

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. 31

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.2000-2244
Application No. 08/660,709

ON BRIEF

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

DECISION ON REQUEST FOR REHEARING

A patent examiner rejected claims 23-31. The appellants appealed therefrom under 35 U.S.C. § 134(a). We affirmed-in-part. *Ex parte Hemminger*, No. 2000-2244, slip op. at 1 (Bd.Pat.App. & Int. Sept. 27, 2002). The appellants now ask us to reconsider our decision to affirm the rejection of claims 23-28 under § 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, chs. 5-6 (circa 1990¹) and U.S. Patent No. 4,298,839 ("Johnston").
(Req. Reh'g at 1.)

Rather than reiterate the positions of the examiner or appellants *in toto*, we address the main point of contention therebetween. "The Examiner points to column 5, line 65 to column 7, column 23, of Johnston where it is indicated that kilowatt hours and kilowatt demand are stored in RAM and selectively read out on an eight digit display or impulse signal." (Examiner's Answer at 4-5.) The appellants argue, "those are not different 'types' of electrical energy." (Req. Reh'g at 3.)

"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). Here, claim 23 specifies in pertinent part the following limitations:
"generating energy signals representative of said multiple types of electrical energy. . .
." Accordingly, the limitations require generating signals representing at least two (different) types of electrical energy.

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.)

Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious. "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)). "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's "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 are not persuaded that the reference's kilowatt hours and kilowatt demand represent different types of energy. To the contrary, we agree with the appellants that these are measurements of "a single 'type' of electrical energy - real energy (watthours)." (Req. Reh'g at 3.)

The examiner fails to allege, let alone show, that the addition of Schlumberger cures the aforementioned deficiency of Johnston. Absent a teaching or suggestion of generating signals representing at least two (different) types of electrical energy, the examiner fails to present a *prima facie* case of obviousness. Therefore, we reverse the obviousness rejection of claim 23 and of claims 24-28, which depend therefrom.

GRANTED

JERRY SMITH
Administrative Patent Judge

ANITA PELLMAN GROSS
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

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APPLICATION NO. 08/660,709

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APJ JERRY SMITH

After signing, return to APJ Barry for disk.

After APJ Barry provides disk, forward to Team 3 for entering changes and mailing.

Prepared By: APJ BARRY

DRAFT SUBMITTED: 15 Apr 04

FINAL TYPED:

Team 3:

I typed all of this opinion.

Please proofread spelling, cites, and quotes. Mark your proposed changes on the opinion, but **do NOT change matters of form or style. I will include the diskette with the signed copy so that you can make all changes before mailing.**

For any additional reference provided, please prepare PTO 892 and include copy of references

Thanks, Judge Barry