

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID H. MCDOWELL

Appeal 2008-4811
Application 10/294,306
Technology Center 2100

Decided: December 22, 2008

Before ALLEN R. MACDONALD, ST. JOHN COURTENAY III, and
DEBRA K. STEPHENS, *Administrative Patent Judges*.

STEPHENS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from a final rejection of
claims 1-9. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

STATEMENT OF CASE

Introduction

According to Appellant, Appellant invented a system utilizing a remote computer and a server computer that retrieves information from a remotely located spectrum analyzer (Abstract). The system includes a client computer that communicates over a wide area or local area network to a server connected to both an RF switching device and a spectrum analyzer which is also connected to the RF switching device (Spec. 2, ll. 17-20). The RF switching device is additionally connected to an antenna which receives signals from a satellite (Spec. 2, ll. 9-16; Fig. 1).

The client computer has a local graphical user interface that allows for control of the spectrum analyzer and selection of information retrieved from the spectrum analyzer and displayed or analyzed for specific characteristics (Spec. 3, l. 35 to 4, l. 17 and Figures 2, 3, and 4). Characteristics may include center frequency, frequency span, sweep time, video bandwidth, resolution bandwidth, reference level, scale per division and reference display line amplitude level (Spec. 4, ll. 15-23 and Figure 2, element 22a).

The graphical user interfaces includes a numeric keypad, pull-down lists, and last command entered display that allow a user to input display and analysis selections (Spec. 4, ll. 24-29 and Figure 2, elements 22, 22b, and 23). Additionally, print and exit selection boxes permit storing the plot for display or print-out and exiting the software (Spec. 5, ll. 1 to 5 and Figure 2, element 28).

The server may also process RF data in accordance with commands from the client computer and send trace data to the client computer (Spec. 5, ll. 29 -36). (See also Fig. 5 which illustrates generally how the process works.) The user of the client computer can then selectively switch between transponders or make parameter changes (Spec. 6, ll. 1-2).

Exemplary Claims 1 and 5

Exemplary independent Claim 1 under appeal reads as follows:

A carrier signal analysis system, comprising:

a communication antenna for receiving carrier signals transmitted by transponders on an orbiting spacecraft;

RF switching apparatus coupled to the communication antenna;

a spectrum analyzer is coupled to the RF switching apparatus for receiving the carrier signals for processing;

a server computer coupled to the RF switching apparatus and to the spectrum analyzer for controlling RF feed and processing RF data;

a network coupled to the server computer;

a client computer coupled to the network that communicates with the server computer and the spectrum analyzer; and

software comprising a software interface disposed on the client computer that remotely controls the spectrum analyzer by way of the network and server computer, and that locally processes carrier signals on the client computer that are received by the spectrum analyzer.

Exemplary independent Claim 5 under appeal reads as follows:

Software comprising a software interface for remotely displaying and analyzing carrier signals on a client computer received from a spectrum analyzer, comprising:

a code segment that displays a plot of a received carrier signal derived from a remotely located spectrum analyzer on a display screen of the client computer;

a code segment that displays relevant commands and controls that may be selected to display the carrier signal in a desired manner on the display screen of the client computer;

a code segment that displays a numeric keypad on the display screen of the client computer;

a code segment that displays predetermined selection elements that are user selectable to present the carrier signal on the display screen of the client computer;

a code segment that displays data relating to the frequency and amplitude of the carrier signal on the display screen of the client computer;

a code segment that displays a print box on the display screen of the client computer that may be selected to print the plot of the carrier signal on the display screen; and

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a code segment that displays a selectable exit box on the display screen of the client computer for exiting the software.

Prior Art

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Sprenger	US 5,861,882	Jan. 19, 1999
Hanson	US 6,296,205 B1	Oct. 02, 2001
Moon	US 6,433,801 B1	Aug. 13, 2002
Jorgensen	US 2002/0099854 A1	Jul. 25, 2002
Willenborg	US 6,477,610 B1	Nov. 05, 2002

Rejections

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Sprenger and Hanson.

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Sprenger, Hanson, and Moon.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Sprenger, Hanson, and Jorgensen.

