REFERENCE:

14. Best is directed to a system having a microprocessor which executes programs which are stored in cipher to prevent software piracy. (Abstract).
15. In Best, the microprocessor executes a program by deciphering instructions piecemeal as it fetches and executes them. (Col. 3, ll. 36-38).
16. The enciphered program may be accompanied by enciphered data stored in memory, where that memory may be any of a variety of conventional storage devices. The enciphered program may be read from storage media such as magnetic disc or tape, optically-coded discs, or magnetic bubble domain memory. (Col. 6, ll. 18-30)

THE HELLMAN DEPOSITION:

17. Appellant filed an exhibit captioned "SELECTED PAGES FROM HELLMAN DEPOSITION TESTIMONY" which provided certain pages from a deposition by Martin E. Hellman on March 16, 2005.
18. Mr. Hellman was one of the authors of the New Directions paper and was an expert retained by Requestor in the above-cited litigation. (App. Br. 21).
19. Mr. Hellman indicated that the '857 Patent and Weinstein applied message authentication in a novel way "to a problem that had not occurred to me in 1976 when we wrote the paper." (Hellman Deposition p. 264).

20. According to Mr. Hellman the application of message authentication was novel, in his view, with respect to the 1976 New Directions paper and “not necessarily novel as compared to the Weinstein patent.” (Hellman Deposition p. 264).

#### PRINCIPLES OF LAW

On appeal to this Board, Appellant must show that the Examiner erred in finally rejecting the claims. *Cf. In re Kahn*, 441 F.3d 977, 985-986 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)); *see also* 37 C.F.R. § 41.37(c)(1)(vii).

The United States Patent and Trademark Office (PTO) gives claim terms their broadest reasonable interpretation, taking into account any enlightenment by way of definitions or otherwise found in the specification. *In re Icon Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (“[T]he PTO must give claims their broadest reasonable construction consistent with the specification . . . Therefore, we look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation”).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said

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subject matter pertains.’” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1734 (2007).

*KSR* reaffirmed the analytical framework set out in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), which states that an objective obviousness analysis includes: (1) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; and (3) resolving the level of ordinary skill in the pertinent art. *KSR*, 127 S. Ct. at 1734. Secondary considerations such as commercial success, long felt but unsolved needs, or failure of others “‘might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.’” *Id.* (quoting *Graham*, 383 U.S. at 17-18).

*KSR* explained:

For over a half century, the Court has held that a “patent for a combination which only unites old elements with no change in their respective functions . . . obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men.” . . . This is a principal reason for declining to allow patents for what is obvious. The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.

*KSR*, 127 S. Ct. at 1739. Thus, “when a patent claims a structure already known in the prior art that is altered by mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.” *KSR*, 127 S. Ct. at 1740. And, “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.” *Id.*

*KSR* disapproved a rigid approach to obviousness (*i.e.*, an analysis limited to lack of teaching, suggestion, or motivation). *KSR*, 127 S. Ct. at 1741 (“The obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents.”). See also *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006) (“Our suggestion test is in actuality quite flexible and not only permits, but requires, consideration of common knowledge and common sense”); *Alza Corp. v. Mylan Labs., Inc.*, 464 F.3d 1286, 1291 (Fed. Cir. 2006) (“There is flexibility in our obviousness jurisprudence because a motivation may be found *implicitly* in the prior art. We do not have a rigid test that requires an actual teaching to combine . . .”).

“When the PTO [*i.e.*, an examiner,] shows *prima facie* obviousness, the burden then shifts to the applicant[s] to rebut.” *In re Mayne*, 104 F.3d 1339, 1342 (Fed. Cir. 1997).

“[C]ase law does not require that a particular combination must be the preferred, or the most desirable, combination described in the prior art in order to provide the motivation for the current invention.” *In re Fulton*, 391 F.3d 1195, 1200 (Fed. Cir. 2004).

Mere allegations or conclusory statements in a specification or an affidavit do not take the place of *factual* evidence. See, *e.g.*, *In re Lindner*, 457 F.2d 506, 508 (CCPA 1972) (“The affidavit and specification do contain allegations that synergistic results are obtained with all the claimed compositions, but those statements are not supported by any factual evidence . . . [M]ere conclusory statements in the specification and affidavits are

entitled to little weight when the Patent Office questions the efficacy of those statements.”).

## ANALYSIS

We note that the Examiner and Appellant have some disagreement with the presentation of facts in Appellant’s Appeal Brief. (App. Br. 1-11, Ans. 20-29, Reply Br. 7-9). We have not addressed every point of disagreement over the facts and have only presented the findings of fact *supra* that we have concluded are needed to resolve the issues in this case.

