

2010 WL 3269939 (Bd.Pat.App. & Interf.)

Board of Patent Appeals and Interferences

Patent and Trademark Office (P.T.O.)

Ex Parte A. James Smith, Jr. Appellant and Patent Owner

Appeal 2009-014595

Reexamination Control 90/008,078

Patent 6,571,336 B1 Technology Center 3900

August 17, 2010

*1 AMSTER, ROTHSTEIN & EBENSTEIN LLP

90 PARK AVENUE

NEW YORK, NY 10016

Before [JEAN R. HOMERE](#), [SCOTT R. BOALICK](#), and [KEVIN F. TURNER](#)

Administrative Patent Judges

[TURNER](#)

Administrative Patent Judge

DECISION ON APPEAL ¹

A. James Smith, Jr. ² appeals under [35 U.S.C. §§ 134\(b\)](#) and [306](#) from a final rejection of claims 6, 7, 27, 28, 35-39, and 41-45. Claims 1, 3-5, 8-26, and 29-32, the only other pending claims, have been indicated as patentable and/or confirmed, with claims 1, 27, 33, and 39 having been amended. Therefore, claims 6, 7, 27, 28, 33, 35-39, and 41-45 stand before us on Appeal. We have jurisdiction under [35 U.S.C. §§ 134\(b\)](#) and [306](#).

We AFFIRM.

STATEMENT OF THE CASE

This proceeding arose from a request for *ex parte* reexamination filed by A. James Smith, Jr., patent owner, on June 26, 2006 of United States [Patent 6,571,336 B1](#) issued to A. James Smith, Jr. on May 27, 2003, based on United States Application 09/970,955 filed October 4, 2001.

Patentee's invention relates to a method and system for securing passwords and personal identification numbers utilizing a MasterCode camouflaged within a Mastergrid which contains all the characters, symbols or pictograms of which the MasterCode is a subset. (Abs., Spec. col. 1, ll. 52-55).

Exemplary Independent Claim 6 reads as follows:

6. (Original) A method for securing data and for providing secure access to the data comprising the steps of:

creating a graphical image;

encrypting said data using said graphical image as an encryption key, wherein said encryption key is formed from a character set, and

MICROSOFT
Exhibit 1011

providing the capability to utilize said key for gaining access to said data.

The prior art reference relied upon by the Examiner in rejecting the claims is:

Juels et al. (“Juels”)

7,219,368 B2

May 15, 2007

The Examiner rejected claims 6, 7, 27, 28, 33, 35-39, and 41-45 under [35 U.S.C. § 102\(e\)](#) as anticipated by Juels. (Ans. 4).

Appellant relied upon the following in rebuttal to the Examiner's rejection:

Smith, Jr. (“Smith, Jr. #328”)

US 6,253,328

Jun. 26, 2001 (*See App. Br. 6-13*)

ISSUE

*2 Appellant contends that the Examiner's sole rejection of claims 6, 7, 27, 28, 33, 35-39, and 41-45 under [35 U.S.C. § 102\(e\)](#) as anticipated by Juels is in error because Juels³ is not prior art. (App. Br. 6, *see also* Reply Br. 2). Appellant asserts that the presently rejected claims of [U.S. Patent No. 5,671,336](#)⁴ (hereinafter “the #336 patent”), under Appeal, are entitled to the priority date of its parent, [U.S. Patent No. 6,253,328](#)⁵ (hereinafter “the #328 patent”). Thus, Appellant argues that Jules, which was filed after the #328 patent, cannot be a reference against the rejected claims. (Reply Br. 1- 2). The Examiner responds that “[e]ach of the claims on appeal recite[] the limitation ‘graphical image,’ for which there's no support in the #328 patent.” (Ans. 8). Specifically, the Examiner finds that the display of the MasterCode in a MasterGrid as disclosed in the #328 patent, is not a “graphical image.” (Ans. 8).