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Sprenger, Hanson, Jorgensen, and Willenborg.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Sprenger and Moon.

Claims 6 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Sprenger, Moon, and Jorgensen.

Claims 7 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Sprenger, Moon, Jorgensen, and Willenborg.

FIRST ISSUES

Claim 1, 6 and 8

Appellant contends the prior art Sprenger does not disclose a server computer and a client computer, the Examiner has not identified any client computer in Sprenger by any reference numeral, and only one computer is shown in Figure 1 of Sprenger (Reply. Br. 6).

The Examiner finds Sprenger teaches a test element may be a server computer that controls RF feed and processes RF data and a client computer coupled to the network that communicates with the server computer and the spectrum analyzer (Ans. 15 and 16).

Issue 1: Has the Appellant shown the Examiner erred in concluding the prior art teaches a client computer coupled to a server computer?

Claim 1

Appellant further contends Sprenger does not disclose a software interface on a client computer that remotely controls the spectrum analyzer by way of the network and server computer and Hanson does not disclose or suggest a system coupling a server computer and a client computer (Reply. Br. 6).

The Examiner finds Sprenger teaches a test element may be a server computer that controls RF feed and processes RF data and a client computer coupled to the network that communicates with the server computer and the spectrum analyzer (Ans. 15 and 16). Additionally, the Examiner finds Sprenger discloses a client computer has a software interface and remotely controls the spectrum analyzer by way of the network and server computer (Ans. 16).

Issue 2: Has the Appellant shown the Examiner erred in concluding the prior art teaches a client computer coupled to a server computer such that the client computer through a software interface, remotely controls a spectrum analyzer by way of the network and server computer?

FINDINGS OF FACT

The following Findings of Fact are shown by a preponderance of the evidence. Additional and more specific Findings of Fact are set forth below in the Analysis.

Appellant's Invention

(1) The server computer controls the RF switching apparatus, controls the spectrum analyzer and communicates with a client computer (Spec. 3, ll. 14-16).

(2) A client computer, including a client software interface, remotely controls the spectrum analyzer through the network and server computer and locally processes carrier signals (Spec. 3, ll. 21-26).

(3) The client software interface provides a local graphical-user-interface (GUI) for the remotely located spectrum analyzer (Spec. 3, ll. 35-37).

Sprenger Patent

(4) An integrated test and measurement means employs a graphical user interface that allows multiple testing elements to be coupled through switches to a bus (Title, ABSTRACT and apparatus shown in Fig. 1).

(5) A computer is coupled via a bus to RF switching apparatus and a spectrum analyzer for controlling RF feed and processing RF data (Col. 3, l. 66 through Col. 4, l. 6; Col. 5, ll. 1-16; and Figures 1 and 2). Sprenger further teaches the bus may be any switching matrix or network (Col. 5, ll. 1-17).

(6) A software interface remotely controls the testing devices (e.g. spectrum analyzer) via the network and locally processes the information (Col. 6, ll. 51-59; Col. 8, line 50 through Col. 9, line 37 that use example of an oscilloscope as a testing device; Fig. 7 and Fig. 9).

Hanson Patent

(7) An inspection satellite includes monitoring equipment and provides diagnostic information of a proximate orbiting satellite (target satellite) to an earth station (operator terminal) (Abstract and Fig. 2).

(8) The inspection satellite includes a monitor system with a processor coupled via a bus to an RF switching apparatus and a spectrum

analyzer and is used to detect and process RF emissions (Col. 3, ll. 9-13 and 53-65; Col. 4, ll. 5-13; Col. 5, ll. 31-38; Claim 4 and Fig. 2). The monitor system includes a receiving system that, under the control of the processor, selects a receptor to provide the signals of the desired characteristics sought to be tested and then provides the received signals or emissions (Col. 5, ll. 53-65).

(9) The inspection satellite (through its processor) communicates with the remote operator terminal (Col. 3, ll. 13-17 and Figure 2).

(10) An operator at the operator terminal controls the monitor equipment in the inspection satellite through a user interface resembling the monitor equipment selected (Col. 4, ll. 13-19). The operator terminal can view and process the received RF emissions (Col. 4, ll. 27-32).

Jorgensen

(11) Client and server computers are connected for communications over various networks (LAN, WAN, etc.) to communicate with other devices (p.16, [0208] and Figs. 1A, 1B, and 2A)

PRINCIPLES OF LAW

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of

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nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

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 subject matter pertains.”

KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1734 (2007).

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court explained:

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

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unless its actual application is beyond his or her skill.

Id. at 1740. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

ANALYSIS

Issue 1: Claims 1, 6 and 8

Sprenger does not specifically teach a client and server computer. However, both Jorgensen and Hanson do. Jorgensen specifically describes several networks with a client and server (FF11). Hanson teaches an operator terminal that, like the client computer in Appellant’s invention, includes a software interface that allows remote control of the spectrum analyzer through the network and a server computer and locally processes carrier signals (FF 2 and 10).

Additionally, Hanson teaches a monitor system including a processor that, like the server computer in Appellant’s invention, controls the spectrum analyzer and communicates with the client computer (i.e., operator terminal) (FF 1, 8, and 9). We therefore find Hanson and Jorgensen each teach a client and server computer.

Issue 2: Claim 1

Sprengrer teaches a graphical user interface that remotely controls the testing devices – which can be a spectrum analyzer – via the network (FF 6). Hanson further teaches a user interface is a software interface that remotely controls the monitor equipment (one of which can be the spectrum analyzer) by way of the network and server computer (FF 9 and 10). Since in both Sprengrer and Hanson, the software interface is present on the computer display and used to remotely control the testing device (spectrum analyzer), we find Sprengrer and Hanson each teach “software including a software interface that remotely controls the spectrum analyzer by way of the network” (claim 1).

Hanson further teaches the client computer communicates with the monitor equipment (spectrum analyzer) through the network to the processor (server computer) (FF 9 and 10). Accordingly we find Hanson teaches “software including a software interface that remotely controls the spectrum analyzer by way of the network and server computer” (claim 1).

Additionally, Hanson teaches the operator terminal can view and process the received RF emissions (FF 10). The RF emissions are the signals received by the spectrum analyzer (FF 8). Since a carrier signal is an RF emission, we find Hanson teaches the client computer “locally processes carrier signals on the client computer that are received by the spectrum analyzer” (claim 1).

Sprenger teaches the computer locally processes the information received by the testing device which can be a spectrum analyzer (FF 6). Since a spectrum analyzer can provide the carrier signal (and other signals), we find Sprenger also teaches the computer “locally processes carrier signals on the client computer that are received by the spectrum analyzer” (claim 1).

With the above discussion in mind, we find “software comprising a software interface disposed on the client computer that remotely controls the spectrum analyzer by way of the network and server computer, and that locally processes carrier signals on the client computer that are received by the spectrum analyzer” (claim 1) is taught by Hanson alone and by the combination of Hanson and Sprenger.

CONCLUSION OF LAW

We find Appellant has failed to show the Examiner erred in concluding the prior art, Sprenger and Hanson, teaches a client computer coupled to a server computer such that the client computer through a software interface, remotely controls a spectrum analyzer by way of the network and server computer.

ADDITIONAL ISSUES

Appellant contends the Examiner erred in concluding a skilled artisan would combine the features of Sprenger, Hanson, Moon, Jorgensen, and Willenborg in various combinations.

Appellant contends:

- Sprenger is directed to integrated test and measurement means employing a graphical user interface and nowhere teaches, suggests or implies use of the system for satellite applications (App. Br. 9);
- Hanson is related to RF inspection satellite (App. Br. 10);
- Moon is directed to a method and apparatus for using a touch screen display on a portable intelligent communications device (App. Br. 13);
- Jorgensen teaches an error recovery protocol (App. Br. 15); and
- Willenborg is directed to reordering responses at a data bus based on size of the response (App. Br. 16).

Appellant therefore asserts:

- (1) The references are non-analogous art (App. Br. 9-10, 13-16, and 19-21);
- (2) The references do not provide motivation or suggestion to one skilled in the art to combine the references (App. Br. 9-10, 13-16, and 19-21); and
- (3) The Examiner used improper hindsight reconstruction (Reply Br. 7, 8, 11, 13, and 14).

Appellant next contends if the cited elements of Moon were important, they would have been disclosed in the Sprenger patent (Reply Br. 10) and had the aspect disclosed in Jorgensen been required or desired

in the Sprenger system, it would have been disclosed in the Sprenger patent (Reply Br. 14).

The Examiner concludes:

(1) Sprenger and Hanson are analogous art both directed to monitoring data of a spectrum analyzer displayed on a graphical user interface and including the Hanson antenna to obtain diagnostic information from an orbiting satellite would have been obvious to a person of ordinary skill in the art (Ans. 17);

(2) Sprenger, Hanson, and Moon are in the same field of endeavor, namely monitoring data and displaying it on a graphical user interface, and incorporation would allow easier use of the graphical user interface and therefore, it would have been obvious to incorporate Moon's numeric keypad, print box and exit box and Hanson's communication antenna into Sprenger's test and measurement system (Ans. 19);

(3) Sprenger, Hanson, and Jorgensen are all directed to transmitting information and displaying the information on a graphical user interface; therefore, it would have been obvious to a person of ordinary skill in the art to include the error recovery protocol as taught by Jorgensen within the modified Sprenger carrier signal analysis system to provide information with greater reliability (Ans. 19);

(4) Sprenger, Hanson, Jorgensen, and Willenborg are related to transmitting information within a network; therefore, at the time of the

invention it would have been obvious to a person of ordinary skill in the art to include the optimization algorithm as taught by Willenborg within the modified Sprenger carrier signal analysis system to maximize the efficiency of a bus (Ans. 20);

(5) Moon teaches a graphical interface; therefore, it would have been obvious to a person of ordinary skill in the art to include the graphical user interface components as taught by Moon within the graphical user interface of Sprenger for greater ease of use (Ans. 20); and

(6) The combination of Willenborg's handling of trace data, Moon's graphical interface elements and Jorgensen's communication system management would have been obvious to incorporate into the Sprenger system (Ans. 21).

Has Appellant met the burden of showing the Examiner erred:

(1) In concluding motivation exists for combining the Sprenger, Hanson, Jorgensen, Willenborg, and Moon references in the various combinations presented by the Examiner?

(2) By using a piecemeal reconstruction and hindsight to combine aspects of the five references (Sprenger, Hanson, Jorgensen, Willenborg, and Moon)?

(3) In concluding the five references (Sprenger, Hanson, Jorgensen, Willenborg, and Moon) reside in analogous art?

ADDITIONAL FINDINGS OF FACT

The following Findings of Fact are shown by a preponderance of the evidence.

Sprenger Patent

(12) A wide range of radios, radio system and other apparatus are tested using equipment or testing elements such as oscilloscopes, baseband analyzers, spectrum analyzers, signal generators and other equipment (ABSTRACT and Col. 6, l. 62 through Col. 7, l. 8).

(13) These testing elements are coupled to a bus under control of a computer (ABSTRACT and apparatus shown in Fig. 1).

Hanson Patent

(14) The monitor equipment or diagnostic equipment may include a filter bank, a spectrum analyzer, a phase and linearity analyzer, and other such equipment (Col. 3, l. 66 to Col. 4, l. 13).

(15) The inspection satellite includes a diagnostic control processor that communicates to an operator terminal (Col. 3, ll. 61-65 and Fig. 2).

Moon Patent

(16) A cellular telephone taught by Moon includes a graphical user interface (col. 1, ll. 8-11). Various functions can be provided through the interface including command selection, keypads, and buttons that perform preselected functions (Col. 1, ll. 11-15 and Figures 3-13).

(17) A microprocessor controls data transfer, controls the graphical display, and communicates with other components over a bus system (Col. 4, ll. 60-67).

Jorgensen Patent

(18) The wireless system and method of Jorgensen seeks to improve quality of service in a wireless transmission system including improving the accuracy of the sent data and accounting for lost data by retransmitting data until receipt of a non-corrupted data packet is acknowledged (Page 1, [0001] and Page 41, [0574]).

(19) A standard telecommunications network includes many different types of computers and other processing devices that communicate across the network (Page 12, [0160] to [0162] and Figure 1A).

