

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM STEIN, III
and
WILLIAM STEIN, IV

Appeal No. 1998-0183
Application No. 08/413,040

ON BRIEF

Before KRASS, LALL, and BARRY, Administrative Patent Judges.

LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the final rejection¹ of claims 1 to 3, 6 to 10, and 12 to 14. Claims 4, 5, 11, and 15 have been canceled.

¹An amendment after the final rejection was filed as paper no. 10, which was allowed entry (paper no. 11). However, this amendment made no changes to the claims.

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The invention is related to a device for protecting data transmitted by a facsimile machine. The device is a self-contained unit comprising a lightweight, detachable, portable housing which can be attached to a free standing facsimile machine or directly to a telephone line. Mounted within the housing is a keypad and a visual display associated with the keypad for transmitting command signals to electronic circuitry mounted within the housing. The electronic circuitry allows encryption of the data received by the facsimile machine and storage of the encrypted data for subsequent retrieval upon command of the user of the device. When a retrieval signal is transmitted to the electronic circuitry, the data are either transmitted in an encrypted form to a receiving facsimile, where they are decrypted in accordance with the matching code, or are decrypted by a similar device attached to a remote (receiving) facsimile machine. The invention is further illustrated by claim 1 below.

1. A device for protecting data transmitted by a facsimile machine, comprising:

a lightweight self-contained detachable, portable housing provided with means for encrypting

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and decrypting data converted to a binary code;

a means for storing encrypted data for subsequent retrieval upon demand;

a means for selectively storing the transmitted data in a decrypted form for subsequent retrieval upon demand; and

a means mounted in said housing for transmitting program signals to said means for encrypting and decrypting the data, said means comprising a keypad with a plurality of command keys and a visual display operationally connected to the keypad.

The Examiner relies on the following references:

Morgan et al. (Morgan)	4,229,817	Oct. 21, 1980
Goss	4,956,863	Sep. 11, 1990

Claims 1 to 3, 6 to 10, and 14 stand rejected under 35 U.S.C. § 103 over Goss and Morgan, whereas claims 12 to 13 stand rejected over Goss alone.

Rather than repeat the positions and the arguments of Appellants or the Examiner, we make reference to the briefs and the answer for their respective positions.

OPINION

We have considered the rejections advanced by the Examiner. We have, likewise, reviewed Appellants' arguments

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against the rejection as set forth in the briefs.²

²A reply brief was filed as paper no. 14 and was approved for entry without any further response from the Examiner (paper no. 15).

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It is our view, after consideration of the record before us, that the rejection under 35 U.S.C. § 103 is sustained with respect to claims 12 to 14, but not with respect to claims 1 to 3 and 6 to 10. Accordingly, we affirm-in-part.

Rejection under 35 U.S.C. § 103

In our analysis, we are guided by the general proposition that in an appeal involving a rejection under 35 U.S.C. § 103, an examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward 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 In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); 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, 1051, 189 USPQ 143, 147 (CCPA 1976). We are further guided by the precedence of our reviewing court that the limitations from the disclosure

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are not to be imported into the claims. In re Lundberg, 244 F.2d 543, 548, 113 USPQ 530, 534 (CCPA 1957); In re Queener, 796 F.2d 461, 464, 230 USPQ 438, 440 (Fed. Cir. 1986). We also note that the arguments not made separately for any individual claim or claims are considered waived. See 37 CFR § 1.192 (a) and (c). In re Baxter Travenol Labs., 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991) ("It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art."); In re Wiechert, 370 F.2d 927, 936, 152 USPQ 247, 254 (CCPA 1967) ("This court has uniformly followed the sound rule that an issue raised below which is not argued in this court, even if it has been properly brought here by reason of appeal is regarded as abandoned and will not be considered. It is our function as a court to decide disputed issues, not to create them.")

