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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GAVIN JONES, BALU SUBRAMANYA, and
MIKE NICKOLAUS

Appeal 2014-008262
Application 13/468,859¹
Technology Center 3600

Before JENNIFER D. BAHR, STEFAN STAICOVICI, and
SEAN P. O'HANLON, *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Gavin Jones et al. (Appellants) appeal under 35 U.S.C. § 134(a) from the Examiner's final decision rejecting claims 1–16 and 18–23.² We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

¹ According to Appellants, the real party in interest is Duncan Solutions, Inc. Appeal Br. 1 (filed Jan. 13, 2014).

² Claim 17 is cancelled. *Id.* at 31.

SUMMARY OF DECISION

We AFFIRM-IN-PART, and denominate our affirmance as a NEW GROUND OF REJECTION pursuant to our authority under 37 C.F.R. § 41.50(b).

INVENTION

Appellants' invention relates "to a parking meter system equipped for wireless communication between the various components of the parking system." Spec. ¶ 2.

Claims 1, 12, and 18 are independent. Claim 1 is illustrative of the claimed invention and reads as follows:

1. A parking system comprising:
 - a computerized parking management system;
 - a first single-space parking meter including a first solar panel, a first battery and first wireless communications hardware configured to communicate parking data and data related to the operation of the first solar panel between the first single-space parking meter and the parking management system via a wireless network;
 - a second single-space parking meter including a second solar panel, a second battery and second wireless communications hardware configured to communicate parking data and data related to the operation of the second solar panel between the second single-space parking meter and the parking management system via the wireless network; and
 - a mobile citation unit including third wireless communications hardware configured to communicate parking enforcement data between the mobile citation unit and the parking management system via the wireless network;wherein the parking management system processes and stores the parking data and the data related to the operation of the first and second solar panels received from the first and

second single-space parking meters and processes and stores enforcement data from the mobile citation unit.

REJECTIONS

The following rejections are before us for review:

- I. The Examiner rejected claims 1–5 and 8–10 under 35 U.S.C. § 103(a) as being unpatentable over Manion (US 6,037,880, iss. Mar. 14, 2000) and Hunter (US 2009/0026842 A1, pub. Jan. 29, 2009).
- II. The Examiner rejected claims 6 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Manion, Hunter, and Moody (US 2,995,230, iss. Aug. 8, 1961).
- III. The Examiner rejected claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Manion, Hunter, and Marchasin (US 2006/0255119 A1, pub. Nov. 16, 2006).
- IV. The Examiner rejected claims 12–20 under 35 U.S.C. § 103(a) as being unpatentable over Manion and Marchasin.
- V. The Examiner rejected claim 21 under 35 U.S.C. § 103(a) as being unpatentable over Manion, Hunter, and Long (US 2002/0074344 A1, pub. June 20, 2002).
- VI. The Examiner rejected claim 22 under 35 U.S.C. § 103(a) as being unpatentable over Manion, Hunter, and Davis (US 2009/0099761 A1, pub. Apr. 16, 2009).
- VII. The Examiner rejected claim 23 under 35 U.S.C. § 103(a) as being unpatentable over Manion, Marchasin, and Fancher (US 2006/0173733 A1, pub. Aug. 3, 2006).

ANALYSIS

Rejection I

Claim 1

In independent claim 1, first and second wireless communications hardware are configured to communicate data related to the operation of first and second solar panels, respectively, between first and second single-space parking meters and a parking management system. Appeal Br. 28 (Claims App.).

The Examiner finds that although Manion fails to disclose a solar panel to power its battery 1103, nonetheless, Hunter discloses “providing a solar panel (18) as a means to power a parking meter battery (10) as illustrated at figures 1-4 and mentioned at abstract and paragraphs 24-31.” Final Act. 3 (transmitted Aug. 14, 2013). The Examiner further finds that Hunter “discloses communicating data related to the operation of the first solar panel via a wireless network (24, 26), as mentioned at paragraph 32.” *Id.* The Examiner concludes that it would have been obvious for a person of ordinary skill in the art to provide Hunter’s solar panel to recharge Manion’s battery “as solar panels are a well-known means of recharging batteries and would enable elimination of the replacement of said battery every six months, thus enabling reduction of maintenance by service person[nel].” *Id.*

Appellants argue that Hunter fails to disclose communicating data to the parking management system related to the operation of the first and second solar panels, as called for by claim 1, but rather discloses communicating data related to battery operation. Appeal Br. 9. Thus, Appellants are arguing that “claim 1 is patentable because the *type* of data

communicated in the system of claim 1 is patentably different than the *type* of data communicated by the system of Hunter.” *Id.* at 12.

