

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 41

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RODNEY C. HEMMINGER and MARK L. MUNDAY

Appeal No. 2001-1866
Application No. 08/478,606

ON BRIEF

Before JERRY SMITH, GROSS, and BARRY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

A patent examiner rejected claims 3-38. The appellants appeal therefrom under 35 U.S.C. § 134(a). We affirm-in-part and enter new grounds of rejection.

BACKGROUND

The appellants' invention concerns the testing of electronic utility meters. More specifically, their invention uses a single optical communications port to transfer testing signals from an electronic utility meter to external calibration equipment. "The test[ing] signals each represent a selected one of the various types of power measurements

generated by the meter. For example, the kh value watt-hour may be output as a test signal via the optical port when the meter is placed in a test mode.” (Appeal Br. at 4.)

According to the appellants, while other meters include an optical port, those meters do not use the optical port to transfer test signals. (*Id.*) The other meters instead use at least one additional, separate light-emitting diode (“LED”) to transfer testing signals to external equipment. (*Id.*) Having both an optical port and a separate testing LED adds cost, decreases reliability, and limits testing capabilities. (Spec. at 17.) The appellants assert that their invention “overcomes these limitations by multiplexing the various metering function output signals and pulse rates over optical port 40 alone.” (*Id.*)

A further understanding of the invention can be achieved by reading the following claims:

3. In an electronic energy meter which senses input voltage and current signals and processes the input voltage and current signals to generate [sic] various power measurements, and wherein said electronic energy meter includes one optical communications port, a method of providing optical test signals for electronic meter testing comprising the steps of:

selecting one of said various power measurements and defining the same as the selected power measurement;

generating a test signal representative of the selected power measurement; and

transmitting the test signal over said optical communications port for receipt and processing by standard calibration test equipment.

16. In an electronic energy meter which senses input voltage and current signals and processes the input voltage and current signals to generates [sic] various power measurements including real power, reactive power, and apparent power and wherein said electronic energy meter comprises a communications interface and one optical test interface, a method of providing optical test signals for electronic meter testing comprising the steps of:

receiving a data command over the communications interface;

selecting, in response to the data command, one of the various power measurements by selecting between real power, reactive power and apparent power to define a selected power measurement; and

generating a test signal representative of the selected power measurement; and

transmitting the test signal over the optical test interface.

Claims 3-38 stand rejected under 35 U.S.C. § 103(a) as obvious over Schlumberger Indus. Elec. Div. ("Schlumberger"), *Quantum® Electronic Meter Field Reference Manual For Q101, Q111, Q121, Q200, Q210, Q220 and Q230 Electronic Meters* (circa 1990¹) in view of U.S. Patent No. 4,298,839 ("Johnston").

¹The examiner asserts that "[t]he date of the reference titled 'Quantum Electronic Meter. . .' is taken to be 1990 because it refers to the Model Q200 and Product Bulletin 10255, also submitted, refers to Model Q200. Product Bulletin 10255 has a date of 1990 or prior to 1990." (Final Rejection at 2.)

OPINION

At the outset, we recall that claims that are not argued separately stand or fall together. *In re Kaslow*, 707 F.2d 1366, 1376, 217 USPQ 1089, 1096 (Fed. Cir. 1983) (citing *In re Burckel*, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979)). When the patentability of a dependent claim is not argued separately, in particular, the claim stands or falls with the claim from which it depends. *In re King*, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986) (citing *In re Sernaker*, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983); *In re Burckel*, 592 F.2d 1175, 1178-79, 201 USPQ 67, 70 (CCPA 1979)). Furthermore, “[m]erely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.” 37 C.F.R. § 1.192(c)(7).

Here, rather than arguing the patentability of claim 25, the appellants assert, “[i]ndependent claim[] . . . 25 recite[s] similar features” (Appeal Br. at 6), to those of independent claim 3. Although they point out differences in what “certain,” unspecified dependent claims cover, (*id.* at 8), this is not an argument why the claims are separately patentable. Therefore, claims 4-15 and 25-38 stand or fall with representative claim 3, and claims 17-24 stand or fall with representative claim 16. With this representation in mind, we address the following groups of claims:

- claims 3-15 and 25-38
- claims 16-24.

Claims 3-15 and 25-38

Rather than reiterate the positions of the examiner or appellants *in toto*, we address the two points of contention therebetween. First, the examiner asserts, "Johnston `839 shows that an optical port may be made to provide plural types of information by commands received via the optical port." (Examiner's Answer at 4.) The appellants argue, "Johnston does *not* employ the optical communications port for transmission of 'test signals' as claimed. . . ." (Appeal Br. at 7.)