Analysis

Claims 12 and 13

Both these claims have been rejected as being obvious over Goss. We take claim 12 first. After matching the

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claimed features against the Goss reference (answer, pages 3 to 4), the Examiner makes a prima facie case by asserting that "Goss discloses the data as 'digital' rather than 'binary'. The use of binary data, . . . would be an expedient obvious to one of ordinary skill in the art." Appellants present various arguments thereagainst (brief, pages 4 to 9). However, like the Examiner (answer, pages 6 to 8), we find that claim 12 does not recite any storage step and the arguments relating to the storage means or steps are not commensurate with the scope of the claim. We find no specific arguments rebutting the above prima facie case of obviousness. Therefore, we sustain the obviousness rejection of claim 12 over Goss.

With respect to claim 13, Appellants argue (reply brief, pages 2 to 3) that "[t]here is no suggestion in Goss that a [sic] step[s] of decrypting . . . and transmitting the decrypted data for printing . . . are to be contained in a portable housing" The Examiner contends (answer, pages 4 and 9), that Goss does teach the concept of placing an encryption/decryption unit between a facsimile machine and its telephone line and such a unit is of the "connectable" type

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(col. 3, lines 21 to 26). We are not persuaded by Appellants' implication that since Goss calls this arrangement as being carried out "ideally" (id.), (and thus implying a mere fiction), it is not suggested by Goss. On the contrary, Goss shows such a configuration in fig. 4. We, therefore, sustain the obviousness rejection of claim 13 over Goss.

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Claims 1 to 3, 6 to 10, and 14

We consider the two independent claims in this group, namely claims 1 and 8. Claim 1 contains the limitations of (1), "a means for storing encrypted data for subsequent retrieval upon demand," and (2), "means for selectively storing the transmitted data in a decrypted form for subsequent retrieval upon demand." The Examiner's assertion that the combination of Goss and Morgan (answer, pages 4 and 5) meets these two limitations is not supported as Appellants have argued (brief, pages 9 to 16 and reply brief, pages 3 to 5). The Examiner has not presented any evidence which shows these two limitations, or given any line of reasoning along those lines. We conclude that the Examiner has not made out a prima facie case to reject claim 1 and its dependent claims 2 to 3, and 6 to 7. Therefore, we do not sustain the obviousness rejection of claims 1 to 3, and 6 to 7. The other independent claim, 8, also contains limitations similar to those discussed above. Therefore, for the same reasons, we do not sustain the obviousness rejection of claim 8 and its dependent claims 9 to 10.

However, we reach a different conclusion as to claim 14.

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First of all, we note that Appellants have not specifically argued claim 14. The limitations argued above regarding independent claims 1 and 8 are not contained in claim 14 since it depends on claim 12. The Examiner asserts (answer, page 5) that "[r]e claims 1, 8, and 14, Goss does not disclose the use of a keypad. Morgan et al. discloses [sic] . . . a keypad for transmitting key information to its operating electronics, The use of such a keypad [of Morgan] in Goss in order to provide this extra security against unauthorized use would be an expedient obvious to one of ordinary skill in the art." We conclude that the Examiner has established a prima facie case to reject claim 14. We do not agree with Appellants (brief, pages 10 to 14) that there is no motivation to combine. We think that Appellants' view in this respect is misplaced. There does not have to be a specific teaching in the prior art for the suggested combination. It is well established that while there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or prior art specifically suggest making the

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combination (see B.F. Goodrich Co. v. Aircraft Braking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996), and In re Nilssen, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988)) as the Appellants would apparently have us believe. Rather, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Moreover, in evaluating such references, it is proper to take into account not only the specific teachings of the references, but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). Here, we are of the opinion that an artisan would have looked to both Goss and Morgan to design a portable encrypting/decrypting device to be used with a facsimile system. Appellants have not successfully rebutted the Examiner's rejection of claim 14. Therefore, we sustain the obviousness rejection of claim 14 over Goss and Morgan.

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In summary, we have affirmed the Examiner's decision rejecting claims 12 to 14, and reversed rejecting claims 1 to 3, and 6 to 10.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

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)	BOARD OF PATENT
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Administrative Patent Judge)	APPEALS AND
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