Even accepting Appellants’ position that Hunter’s data related to battery operation is of a different type from the claimed data related to solar panel operation, nonetheless, we note that the informational content of data is not functionally or structurally related to the claimed first and second wireless communications hardware and to the claimed parking management system. We, thus, find unpersuasive Appellants’ contention regarding independent claim 1 because it is premised on the informational content of the recitations “data related to the operation of the first solar panel” and “data related to the operation of the second solar panel,” and hence covers non-functional descriptive material.

The informational content of non-functional descriptive material is not entitled to weight in the patentability analysis. *See In re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir. 1994) (“Lowry does not claim merely the information content of a memory. . . . Nor does he seek to patent the content of information resident in a database”). *See also Ex parte Nehls*, 88 USPQ2d 1883, 1887–90 (BPAI 2008) (precedential); *Ex parte Curry*, 84 USPQ2d 1272, 1274 (BPAI 2005) (informative); *Ex parte Mathias*, 84 USPQ2d 1276, 1279 (BPAI 2005) (informative). Our reviewing court has held that non-functional descriptive material cannot lend patentability to an invention that would have otherwise been anticipated by the prior art. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). *Cf. In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (noting that when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention

from the prior art in terms of patentability). *King Pharm., Inc. v. Eon Labs, Inc.*, 616 F.3d 1267, 1279 (Fed. Cir. 2010) (“[T]he relevant question is whether ‘there exists any new and unobvious functional relationship between the printed matter and the substrate.’”) (internal citations omitted).

Here, the informational content of the claimed data related to first and second solar panel operation represents non-functional descriptive material that is entitled to no weight in the patentability analysis. In particular, the claimed data related to first and second solar panel operation imparts no functionality to the claimed first and second wireless communications hardware and to the parking management system. In Appellants’ Specification, “communication subsystem 52” corresponds to the claimed first and second wireless communications hardware, and is described as “standard mobile telephone communication systems” or “a wireless communication antenna.” *See* Spec. ¶¶ 59, 60; *see also* Appeal Br. 2–3. The Specification further describes the claimed “parking management system” as a “computerized, server system.” *See* Spec. ¶ 41; *see also* Appeal Br. 2. Hence, because a wireless communication antenna can transmit data irrespective of the informational content of the data and a server can likewise process and store such data, the claimed data related to first and second solar panel operation does not affect the manner in which the first and second wireless communications hardware and the parking management system function.

Manion’s meter 20, powered by battery 1103, transmits and receives data over network 35 to/from host computer 23. *See* Manion, col. 8, ll. 49–51. Similarly, Hunter’s parking meter, powered by solar panel 18 and

batteries 12, 14, includes communication device 24 for transmitting data over a wireless network to a control system. *See* Hunter, ¶¶ 2, 14, 24, 26, 32. Hence, the combined teachings of Manion and Hunter disclose a single-space parking meter including a solar panel, a battery, and a communications hardware configured to communicate data to a parking management system that processes and stores the data. In other words, the parking system of Manion, as modified by Hunter, transmits, processes and stores data irrespective of the data's informational content, including data related to the operation of the first and second solar panels.

Appellants further argue that the Examiner has failed to articulate an adequate reasoning with rational underpinnings why it would have been obvious for a person of ordinary skill in the art “to have uploaded data related to said solar panel/battery system for any of the solar powered parking meters in Manion's parking meter system.” Appeal Br. 11. According to Appellants, the Examiner's statement that it would have been obvious for a person of ordinary skill in the art “to have uploaded data related to said solar panel/battery system for any of the solar powered parking meters in Manion's parking meter system” is conclusory. *Id.*; *see also* Final Act. 3.