Willenborg Patent

(20) The Willenborg system prioritizes small command structures in bus arbitration where normal bus arbitration permits large data transfers (Abstract).

ADDITIONAL PRINCIPLES OF LAW

Non-Analogous

References within the statutory terms of 35 U.S.C. § 103 qualify as prior art for an obviousness determination only when analogous to the claimed invention. *In re Clay*, 966 F.2d 656, 658 (Fed. Cir. 1992). Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986); see also *In re Wood*, 599 F.2d 1032, 1036 (CCPA 1979) and *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004).

Motivation to Combine

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 subject matter pertains.”

KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. at 1734 (2007).

The Court further stated:

To facilitate review, this analysis should be made explicit. *See In re Kahn*, 441 F.3d 977, 988 [78 USPQ2d 1329] (C.A. Fed. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be

some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

KSR, 127 S. Ct. at 1741. Additionally, the Court stated:

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.

KSR, 127 S. Ct. at 1740.

Hindsight

The Federal Circuit has stated “While this court indeed warns against employing hindsight, its counsel is just that – a warning. That warning does not provide a rule of law that an express, written motivation to combine must appear in prior art references before a finding of obviousness. Stated differently, this court has consistently stated that a court or examiner may find a motivation to combine prior art references in the nature of the problem to be solved.” *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1276

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(Fed. Cir. 2004); Also *Pro-Mold & Tool Co. v. Great Lake Plastic Inc.*, 75 F.3d 1568, 1573; *In re Huang*, 100 F.3d 135, 139 n.5; (Fed. Cir. 1996).

ANALYSIS

The Examiner has articulated reasons why a skilled artisan would have been motivated to combine each feature of the prior art references into the Sprenger system that are persuasive. Further, Sprenger, Hanson, Moon, and Jorgensen are all directed to radio based systems (FF 1, 7, 12, 14, 16, and 18). Willenborg is directed to handling data on a bus (FF 20). The bus is present in computer based systems. Sprenger, Hanson, Moon, and Jorgensen all are computer based with buses (FF 13, 15, 17, and 19).

Therefore, we find Sprenger, Hanson, Moon, Jorgensen, and Willenborg are from the same field of endeavor – computer based systems handling data. Additionally, we find all five references are within the field of the inventor’s endeavor – to provide remote testing of a wireless device in an efficient and effective manner.

Both the Sprenger and Hanson systems seek to test the various signals, digital processing, modulations, signal coding techniques, and other aspects of radios, radio systems or components thereof (FF 13 and 14). Both teach systems that couple computers over a network to a testing device(s) utilizing switches to select the coupling (FF 5 and 8). Further, both Sprenger and Hanson teach computers with a graphical user interface to allow a user

to control the testing device(s) and receive, analyze, and process received information remote from the actual testing devices (FF 6 and 11).

Therefore, we find a skilled artisan would have been motivated to combine Sprenger and Hanson.

Moon addresses the same issue both the Sprenger and Hanson graphical user interfaces address - allowing a user ease in controlling functionality (FF 16). Therefore, we find a skilled artisan would have been motivated to combine the graphical user interface of Moon with the Sprenger system and the modified Sprenger and Hanson system to better control remote device's functionality.

Jorgensen teaches a radio system that may include a satellite, with functionality to improve quality of service in a wireless system network, specifically, the accuracy and timing of information delivery over the network using an error recovery protocol (FF 18). Thus, we find a skilled artisan would have been motivated to incorporate Jorgensen's error recovery protocol into the Sprenger system, modified Sprenger and Hanson system and modified Sprenger and Moon system to improve the accuracy and timing of information delivery over the network.

Willenborg teaches sending data to a client computer until a change command is transmitted (FF 20). This feature of Willenborg insures accurate and complete data in a network. Again, we find a skilled artisan would have been motivated to include this feature in the modified Sprenger systems to allow a user at the client computer to receive trace data from a

remote device until the user inputs a new command.

We further find a skilled artisan would have been motivated to combine the features of Moon, Jorgensen, and Willenborg into the Sprenger system or modified Sprenger and Hanson systems.

