



UNIVERSITY OF  
MARYLAND  
SCHOOL OF LAW

**PATENT LAW  
UPDATE**

***In re Huston***

No. 02-1048  
Federal Circuit  
Oct. 17, 2002

*“The Board’s cryptic finding of a motivation to combine may be affirmed because it was supported in the record, even though the record reference was not quoted, just as a district court’s factual finding may be sustained if supported by record evidence not specifically cited by the district court.”*

On October 17, 2002, the Federal Circuit affirmed the decision of the Board of Patent Appeals and Interferences, which upheld the examiner’s rejection of certain claims of U.S. patent application Serial No. 08/926,293, which related to the display of an advertising message to a golfer on a screen based on the golfer’s current position as determined by a global positioning satellite (GPS) system. The Federal Circuit agreed that the claims are not entitled to the filing date of an earlier filed application and would have been obvious to one of ordinary skill in the art at the time of invention, and stated:

Appellants [seek] the benefit of the December 10, 1991, filing date of the ‘368 application. In order “[t]o gain the benefit of the filing date of an earlier application under 35 U.S.C. § 120, [a later-filed application] must comply with the written description requirement of 35 U.S.C. § 112.” [A]ppellants argue that the ‘368 application discloses the “genus” of transmitting “information,” and that the ‘293 application is directed to the particular “species” of transmitting “advertising information.” While the specification discloses the transmission of distance information and help messages to a golfer based on the golfer’s position as determined by GPS, it does not in fact disclose the transmission of generic “other information” to a golfer based on the golfer’s position as determined by GPS. Thus, even if advertising could be viewed as a subset of “other information,” the transmission of “other information” based on position as determined by GPS was not disclosed, and in particular the transmission of positional advertising was not disclosed. “Entitlement to a filing date does not extend to subject matter which is not disclosed, but would be obvious over what is expressly disclosed. It extends only to that which is disclosed.” Huston’s parent application disclosure fails to support the presently claimed “displaying an advertising message” based on position, and the effective filing date is therefore December 30, 1994.

It follows that the Board properly considered the Paul and Dimitriadis patents as prior art under 35 U.S.C. § 102(e). [T]he Board properly rejected the Horne declaration [which addressed only] whether it would have been obvious in December 1991 to combine [other] prior art references. [S]ubstantial evidence supports the Board’s determination of the effective filing date and its rejection of the Horne declaration. . . .

Appellants complain that the Board did not specifically find a suggestion or motivation to combine the references in the prior art, except through its reliance on common knowledge and common sense. . . . We disagree. . . . Despite the Board’s passing reference to “common knowledge and common sense,” the Board in fact has not relied on its own general knowledge. Rather, it has found the motivation in the prior art references themselves. Its conclusions are cryptic, but they are supported by the record. . . . Paul provides the motivation to substitute a GPS system for the radio system of Dudley. Under such circumstances the Board’s decision must be affirmed despite its failure to specifically cite the Paul reference for this purpose. . . . This is a situation where the Board’s “path may reasonably be discerned,” [which justifies upholding an agency decision of less than ideal clarity].