We are not persuaded by Appellants' argument because no such modification of the system of Manion and Hunter is required to satisfy the language of claim 1, as Appellants contend. The parking system of Manion, as modified by Hunter, transmits, processes and stores data, and, thus, can also transmit, process and store data related to the operation of the first and second solar panels. In other words, as we have stated above, the system of

Manion, as modified by Hunter, constitutes a single-space parking meter including a solar panel, a battery, a communication hardware, and a parking management system (server) that transmits, processes, and stores data irrespective of the data's informational content, including data related to the operation of the first and second solar panels.

In conclusion, for the foregoing reasons, we sustain the rejection under 35 U.S.C. § 103(a) of claim 1 as unpatentable over Manion and Hunter. However, we denominate our affirmance as a NEW GROUND OF REJECTION pursuant to 37 C.F.R. § 41.50(b), because our analysis relies upon facts and reasoning that the Examiner did not use.

Claim 2

Claim 2 depends from claim 1 and adds the limitations of first and second vehicle sensors configured to detect the presence of a vehicle, wherein data generated by the first and second vehicle sensors is communicated to the parking management system via first and second wireless communications hardware. Appeal Br. 28–29 (Claims App.).

The Examiner finds that “Manion discloses . . . 1st and 2nd parking meters (20) includ[ing] a vehicle sensor in the form of a sonar range finder (1108), as mentioned at abstract, col. 1, lines 50-56, col. 2, lines 19-44, col. 3, lines 14-22 and col. 8, lines 49-67 and illustrated at fig. 11.” Final Act. 4. According to the Examiner, Manion's sonar range finder 1108 “checks to see if a vehicle is present, and communicates said information to the host computer . . . for the purpose of notifying a parking attendant of the location

of a violating vehicle.” Final Act. 7–8 (citing Manion, Abstract, col. 1, ll. 50–60, col. 2, ll. 19–44, col. 3, ll. 14–22, col. 8, ll. 49–67, Fig. 11).

Appellants argue that the data transmitted to Manion’s host computer 23 is not data generated by sonar range finder 1108, but rather is a “notification of an illegally parked car.” Appeal Br. 14. According to Appellants, data from Manion’s sonar range finder 1108 is “*locally processed*” at each single space meter to determine whether a parking violation has occurred and only the locally processed determination . . . is transmitted to the host computer.” *Id.* at 13. Thus, Appellants contend that “the plain meaning of the term ‘data generated’ by a vehicle sensor is different from a determination based upon processing of the vehicle sensor data, as taught by Manion.” *Id.* at 14 (citing Spec. 7:10–15, 8:23–29, 26:8–14).

We do not agree with Appellants’ position because although the claims are interpreted in light of the Specification, limitations from the Specification are not read into the claims. We must be careful not to read a particular embodiment appearing in the written description into the claim if the claim language is broader than the embodiment. *See Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004). In this case, the limitations “data generated by the first vehicle sensor” and “data generated by the second vehicle sensor” are not limited to raw data, as Appellants contend, and thus, do not preclude local processing of the data and transmitting processed data to the parking management system. Limitations not appearing in the claims cannot be relied upon for patentability. *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982). Such an

interpretation is consistent with Appellants' Specification, which describes "data generated by the vehicle sensor" as "data *related* to the presence of a vehicle." Spec. ¶ 44 (emphasis added). Manion's transmission of processed data regarding an illegally parked vehicle constitutes data related³ to the presence of the vehicle in the parking space. *See* Manion, col. 3, ll. 14–21.

We also do not agree with Appellants' contention that claim 4 does not further limit claim 2 if we interpret the limitations "data generated by the first vehicle sensor" and "data generated by the second vehicle sensor" as including processed data. Appeal Br. 15. Claim 4, which depends from claim 2, limits the processed data of claim 2 to data "processed to determine whether a vehicle is currently parked in the parking spaces associated with the first and second single-space meters, respectively" and "parking data . . . [to] data related to the parking violation occurrence." *Id.* at 29 (Claims App.).

We thus sustain the rejection of claim 2 over the combined teachings of Manion and Hunter. However, we denominate our affirmance as a NEW GROUND OF REJECTION pursuant to 37 C.F.R. § 41.50(b), because our analysis relies upon facts and reasoning that the Examiner did not use.

³ An ordinary and customary meaning of the term "related" is "connected by reason of an established or discoverable relation." *Merriam Webster's Collegiate Dictionary* (10th ed. 1997).

Claim 4

Appellants argue that the combined teachings of Marion and Hunter fail to disclose communication of *both* data generated by vehicle sensors and data related to parking violation occurrence. Appeal Br. 15–16.

