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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ALAN THOMAS MCGRATH

Appeal 2014-007659
Application 12/151,178
Technology Center 3600

Before JENNIFER D. BAHR, JAMES P. CALVE, and
FREDERICK C. LANEY, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Alan Thomas McGrath (Appellant) appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 6–16 under 35 U.S.C. § 103(a) as unpatentable over Tillotson (US 7,365,674 B2, iss. Apr. 29, 2008) and Lacaze (US 2007/0260366 A1, pub. Nov. 8, 2007). We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

THE CLAIMED SUBJECT MATTER

Claim 11, reproduced below, is illustrative of the claimed subject matter.

11. A method of controlling the flight of an aircraft in windy and current icing potential conditions, the method comprising:

(a) releasing a plurality of dropsonde[s] which measure meteorological values of the atmosphere;

(b) collecting meteorology data by the dropsondes;

(c) transmitting the data from the dropsondes to the plane;

(d) calculating wind vectors and current icing potential during flight for comparison to pre-determined values in a table for determining whether unfavorable wind conditions or current icing potential exist;

(e) when wind or current icing potential values exceeds a selected value in the table indicating unfavorable winds or current icing potential conditions, automatically operating flight control devices on the aircraft so as to minimize the effects of the wind or current icing potential conditions on the flight of the aircraft.

DISCUSSION

Appellant argues for patentability of claims 6–16 subject to the rejection under 35 U.S.C. § 103(a) as a group. Br. 5–14. We select claim 11 as representative of this group, and claims 6–10 and 12–16 stand or fall with claim 11. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner found that Tillotson discloses a method of controlling the flight of an aircraft in windy and current icing potential conditions, as called for in claim 11, except that Tillotson

does not explicitly recite calculating the wind vectors and current icing potential for comparison to predetermined values in a table

for determining whether an unfavorable wind condition or an unfavorable current icing potential exist; or when wind or current icing potential values exceeds a selected value in the table indicating unfavorable winds or current icing potential conditions, automatically operating flight control devices on the aircraft so as to minimize the effects of the wind or current icing potential conditions on the flight of the aircraft.

Final Act. 5–6.

The Examiner determined:

In view of Lacaze's teaching of the application of an aircraft using calculated values related to meteorological values and specific aircraft characteristic (e.g. the mass etc), comparing them to predefined values to see if they exceed a selected value, determining whether unfavorable conditions for the aircraft exist based on the comparison and further automatically controlling the aircraft in accordance with a result of the comparison, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Tillotson's disclosed method such that the calculated wind vectors and current icing potential are used for comparison to pre-determined values in a table for determining whether an unfavorable wind condition or an unfavorable current icing potential exist and when the wind or current icing potential values exceed a selected value in the table indicating unfavorable winds or current icing potential conditions, automatically operating flight control devices on the aircraft so as to minimize the effects of the wind or current icing potential conditions on the flight of the aircraft for the purpose of increasing automation and utility in the method by scaling the calculated wind vectors and current icing potential with aircraft specific characteristics such as mass, to predict the performance of the aircraft, and provide an automated means for dealing with adverse conditions, should they arise.

Id. at 7–8.

Appellant does not contest either the Examiner's findings with respect to the teachings of Tillotson and Lacaze or the Examiner's determination that the subject matter of claim 11 would have been obvious in view of the

combined teachings of Tillotson and Lacaze. Br. 5–14. Rather, Appellant seeks to disqualify Lacaze as prior art to Appellant’s invention by relying on two affidavits¹ purporting to establish conception of the claimed invention prior to the effective date of Lacaze (i.e., March 29, 2007, the date on which the Lacaze application was filed) coupled with due diligence from prior to March 29, 2007 to May 6, 2007 (i.e., the filing date of the provisional application to which the present application claims benefit). *See* Final Act. 2; Br. 5–6, 14.

After reviewing the affidavits, including the attachments thereto, the Examiner determined that they are ineffective to disqualify Lacaze as prior art. Final Act. 9. In particular, the Examiner identified two deficiencies in the submitted evidence, as set forth below. *Id.* at 9–11.

First, according to the Examiner, the submitted evidence is sufficient to establish conception of parts of the claimed invention, but insufficient to establish conception of the entirety of the claimed invention. *Id.* at 9.

