

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(2) is not binding precedent of the Board.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. 38

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARL HEITSCHEL, COLIN WILLMOTT,
and WAYNE SCHINDLER

Appeal No. 1999-0880
Application 08/700,610¹

HEARD: October 18, 1999

Before KRASS, BARRETT, and FRAHM, Administrative Patent Judges.

¹ Application filed August 12, 1996, for reissue of U.S. Patent No. RE 35,364, which is based on Application No. 08/425,724, filed April 20, 1995, which is a continuation of Application 08/087,142, filed July 2, 1993, now abandoned; which is a continuation of Application 07/715,006, filed June 13, 1991, now abandoned; which is a continuation of Application 07/398,379, filed August 24, 1989, now abandoned; which is a continuation of Application 06/792,661, filed October 29, 1985, now U.S. Patent No. 4,750,118; which is a continuation-in-part of Application 06/615,339, filed May 30, 1984, now U.S. Patent No. 4,638,433.

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KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 20 through 45, all of the claims pending in this reissue application.

The invention is directed to remote control garage door openers. More particularly, manual code switches for transmitters in such systems are eliminated by the instant invention via a system which enables a garage door opener to learn the identities of and respond to multiple transmitters with different codes. In a program mode, the receiver stores a pre-programmed code which it receives from a transmitter.

Representative independent claim 20 is reproduced as follows:

20. An operator for controlling a position of a barrier comprising:

at least one radio frequency transmitter having a non-user changeable code for radio frequency transmitting a radio frequency transmission corresponding to the transmitter

a radio frequency receiver for being adapted to receive the first-mentioned radio frequency transmission from the first-mentioned radio frequency transmitter and being adapted to receive a second radio frequency transmission from a second

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radio frequency transmitter having a second non-user changeable code, different from said first non-user changeable code;

a program mode designator for designating a program mode;

a memory comprising a plurality of storage locations;

a processor having a processor controlled code location pointer and responsive to a program mode designation by said program mode designator and the reception by said radio frequency receiver of said first-mentioned radio frequency transmission for storing a first stored code corresponding to the first-mentioned radio frequency transmitter in one of said plurality of storage locations derived from the processor controlled code location pointer, the processor responsive to said program mode designation by said program mode designator and the reception by said receiver of said second radio frequency transmission for storing a second stored code corresponding to the second radio frequency transmitter in another of said plurality of storage locations derived from the processor controlled code location pointer, and the processor responsive to an operate mode and the reception of said first-mentioned radio frequency transmission after the storage of said first stored code for moving the barrier and responsive to said operate mode and to the reception of said second radio frequency transmission after the storage of said first and said second stored codes for moving said barrier.

The examiner relies on the following references:

Tolson	3,337,992	Aug. 29, 1967
Early	4,369,481	Jan. 18, 1983
Tsubaki et al. (Tsubaki)	4,385,296	May 24, 1983
Pinnow (Pinnow '046)	4,573,046	Feb. 25, 1986 (filed Nov. 1, 1983)
Pinnow	4,665,397	May 12, 1987

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(Pinnow '397)

(filed effective Nov. 1, 1983)

Claims 20, 21, 33, 35 through 39, 41 and 44 stand rejected under 35 U.S.C. § 112, second paragraph, as being vague and indefinite. Claims 20 through 45 stand rejected under 35 U.S.C. § 251 as being based on new matter added to the patent for which reissue is sought. Claims 20 through 45 stand further rejected under 35 U.S.C. § 112, first paragraph, as relying on an inadequate written description. Still further, claims 20 through 45 stand rejected under 35 U.S.C. § 103 based on five alternative rejections: Tsubaki and Early; either one of Pinnow '397 or Pinnow '046 in view of Tolson and Early; or either one of Pinnow '397 or Pinnow '046 in view of Tsubaki and Early.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

We have carefully considered the evidence before us including, inter alia, the arguments by appellants and the examiner, the Rhyne, Willmott and Rolls declarations, Special Master reports and the October 13, 1999 Federal Circuit decision in Overhead Door Corporation and GMI Holdings, Inc v.

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The Chamberlain Group, Inc., No. 98-1428 (Fed. Cir. Oct. 13, 1999) in reaching the following findings.

We turn first to the rejection under 35 U.S.C. § 112, second paragraph. The examiner contends that it is unclear whether claim 20 is limited to a second transmitter because line 3 only requires "at least one" transmitter and the receiver "being adapted to" receive a transmission from a second transmitter does not positively require a second transmitter. The examiner also questions the "can be" language of claims 33 and 35 as being indefinite because it is not clear to the examiner if the functions following this language are positively required by the claims.

We will not sustain the rejection of claims 20, 21, 33, 35 through 39, 41 and 44 under 35 U.S.C. § 112, second paragraph. Claim 20 recites "at least one" transmitter, which means there may be one or more transmitters but there must be at least one transmitter. This is not inconsistent with the receiver "being adapted to" receive first and second RF transmissions from respective first and second transmitters. The language merely indicates that there need not be a second transmitter, but if there is a second transmitter, the

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receiver "is adapted to" receive an RF transmission from that second transmitter, as well as from the first transmitter.

The "can be" language of claims 33 and 35 also is not found to be indefinite in any way. It merely indicates, consistent with the specification, that while a code stored in memory does not need to be changed, it "can be" changed by switching to program mode and energizing a transmitter with a code different from that previously stored in the memory. Similarly, in claim 35, while a code in a transmitter may never be derived if such transmitter is not activated in a program mode, the claim merely states that an RF signal carries a code from which the transmitter code "can be" derived if it is desired to do so.

We turn now to the rejections of claims 20 through 45 based on prior art. We will not sustain any of the rejections under 35 U.S.C. § 103 because we find no prima facie case of obviousness based on the evidence provided by the applied references.

While there are many distinctions between the instant claimed invention and the primary references to Tsubaki and Pinnow, we find it unnecessary to discuss these distinctions

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because each one of the prior art rejections relies, at least in part, on Early and we find Early to constitute nonanalogous art. Early is applied by the examiner for a teaching of a non-user-changeable code, the examiner concluding that it would have been obvious to have modified the primary references, allegedly disclosing user-changeable code, in order to provide for a plurality of transmitters with non-user-changeable codes.

Early is directed to a key which is "coded" in an optical manner so that when the key is inserted into a lock, a correctly "coded" key will unlock the lock. The "coded" key comprises light reflecting means on the key. When the key is inserted into the lock, these light reflecting means are located in the path of a laser beam and, if the key is a valid one, light reflected back to a unique pattern of photo-diodes will cause the lock to be unlocked.

Early is not directed to anything related to garage door opener systems or to controlling a position of a barrier, as claimed. Early does not employ radio frequency signals nor is Early directed to a remote control of an object since the "coded" key in Early must be inserted into the lock.

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Therefore, we find it difficult to discern any reason for the artisan skilled in the RF remote control garage door opener art to have looked to Early for any guidance on improving or modifying remote control garage door openers taught by Tsubaki and only tangentially suggested by the Pinnow references (e.g., column 9, lines 55-61) which are primarily concerned with a universal electronic locking system contained in a wristwatch and employing a photo-optical system for controlling a locking mechanism.

A two-prong test has evolved in determining whether prior art is analogous. First, we ask whether the prior art is from the same field of endeavor as applicants' invention, regardless of the problem addressed. Then, if a reference is not within the same field of endeavor, we ask whether the reference is still reasonably pertinent to the particular problem with which the applicants are involved. In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979).

Quite clearly, Early is not directed, in any manner, to the same field of endeavor, viz., garage door openers, as the instant invention. Thus, we must determine whether Early might still be reasonably pertinent to the particular problem

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with which applicants were involved. That problem was the elimination of DIP switches to set codes in a transmitter and receiver. Applicants' solution was to employ RF signals and to use a non-user changeable code in the transmitter and have the receiver learn that code from the transmitter when the device is in a program mode. We do not find Early's key for operating a locking mechanism by optical means to be reasonably pertinent to applicants' problem of eliminating the use of DIP switches in RF-remote control devices nor do we find Early suggestive, in any manner, of a non-user-changeable code in a transmitter which is learned by a receiver in a program mode.

We find Early to constitute non-analogous art and, as such, to be not applicable to the instant claimed invention. Since the examiner has relied on Early for each and every one of the rejections of the claims under 35 U.S.C. § 103, we will not sustain the rejection of claims 20 through 45 under 35 U.S.C.

§ 103 based on any combination of references set forth by the examiner. None of the remaining references discloses or suggests the claimed non-user changeable code in a transmitter

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which is learned by a receiver in a program mode within a system for controlling the position of a barrier.

Finally, we turn to the rejections of claims 20 through 45 under 35 U.S.C. § 251 and under 35 U.S.C. § 112, first paragraph. We treat these rejections together because they are both based on the examiner's position that there is no support for a "processor controlled code location pointer" or memory selection means in claims 20, 22 and 35, for a "software controlled code location pointer" or memory selector in claims 21, 23, 28, 30 and 40, or for a microprocessor incrementing the code location pointer to select the memory address in claim 34.