In addition to the discussion *supra* in the arguments against the rejection of claim 2, we further note that claim 4 does not require that *both* raw data generated by the first and second vehicle sensors and processed data related to a parking violation occurrence are transmitted to the claimed parking management system. Rather, claim 4 limits the processed data of claim 2 to data “processed to determine whether a vehicle is currently parked in the parking spaces associated with the first and second single-space meters, respectively” and “parking data . . . [to] data related to the parking violation occurrence.” *Id.* at 29 (Claims App.).

The Examiner is correct that Manion’s system determines whether a vehicle is present in a parking space using sonar ranger finders 1108, checks the time and/or the amount of money on the parking meter, and transmits data related to a parking violation occurrence to computer 23. *See* Final Act. 4, Ans. 5; *see also* Manion, col. 3, ll. 14–21, col. 9, ll. 1–6, and Fig. 12.

We, thus, sustain the rejection of claim 4 over the combined teachings of Manion and Hunter. As claim 4 depends from independent claim 1, we denominate our affirmance as a NEW GROUND OF REJECTION pursuant to 37 C.F.R. § 41.50(b), because our analysis relies upon facts and reasoning that the Examiner did not use.

Claims 3, 5 and 8–10

Appellants do not make any other substantive arguments regarding the rejection of claims 3, 5, and 8–10. *See* Appeal Br. 8–16.

Therefore, for the reasons expressed *supra*, we likewise sustain the rejection under 35 U.S.C. § 103(a) of claims 3, 5, and 8–10 as unpatentable over Manion and Hunter. As claims 3, 5, and 8–10 depend from independent claim 1, we denominate our affirmance as a NEW GROUND OF REJECTION pursuant to 37 C.F.R. § 41.50(b), because our analysis relies upon facts and reasoning that the Examiner did not use.

Rejections II and III

Claims 6, 7, and 11

Appellants rely on the arguments presented *supra* against the rejection of claim 1. Appeal Br. 16–19.

Therefore, for the same reasons discussed above, we also sustain the rejections under 35 U.S.C. § 103(a) of claim 6 and 7 as unpatentable over Manion, Hunter, and Moody and of claim 11 as unpatentable over Manion, Hunter, and Marchasin. As claims 6, 7, and 11 depend directly or indirectly from independent claim 1, we denominate our affirmance as a NEW GROUND OF REJECTION pursuant to 37 C.F.R. § 41.50(b), because our analysis relies upon facts and reasoning that the Examiner did not use.

Rejection IV

Claims 12 and 18

Appellants rely on the arguments discussed *supra* in the rejection of claims 1 and 2. Appeal Br. 19–22.

Therefore, for the same reasons discussed above, we sustain the rejection under 35 U.S.C. § 103(a) of claims 12 and 18 as unpatentable over Manion and Marchasin. However, we denominate our affirmance as a NEW GROUND OF REJECTION pursuant to 37 C.F.R. § 41.50(b), because our analysis relies upon facts and reasoning that the Examiner did not use.

Claim 13

Claim 12 recites the limitation of a server configured to receive wireless communication of parking data . . . wherein the [] parking data includes vehicle sensor data generated by the vehicle sensors.” Appeal Br. 30–31 (Claims App.). Claim 13 depends from claim 12 and adds the limitation of “the server processes the parking data to determine whether a parking violation has occurred.” *Id.* at 31 (Claims App.). Hence, in contrast to independent claim 12, claim 13 requires that the *server* have a specific configuration, i.e., hardware/software, needed “to determine whether a parking violation has occurred.”

As the Examiner correctly finds, “Manion discloses . . . 1st and 2nd parking meters (20) includ[ing] a vehicle sensor in the form of a sonar range finder (1108), as mentioned at abstract, col. 1, lines 50-56, col. 2, lines 19-44, col. 3, lines 14-22 and col. 8, lines 49-67 and illustrated at fig. 11.” Final Act. 4. Furthermore, in Manion, parking meters 20 determine whether