Thus, the sole dispositive issue⁶ arising from the respective positions of Appellant and the Examiner is:

Was the Examiner's determination in error, specifically that at the time of the invention, the disclosure of the #328 patent does not reasonably convey to one of ordinary skill in the art that the Appellant had possession of a “graphical image,” as presently claimed in the #336 patent, and as such, Appellant is not entitled to claim benefit of the #328 patent's filing date?

FINDINGS OF FACT

Facts Pertinent to the Original Prosecution History of the #336 Patent (Child)

1. The #336 patent, U.S. App. No. 09/970,955, claims domestic priority under [35 U.S.C. § 120](#) as a continuation-in-part (hereinafter “CIP”) of U.S. App. No. 09/891,132 filed on June 25, 2001, now abandoned, which claimed priority to U.S. App. No. 09/022,578, now the #328 patent, filed on February 12, 1998,
2. In a Non-Final First Office Action (hereinafter “FAOM”) mailed, May 22, 2002, the Examiner acknowledged Appellant's claim for domestic priority, but the Examiner did not find adequate support under 35. U.S.C. § 112, first paragraph for original claims 6-12 and 27-32 in the #328 patent, the parent application. (FAOM 4)
3. In the FAOM, the Examiner found with respect to claims 6-12, that there was no “... written description of encrypting data using a graphical image as an encryption key [citation omitted].” (FAOM 4).

*3 4. In the FAOM, the Examiner found with respect to claims 27-32, that there was "... no support for masking data using a graphical image as a key. [citation omitted]." (FAOM 4).

5. In Appellant's Remarks ⁷, received August 7, 2008 (hereinafter "App. Remarks"), Appellant responded to the FAOM stating, "[w]ith respect to claim 12, it is submitted that claim 12 is fully supported by the [#328 patent], because claim 12 of the pending application is exactly the same claim 12 in the [#328 patent]." ⁸ (App. Remarks 5).

6. In a Final Office Action, mailed September 26, 2002 (hereinafter "FOA"), the Examiner maintained the priority findings from the FAOM with respect to claims 6-11 ⁹ and 27-32. (FOA 4).

7. Additionally, in the FOA, the Examiner denied benefit of priority to new claims 43-55. (FOA 4).

8. In the FOA, the Examiner found with respect to claims 43-55 that the # 328 patent "... provides no support for masking a password in a graphical image [citation omitted]." (FOA 4).

9. After a Request for Continued Examination, received December 20, 2002, a Notice of Allowance (hereinafter "NOA") was mailed on February 10, 2002.

10. In the NOA, the Examiner allowed claims 1-32 and 43-55, but in the Reasons for Allowance, the Examiner again maintained that the #328 patent, upon which priority is claimed fails to provide adequate support under 35 U.S.C. § 112, first paragraph for claims 6-11, 27-32, and 43-55. (NOA 2-3).

Facts Pertinent to the Reexamination Prosecution History of the #336 Patent (Child)

11. Appellant requested reexamination of the #336 patent in a Request for *Ex Parte* Reexamination by Patent Owner, filed June, 26, 2006 (hereinafter "Req. for Reexam.").

12. In the Request for Reexamination, Appellant raised substantial new questions of patentability with respect to independent claims 33 and 39 in view of the Blonder Patent ¹⁰.

13. Appellant responded to an *ex parte* reexamination Non-Final Action, mailed January 28, 2008 (hereinafter "NFA"), with arguments to antedate Jules as prior art, in a response filed March 28, 2008 (hereinafter "App. Response to NFA"). (App. Response to NFA 7-15).

14. In an *ex parte* reexamination Final Action, mailed May 27, 2008 (hereinafter "RFA"), the Examiner confirmed claims 1, 3-5, 8-26, and 29-32, but refused to disqualify Jules as prior art for claims 6, 7, 27, 28, 33, 35-39, and 41-54. (RFA 7).

15. Appellant responded to the Examiner's RFA in a response filed July 14, 2008 (hereinafter "App. Response to RFA"), again attempting to disqualify Jules as prior. (App. Response to RFA 5-13).

*4 16. Appellant filed a Notice of Appeal, received August 21, 2008, in response to the Reexamination Examiner's RFA denying benefit of priority to the #328 patent with respect to claims 6, 7, 27, 28, 33, 35-39, and 41-45.

