

Kratz, Quintos & Hanson, LLP – IP Newsletter

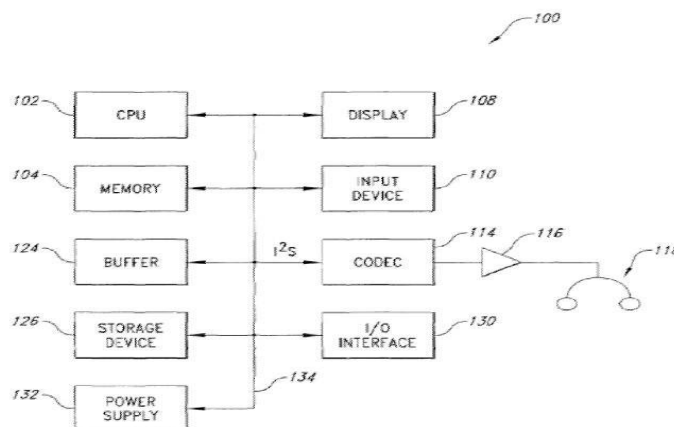
IN THE CASE OF *IN RE SCHWEICKERT*, THE CAFC HOLDS THAT THE U.S. PTO'S ATTEMPT TO COMBINE TWO REFERENCES IS "ILLOGICAL," "DEFICIENT," AND "ILL FIT"

By: Mel R. Quintos

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n the case of *In re Schweickert* (decided by the U.S. Court of Appeals for the Federal Circuit (CAFC) on January 26, 2017), the U.S. Patent and Trademark Office (PTO) instituted an *Ex parte* reexamination of U.S. Patent No. 7,574,272 (hereinafter, "the '272 patent"). The PTO rendered the claims of the '272 patent obvious based on a two-reference combination (namely, U.S. Patent No. 6,332,175 to Birrell and U.S. Patent No. 5,842,015 to Cunniff).

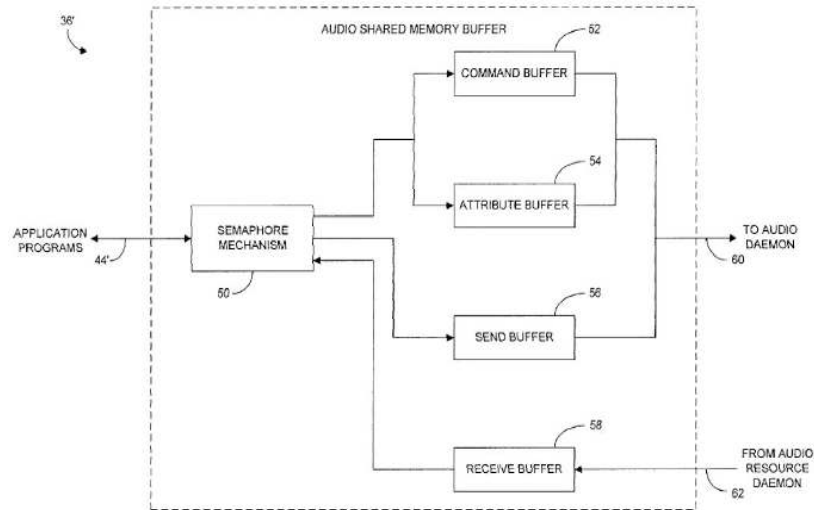
The '272 patent is directed to a portable media player, which as shown in the figure below, includes a CPU 102 that executes the transfer of compressed digital data from a storage device 126 to a buffer 124 then transfers the data through a high speed serial bus to a CODEC 114, where the data is converted to a decompressed analog data and ultimately sent to an audio output device 118 (e.g., a pair of headphones).



The buffer 124 has a "lockable feature" for limiting the amount of compressed digital data that can be reloaded into the buffer 124 to reduce the frequency in which the storage device 126 has to be activated and the motor therein operable.

The Birrell patent is generally directed to a portable audio player that stores compressed data into a RAM and converts the compressed data to decompressed audio, which is ultimately sent to an output jack. The Cunniff patent, as shown on the back page, is directed to a hardware resource manager or a software program that controls access to a hardware resource by several application programs.

In order to protect the integrity of the shared memory buffer 36, Cunniff's system includes a "SEMAPHORE MECHANISM" 50 to prevent having more than one application program write to the shared memory buffer 36 at a time.



The CAFC disagreed with the PTO's attempts to combine the Birrell and Cunniff patents to render obvious the claims of the '272 patent for the following reasons:

- (1) It is "illogical" for Cunniff's SEMAPHORE 50 to be used in Birrell's system because "it would leave Birrell void of the mechanism it relies on to monitor when the compressed data in the RAM has fallen below a [certain] level."
- (2) There are at least two application programs competing for access to a limited hardware resource in Cunniff, but "there is no similar competition for access to Birrell's RAM."
- (3) The PTO argues that both references seek "to avoid unintended overwriting of data." However, Birrell's play control logic times the copying of new data; and thus avoids any unintended overwriting of data and does not require any teachings from Cunniff to achieve this objective.
- (4) The claimed invention in the '272 patent requires multiple lockable buffers. Birrell's RAM requires only a single buffer for the compressed data. The PTO's attempt to combine the references is "deficient" because the PTO has not explained why a skilled artisan would modify Birrell's RAM to include multiple lockable buffers.

Decision: The U.S. Court of Appeals for the Federal Circuit finds that the PTO "has proffered no sufficient basis for why a skilled artisan would have readily applied the Cunniff reference to the Birrell reference," and concludes that, for the above reasons, the Cunniff reference is "an ill fit" for the Birrell reference. VACATED AND REMANDED.

Washington D.C. Office:
 4th Floor
 1420 K Street, N.W.
 Washington, DC 20005
 U.S.A.
 Tel: 202-659-2930
 Fax: 202-887-0357
correspondence@kqhpatentlaw.com
www.kqhpatentlaw.com

Tokyo Liaison Office:
 21st Floor
 Shin-Marunouchi Center Building
 1-6-2 Marunouchi, Chiyoda-ku
 Tokyo 100-0005 JAPAN
 Tel: 03-3216-7188
 Fax: 03-3216-7210

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