a parking violation has occurred and transmit the violation status to host computer 23, which then transmits the information to personal communicator 22 of a parking attendant. *See* Manion, col. 7, ll. 33–42, col. 9, ll. 3–5. However, although we appreciate that Manion’s host computer 23 does not determine whether a parking violation has occurred, we agree with the Examiner that “Appellant does not provide criticality as to processing of the data either locally at the meter or remotely at the central processing computer.” Ans. 5–6. Therefore, it would have been obvious to a person of ordinary skill in the art to further modify the parking meter system of Manion, as modified by Marchasin,⁴ and have the server of Marchasin process the data generated by Manion’s vehicle sensors to determine whether a parking violation has occurred in order to reduce the complexity of the parking meter and, thus, provide for simpler maintenance. Such a modification in the location of software/hardware at either the parking meter site or the server site is an obvious matter of design choice. *See, e.g., In re Kuhle*, 526 F.2d 553, 555 (CCPA 1975). Simply selecting one of a plurality of a finite number of identified predictable solutions might not be the product of innovation but something that occurs in the ordinary course of using a known device. *See, e.g., In re Kubin*, 561 F.3d 1351, 1358–61 (Fed. Cir. 2009). The Examiner is correct that “the outcome is the same” as “the [parking] violation is transmitted to the personal communicator of the

⁴ The Examiner concluded that it would have been obvious for a person of ordinary skill in the art to substitute Marchasin’s server 42 for Manion’s host computer 23 because “a server is part of a well known method of communication using web based communication.” Final Act. 8 (citing Marchasin ¶¶ 50, 59, 112–14).

parking attendant for issuance of the ticket to the violator,” regardless of whether the data is processed at the parking meter site or at the server site. Ans. 5–6.

In conclusion, for the foregoing reasons, we sustain the rejection under 35 U.S.C. § 103(a) of claims 13 as unpatentable over Manion and Marchasin. However, we denominate our affirmance as a NEW GROUND OF REJECTION pursuant to 37 C.F.R. § 41.50(b), because our analysis relies upon facts and reasoning that the Examiner did not use.

Claims 14–17, 19, and 20

Appellants do not make any other substantive arguments regarding the rejection of claims 14–17, 19, and 20. *See* Appeal Br. 19–22.

Therefore, for the reasons expressed *supra*, we likewise sustain the rejection under 35 U.S.C. § 103(a) of claims 14–17, 19, and 20 as unpatentable over Manion and Marchasin. As claims 14–17, 19, and 20 depend from independent claims 12 and 18, respectively, we denominate our affirmance as a NEW GROUND OF REJECTION pursuant to 37 C.F.R. § 41.50(b), because our analysis relies upon facts and reasoning that the Examiner did not use.

Rejection V

The Examiner finds that Manion discloses most of the limitations of claim 21, but fails to disclose a parking meter “configured to initiate the display of instructions.” Final Act. 8–9. Nonetheless, the Examiner finds that Long discloses a fuel dispenser 10 “configured to initiate the display of

instructions.” *Id.* at 9 (citing Long ¶¶ 24, 26, 37). The Examiner concludes that it would have been obvious for a person of ordinary skill in the art to have provided Long’s display to the parking system of Manion, as modified by Hunter, “for the purpose of . . . displaying instructions on how a customer may use and operate Manion’s parking meters.” *Id.*

Appellants argue that “Manion teaches away from a modification, such as that with Long . . . proposed by the Examiner, to include a display of instructions at the single space meter of Manion.” Appeal Br. 23.

Teaching away requires a reference to actually criticize, discredit, or otherwise discourage the claimed solution. *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). In this case, Appellants are correct that “Manion expressly teaches that use of a display at the single space meters is undesirable.” Appeal Br. 23. More specifically, Manion states that “[t]here will not be a display or any visible means for customer interface with this unit except for the N-PCS communications port. This limits current consumption thus increasing battery life to a minimum of 6 months.” Manion, col. 8, ll. 44–48. We, thus, agree with Appellants that “[g]iven this strong teaching of the disadvantage of a single space parking meter having ‘any visible means for customer interface,’ Manion teaches away from a modification including a complicated visual display interface such as taught by Long.” Appeal. Br. 23 (underlining omitted).

Therefore, for the foregoing reasons, we do not sustain the rejection under 35 U.S.C. § 103(a) of claim 21 as unpatentable over Manion, Hunter, and Long.

Rejection VI

The Examiner finds that Manion discloses most of the limitations of claim 22, but fails to disclose that the “data related to the operation of the first and second solar panels is data related to the current supplied by the first and second solar panels.” *See* Final Act. 9–10; *see also* Appeal Br. 33 (Claims App.). Nonetheless, the Examiner finds that Davis discloses monitoring solar panel 105 for output voltage and/or current by controller 150 and wirelessly transmitting/communicating a fault signal to a remote base station 160 for alerting the need for maintenance of the solar panel and/or battery. Final Act. 9 (citing Davis ¶ 49). The Examiner concludes that it would have been obvious for a person of ordinary skill in the art to provide a “solar panel and battery system with monitoring capability to monitor the voltage and/or current supplied from the solar panel,” as taught by Davis, to the parking meters of Manion “for the purpose of enabling an alert of the need for maintenance of said first or second or plural parking meters.” *Id.* at 10.

Appellants first argue that Davis “does not remedy the deficiencies of Manion and Hunter.” Appeal Br. 24 (underlining omitted). We are not persuaded by Appellants’ argument because, for the reasons set forth in the rejection of independent claim 1, from which claim 22 depends, we did not find any deficiencies with the rejection based on the combined teachings of Manion and Hunter.⁵

⁵ However, we note that Davis discloses transmission of data related to the operation of a solar panel, i.e., output voltage and/or current. Davis ¶ 49.

Appellants further argue that none of Manion, Hunter, or Davis provide a “teaching regarding why solar panel monitoring would be advantageous or feasible in the parking meter context.” *Id.* at 25. According to Appellants, Davis “provides an optional teaching regarding solar panel monitoring in the air transportation field,” Hunter discloses transmitting only battery status notification, and Manion discloses that limiting power usage is advantageous. *Id.* (citing Davis ¶49; Manion, col. 8, ll. 39–48; Hunter ¶14). Thus, Appellants conclude that the Examiner’s determination of obviousness is based on impermissible hindsight. *Id.*

Appellants’ argument appears to be holding the Examiner to a teaching, suggestion, or motivation (“TSM”) standard according to which there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 415 (2007) (“We begin by rejecting the rigid [application and requirement of a TSM to combine known elements in order to show obviousness]”). The proper inquiry is whether the Examiner has articulated adequate reasoning based on a rational underpinning explaining why a person of ordinary skill in the art would combine the teachings of Manion, Hunter, and Davis. *See KSR*, 550 U.S. at 418 (stating that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006))). In this case, given that Manion specifically discloses that parking meter 20

transmits self-diagnosis data to host computer 23 (*see* Manion, col. 9, ll. 7–9), the Examiner’s reasoning, to “alert of the need for maintenance of said first or second or plural parking meters” in the parking system of Manion, as modified by Hunter and Davis, has rational underpinnings. Therefore, the Examiner’s determination of obviousness is not based on impermissible hindsight.

We thus, sustain the rejection under 35 U.S.C. § 103(a) of claim 22 as unpatentable over Manion, Hunter, and Davis. As claim 22 depends from independent claim 1, we denominate our affirmance as a NEW GROUND OF REJECTION pursuant to 37 C.F.R. § 41.50(b), because our analysis relies upon facts and reasoning that the Examiner did not use.

Rejection VII

Appellants rely on the arguments discussed *supra* in the rejection of claim 12, which we have found unpersuasive. Appeal Br. 25–26.

With respect to Appellants’ arguments regarding the level of ordinary skill in the art (*see* Appeal Br. 26), we consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”).

In conclusion, we likewise sustain the rejection under 35 U.S.C. § 103(a) of claim 23 as unpatentable over Manion, Marchasin, and Fancher. As claim 23 depends from independent claim 12, we denominate our

affirmance as a NEW GROUND OF REJECTION pursuant to 37 C.F.R. § 41.50(b), because our analysis relies upon facts and reasoning that the Examiner did not use.

SUMMARY

The Examiner's decision to reject claims 1–16 and 18–23 is affirmed as to claims 1–16, 18–20, 22, and 23 and reversed as to claim 21.

For the reasons discussed above, we denominate our affirmance of the rejections of claims 1–16, 18–20, 22, and 23 as new grounds of rejection pursuant to 37 C.F.R. § 41.50(b).

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides:

When the Board enters such a non-final decision, the appellant, within 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 the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the prosecution will be remanded to the Examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

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

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)