

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** JOHN PETERSON

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Appeal No. 96-4189  
Application 08/279,157<sup>1</sup>

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ON BRIEF

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Before MARTIN, FLEMING and CARMICHAEL, **Administrative Patent Judges**.

FLEMING, **Administrative Patent Judge**.

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<sup>1</sup> Application for patent filed July 22, 1994.

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**DECISION ON APPEAL**

This is a decision on appeal from the final rejection of claims 8 through 16, all of the claims pending in the present application. Claims 1 through 7 have been canceled.

The invention relates to security systems. In particular, the invention relates to a security system having a remote control unit for producing IR signals to arm or disarm the security system. On page 6 of the specification, Appellant discloses that Figure 1 is a schematic of the invention. Figure 1 shows a security system 2 provided with an indoor remote signal receiver 20 having a display 30, a personal remote control 22 and a control panel 6. On page 7 of the specification, Appellant discloses the disarming sequence of the security system which is controlled by the remote control 22. A user positions himself adjacent a window pane 42 of the dwelling such that the display 30 of the indoor remote signal receiver 20 is visible. A first IR signal is

generated by the remote control when the user presses button 24 on the remote control. The indoor remote signal receiver 20 then communicates with the control panel 6 via another communication channel such as RF. The control panel 6 then sends to the indoor remote signal receiver a prompt, "enter first code." This prompt is displayed on the display 30 of the indoor remote signal receiver 20 to instruct the user. The user then presses a series of actuations of either of the buttons 24 or 26 of the remote control 22 to enter the first code. The display 30 then provides a second prompt asking the user to enter a second code. On page 8 of the specification, Appellant discloses when all of the proper codes have been properly entered, display 30 then provides a prompt, "do you want the system to remain armed" and again the user can communicate "yes" or "no" by pressing a particular sequence of the buttons on the remote control 22.

The independent claim 8 is reproduced as follows:

8. A security system comprising a number of sensors for sensing an alarm condition, a control panel for receiving signals from said sensors and processing the same for determination of an alarm event, an interior keypad for inputting information to said control panel, said security system further comprising a wireless remote control arrangement having a portable unit to be carried by a user and an interior receiver arrangement for receiving signals from said portable unit and communicating with said control panel to alter the status of the security system including arming and disarming of the security system; said portable unit including at least one key actuator and means to generate and transmit a predetermined IR signal in response to actuation of said at least one key actuator, said receiver arrangement upon receipt of said predetermined IR signal from said portable unit providing visual feedback to the user to assist the user in the entry of an identification code produced by means of a series of IR signals produced by multiple actuation of said at least one key actuator and to also assist the user in the entry of instructions to alter the status of the security system, said interior receiver upon receipt of said IR signals to alter the status of the security system instructing said control panel to change the status of the security system in accordance with said received IR signals.

The Examiner relies on the following references:

Lewiner et al. (Lewiner) 1987	4,692,762	Sept. 8,
van den Boom et al. (van den Boom) 1988	4,723,121	Feb. 2,
Jacob 1990	4,908,604	Mar. 13,

Claims 8 through 16 stand rejected under 35 U.S.C.

§ 103 as being unpatentable over Jacob in view of Lewiner and van den Boom.

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Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the brief and answer<sup>2</sup> for the respective details thereof.

**OPINION**

We will not sustain the rejection of claims 8 through 16 under 35 U.S.C. § 103.

The Examiner has failed to set forth a ***prima facie*** case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found

in the prior art, or by implications contained in such teachings or suggestions. ***In re Sernaker***, 702 F.2d 989, 995,

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<sup>2</sup> The Examiner mailed a supplemental Examiner's answer on July 10, 1996. However, the answer is a substitute for the Examiner's answer mailed on May 8, 1996. We will thereby treat the July 10, 1996 as the Examiner's answer for this appeal.

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217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." ***Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.***, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), ***cert. denied***, 117 S.Ct. 80 (1996) ***citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.***, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), ***cert. denied***, 469 U.S. 851 (1984).