17. The Examiner finds that there is no support in the #328 patent for each of the claims 6, 7, 27, 28, 33, 35-39, and 41-45, which recite the term "graphical image." (Ans. 8).

Facts Pertinent to the Filing Date of the Jules Reference

18. Jules was filed as U.S. App. No. 09/815,560 on March 23, 2001 and issued from this application on May 15, 2007.
19. Jules claims priority as a CIP of PCT/US00/03522, filed on February 10, 2000.
20. PCT/US00/03522 claims priority to Provisional Apps. 60/119,674 and 60/137,687, filed February 11, 1999 and June 4, 1999, respectively.
21. Jules is also a CIP of U.S. App. No. 09/544,809, filed April 7, 2000, now abandoned.
22. The Jules Reference is definitively available as prior art as of March 23, 2001 which antedates only the filing date of the #336 patent by approximately 195 days.¹¹

Facts Pertinent to the Filing Date of the #328 Patent (Parent)

23. The #328 patent, was filed February 12, 1998.
24. The #328 patent antedates the earliest possible effective filing date of the Jules Reference by approximately 364 days.¹²

PRINCIPLES OF LAW

Determination of a priority date is purely a question of law if the facts underlying that determination are undisputed. *See E.I. du Pont de Nemours & Co. v. MacDermid Printing Solutions, L.L.C.*, 525 F.3d 1353, 1359 (Fed. Cir. 2008). However, determination whether a priority document contains sufficient disclosure to comply with the written description aspect of 35 U.S.C. § 112, first paragraph, is a question of fact. *Waldemar Link v. Osteonics Corp.*, 32 F.3d 556, 558 (Fed. Cir. 1994); *Bradford Co. v. Conteyor North America, Inc.*, 603 F.3d 1262, 1269 (Fed. Cir. 2010)).

Filing a Board appeal does not, unto itself, entitle an appellant to *de novo* review of all aspects of a rejection. If an appellant fails to present arguments on a particular issue - or, more broadly, on a particular rejection - the Board will not, as a general matter, unilaterally review those uncontested aspects of the rejection. *See, e.g., Hyatt v. Dudas*, 551 F.3d 1307, 1313-14 (Fed. Cir. 2008) (the Board may treat arguments appellant failed to make for a given ground of rejection as waived).

Different claims of a continuation-in-part (CIP) application may receive different effective filing dates because subject matter arising “for the first time in the CIP application does not receive the benefit of the filing date of the parent application.” *Augustine Medical, Inc. v. Gaymar Indus., Inc.*, 181 F.3d 1291, 1302 (Fed. Cir. 1999). Under 35 U.S.C. § 120, “in a chain of continuing applications, a claim in a later application receives the benefit of the filing date of an earlier application so long as the disclosure in the earlier application meets the requirements of 35 U.S.C. § 112, ¶ 1, including the written description requirement, with respect to that claim.” *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326 (Fed. Cir. 2008) (citing *Transco Prods. Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 556 (Fed. Cir. 1994)).

*5 Prosecution history can also be relevant to claim interpretation. *See Renishaw plc v. Marposs Societa per Azioni*, 158 F.3d 1243, 1249 n.3 (Fed. Cir. 1998) (“[A]ny interpretation that is provided or disavowed in the prosecution history also shapes the claim scope.”); *see also Schwing GmbH v. Putzmeister Aktiengesellschaft*, 305 F.3d 1318, 1324 (Fed. Cir. 2002) (“[P]rosecution history ... cannot be used to limit the scope of a claim unless the applicant took a position before the PTO that would lead a competitor to believe that the applicant had disavowed coverage of the relevant subject matter.”).

An applicant's statement to the examiner is a compelling disclaimer of scope such that a patent may not be entitled to an earlier priority date. *Bradford*, 603 F.3d at 1269 (citing *Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340,

1350 (Fed. Cir. 2004) (“We take the patentee at its word and will not construe the scope of ... [a] patent's claims more broadly than the patentee itself clearly envisioned.”)). That is because arguments made to persuade an examiner to allow an application trump an ambiguous disclosure that otherwise might have sufficed to obtain an earlier priority date. See *Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 452 (Fed. Cir. 1985) (holding that any argument made to convince the examiner of the patentability of the claimed invention “limits the interpretation of claims so as to exclude any interpretation that may have been disclaimed or disavowed during prosecution in order to obtain claim allowance”).

ANALYSIS

Appellant's sole argument in response to the Examiner's rejection of claims 6, 7, 27, 28, 33, 35-39, and 41-45 under 35 U.S.C. § 102(e) is that Jules is not prior art since Appellant is relying on the filing date of the #328 patent which discloses the term “graphical image,” and thus provides written support under 35 U.S.C. § 112, first paragraph, thereby disqualifying Jules. (App. Br. 6-7, see also Reply Br. 2). We are not persuaded by Appellant's arguments and agree with the Examiner that Jules is prior art under 35 U.S.C. § 102(e) with respect to claims 6, 7, 27, 28, 33, 35-39, and 41-45. (FF 17, 18, 22).

During the course of reexamination prosecution, the Examiner denied Appellant's claim to benefit of priority to the #328 patent, and found no support in the #328 patent for each of the claims in the #336 patent that recite the term “graphical image.”¹³ (Ans. 8). However, we find no need to make a determination as to whether the #328 Patent provides support for the contested subject-matter during this reexamination, and instead find that Appellant is estopped from disqualifying Jules as intervening art since Appellant failed to traverse the Examiner's findings regarding priority during the original prosecution of the #336 Patent (FF 5) and in fact did not raise any issues regarding benefit of priority to the #328 patent in the Request for *Ex Parte* Reexamination by Patent Owner. (FF 11, 12).

*6 In making this determination, we find that during the original prosecution of the #336 patent, the Examiner made specific unambiguous priority findings during a First Office Action (FF 2, 3, 4), a Final Office Action (FF 6, 7, 8), and again in the Examiners Reasons for Allowance (FF 10). In response to these priority findings, Appellant did not contest the findings other than to correct the Examiner's apparent clerical error. (FF 5). Thus, in overcoming the prior art during the prosecution of the #336 patent without attempting to traverse the Examiner's priority findings, the Appellant forfeited opportunities to persuade the Examiner that there may be support for the contested subject-matter in an ambiguous disclosure that otherwise might have sufficed to obtain an earlier priority date. Determination of a priority date is purely a question of law if the facts underlying that determination are undisputed. See *E.I. du Pont de Nemours*, 525 F.3d at 1359.

Further, while we realize that a patentee's silence in the face of the Examiner's Reasons for Allowance (FF 10) should not be treated as an acquiescence, we do find these facts compelling, and thus cannot be ignored when combined with the Appellant's silence in the responses to formal office actions during the original prosecution. As a result, we find that it would be reasonable to infer from this that Appellant did not contest the Examiner's priority findings, and indeed is not rightfully entitled to benefit from the # 328 patent's earlier effective filing date for the claims presently at issue. Thus, we find that based upon Appellant's silence and the prosecution history *in toto*, it would be reasonable for a competitor to believe that the applicant had disavowed priority with respect to claims 6, 7, 27, 28, 33, 35-39, and 41-45 based on the original Examiner's priority findings.

Therefore, based upon the Examiner's unambiguous priority findings (FF 2, 3, 4, 6, 7, 8), the Appellant's full and fair opportunity to contest these findings during original prosecution (FF 5), and their opportunity to appeal to the Board (FF 9), we find that these circumstances have created an estoppel for the Appellant to deny that there was new matter present in the CIP. As such, Appellant's silence during the original prosecution creates an estoppel for the Appellant to deny the Examiner's repeated priority findings, thereby impliedly conceding their correctness, and therefore Appellant's lack of entitlement to the original filing date of the #328 patent for the term “graphical image,” as recited in claims 6, 7, 28, 33, 3-9, and 41-45 of the #336 patent.

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