Specifically, the Examiner determined that “[t]here is insufficient evidence to establish conception of” the aspect of claim 11 directed to

calculating current icing potential during flight for comparison to predetermined values in a table for determining whether current icing potential exists; when current icing potential values exceed a selected value in the table indicating current icing potential conditions, operating flight control devices so as to minimize the effects of the current icing potential conditions on the flight of the aircraft.

Id.

¹ Br. B084–B090 (Affidavit of Alan McGrath dated Dec. 12, 2011), B115–B186 (Affidavit of Alan McGrath dated Jan. 14, 2013).

Second, the Examiner determined that “[t]he submitted evidence . . . is insufficient to establish diligence from a date prior to the date of reduction to practice (March 29, 2007) of the Lacaze reference to either a constructive reduction to practice (May 6, 2007) or an actual reduction to practice.” *Id.* at 10.

Appellant does not contest the Examiner’s determination that the submitted evidence is insufficient to establish conception of the invention of claim 11 as a whole. *See* Br. 5 (“According to the Examiner, I didn’t establish an early enough date of conception for the ‘icing potential’ elements of the above claims. Those elements are parts of items (d) and (e) of claims 6 and 11. I am not appealing that rejection (B196 and B197).”). Rather, the only issue identified by Appellant for our review is “whether the evidence supports that [Appellant] established reasonable diligence through affirmative actions or excuses to establish an earlier invention date for some of the claims of [Appellant’s] invention.” *Id.*

In order to disqualify a reference as prior art by establishing invention of the subject matter of a rejected claim prior to the effective date of the reference on which the rejection is based:

The showing of facts for an oath or declaration . . . shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or *conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application.*

37 C.F.R. § 1.131(a), (b) (emphasis added).

Appellant does not allege, and has not submitted any evidence to establish, reduction to practice of the claimed invention prior to the effective date of the Lacaze reference. *See* Br. 5–14. Thus, Appellant seeks to show

prior invention by establishing conception of the invention prior to the effective date of the Lacaze reference coupled with due diligence from prior to said date to the filing of the application (i.e., the date of the provisional application of which the present application claims benefit). *See* Br. 14 (asserting error in the Examiner's determination that the evidence is insufficient to establish diligence from a date prior to the filing date of the Lacaze reference "to the constructive reduction to practice (May 6, 2007)."

In order to be effective to antedate and disqualify Lacaze as prior art, Appellant's evidence must establish *both* conception of the claimed invention prior to the effective date of Lacaze *and* due diligence from prior to the effective date of Lacaze to the filing date of the present application. In other words, a deficiency in showing either conception or due diligence renders Appellant's submitted evidence ineffective to antedate and disqualify Lacaze as prior art. Moreover, in order to establish conception of the claimed invention, the affidavit, "in addition to showing what the reference shows," must also establish "possession of either the whole invention claimed or something falling within the claim, in the sense that the claim as a whole reads on it." *In re Tanczyn*, 347 F.2d 830, 833 (CCPA 1965).

As already noted above, the Examiner has determined that Appellant's submitted evidence is deficient in regard to both the conception showing and the due diligence showing. Final Act. 9–10. Thus, in order to show error in the Examiner's determination that Appellant's submitted evidence is insufficient to antedate and disqualify Lacaze as prior art, it is not enough for Appellant to identify error only in the Examiner's determination that the evidence is insufficient to establish the requisite due diligence, even

assuming, *arguendo*, that Appellant is correct on this point. Appellant must also identify error in the Examiner's determination that Appellant's submitted evidence is insufficient to establish conception of the claimed invention as a whole. As Appellant does not contest the Examiner's determination that Appellant's submitted evidence is insufficient to establish conception of the invention of claim 11 *as a whole*, Appellant fails to apprise us of error in the Examiner's determination that Appellant's submitted evidence is insufficient to antedate and disqualify Lacaze as prior art against claim 11. Consequently, Appellant fails to apprise us of error in the rejection of claim 11. Accordingly, we sustain the rejection of claim 11, as well as claims 6–10 and 12–16, which fall with claim 11, under 35 U.S.C. § 103(a) as unpatentable over Tillotson and Lacaze.

DECISION

The Examiner's decision rejecting claims 6–16 is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED