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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM SCHERSCHEL and HAROLD J. MORROW

Appeal 2009-009166
Application 10/931,172
Technology Center 2600

Before JOHN C. MARTIN, ALLEN R. MACDONALD, and
CARLA M. KRIVAK, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING ¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Introduction

This is a decision on Appellants' Request for Rehearing.

Exemplary Claim

Exemplary independent claim 1 under appeal reads as follows

(emphasis added):

1. A communication system for transmitting and receiving wireless communications and controlling an access control device operator comprising:

a wireless communication portion comprising a wireless communication transmitter for providing wireless communications between a user at a communication device and a target communication device; and

an accessory portion *connected to but functionally separate from* the wireless communication transmitter, the accessory portion including an access control transmitter having a *power source that is not shared* with the wireless communication transmitter, the access control transmitter providing a signal to activate an access operator.

Appellants' Contentions

1. At page 2 of the Request, Appellants contend that the Board erred because:

In rejecting the claims, the Board applied *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007) ("*KSR*") to find the combination obvious. Specifically, the Board cited *Anderson 's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62 (1969) as cited in *KSR* at 416-17 to support a notion that the combination of known elements is obvious.

Analysis under *KSR*, however, does [not] properly end at this point. *KSR* also mandates that we consider a common-sense consideration of market forces and the effects of demands known to the design community when assessing the obviousness of a given prior art combination. *KSR* at 417-18.

These must be analyzed "in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *Id.* at 418.

2. At page 3-4 of the Request, Appellants contend that the Board erred because:

The Supreme Court in *KSR* articulated exactly how *Anderson's-Black Rock* is to be used in determining obviousness: "*Anderson's-Black Rock* [is] illustrative - a court must ask whether the improvement is *more than the predictable use* of prior art elements according to their established functions." *KSR* at 417 (emphasis added). Applicants strongly assert that combining an access control transmitter and a wireless communication transmitter in a manner such that they *do not* share a power supply is indeed "more than the predictable use of prior art elements." The Supreme Court's admonitions in *KSR*, taken as a whole, therefore clearly compel a conclusion that the claimed configuration is in no way obvious.

It is also worth noting that the facts of *Anderson's-Black Rock* are significantly different from the present facts in a very relevant way. In particular, when making the combination of the radiant-heat burner with the paving machine, there is no suggestion on the record that these two mechanisms had any components that were suitable to share; the parts that made up the radiant-heat burner were all different and discrete from the parts that made up the paving machine. This being so, a combination of the two could never amount to anything more than simply "gluing" the two mechanisms together.

ANALYSIS

First Contention

We disagree with Appellants' first contention. The Court in *KSR* does not "mandate[] that we consider a common-sense consideration of market

forces and the effects of demands known to the design community when assessing the obviousness of a given prior art combination,” as argued by Appellants. (Req. 2). *Anderson’s-Black Rock* specifically precludes Appellants’ reading of *KSR* (emphasis added).

A combination of elements may result in an effect greater than the sum of the several effects taken separately. No such synergistic result is argued here. *It is, however, fervently argued that the combination filled a long felt want and has enjoyed commercial success. But those matters ‘without invention will not make patentability.’* *Great A. & P. Tea Co. v. Supermarket Corp.*, 340 U.S. 147, 153, 71 S.Ct. 127, 130, 95 L.Ed. 162.

Anderson’s-Black Rock, 396 U.S. at 61.

Also, Appellants’ argument that “having two separate power supplies . . . would seem unduly complex and duplicative to the person of ordinary skill in the art when viewed through the prism of common sense and balanced by market forces” (Req. 3) is not responsive to the rationale stated at page 6 of the Decision on Appeal, which is that the argued claims read on combining a *pre-existing* wireless transmitter and a *pre-existing* barrier control. Each of these elements already has its own power supply. Combining known elements for the purpose of convenience does not impart patentability to the combination. *See Anderson’s-Black Rock*, 396 U.S. at 61 (“The combination of putting the burner together with the other elements in one machine, though perhaps a matter of great convenience, did not produce a ‘new or different function,’ *Lincoln Engineering Co. of Illinois v. Stewart-Warner Corp.*, 303 U.S. 545, 549, 58 S.Ct. 662, 664, 82 L.Ed. 1008, within the test of validity of combination patents.”).

Second Contention

We disagree with Appellants' second contention. Appellants are mistaken in "strongly" asserting that "combining an access control transmitter and a wireless communication transmitter in a manner such that they *do not* share a power supply is indeed 'more than the predictable use of prior art elements.'" (Req. 4). Rather, we conclude that the claims on appeal are the epitome of obvious for the reasons set forth in our prior decision.

Further, Appellants are mistaken in asserting that the facts of *Anderson's-Black Rock* are significantly different from the present facts in a very relevant way. We conclude that it is irrelevant whether the parts that made up the first device were all different and discrete from the parts that made up the second device. As set forth in *Anderson's-Black Rock*, what is relevant is whether the combination of elements results in an effect greater than the sum of the several effects taken separately. We find no such greater effect in the claims on appeal.

DECISION

In view of the foregoing discussion, we grant Appellants' Request for Rehearing to the extent of reconsidering our decision, but we deny Appellants' request with respect to making any change thereto.

REQUEST FOR REHEARING DENIED

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