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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID TROPP

Appeal 2016-001455
Application 13/412,233¹
Technology Center 3600

Before JOSEPH A. FISCHETTI, ANTON W. FETTING, and
CYNTHIA L. MURPHY, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 29–53. We have jurisdiction under 35 U.S.C. § 6(b). A hearing was held on April 27, 2017.

SUMMARY OF DECISION

We AFFIRM.

¹ Appellant identifies Blessed By Pinto, LLC as the real party in interest. Br. 1.

THE INVENTION

Appellant claims a method and articles for improving airline luggage inspection. (Spec. 1).

Claim 29 reproduced below, is representative of the subject matter on appeal.

29. A set of locks for securing travelers' luggage while facilitating an entity's authorized luggage-screening of luggage that the travelers have locked with said locks, without breaking the locks or the luggage, wherein the set comprises at least a first subset and a second subset each comprising plural locks, each lock in each of the first and second subsets having a combination lock portion for use by the travelers to lock and unlock the lock and in addition having a master key portion for use by the luggage-screening entity to unlock and re-lock the lock while the combination lock portion of the same lock remains in a locked state, wherein the same master key unlocks the master key portion of each lock in the first and second subsets, and different locks of the first and second subsets have combination lock portions with different plural numbers of dials, wherein:
- the master key portion of each lock in the first and second subsets of locks is configured for the same master key to unlock and re-lock the lock for the authorized luggage-screening independently of a locked state of the combination lock portion of the same lock;
 - the combination lock portion of each lock in the first and second subsets of locks is configured to unlock and re-lock the lock independently of a locked state of the master key portion of the same lock, using respective different combination dial settings of the plural number of dials as selected by of for the travelers;

each lock of a first subset of plural locks and a second subset of plural locks of the locks in the set has two or more combination lock dials;

the number of dials in each lock of the first subset differs from the number of dials in each lock of the second subset; and

each lock in the set has the same prominent indicia configured to uniquely differentiate the locks of the set from locks that are not configured for the luggage-screening entity to unlock and re-lock with the same master key for said authorized luggage-screening by said entity.

each lock in the set has the same prominent indicia configured to uniquely differentiate the locks of the set from locks that are not configured for the luggage-screening entity to unlock and re-lock with the same master key for said authorized luggage-screening by said entity.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Misner et al. US 6,877,345 B1 April 12, 2005

MasterLock, *MasterLocks.com*, <http://masterlocks.com>.

Travel Good Showcase Magazine, *Getting Back the Business: An Update on the Travel Sentry Project*, 24–25 (July/August 2003).

The following rejections are before us for review.

Claims 29–53 are rejected under 35 U.S.C. § 112(a).

Claims 49–53 are rejected under 35 U.S.C. § 101.

Claims 29–53 are rejected under 35 U.S.C. § 103(a).

FINDINGS OF FACT

1. We adopt the Examiner's findings as set forth on pages 3–6 of the Answer concerning only the rejection made under 35 U.S.C. § 112 first paragraph.

2. The Specification of US 7,021,537 describes, “FIG. 1 is a front plan view of one embodiment of the special lock used in the method of the present invention in open position modified to show a key hole for a master key on the bottom.” Col. 3, ll. 46–48.

3. The Specification of US 7,021,537 describes “FIG. 2 is a front plan view of a second embodiment of the special lock used in the method of the present invention.” Col. 3, ll. 49–50.

4. The Specification of US 7,021,537 describes “FIG. 3 is a front plan view of a second embodiment of the special lock used in the method of the present invention modified to show a key hole for a master key on the bottom.” Col. 3, ll. 51–54.

5. The Specification of US 7,021,537 describes,
special lock having a combination lock portion and having a master key lock, the master key lock portion for receiving a master key that can open the master key lock portion of any special lock of this type, the special lock designed to be applied to an individual piece of airline luggage.

Col. 2, ll. 62–67.

6. The Specification of US 7,021,537 only uses the word “set” as a verb, stating, “The combination can be a front dial that is turned or 65 several dials that are turned to set the combination.” Col. 4, ll. 64-65.