We note that the '857 Patent discloses the problems associated with the prior art systems (FF. 2) and discloses the nature of public-key cryptography and how it provides authentication (FF. 4). Questions raised at the Oral Hearing were concerned with whether the invention claimed in the '857 Patent merely required the application of known elements to solve a known problem. (Oral Hearing 7). Appellant indicated that the new function, achieved for the known elements, was the prevention of a third-party cartridge manufacturer from producing cartridges that could be used on a machine embodying the invention. (Oral Hearing 7-8). It is in this context, of considering whether a technique that has been used to improve one device would be apparent to a person of ordinary skill to improve other devices in the same way, that we consider the prior art rejection made by the Examiner.

### *Combinations of the Cited Prior Art*

Appellant concedes that the same encryption process applies to both data and instructions in Weinstein, but argues that if Weinstein had instructions on smart cards, they wouldn’t be executed. (App. Br. 13).

Additionally, Appellant argues that there is no teaching of instructions receivable from the outside. (Reply Br. 1-2). The Examiner found that this is mere speculation because the system in Weinstein is capable of reading and executing code. (Ans. 33-34). We agree with the Examiner to the extent that we do not find Weinstein as precluding the execution of outside executable instructions. Given the teachings of Flies and Best, (FF. 12 and 16), we cannot say that one of ordinary skill in the art would not have altered Weinstein to execute code provided on an insertable medium.

Appellant argues that the purpose of Weinstein is to verify identity and is not applicable to the present invention. Appellant argues that verification of identity would not be accomplished through entry by the user of executable instructions. (App. Br 14). However, given the teachings of Flies and Best, (FF. 12 and 14), executable programs can be used to provide authorization, which is related to verification. The objectives of identity verification and authorization are at least compatible, if not overlapping, and are not opposite as Appellant has argued.

Appellant argues that Weinstein encourages other companies to issue credit cards that could be used with his machines, which is the opposite objective of the '857 Patent. (App. Br. 14-16). Appellant argues that the present invention wants to restrict media that will work with a particular machine and Weinstein wants all credit cards to work with his machine. However, Weinstein does not encourage the use of unauthorized credit cards or unauthorized users. We therefore cannot agree with Appellant's assertion. Additionally, the process of authentication is common to Weinstein and the '857 Patent. The Examiner noted, (Ans. 37-38), that persons may be authorized to issue cards that are compatible with

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Weinstein's machines, just as they may be authorized by the manufacturer to produce cartridges, which is a similar objective as provided in the '857 Patent. As such, we do not find the objectives of Weinstein and the '857 Patent to run counter to the extent that one of ordinary skill in the art would not have considered Weinstein in an effort to overcome the prior art problems acknowledged in the '857 Patent. (FF. 3).

Appellant argues that Best requires cartridges to not work on all machines because Best's objective is to thwart copying. Appellant also argues that Flies requires that every key works differently because each user has their own password, and cannot provide keys that work with all machines. Thus, Appellant concludes that Best and Flies have objectives which are opposite of the '857 Patent. (App. Br. 14-16). We do not agree. In Best, while prevention of copying may be one objective, the use of a cipher requires authentication of the data being encrypted through that cipher, or else no programming can be decrypted. In other words, programming not enciphered may not operate on a system requiring enciphered data. In Flies, while the keys may not work in every machine, the system still provides authentication for that individual key and user. Thus, we do not find the objectives of Best and Flies to run counter to the objectives of the '857 Patent which includes authentication of particular insertable media. Given the similar interests, we find that one of ordinary skill in the art would have considered Best and Flies in an effort to overcome the prior art problems acknowledged in the '857 Patent.

Appellant argues that the object of present application is to control who could write original software that would run on a machine and the prior art combinations do not achieve this object. (App. Br. 16). The Examiner

found that the objective of application is not claimed and is irrelevant. (Ans. 42-43). We disagree with the Examiner in that method claims 3 and 7 recite the prevention of unauthorized manufacture of compatible cartridges; however, we agree with the Examiner that the argument is irrelevant since the combinations of Weinstein and Best or Flies allow for this objective to be met, as discussed above.

Appellant argues that one of ordinary skill in the art would not have looked to Best or Flies since their design philosophies are opposite of Weinstein. (App. Br. 17-18). The Examiner found that the design philosophies are not opposite because there is no fixed design philosophy with respect to the kind of encryption used to secure executable code. (Ans. 43). We agree with the Examiner since we do not find the design philosophies or other aspects of Best and Flies to be opposite to those of Weinstein. We further agree with the Examiner that Weinstein would have informed one of ordinary skill in the art of the types of cryptography that could be applied in the cryptographic applications disclosed in either of Best or Flies.

Appellants also argue that Weinstein has no way of running instructions received from card and Weinstein has nothing to do with the prevention of software copying. (App. Br. 17-18). The Examiner found that Weinstein has capability to receive instructions and it would have been obvious to execute those instructions. (Ans. 45-46). We agree with the Examiner that if Weinstein received executable instructions, per Best or Flies, it would have been obvious to execute those instructions. We also agree that since Weinstein is disclosed to be capable of executing instructions, this functionality is already found in Weinstein. Also, since

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Weinstein is concerned with securing information, executable instructions would benefit from encryption used in Weinstein, to at least the same extent as instructions in Best or Flies benefit from encryption.

Appellant argues that the Examiner's argument about adding program data to the other data does not consider public key encryption and that not all data are the same. (App. Br. 18-21). The Examiner found that Weinstein teaches public key encryption and that cryptography applies to both unexecutable and executable data. (Ans. 49-50). We agree with the Examiner in that providing public key encryption on every machine in view of Weinstein would have been obvious. In addition, in view of Best, the provision of encryption of both programming and additional data is explicitly disclosed. (FF. 16). As such, we do not find Appellant's counterarguments to be compelling.

Appellant argues that Weinstein's disclosed "numerous other purposes" do not envision providing secure access to programs, contrary to what the Examiner has found, and instead are concerned with prevention of copying. (App. Br. 21). Even if we were to agree with Appellant that the clear implication of Weinstein was the prevention of copying, that does not mean that Weinstein cannot be applied to the process of securing access to programs, as proposed in the rejection.

Appellant also argues that the testimony of Hellman, characterized by Appellant as an "expert," details that the present application's use of his authentication technique was "novel" contradicts obviousness findings. (App. Br. 21-22). The Examiner found that the testimony does not point to novelty and that the testimony discusses the novelty of the '857 Patent with respect to the New Directions paper but not with respect to Weinstein.

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(Ans. 57-59; FF. 20). The Examiner, therefore, declined to give much, if any, weight to the Hellman testimony. We have no reason to disagree with the Examiner. We add that the disclosure of Weinstein also suggests that applications of public key cryptography, other than those envisioned by the authors of New Directions, were being contemplated by those of ordinary skill in the art.

Appellant also argues that either formulation of cited references fails. Appellant argues that in either of Best or Flies in view of Weinstein, the encrypted instructions are designed for a single machine or user with the addition of public key cryptography. (App. Br. 22-23). We disagree, as discussed above, in that the combination would not necessarily result in encrypted instructions designed for use in a single machine. In both Best and Flies, the instructions would be executable by multiple machines that are compatible with the processes disclosed in Best and Flies.

Appellant also argues that Weinstein in view of either Best or Flies provides for cards which work on all machines with no programs, but that the addition of either of Best or Flies restricts use of cards/cartridges. (App. Br. 22-23). We disagree, as discussed above, in that the combination would not necessarily result in restricted use of the insertable media, since it would depend on the compatibility of the machines with the processes disclosed in Best and Flies.

In the Supplemental Answer, the Examiner found that one of ordinary skill in the art would have known that asymmetric cryptography, as in Weinstein, was “better” than symmetric cryptography. (Supp. Ans. 2-6). Appellant argues that neither Flies nor Best is made better by using public key cryptography since key distribution is not an issue in either. (Supp.

Reply Br. 1-3). We find the discussion to be immaterial to the obviousness of the combination of Weinstein with either of Best or Flies since it is not required that a particular combination must be the most desirable or best to provide the motivation for the combination. As such, we do not find Appellant's arguments to be compelling and we affirm the rejection of claims 1-8.

*Other Briefed Issues*

The Appellant alleges that the Examiner improperly uses "code" to gloss over differences. However, the Examiner ultimately found that the usage has been clarified and Appellant has had the opportunity to respond. (App. Br. 24; Ans. 60). Appellant makes similar arguments with respect to the Examiner's use of the terms "information" and instructions" interchangeably. (Reply Br. 6-7). Even if we agreed with Appellant that the terms "code" and "instructions," in the context of the '857 Patent are certainly different or that the terms "information" and "instructions" are likewise different, we find any such juxtaposition by the Examiner to be inadvertent and immaterial to the rejections proffered and our analysis. As discussed above, Appellant has not established any error in the rejection of the claims, even in view of the distinctions between the terms as emphasized by Appellant.

Appellant also argues that the original Board panel, which issued the December 16, 1986 Opinion, considered "New Directions" which is the same as Weinstein. Appellant argues: "[i]nsofar as the '857 claims are concerned, Weinstein adds nothing to 'New Directions.'" (App. Br. 24). As such, Appellant argues that the present issues have already been decided.

However, as the Examiner found, (Ans. 60), the rejection before the prior panel is not the same as the instant rejection. While we have considered the prior panel's opinion, we are not precluded from our findings because of that panel's opinion. The prior panel did not consider any rejections applying Weinstein or Flies and we accept its findings with respect to Best alone. As such, we do not find the present issues before us to have been previously decided.

*Other Issues Raised at Oral Hearing*

At Oral Hearing [but not in its briefs], Appellant indicated that based on the grant of reexamination request, the Requestor wrote a letter to the judge in the above-cited litigation indicating that ordering reexamination supported Requestor's charge of inequitable conduct on the part of Appellant for not disclosing Weinstein to the Examiner in the original prosecution of the '857 Patent. (Oral Hearing p. 29). Seeking to inject into this reexamination proceeding an issue which is apparently before the district court, Appellant requested that we find that (1) "there is nothing in Weinstein that adds anything pertinent to [the] '857 [patent] over New Directions," and (2) Weinstein is cumulative to New Directions. (Oral Hearing p. 29).

Appellant invites us to issue an advisory opinion on an inequitable conduct issue not relevant to any issue before the Board. We decline the invitation. If Appellant believes the references are cumulative, it should present its argument to the district court. *See In re Lanham*, 1 USPQ2d 1877 (Comm'r Pat. 1986), *aff'd sub nom. Stewart Systems, Inc. v. Commissioner*,

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1 USPQ2d 1897 (E.D. Va. 1986) (fraud in the procurement of a patent not an issue which is considered in reexamination)

At Oral Hearing, Appellant also called out attention to a recently decided case, *In re Swanson*, 540 F.3d 1368 (Fed. Cir. 2008). Based on *Swanson*, Appellant invites us to determine whether a substantial new question of patentability exists vis-à-vis a prior reexamination request said to have been made in 1993. According to Appellant, it was decided that the prior request for reexamination determined that no new substantial question of patentability existed. (Oral Hearing p. 32). Appellant told us that (1) the earlier reexamination request was made on the basis of unpatentability of claims in view of Weinstein and Best and (2) the present reexamination request was made on the basis of unpatentability of claims in view of Weinstein, Best, and Flies. Appellant further told us that Flies is cumulative in its teachings with Best and is applied in the alternative to Best. Appellant therefore reasons that the issues in the two reexamination requests were the same, and that reexamination is barred under *Swanson*.

Appellant, of course, is a registered patent attorney and therefore an applicant familiar with reexamination. The *Swanson* issue, having not been presented before the Examiner, or briefed before us, has been waived. 37 C.F.R. § 41.37(c)(1) (vii) ("Any arguments or authorities not included in the brief or a reply brief ... will be refused consideration unless good cause is shown"). To be sure, *Swanson* was decided after briefing. However, unlike *Swanson* who presented and preserved an issue for appeal, Appellant did not do so. No excuse is apparent why the issue could not have been raised. *Swanson* demonstrates that it could have been raised.

Beyond Appellant's failure to raise the issue is the state of this record. Appellant, in effect, invites us (1) to search the record of the prior reexamination, as well as perhaps the prosecution of the application which matured into the patent under reexamination, (2) compare the evidence and arguments made in the prior reexamination with those made in this reexamination, and (3) see if we can come up with some theory upon which Appellant might prevail. We decline this invitation as well. The Board will not take on the role of an advocate for an appellant, particularly in a reexamination requested by a third party.

First, Appellant has not presented a complete record.

Second, we do not have the views of the Examiner on the precise argument which Appellant now seems to advance.

Third, reexamination proceedings are to be carried out with special dispatch.

Fourth, we decline to speculate on the precise facts, or order a remand so that a record can be developed at this point, because the third party requester and district court may be waiting to learn the outcome of this reexamination.

For the reasons given, on a totality of the evidence before us, Appellant has not shown good cause for raising the issue for the first time at oral hearing. We exercise discretion not to consider issue raised for the first time at oral argument.

#### CONCLUSION

Appellant has failed to demonstrate error in the Examiner's determination that a person having ordinary skill in the art would have found it prima facie obvious to combine Weinstein with Best or combine

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Weinstein with Flies according to the rationales supplied in the rejection of the claims of the '857 Patent, and that the proffered combinations would have provided the functionalities specified in the claims of the '857 Patent.

DECISION

The Examiner's decision to reject appealed claims 1-8 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

ack

cc:

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