"Analysis begins with a key legal question -- *what is the invention claimed?*" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question, "the Board must give claims their broadest reasonable construction. . . ." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

Here, representative claim 3 specifies in pertinent part the following limitations: "generating a test signal representative of the selected power measurement; and transmitting the test signal over said optical communications port." Giving the

representative claim its broadest, reasonable construction, the limitations require transmitting a signal that represents a power measurement over an optical communications port.

Having determined what subject matter is being claimed, the next inquiry is whether the subject matter is obvious. The question of obviousness is “based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently. . . .” *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966); *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ 1614, 1616 (Fed. Cir. 1999); *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995)). “A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.” *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, Johnston generally “relates to an external data communication arrangement for a programmable AC electric energy meter having a sealed enclosure and more particularly to such an arrangement including a transparent communications window portion of the enclosure for receiving and transmitting coded radiations into and

from a radiation sensitive external data interface.” Col. 1, ll. 8-14. We find that the coded radiations transmitted from the electric meter are signals that represent power measurements. Specifically, the reference initially captures data representing power measurements. More specifically, “circuit 16 totalizes and stores in the data RAM memory 34 the values of the electric energy parameters to be measured including **kilowatt hours** and **kilowatt demand** for the predetermined high rate, mid rate and low rate periods during each day.” Col. 6, ll. 22-27 (emphasis added).

We further find that Johnston then transmits pulsed signals representing the power measurements of kilowatt hours or kilowatt demand over an optical communications port. Specifically, “[t]he stored read-write memory data is . . . read out in pulse signal by means of the present invention. . . .” Col. 6, ll. 33-35. The appellants admit that in the reference, “[a] four element optical communications port is provided . . . for reading the required parameters out of the data RAM 34.” (Appeal Br. at 7.) It is that four element optical communications port, moreover, that Johnston uses to transmit its signals representing power measurements. See Fig. 1 (showing the signals “DATA OUT” and “STROBE OUT” being transmitted via respective apertures 117 and 115 of the optical port).

Second, the examiner asserts, "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have adapted the apparatus of the 'Quantum Electronic Meter. . .' reference to read watt-hour and var test signals using a single optical port and switching means in accord with the teaching of Johnston '839 because one skilled in the art would realize that such would reduce the number of optical ports necessary." (Examiner's Answer at 4-5.) The appellants argue, "there [is] no motivation to combine the references. . . ." (Appeal Br. at 8.)

As explained regarding the first point of contention, we have found that teachings from Johnston itself would have suggested the claimed subject matter to a person of ordinary skill in the art. Because the teachings of Schlumberger are merely cumulative to those of Johnston, we decline to address the motivation to combine the two references. Therefore, we affirm the rejection of claim 3 and of claims 4-15 and 25-38, which fall therewith.

Claims 16-24

The examiner asserts, "Johnston '839 shows that an optical port may be made to provide plural types of information by commands received via the optical port." (Examiner's Answer at 4.) The appellants argue, "Johnston does *not* employ the

optical communications port for transmission of 'test signals' as claimed. . . ." (Appeal Br. at 7.)

“[T]he main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. *[T]he name of the game is the claim. . . .*” *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) (quoting Giles S. Rich, *The Extent of the Protection and Interpretation of Claims --American Perspectives*, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499, 501 (1990)).

Here, like claim 3, claim 16 specifies in pertinent part the following limitations: "generating a test signal representative of the selected power measurement; and transmitting the test signal over the optical test interface." Claim 16 further specifies that the "power measurements includ[e] real power, reactive power, and apparent power. . . ." Giving the latter claim its broadest, reasonable construction, the limitations require transmitting a signal that selectively represent the power measurements of real power, reactive power, and apparent power over an optical interface.

“In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness.” *In re Rijckaert*, 9 F.3d 1531,

1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993)(citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). Here, as explained regarding claims 3-15 and 25-38, Johnston transmits pulsed signals representing the power measurements of kilowatt hours and kilowatt demand over an optical communications port. The examiner fails to allege, let alone show, however, that the reference's kilowatt hours or kilowatt demand correspond to the limitations of real power, reactive power, and apparent power. We will not "resort to speculation," *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), as to such correspondence. Absent a teaching or suggestion of transmitting a signal that selectively represents real power, reactive power, and apparent power, the examiner fails to present a *prima facie* case of obviousness. Therefore, we reverse the rejection of claim 16, and of claims 17-24, which fall therewith.