§ 103

Appellant argues had the aspect disclosed in Moon been required or desired in the Sprenger system, it would have been disclosed in the Sprenger patent. Appellant makes a similar argument regarding inclusion of elements taught by Jorgensen.

The Examiner's rejection is under 35 U.S.C. § 103 not 35 U.S.C. § 102. 35 U.S.C. § 103 requires 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 to a skilled artisan.

The Examiner has articulated why one skilled in the art would have been motivated to combine features of the various references into the Sprenger system, based on the references analogous art and the nature of the problem to be solved. Appellant has not provided any argument as to why hindsight or piecemeal combination was used.

Appellant has not shown or articulated a reason as to how the Examiner erred in combining the references in their varying combinations. Therefore, for the reasons articulated above, we find one skilled in the art would have been motivated to combine the features of Sprenger, Hanson,

Moon, Jorgensen, and Willenborg to provide a system for testing remote devices over a radio network in an efficient and accurate manner.

CONCLUSION OF LAW

Appellant has not met the burden of showing the Examiner erred:

(1) In concluding motivation exists for combining the Sprenger, Hanson, Jorgensen, Willenborg, and Moon references in the various combinations presented by the Examiner;

(2) By using a piecemeal reconstruction and hindsight to combine aspects of the five references (Sprenger, Hanson, Jorgensen, Willenborg, and Moon); and

(3) In concluding the five references (Sprenger, Hanson, Jorgensen, Willenborg and Moon) reside in analogous art.

We find a skilled artisan would have been motivated to combine the features of Hanson, Moon, Jorgensen and Willenborg in the varying combinations identified by the Examiner in the rejections, into the system of Sprenger.

CLAIMS 1-9: REMAINING ELEMENTS ARGUED

For the remaining elements of claims 1-9 specifically noted by Appellant in the Appeal Brief, Appellant has: (1) merely quoted the portion of the prior art the Examiner cited; (2) recited the language of the claim; (3) asserted the limitations are not taught or suggested by the prior art cited;

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and, (4) failed to respond to the specifics of the Examiner's rejection (see App. Br. 6-21).

Appellant has failed to show the Examiner presented insufficient evidence of *prima facie* obviousness and further, has not rebutted the Examiner's *prima facie* case with evidence of secondary indicia of nonobviousness. Moreover, Appellant has failed to comply with the requirements of 37 C.F.R. § 1.111(b) by merely reciting the language of the claim and asserting such language is not taught by the reference.

Therefore, we conclude Appellant has not met the burden of coming forward with evidence or argument to rebut the Examiner's legal conclusion of obviousness for the cited elements of claims 1-9. The effect is Appellant has not in effect presented arguments directed to these remaining noted elements.

REPLY BRIEF

We note the Reply Brief is properly used to respond to issues raised by the Examiner in the Answer and not as a means for presenting new arguments. *See Optivus Tech., Inc. v. Ion Beam Applications S.A.*, 469 F.3d 978, 989 (Fed. Cir. 2006) (an issue not raised in an opening brief is waived). While we have fully considered Appellant's responses in the Reply Brief, we decline to address any new issues not originally presented in the principal Brief. With respect to all claims before us on appeal, arguments Appellant could have made but chose not to make have not been considered

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and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Watts*, 354 F.3d 1362, 1368 (Fed. Cir. 2004).

DECISION

The Examiner's rejection of Claims 1 through 9 is affirmed.

The Examiner's rejection of Claim 1 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Sprenger and Hanson is affirmed.

The Examiner's rejection of Claim 2 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Sprenger, Hanson, and Moon is affirmed.

The Examiner's rejection of Claim 3 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Sprenger, Hanson, and Jorgensen is affirmed.

The Examiner's rejection of Claim 4 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Sprenger, Hanson, Jorgensen, and Willenborg is affirmed.

The Examiner's rejection of Claim 5 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Sprenger and Moon is affirmed.

The Examiner's rejection of Claims 6 and 8 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Sprenger, Moon, and Jorgensen is affirmed.

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The Examiner's rejection of Claims 7 and 9 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Sprenger, Moon, Jorgensen, and Willenborg 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

rwk

K&A ASSOCIATES
1407 FOOTHILL BLVD., SUITE 233
LA VERNE CA 91750