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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

BELKIN INTERNATIONAL, INC.;
CISCO LINKSYS LLC; D-LINK SYSTEMS, INC.;
AND
NETGEAR, INC.
Requester and Appellant
v.

OPTIMUMPATH, LLC.
Patent Owner and Respondent

Appeal 2011-003697
Inter partes Reexamination Control 95/001,089
United States Patent 7,035,281 B1
Technology Center 3900

Before JAMES T. MOORE, *Acting Chief Administrative Patent Judge*,
RICHARD TORCZON, SALLY G. LANE, ALLEN R. MACDONALD,
and STEPHEN C. SIU, *Administrative Patent Judges*.¹

SIU, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The Acting Chief Judge and Judge Lane joined the panel after the hearing to consider and decide the jurisdictional question below. *Cf. Kingsdown Med. Consultants, Ltd. v. Hollister Inc.*, 863 F.2d 867, 876 n.16 (Fed. Cir. 1988) (using en banc panel for only one section of opinion).

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Third-party requester (Appellant) appeals under 35 U.S.C. §§ 134(b) and 306 from a Right of Appeal Notice confirming claims 1-3 and 8-10. No substantial new question of patentability was determined to affect claims 4-7 and 11-32.² Patentee (Respondent) filed a brief in support of the Examiner's confirmation.

We have jurisdiction under 35 U.S.C. §§ 134(b) and 306.

STATEMENT OF THE CASE

This proceeding arose from a third party request for *inter partes* reexamination of United States Patent 7,035,281 B1 (the '281 patent), titled "Wireless Provisioning Device" and issued to Anthony C. Spearman and Andrew E. Tompkins on April 25, 2006. The request for reexamination was filed on October 13, 2008 by David L. McCombs on behalf of Belkin International, Inc.; Cisco Linksys LL.C.; D-Link Systems, Inc.; and Netgear, Inc. The '281 patent was the subject of co-pending litigation styled as *OptimumPath, LLC v. Belkin Int'l, Inc.*, No. C 09-01398 CW (N.D. Cal.), transferred from No. 4:08-CV-317-TLW (D. S.C. filed January 30, 2008). An oral hearing for this appeal was conducted at the USPTO on March 9, 2011.

The '281 patent describes a wireless provisioning device (col. 2, ll. 19-20).

² This opinion employs the following abbreviations: Examiner's Answer ("Ans."), Examiner's Right of Appeal Notice (mailed July 31, 2009) ("RAN"), Appellant's Appeal Brief ("App. Br."), Appellant's Rebuttal Brief ("Reb. Brief"), and Respondent's Brief ("Resp. Br.").

Exemplary claim 1 on appeal reads as follows:

1. A wireless provisioning device for use in public domain networks wherein the wireless provisioning device is accessible by a user of mobile computing devices comprising:
 - a chassis;
 - at least one network card;
 - at least one wireless card;
 - at least one processor;
 - an operating system, the operating system operably configured in the chassis to control the at least one, network card, the at least one wireless card and the at least one processor, which are operatively coupled with the chassis;
 - a packet-switched interface capable of receiving a multiplicity of inbound framed packet-data to provide inbound packets and transmitting a multiplicity of outbound framed packet-data comprising outbound packets;
 - a channeling controller, coupled to the packet-switched interface that channels the inbound packets based on the inbound address information and constructs the outbound packets and channels the outbound packets with the outbound address information, the channeling controller capable of being effectively connected to at least one network via the operating system; and
 - an authenticator in operative communication with the operating system to allow authentication at the wireless provisioning device;whereby the user of a mobile computing device connects to the wireless provisioning device without having to first access the Internet.

(App. Br. 24, Claims Appendix).

The prior art references are:

Peirce	US 6,560,217 B1	May 6, 2003
Redlich	US 6,591,306 B1	July 8, 2003

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“Wireless LAN: basic knowledge and application case studies,” *Transistor Gijutsu*, October 1, 1999 (“Transistor Article”).

Michael Taht and Greg Retkowski, “Wireless Router Howto,” <http://www.rage.net/wireless/wireless-howto.html>, December 20, 1998, Archived on April 29, 1999, by archive.org, see <http://web.archive.org/web/19990429115208/www.rage.net/wireless/wireless-howto.html> (“Howto Guide”).

Doug Cinege, “Linux Router Project,” March 28, 1999. Archived on April 29, 1999 by archive.org, see <http://web.archive.org/web/19990429012745/http://www.linuxrouter.org/> (“Linux Router”).

Lucent Technologies, InterNetworking Systems, “RADIUS for UNIX Administrator’s Guide,” February 1999 (“Radius”).

Steve Frampton, “Linux Administration Made Easy,” the Linux Documentation Project, 1999 (“Linux Administration”)

Third-Party Requester filed a Request for Inter Partes Reexamination dated October 13, 2008 proposing the following substantial new questions of patentability:

- 1) Claims 1-10 and 13 as allegedly being anticipated by Transistor Article;
- 2) Claims 1-6, 8-14, 26, and 27 as allegedly being anticipated by Howto Guide;
- 3) Claims 1-6 and 8-13 as allegedly being anticipated by Redlich;
- 4) Claims 1-3 and 8-10 as allegedly being anticipated by Peirce;
- 5) Claims 1-6, 8-14, 26, and 27 as allegedly being unpatentable over Howto Guide and Linux Router;

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- 6) Claim 7 as allegedly being unpatentable over Linux Administration and any of Howto Guide or Redlich;
- 7) Claims 1-6, 8-18, 20-25, and 27-32 as allegedly being unpatentable over Redlich and Linux Administration;
- 8) Claims 19 and 26 as allegedly being unpatentable over Howto Guide, Redlich, and Linux Router;
- 9) Claims 1-6 and 8-32 as allegedly being obvious over Howto Guide, Linux Router, and Radius.

The Examiner determined no substantial new questions of patentability were raised with respect to the Transistor Reference, the Howto Guide, or Redlich but determined a substantial new question of patentability was raised only with respect to Peirce as anticipating claims 1-3 and 8-10 (Order dated 1/12/2009, pp. 7-12). Appellant's petition dated February 4, 2009 requesting the Director to order reexamination of claims 4-7 and 11-31 with respect to at least the Transistor Reference, the Howto Guide, or Redlich was denied (Petition Decision dated July 10, 2009).

ISSUES

(1)

The Examiner finds no substantial new questions of patentability of claims 1-32 with respect to the Transistor Article, the Howto Guide, or Redlich.

Appellant argues that "Federal Statutes Empower the Board to Hear this Appeal" and that "Patent Office rules are consistent with the statutes"

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(Reb. Brief 2-3) regarding Appellant's request for appeal of the Examiner's determination of the lack of substantial new questions of patentability with respect to the Transistor Article, Howto Guide, or Redlich.

Does the board have jurisdiction to consider whether the examiner erred in finding no substantial new question of patentability in view of the Transistor Article, the Howto Guide or Redlich?

(2)

The Examiner finds that Peirce fails to disclose "the claimed wireless cards" or that the "system must first access the Internet to connect" (Ans. 14).

Did the Examiner err in finding that Pierce fails to disclose a wireless card and a user connecting to a wireless provisioning device without having to first access the Internet?

PRINCIPLES OF LAW

35 U.S.C. § 102

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted).

35 U.S.C. § 103

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and

(3) the level of skill in the art. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966).

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007).

35 U.S.C. § 312

(a) *Reexamination.* – Not later than 3 months after filing of a request for inter partes reexamination under section 311, the Director shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications

. . .

(c) *Final decision.* – A determination by the Director under subsection (a) shall be final and non-appealable . . .

35 U.S.C. § 313

(a) If, in a determination made under section 312(a), the Director finds that a substantial new question of patentability affecting a claim of a patent is raised, the determination shall include an order for inter partes reexamination of the patent for resolution of the question

35 U.S.C. § 315

(b) *THIRD-PARTY REQUESTER.* – A third-party requester –
(1) may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, with respect to any final

decision favorable to the patentability of any original or proposed amended or new claim of the patent. . . .

ANALYSIS

Substantial new questions of patentability

Appellant argues that the Board of Patent Appeals and Interferences has jurisdiction to determine appeals regarding requests raised by third-party requestors as to whether a substantial new question of patentability exists (Reb. Br. 2-4). We disagree.

As set forth above, 35 U.S.C. § 312 states that the Director makes such determinations (of whether a substantial new question of patentability exists) and that the determination “by the Director . . . shall be final and non-appealable.” Only when the Director makes the determination that a substantial new question of patentability affecting a claim of a patent is raised (i.e., that a substantial new question of patentability exists for a particular claim) shall an *inter partes* reexamination of the claim(s) in question be performed for resolution of the question (35 U.S.C. § 313). Therefore, on the other hand, when the Director makes a determination that a substantial new question of patentability affecting a particular claim is *not* raised, the Director does *not* order *inter partes* reexamination of the patent with respect to those claims. Under those circumstances, no reexamination is performed with respect to those proposed substantial new questions of patentability. Also, as pointed out above, the Director’s determination that no substantial new question of patentability was established for any particular claim(s) is final and non-appealable (35 U.S.C. § 312(c)).

Since, under 35 U.S.C. § 312 and 35 U.S.C. § 313, reexamination of the patent claims in question cannot proceed when the Director makes a determination that a substantial new question of patentability has not been raised for those claims and that the Director's determination is non-appealable, no final decision, whether favorable or unfavorable, can be rendered pertaining to those claims. Under 35 U.S.C. § 315(b), a third-party requester may appeal with respect to any "final decision favorable to the patentability" of disputed claims. However, as described above, if the Director makes the non-appealable determination that no substantial new question of patentability has been raised, then reexamination is not performed for those claims in question with respect to the corresponding prior art references. There cannot have been a final decision (either favorable or unfavorable) on the patentability of the claims in question under 35 U.S.C. § 315(b), the claims not having been reexamined in the first place for lack of a substantial new question of patentability.

The Code of Federal Regulations are consistent with the statutes and do not grant the Board of Patent Appeals and Interferences jurisdiction to decide non-appealable determinations of the lack of substantial new questions of patentability. 37 C.F.R. § 1.927 states that "[t]he third party requester may seek review by a petition to the Director . . . of the examiner's determination refusing to order *inter partes* reexamination" and that "[i]f no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable." In the present case, third-party requester timely filed a petition (Petition dated February 4, 2009) under 37 C.F.R. §

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1.927 seeking review of the Examiner's determination refusing to order *inter partes* reexamination, which was denied. Under 37 C.F.R. § 1.927 and 35 U.S.C. § 312, the Director's determination refusing to order *inter partes* reexamination for lack of a substantial new question of patentability is final and non-appealable.

While 37 C.F.R. § 41.61 states that "the requester may appeal to the Board with respect to any final decision favorable to the patentability" of disputed claims, as we noted above, no final decision favorable to the patentability" of claims with respect to the Transistor Article, Howto Guide, or the Redlich reference exist since the Director previously determined that no substantial new question of patentability existed with respect to the Transistor Article, Howto Guide, or the Redlich reference and, as such, no reexamination had been ordered in the first place.

A notice of Defective Appellant Brief dated March 1, 2010 responsive to Appellant's Brief dated October 28, 2009 required removal of Appellant's arguments pertaining "to the denial of the [substantial new questions of patentability], which is a non-appealable issue" (Notice of Defective Appellant Brief dated March 1, 2010, p. 4). A new notice of Defective Appellant Brief was issued March 31, 2010 in which the requirement to remove Appellant's arguments pertaining the issue of the existence of a substantial new question of patentability with regard to the Transistor Article, Howto Guide, and Redlich reference was removed.

No reasons were stated in the new notice of Defective Appellant Brief (March 31, 2010) as to why the requirement to remove from Appellant's brief any arguments regarding substantial new questions of patentability was

removed from the notice. However, since the original final determination by the Director that no substantial new question of patentability exists with regard to the Transistor Article, Howto Guide, and Redlich references is non-appealable, we do not find that the presence or absence of arguments supporting the existence of a substantial new question of patentability in Appellant's Brief indicative that we have jurisdiction to decide a non-appealable issue.