ANALYSIS

35 U.S.C. § 112 REJECTION

We will sustain the rejection of claims 29–53 under 35 U.S.C. § 112 first paragraph.

The Examiner found:

The disclosure of ‘500 fails to recite Pg. 2123–25 of the instant invention in which appellant discloses a definition of ‘any special lock’ and the definition directed to size and shape of the lock. This aspect of the instant invention first appears in appellants appellant 10/75631 (now patent 8145576) filed January 1, 2004. As such any claim limitation directed to a different “look or size” or type of lock is only afforded the priority date of January 1, 2004. The examiner notes the limitations in questions are of claims 29, 36, 42 and 49 which claim a first and second subset of looks.
(Answer 3.)

Appellant argues,

Indeed, the specification makes clear that “[t]he phrase ‘any special lock of this type’ is intended to include special locks having a multiplicity of sub-types. . . .” ’223 Appln., at page 6, lines 22–23. In addition, the disclosure states that “the master key lock portion” receives “a master key that can open the master key lock portion of **any** special lock of this type,” and consistently refers to the master key in the singular. In other words, the same master key can open different locks.

Accordingly, the Examiner's reliance on this part of the disclosure as support for her rejection under 35 U.S.C. § 112, paragraph 1, is misplaced.

(Appeal Br. 12)

We disagree with the Appellant. We find that Appellant has failed to show, as of the filing date sought, that Appellant was in possession of the invention as now claimed. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991). An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). Our review of the present Specification as well as prior filed, 10/706,500 now, US 7,021,537² shows no description of a set of locks,

wherein the set comprises at least a first subset and a second subset each comprising plural locks, each lock in each of the first and second subsets having a combination lock portion for use by the travelers to lock and unlock the lock and in addition having a master key portion for use by the luggage-screening entity to unlock and re-lock the lock while the combination lock portion of the same lock remains in a locked state, wherein the

² Priority Application 10/756,531, now US 8,145,576, does describe “any special lock of this type’ is intended to include special locks having a multiplicity of sub-types such as different sizes, different manufacturing designs or styles, etc.” (Col. 4, ll. 21-24), but Application 10/756,531 is a C.I.P. of US’537. We find this description constitutes at least part of the added new matter of the continuation-in-part application.

same master portion of each lock in the first and second subsets.

App'x. Claim 29.

Appellant's assertion that the term "special lock" warrants a definition of a set of locks with first and second subset of locks is not supported by the instant Specification or anything found in the US '537 Specification on which Appellant bases priority. At best, the Specification describe "special lock" only in terms of its components, stating,

special lock having a combination lock portion and having a master key lock, the master key lock portion for receiving a master key that can open the master key lock portion of any special lock of this type, the special lock designed to be applied to an individual piece of airline luggage.

(FF. 5). Nowhere in the in the present Specification or in that of priority US '537 is the word "subset" used. Nowhere are the words "set of locks" used, let alone a set of locks with different combination arrangements. None of Appellant's available Specifications include such a description. In fact, the only use of the word "set" in the available Specifications is as a verb, and only in the context of setting a combination, i.e., turning the dials of the lock. (FF. 6).

Appellant also argues,

The specification describes that the traveler-operated lock portion in one subset is a 4-dial combination lock, in another subset it is a 3-dial combination lock, and in yet another subset it is a lock mechanism other than a combination lock. '233

Appln., Figs. 1 and 3, page 10 lines 14–17. In all three subsets, each of the traveler-operated lock portions are different, yet they share the same master key that locks the master lock portion of each. (*See e.g.*, '233 Appln., pg. 8, lines 16–18) (“As seen from Figs. 1–4, special lock 10 includes a combination lock portion 20 having a unique combination and a master key lock. The master key lock portion is operated by a master key.”). Accordingly, the application shows examples of the different subsets of the special lock, all opened with the same master key and thus meeting the stated objects of providing “special locks that remain viable after being subjected to airport luggage screening (*id.* at page 4, lines 8–10) and of “a master key exclusively maintained by the luggage screening authority” (*id.* at page 4, lines 12–13).

(Appeal Br. 12–13).