Under 37 C.F.R. § 1.196(b)(2002), we enter two new grounds of rejection against claims 16-24. First, "compliance with the 'written description' requirement of §112 is a question of fact. . . ." *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991) (citing *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989); *Utter v. Hiraga*, 845 F.2d 993, 998, 6 USPQ2d 1709, 1714 (Fed. Cir. 1988)). "Although [the applicant] does not have to describe exactly the subject matter claimed, . . . the description must clearly allow persons of

ordinary skill in the art to recognize that [he or she] invented what is claimed." 935 F.2d at 1563, 19 USPQ2d at 1116 (quoting *Gosteli*, 872 F.2d at 1012, 10 USPQ2d at 1618). "[T]he test for sufficiency of support . . . is whether the disclosure of the application relied upon 'reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.'" *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)).

"Application sufficiency under §112, first paragraph, must be judged as of the filing date [of the application]." *Vas-Cath*, 935 F.2d at 1566, 19 USPQ2d at 1119 (citing *United States Steel Corp. v. Phillips Petroleum Co.*, 865 F.2d 1247, 1251, 9 USPQ2d 1461, 1464 (Fed. Cir. 1989)).

Here, the appellants added claims 16-24 to their specification by an amendment. (Paper No. 8.) Independent claim 16 specifies in pertinent part the following limitations: "said electronic energy meter comprises a communications interface and one optical test interface. . . ." (Emphasis added.) Dependent claim 22 further specifies that "the communications interface is an optical communications port;" dependent claim 24 further specifies that "the test interface is an LED." In combination, the limitations require **both** an LED and an optical port.

The appellants fail to show that the original specification, which includes the original claims, disclosed the limitations. Although the specification acknowledges that “[t]raditionally, electronic meters have provided a single light emitting diode (LED) in addition to an optical port,” (Spec. at 16-17), it teaches away from “[h]aving *both* an optical port and one or more separate test LEDs. . . .” (Appeal Br. at 4.) Specifically, “[s]uch designs add cost, decrease reliability and limit test capabilities.” (Spec. at 17.) Instead of having both an optical port and one or more separate test LEDs, the specification discloses that the appellants’ “invention overcomes these limitations by multiplexing the various metering function output signals and pulse rates over optical port 40 **alone**.” (*Id.* (emphasis added).)

Because added claims 16-24 require both an LED and an optical port, while the original specification discloses using an optical port alone, we are not persuaded that when the appellants’ application was filed, the appellants had possession of an “electronic energy meter compris[ing] a communications interface and one optical test interface” wherein “the communications interface is an optical communications port,” and “the test interface is an LED.” Therefore, we reject claims 16-24 under 35 U.S.C. § 112, ¶ 1, as lacking an adequate written description.

Second, “[t]he test for definiteness is whether one skilled in the art would understand the bounds of the claim when read in light of the specification.” *Miles Labs., Inc. v. Shandon Inc.*, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993) (citing *Orthokinetics Inc., v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986)). Because claims 16-24 require both an LED and an optical port, while the original specification discloses using an optical port alone, we are not persuaded that one skilled in the art would understand the bounds of the claims when read in light of the specification. Therefore, we reject claims 16-24 under 35 U.S.C. § 112, ¶ 2, as indefinite.

CONCLUSION

In summary, the rejection of claims 3-15 and 25-38 under § 103(a) is affirmed; the rejection of claims 16-24 under § 103(a) is reversed; and new rejections of claims 16-24 under 35 U.S.C. § 112, ¶¶ 1 and 2, are added. “Any arguments or authorities not included in the brief[s] will be refused consideration by the Board of Patent Appeals and Interferences. . . .” 37 C.F.R. § 1.192(a)(2002). Accordingly, our affirmance is based only on the arguments made in the briefs. Any arguments or authorities not included therein are neither before us nor at issue but are considered waived.

Our opinion contains a new ground of rejection pursuant to 37 C.F.R. § 1.196(b) (2002). Section 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review." It also includes the following provisions.

[T]he appellant, withing two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time for taking any action in connected with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART
37 C.F.R. § 1.196(b)

JERRY SMITH
Administrative Patent Judge

ANITA PELLMAN GROSS
Administrative Patent Judge

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