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MACMILLAN, SOBANSKI & TODD, LLC ONE MARITIME PLAZA - FIFTH FLOOR 720 WATER STREET TOLEDO, OH 43604			FANTU, YALKEW	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ALLAN R. GALE and MICHAEL DEGNER

Appeal 2010-010789
Application 11/717,312
Technology Center 2800

Before JOSEPH L. DIXON, ST. JOHN COURTENAY III, and
CARLA M. KRIVAK, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Patent Examiner finally rejected claims 1-22. Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

INVENTION

This invention relates to "detecting the current rating of a circuit that supplies power to the charger and battery." (Spec. 1). Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A method for charging an electric storage battery in a plug-in hybrid electric vehicle through a power supply circuit, comprising the steps of:

- (a) coupling the charger to the circuit;
- (b) providing the charger with a signal representing a current capacity of the circuit;
- (c) using the signal to determine a maximum charge rate corresponding to the current capacity of the circuit represented by the signal; and
- (d) charging the battery through the circuit and charger at the maximum charge rate.

REJECTIONS

R1. Claims 1-3, 6-8, 11-13, 15-17, and 19-21 stand rejected under 35 U.S.C. §102(b) as being anticipated by Hobbs (US Patent Application Pub. No. 2004/0169489 A1). (Ans. 4).

R2. Claims 4, 5, 9, 10, 14, 18, and 22 stand rejected under 35 U.S.C. §103(a) over the combined teachings and suggestions of Hobbs and Bertness (US Patent Application Pub. No. 2005/0212521 A1). (Ans. 5).

PRINCIPLE OF LAW

"It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim, and that anticipation is a fact question" *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik GMBH v. Am. Hoist & Derrick Co.*, 730 F.2d 1452, 1457 (Fed. Cir. 1984)).

ANALYSIS

Undue Multiplicity under 37 C.F.R. §1.75(b)

At the outset, we observe that claims 6 to 10 appear to be identical to claims 1 to 5. Claims 15-18 also appear to be identical to claims 11-14. *See* MPEP §2173.05(n) (discussion on undue multiplicity); *See also* 37 C.F.R. §1.75(b): "More than one claim may be presented provided they differ substantially from each other and are not unduly multiplied."

The record indicates that Appellants attempted to cancel duplicate claims 6-10 and 15-18 by filing an after-final amendment on March 24, 2010, which was *one day before* the Notice of Appeal and Appeal Brief were *simultaneously* filed on March 25, 2010. However, we find no PTOL-303 response by the Examiner in the record indicating whether Appellants' after-final amendment (Mar. 24, 2010) was entered, or would be entered on appeal. Instead, the Examiner indicates in the Examiner's Answer that the after-final amendment (Mar. 24, 2010) was *not entered*:

(iii) Status of Claims

The statement of the status of claims contained in the brief is correct.

(iv) Status of Amendments After Final

The amendment after final rejection filed on 03/24/2010 has not been entered; amendment after final rejection has not been acted [on] since filed at the same time with appeal brief (appeal brief filed on 03/25/2010).

(Ans. 2).

Thus, the claims appendix to the Appeal Brief (Mar. 25, 2010) reflects the status of the claims *before* the after-final amendment of March 24, 2010, which was *not entered* by the Examiner. Therefore, for purposes of this appeal, we have considered the status of the claims as they are presented in the appendix to the claims in the Appeal Brief.

We note that a rejection under §112(b) on the ground of undue multiplicity is not before us on appeal. We leave it to the Examiner and Appellants to resolve this issue of undue multiplicity, as these claims cannot go to issue as currently presented with duplicate claims. If this issue is not cured by appropriate action by Appellants, then the Examiner should consider a rejection under 35 U.S.C. §112(b). *See* MPEP §2173.05(n).

R1.

Issue: Under §102, did the Examiner err in finding that the cited Hobbs reference discloses "(b) providing the charger with a signal representing a current capacity of the circuit," within the meaning of claim 1 and the commensurate language of claims 6, 11, 15, and 19?

Appellants contend:

Hobbs is silent with respect to providing either charger 100, 160 with a signal representing the current capacity, i.e., the current rating, of a power supply circuit, as claim 1 recites. The power supply circuit 12 of the subject patent application is comparable to Hobbs's power cable 120, whose current carrying capacity is not discussed in Hobbs.

(Reply Br. 2; *See* App. Br. 6-7).

In reviewing the record before us, we find speculation is required to ascertain exactly how the Examiner is reading the disputed claimed: (1) "power supply circuit" and (2) "a signal representing a current capacity of the circuit" on multiple portions of the Hobbs reference cited on pages 4 and 7-8 of the Answer. (Claim 1).

We find the Examiner's mapping of at least the claimed "power supply circuit" to the corresponding element on the Hobb's reference is unclear. (Ans. 4-5; 7-8; *see also* claim 1). To the extent the Examiner may be reading the claimed "power supply circuit" (claim 1) on Hobbs' power grid (105; Fig. 1; Ans. 4) and "a signal representing a current capacity of the circuit" on Hobbs' look-up table 272 in the charger's controller 270 (that stores electrical parameters of the batteries) (§ 0052]; Fig. 2; 272), we find Hobbs' look-up table 272 does not output "a signal representing a current capacity of the circuit." This is because the look-up table's electrical parameters of the *batteries* (152) do not represent the "current capacity" of *power grid* 105 ("power supply circuit"). (*Id.*).

We note that in an ex parte appeal, the Board "is basically a board of review – we review . . . rejections made by patent examiners." *Ex parte Gambogi*, 62 USPQ2d 1209, 1211 (BPAI 2001). "The review authorized by 35 U.S.C. Section 134 is not a process whereby the examiner . . . invite[s]

the [B]oard to examine the application and resolve patentability in the first instance.” *Ex parte Braeken*, 54 USPQ2d 1110, 1112 (BPAI 1999).

Because the Board is basically a board of review and not a place of initial examination, we will not engage in the *de novo* examination required to precisely map each of the elements disputed by Appellants to the Hobbs reference. (App. Br. 5-7). To affirm the Examiner on this record would require speculation on our part. We decline to engage in speculation.

On this record, we cannot affirm the Examiner's anticipation rejection of independent claims 1, 6, 11, 15, and 19. Because we have reversed the anticipation rejection for each independent claim before us on appeal, we also reverse the Examiner's anticipation rejection R1 of associated dependent claims 2, 3, 7, 8, 12, 13, 16, 17, 20, and 21.

R2.

Regarding the § 103 rejection R2 of dependent claims 4, 5, 9, 10, 14, 18, and 22, Appellants argue these claims are patentable by virtue of their dependency from their parent claims. (App. Br. 17-22). Appellants further argue that the additionally cited Bertness reference does not cure the deficiencies of the rejection of the parent claims. (*Id.*). The Examiner did not allege that Bertness would have taught or suggested the limitations disputed above regarding the independent claims rejected under § 102. (Ans. 5-6, 11-14). Therefore, we reverse the Examiner's §103 rejection R2 of dependent claims 4, 5, 9, 10, 14, 18, and 22.

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DECISION

We reverse the Examiner's rejection R1 under § 102 of claims 1-3, 6-8, 11-13, 15-17, and 19-21.

We reverse the Examiner's rejection R2 under § 103 of claims 4, 5, 9, 10, 14, 18, and 22.

ORDER

REVERSED

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