The examiner contends that the only reference in the specification to a "code location pointer" is at column 4, line 55, and such is directed to switch 23 which is the only code location pointer disclosed. The examiner dismisses the flow charts of Figures 3 and 4 because the description of the flowcharts in the specification does not specify that the flowcharts represent software or are in any way limited to a processor control as a second embodiment of the invention. The examiner takes the position that any "control" must be

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interpreted as relying on, and responsive to, switch 23 as the code location pointer since the original disclosure lacks any reference to software or processor control of the pointer or to the pointer being part of the processor. At page 6 of the answer, the examiner states that

[t]here is no indication that the incrementing of the location pointer in fig. 4 is a separate software embodiment and this incrementing is interpreted as controlled by movement of switch 23 to the next position based on the several references to switch 23 determining the memory location in appellants's [sic] disclosure.

While we are not unsympathetic to the examiner's reasoning and we are not overly enthralled by appellants' now claiming a "processor controlled code location pointer" and "software controlled code location pointer" in view of the very meager description of any software and the rather cryptic descriptions in the flowchart boxes of Figure 3, we must reverse the rejection of claims 20 through 45 under both 35 U.S.C. § 251 and 35 U.S.C. § 112, first paragraph, because we believe that Figure 3 does disclose enough to indicate that the inventors did have in their

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possession, at the time of the original filing date, the invention as now claimed, viz., a "processor" or "software" controlled code location pointer.

Initially, we point out that we have read and are aware of the recent decision of the Federal Circuit in Overhead Door Corporation and GMI Holdings, Inc v. The Chamberlain Group, Inc. While appellants' representative at the hearing of October 18, 1999 indicated that the Federal Circuit has now spoken on the issue with which we are confronted, we cannot agree. In our view, we are not bound by the Overhead Door decision because the court dealt therein with an appeal from a District Court grant of summary judgment, concerned with whether there were material issues of fact to be decided which might negate the summary judgment decision. Further, the claims with which we deal are different from the patented claims in Overhead Door, the issues are different (we deal with the factual question of whether there was an adequate written description, or support, in the original disclosure for that which appellants now claim) and Overhead Door was directed to an infringement action wherein we deal with the patentability of newly added claims in a reissue application.

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Thus, while Overhead Door is certainly closely related to the issues with which we deal in this appeal, we do not find that case to be dispositive of the issues before us notwithstanding the dicta within the decision regarding a software embodiment.

In any event, we find, fortuitously, that there is support in the original disclosure for the now claimed "processor controlled code location pointer" and "software controlled code location pointer" and, so, our decision is compatible with the dicta in Overhead Door.

We have reviewed the arguments of appellants and the examiner, as well as the Special Master's reports and the Rhyne declaration, of record. We find the declaration of Dr. Rhyne to be persuasive. While the original specification appears to disclose only one embodiment of a "code location pointer," viz., the mechanical switch 23 in Figure 2, Figures 3 and 4 appear to indicate that there was some software embodiment originally envisioned by appellants. Now, it may be that the flowcharts are merely system diagrams with indications of the operations performed, those operations not necessarily being performed by software. For example, the diamond-shaped box in Figure 3 asking "In Program Mode?" is

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just an indication that switch 22 is either in program mode or not. This box does not, necessarily, describe a software operation. Similarly, further on down in the flowchart, when it is indicating "Store code at location pointed to by the code location pointer," this is easily explained by the microprocessor 44 storing the code at a location indicated by mechanical code location pointer 23. Further, the instruction in the next block, indicating "Increment code location pointer. If pointer increments over five," may very well represent a manual "incrementation" of manual code control pointer 23 back to the "1" position after storing a code in the "5" position, notwithstanding Dr. Rhyne's indication that the term "increment" would be understood by artisans to refer to a software embodiment. However, when the last mentioned block in Figure 3 also recites, "then load code location pointer with one" [emphasis ours], we agree with Dr. Rhyne that this can only refer to a software-based action since "load" is conventionally meant "[t]o place data into internal storage" [see IEEE Dictionary (1984)-Exhibit B attached to the Rhyne declaration]. In our view, it would not be reasonable to attribute a "loading" function to the mechanical code

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control pointer 23 of Figure 2. Accordingly, although, in our view, the decision comes down to one word, viz., "load," appearing in a box in the flow diagram of Figure 3, that is enough to establish adequate support for the now claimed "processor controlled code location pointer" and "software controlled code location pointer" as it shows that the inventors had possession of a processor controlled code location pointer, in addition to the mechanical code location pointer 23 of Figure 2, at the time the application was originally filed. Thus, we will reverse the rejections of claims 20 through 45 under 35 U.S.C. § 251 and 35 U.S.C. § 112, first paragraph.

We have reversed all outstanding rejections of the instant claims. Accordingly, the examiner's decision is reversed.

REVERSED

Errol A. Krass)
Administrative Patent Judge)