We disagree with Appellant that “the application shows example of the different subsets of the special lock” *Id.* at 13. We find instead that the Specification always describes a special lock in the context of a single embodiment. *See* (FF. 2–4). The definition of embodiment is based on a representation of a single idea.³ The Specification only describes the special lock in terms of its own features. (FF. 5). Therefore, we find no merit in Appellant’s argument that the three separate embodiments of the lock shown in Figures 1-3 of the Specification constitute subsets of a set.

35 U.S.C. § 103 REJECTION

³ Someone or something that is a perfect representative or example of a quality, idea, etc. <https://www.merriam-webster.com/dictionary/embodiment> (last visited 6/15/2017).

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We will not sustain the rejection of claims 29–53 under 35 U.S.C. § 103(a).

The Examiner found concerning the rejection of claims 29–53 that MasterLock teaches a set of wherein:

the master key portion of each lock in the first and second subsets of locks is configured for the same master key to unlock and re-lock the lock for the authorized luggage-screening independently of a locked state of the combination lock portion of the same lock, the combination lock portion of each lock in the first and second subsets of locks is configured to unlock and re-lock the lock independently of a locked state of the master key portion of the same lock.

(Final Act. 8).

Appellant argue,

The Examiner also asserts (Office Action ¶ 15) that Masterlock teaches that multiple locks have their own individual key to unlock as well as can be unlocked by the master key, citing “1500 series” locks in Masterlock page 3. However, these locks only open with master keys that differ for each location such as a school, a health club, and employee lockers. Different keys are used for different locations. In addition, as noted above they lack the recited showing of plural subsets that differ from each other, where at least one subset has plural-dial traveler-operated lock portion.

(Appeal Br. 21).

We agree with Appellant. We find nothing in MasterLock that discloses or suggests a set of locks having a plurality of subsets that differ

from each other at the combination lock portion. Even assuming that the plurality of pictures of locks on page 1 of MasterLock are of different locks constituting a set, MasterLock here shows all locks having the same combination arrangement, namely, one spin dial combination and a master key release in the rear of the lock. Since each of independent claim 29, 36, 42, 49 all include the feature of different traveler operated portions, and there is no evince why one having ordinary skill in the art would provide such a set, the claims are not met by Masterlock. Since claims 30-35, 37-39, 43-48 and 50-53 depend from one of claims 29, 36, 42, 49 and since we cannot sustain the rejection of claims 29, 36, 42, 49, the rejection of claims 30-35, 37-39, 43-48 and 50-53 likewise cannot be sustained. Therefore, we will not sustain the rejection of claims 29–53 under 35 U.S.C. § 103(a).

35 U.S.C. § 101 REJECTION

We will not sustain the rejection of claim 49-53 rejected under 35 U.S.C. § 101 because the claims are directed to an improvement in the relevant technology of combination locks, and not to an abstract idea. (*McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016). The Federal Circuit noted in *McRO* that the abstract idea exception has been applied to prevent patenting of claims that abstractly cover results where “it matters not by what process or machinery the result is accomplished.” *McRO*, 837 F.3d at 1312. The court in that case, thus, looked to whether the claim at issue focused on a specific method that improves the relevant technology, i.e., computer animation, or instead was

directed to a result or effect that itself is the abstract idea and merely invokes generic processes and machinery. *Id* at 1313.

Here independent claim 49, albeit a method, requires specific structure for a set of locks with a master key portion of each lock configured for the same master key to unlock and relock the lock independently of a locked state of the combination portion and a combination portion configured to unlock and relock of a locked state independently of the master key portion. Independent claim 49 is thus squarely directed to a technological improvement in the field of lock technology, an improvement moreover in an article of manufacture which is patent eligible subject matter.

CONCLUSIONS OF LAW

We conclude the Examiner did not err in rejecting claims 29–53 under 35 U.S.C. § 112.

We conclude the Examiner did err in rejecting claims 49–53 under 35 U.S.C. § 101.

We conclude the Examiner did err in rejecting claims 29–53 under 35 U.S.C. § 103.

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DECISION

The decision of the Examiner to reject claims 29–53 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED