

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 67

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAYMUND H. EISELE

Appeal No. 2001-1786
Application 08/420,796

ON BRIEF

Before JERRY SMITH, RUGGIERO and BLANKENSHIP, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 28, 30-35 and 37-47, which constitute all the claims remaining in the application.

The disclosed invention pertains to a method and apparatus for enhancing the data security of an electronic data processing computer. The invention uses a device which can be

inserted into the conventional floppy disk drive or tape cassette drive of the electronic computer. A data processing means within the device performs processing of data to enable secure access, encryption and affecting operation of the electronic computer. The device operates to simulate the presence of a floppy disk or a tape cassette as input to the computer.

Representative claim 28 is reproduced as follows:

28. A data security system for electronic data processing equipment, the electronic data processing equipment having a central processing unit with a storage unit, the storage unit being one of a diskette drive and a tape cassette storage unit having at least one magnetic read/write head, and a device for providing data security, the device comprising:

housing means for housing components of the device, and for insertion into the storage unit, the housing means being of a shape and size of one of a diskette and a cassette housing and being designed to fit at least partially into and operatively engage the storage unit;

a single interface means disposed in said housing means, for transferring data to and from the device and the at least one magnetic read/write head of the storage unit of the electronic data processing equipment;

data processor means, disposed in said housing means and operatively connected to said interface means, for performing processing of data to enable secure access, encryption, and affecting operation of the electronic data processing equipment;

a battery, disposed in said housing means, for storing energy to operate the device; and

wherein the interface means includes simulation means for simulating one of a diskette and a tape storage medium, the simulation means comprising driver circuit means operatively

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connected to the data processor means, for converting digital data signals from the data processor means into simulated storage media signals to be provided to the storage unit and for converting received signals from the storage unit into digital data signals for processing by the data processor means.

The examiner relies on the following references:

Berwick et al. (Berwick)	4,504,871	Mar. 12, 1985
Hirokawa	4,672,182	June 09, 1987
Francini et al. (Francini)	4,701,601	Oct. 20, 1987
Sato et al. (Sato)	4,891,727	Jan. 02, 1990
		(filed June 15, 1988)
Eisele	5,159,182	Oct. 27, 1992

Claims 28, 30-35 and 37-47 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-11 of Eisele. Claims 28, 30-35 and 37-47 also stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Hirokawa in view of Sato, Francini and Berwick.

Rather than repeat the arguments of appellant or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness and double patenting relied upon by the examiner as support for the rejections. We have, likewise, reviewed and

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taken into consideration, in reaching our decision, the appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. We reach the same conclusion with respect to the double patenting rejection. Accordingly, we reverse.

We consider first the rejection of the appealed claims on the ground of obviousness-type double patenting over the claims of Eisele. As a preliminary matter, we note that appellant filed a terminal disclaimer in parent application Serial No. 07/947,570, and that this is a continuation application of that application filed under 37 CFR § 1.62 (file wrapper continuation) which was effective at that time. Appellant argues that the terminal disclaimer filed in the parent application should be effective in this file wrapper continuation [brief, pages 7-8]. The examiner responds that the terminal disclaimer filed in the parent application is not effective in this file wrapper continuation because the disclaimer does not by its terms

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indicate that it applies to any continuation applications filed with respect to the parent application [answer, page 8].

We agree with the examiner on this point. As noted by the examiner, this question is covered in section 1490 of the Manual of Patent Examining Procedure (MPEP). Although appellant's argument would be correct under current practice involving continued prosecution applications (CPAs) or requests for continued examination (RCEs), the current practice does not apply to file wrapper continuations filed under 37 CFR § 1.62. Since a file wrapper continuation is given a new application number, it is considered to be a different application from its parent application for purposes of a terminal disclaimer. Therefore, since appellant's terminal disclaimer does not indicate that it applies to any continuations filed, it is not effective with respect to this file wrapper continuation.

Thus, we consider the double patenting rejection on the merits. The examiner's rejection states the following:

Although the conflicting claims are not identical, they are not patentably distinct from each other because deletion of a feature, with a corresponding loss of function has been held to be obvious. Note *In re Porter*, 20 USPQ 298. For example, claim 1 of the patent is substantially similar to claim 28 of the instant application yet patented claim 1 further

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includes the recitation of electric power generation means including a rotor, etc., which recitation has not been included in claim 28. Thus the deletion of this limitation, with the corresponding loss of function, would have been obvious to those of ordinary skill in the art in light of the above decision. [answer, page 4].

Thus, the rejection has considered only a single claim of the application (claim 28) and has addressed only the obviousness of eliminating a feature and its corresponding function.

Ordinarily, this rejection would not constitute a prima facie case of obviousness-type double patenting because it does not consider each of the claims on appeal and does not provide a claim by claim comparison of the claims on appeal and the claims of the patent. The examiner has the same burden of providing a prima facie case of unpatentability in support of an obviousness-type double patenting rejection as the examiner has in supporting an obviousness rejection under 35 U.S.C. § 103. However, since appellant has provided a detailed argument in response to this rejection which has forced the examiner to explain in more detail the rationale behind this rejection, we will consider this rejection on the merits.

Appellant has provided a detailed analysis of why the claims of this application are not obvious over the claims of the

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Eisele patent. Specifically, with respect to independent claim 28, appellant argues that claim 28 is directed to a security system while no claims of the patent define a security system or security device [brief, pages 15-16]. The examiner responds that since the Eisele patent and this application have the same disclosure, and since the claims are recited in "means-plus-function" form, the data processor means of this application is the same as the data processor means of the patent when the specification is used to interpret the claimed subject matter [answer, pages 10-11]. The examiner also responds that even if the processor means of the patent do not include the disclosed security features, such feature would have been obvious to the artisan anyway [*id.*, pages 11-12].

We do not agree with either of the examiner's positions in support of the rejection. On the latter point, the examiner has failed to provide evidence in support of the obviousness of adding the claimed security features to the claims of the Eisele patent. Merely because security features were known in the art is not evidence that it would have been obvious to add these features to the claimed invention of the Eisele patent. See the discussion of claim 11 in In re Thrift, 298 F.3d 1357, 63 USPQ2d 2002 (Fed. Cir. 2002). Thus, the Board cannot accept mere

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conclusions of obviousness by the examiner which are not supported by appropriate evidence on the record.

On the former point, we do not agree with the examiner's interpretation of the claims on appeal or the claims of the patent. Claim 1 of the patent recites a processor means "for performing processing of data" while claim 28 recites a data processor means "for performing processing of data to enable secure access, encryption, and affecting operation of the electronic data processing equipment." Although the processor means of both claims performs the processing of data, the means of claim 28 performs processing data for the specific purpose of access, encryption, and affecting operation of the electronic data processing equipment. Thus, the specific function of processing recited in claim 28 is not the same as the more general function recited in patent claim 1.

Construction of a means-plus-function limitation involves two steps. First, one must identify the claimed function. Telemac Cellular Corp. v. Topp Telecom, Inc., 247 F.3d 1316, 1324, 58 USPQ2d 1545, 1549 (Fed. Cir. 2001); Micro Chem., Inc. v. Great Plains Chem. Co., Inc., 194 F.3d 1250, 1258, 52 USPQ2d 1258, 1263 (Fed. Cir. 1999). One must construe the function of a means-plus-function limitation to include the limitations

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contained in the claim language, and only those limitations. It is improper to narrow the scope of the function beyond the claim language. It is equally improper to broaden the scope of the claimed function by ignoring clear limitations in the claim language. Ordinary principles of claim construction govern interpretation of the claim language used to describe the function.

After identifying the claimed function, one must then determine what structure, if any, disclosed in the specification corresponds to the claimed function. In order to qualify as corresponding, the structure must not only perform the claimed function, but the specification must clearly associate the structure with performance of the function. This inquiry is undertaken from the perspective of a person of ordinary skill in the art. Amstel Corp. v. Info. Storage Devices, Inc., 198 F.3d 1374, 1378-79, 53 USPQ2d 1225, 1227-28 (Fed. Cir. 1999). See Cardiac Pacemakers, Inc. v. St. Jude Medical Inc., 296 F.3d 1106, 1113, 63 USPQ2d 1725, 1730 (Fed. Cir. 2002).

The first inquiry noted above results in a finding that the function performed by the processor means of claim 28 is not the same as the function performed by patent claim 1. As noted above, the function of the claimed means cannot be narrowed or

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broadened beyond the actual language of the claim. The structure necessary to support the functions of appealed claim 28 is not the same as the structure necessary to support the function of patent claim 1. Note that the Eisele patent discloses that processor means 2 serves to transmit data between processor 2 and the data processing equipment [column 4, lines 51-54]. The patent also discloses that a particular feature of processing means 2 is that it can also be used for verification, encryption and decryption [id., lines 55-59]. Thus, the processing means of patent claim 1 is not required to have the additional structure of appealed claim 28 for performing the security related functions. Therefore, it was improper for the examiner to consider the means of patent claim 1 to be exactly the same as the means of appealed claim 28.

Independent claim 47 is also recited in "means-plus-function" form in which the functions of claim 47 are not the same as the functions recited in the claims of the patent. Therefore, the examiner has improperly determined the scope of claim 47 and the claims of the patent for the same reasons discussed above with respect to claim 28.

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With respect to independent claims 39 and 40, which are drafted in process form, appellant argues that these claims recite a method of operating a security system whereas none of the patent claims recite a method or a security system. Appellant notes that claim 39 recites steps of transferring user identification data, verifying user authorization, and transferring a verification result, and that these functions are not recited in the patent claims. Appellant makes similar arguments with respect to claim 40 [brief, pages 18-24].

The examiner responds that the recitation of the function and the intended use of the claims in the patent renders obvious the method claims on appeal. The examiner also notes that the steps of these method claims are either inherent in the device claims of the patent or are the logical result of the incorporation of known security features [answer, pages 12-13].

The examiner's double patenting rejection of claims 39 and 40 fails for essentially the reasons argued by appellant in the brief. The claims of the Eisele patent recite nothing about user identification data, user authorization, verification results and personal identification numbers. The steps of the claims on appeal which perform operations on data of this type are not inherent in the device of the patent claims and not

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obvious based on the examiner's bare opinion which is unsupported by any evidence on this record.

In summary, the examiner's double patenting rejection fails with respect to each of the independent claims on appeal. Therefore, we do not sustain this rejection with respect to any of the claims on appeal.

We now consider the rejection of claims 28, 30-35 and 37-47 under 35 U.S.C. § 103 as unpatentable over the teachings of Hirokawa in view of Sato, Francini and Berwick. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert.

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denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 1.192(a)].

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The examiner has indicated how he finds the claims on appeal to be obvious over the applied prior art [answer, pages 5-8]. Appellant has argued in detail the alleged deficiencies of each of the applied references, the impropriety of combining the teachings of the applied prior art, and the reasoning behind appellant's position that the examiner's rejection can only be the result of an improper attempt to reconstruct appellant's invention in hindsight [brief, pages 24-41]. The examiner provides a detailed response in an effort to justify the rejection [answer, pages 13-25].

We will not sustain this rejection of the examiner for essentially the reasons provided by appellant in the brief. We reach this decision primarily because we agree with appellant that there is no motivation for combining the references in the manner proposed by the examiner. The proposed combination of the applied references clearly requires that certain features of each of the references be selected to the exclusion of other features of each of the references. Although the examiner purports to rationalize why this selective use of certain features of the references would have been obvious to the artisan, we are compelled to find that the only motivation for combining the specific selected features of these particular references, while

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eliminating other taught features, is to reconstruct the invention using the claims as a template for applying the prior art. We agree with appellant that this constitutes an improper reconstruction of the claimed invention using hindsight gained by the claimed invention. Accordingly, we do not sustain this rejection of the claims on appeal.

In summary, we have not sustained either of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 28, 30-35 and 37-47 is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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JOSEPH F. RUGGIERO)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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