Even assuming that the notice dated March 31, 2010 omitting the requirement that Appellant remove arguments pertaining to the existence of a substantial new question of patentability is somehow indicative that the original determination by the Director of the lack of a substantial new question of patentability had been withdrawn, the proper sequence of events, under 35 U.S.C. § 313, would be the issuance by the Director of an order "for inter partes reexamination of the patent for resolution of the question" and, under 35 U.S.C. § 314, "reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133."³

Thus, we do not have jurisdiction to decide an appeal on the non-appealable issue of whether a substantial new question of patentability exists. Nor do we have jurisdiction to perform "inter partes reexamination of the patent for resolution of the question" (35 U.S.C. § 313) "according to the procedures established for initial examination under the provisions of sections 132 and 133" (35 U.S.C. § 314) in the event that the initial

³ Appellant does not point to any such order in the record nor do we find such an order in the record.

determination of the lack of a substantial new question of patentability was withdrawn by the Director.

Anticipation over the Peirce Reference

Appellant argues that Peirce discloses a “master home agent 26 of Figure 2” that includes a wide area network interface card and that “[t]he wide area network interface cards are *wireless card[s]*” (Req. for *Inter Partes* Reexamination 75). The Examiner finds that while the “master home agent 26” of Peirce contains a wide area network interface card (WAN interface), “WAN cards are not wireless cards” (Ans. 14) because “WANs are not inherently wireless” (Ans. 7). We agree with the Examiner that one of skill in the art would have interpreted “wide area network” to describe the range of the network as covering “a wider area than a local area network (‘LAN’)” (Ans. 7). Since the range or size of the network does not directly pertain to whether the network is wireless or not, and Appellant has not demonstrated that a WAN is necessarily a wireless network, we agree with the Examiner that a WAN interface is not necessarily a “wireless card.”

Appellant also argues in the alternative that Peirce discloses “a plurality of network access servers 13A, 13B, 13C, 13D that function as foreign agents for the wireless devices” and that the network access servers of Peirce contain wireless cards because “wireless communication of the mobile devices with the network access servers” is shown (Req. for *Inter Partes* Reexamination 75). While Appellant argues that the “master home agent 26” of Peirce satisfies certain claim features of the “wireless provisioning device” (e.g., a chassis, a network card, a processor, an

operating system configured in the chassis, etc.), Appellant has not argued or demonstrated that the “network access servers” of Peirce contain these claim features other than the “wireless card.” Therefore, even assuming that the network access servers of Peirce contain at least one wireless card as Appellant suggests, in view of Appellant’s lack of showing that Peirce discloses that the “network access servers” contain each of the other claim features, we cannot agree with Appellant that the “network access servers” of Peirce supposedly satisfy the claimed “wireless provisioning device.”

Appellant also argues that Peirce discloses a user connecting to a wireless provisioning device without having to first access the Internet because, according to Appellant, it is the network access servers of Peirce that connect via the Internet to the home agent and not the mobile users themselves (App. Br. 21) and that the mobile users connect to the network access servers without first accessing the Internet.

To the extent that Appellant identifies the “master home agent 26” of Peirce as satisfying the claimed “wireless provisioning device,” we are not persuaded by Appellant’s argument at least because, as described above, Peirce fails to disclose that the “master home agent 26” contains “at least one wireless card.” Also, the mobile user in Peirce connects to the “master home agent 26” (i.e., the “wireless provisioning device”) only through the Internet (see Fig. 1). Since the only connection between a mobile user and the “master home agent 26” is through the Internet, we do not agree with Appellant that the mobile user is able to connect to the “master home agent 26” without having to access the Internet.

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To the extent that Appellant identifies one of the “network access servers” of Peirce as satisfying the claimed “wireless provisioning device,” we are also not persuaded by Appellant’s argument at least because, as described above, Appellant has failed to demonstrate or assert that the “network access servers” of Peirce satisfy each of the other claim features of the wireless provisioning device.

Thus, the Examiner did not err in finding that Peirce fails to anticipate claim 1, and claims 2, 3, and 8-10, which depend therefrom.

CONCLUSION

Under 35 U.S.C. § 312 and 35 U.S.C. § 315 and pursuant to 37 C.F.R. § 1.927 and 37 C.F.R. § 41.61, we lack jurisdiction to decide the appeal of the final and non-appealable determination that substantial new questions of patentability with respect to the Transistor Article, Howto Guide, or Redlich do not exist.

We also find that the Examiner did not err in finding that Pierce fails to disclose a wireless card and a user connecting to a wireless provisioning device without having to first access the Internet.

DECISION

The Examiner’s decision confirming claims 1-3 and 8-10 over Peirce is affirmed.

AFFIRMED

rvb

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cc:

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