Appellant argues on pages 7 and 8 of the brief that neither Jacob, Lewiner nor van den Boom, together or individually, teaches or suggests a portable unit and an interior unit which allows for an interaction between the user operation, the portable unit, and the interior unit, where the user actuates the key in response to visual feedback from the interior unit which cumulatively results in entry of a code to change the status of the security system as recited in Appellant's claim 8. Appellant argues on pages 17 and 18 of the brief that neither Jacob, Lewiner nor van den Boom,

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together or individually, teaches or suggests generating and transmitting of an IR signal

in response to actuation of the one key actuator, receiving and recognizing the IR signal at the receiver arrangement, providing visual feedback confirming receipt and recognition of the predetermined IR signal, generating and transmitting further predetermined IR signals in response to multiple actuation of the at least one key actuator of the portable unit and providing visual feedback confirming the receipt and recognition of the IR signal when the authorization has been received, and thereafter providing visual prompts to alter the status of the security system as recited in Appellant's claim 16.

We note that Appellant's claims recite a series of interactions between the user using a remote controller and the interior receiver with a visual feedback after each entry to the user to assist the user to change the status of the security system. Appellant's claim 8 recites a

means to generate and transmit a predetermined IR signal in response to actuation of

said at least one key actuator, said receiver arrangement upon receipt of said predetermined IR signal from said portable unit providing visual feedback to the user to assist the user in the entry of an identification code produced by means of a series of IR signals produced by multiple actuation of said at least one key actuator and to also assist the user in the entry of instructions to alter the status of the security system . . . .

Similarly, we note that the only other independent Appellant's claim, claim 16 recites:

generating and transmitting a predetermined IR signal in response to actuation of at least one key actuator of said portable unit,

receiving and recognizing said predetermined IR signal at said receiver arrangement and providing visual feedback confirming receipt and recognition of said predetermined IR signal by said receiver arrangement,

generating and transmitting further predetermined IR signals in response to multiple actuation of the at least one key actuator of said portable unit to thereby enter an authorization code,

receiving and recognizing said further predetermined IR signals

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at said receiver arrangement and providing visual feedback confirming receipt and recognition of said predetermined IR signals by said receiver arrangement when the authorization code has been received, and thereafter,

providing visual prompts to alter the status of the security system . . . .

The Examiner argues on pages 4 and 5 of the answer that Lewiner teaches in column 2, lines 53-63, and column 3, lines 29-32, that multiple actuation of the keys of the remote determines the entry code. The Examiner also states that Lewiner teaches in column 4, lines 52-56, that the code can be displayed to the user prior to being transmitted.

Upon a careful review of Lewiner, we fail to find the Appellant's claimed limitations of the multiple sequence of interaction between the user and the interior receiver in which a predetermined IR signal is transmitted by the remote, the receiver in response displays a visual prompt, a series of IR signals is then transmitted by the remote and then the receiver instructs the control panel to change the status of

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the security system. Lewiner teaches that the user opens the garage door by pressing a series of keys on the remote to transmit a coded signal to cause the receiver to open the garage door. We agree that Lewiner also teaches that the series of code numbers entered by the user may be displayed by the remote as they are entered. However, Lewiner does not teach Appellant's claimed multiple sequence of interactions between the user and the interior receiver.

We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a

prior art reference, common knowledge or capable of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a *prima facie* case. *In re Knapp-Monarch Co.*, 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961); *In re Cofer*, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966).

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Furthermore, we fail to find any suggestion of modifying Jacob to obtain the invention as recited in Appellant's claims. The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), *citing In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." *Para-Ordnance Mfg.*, 73 F.3d at 1087, 37 USPQ2d at 1239, *citing W. L. Gore*, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13. Therefore, we will not sustain the rejection of claims 8 through 16 under 35 U.S.C. § 103 as being unpatentable over Jacob in view of Lewiner and van den Boom.

We have not sustained the rejection of claims 8 through 16 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

**REVERSED**

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	JOHN C. MARTIN	)	
	Administrative Patent Judge	)	
		)	
		)	
		)	BOARD OF
PATENT		)	
	MICHAEL R. FLEMING	)	APPEALS AND
	Administrative Patent Judge	)	
INTERFERENCES		)	
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		)	
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