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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RICHARD ALAN SMITH, KEVIN G. PIEL, and JOHN M. KOVACH

Appeal 2015-006807
Application 13/241,715
Technology Center 2600

Before ST. JOHN COURTENAY III, THU A. DANG, and LARRY J. HUME, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's non-final rejection of claims 1–10 and 14–20. Claims 11–13 were canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

The Invention

The disclosed and claimed invention relates to "systems and methods to test installed glass break detectors." (Spec. ¶ 1).

Representative Claim

Claim 1 is representative of the subject matter on appeal:

1. An apparatus comprising:

a portable communications device which includes executable software stored therein;

circuitry to emit a test mode entry audio output; and

circuitry to emit a selected glass break detector test signal,

wherein, when executed, *the executable software causes the portable communications device to emit instructions to a user to direct the portable communications device at a detector and within a first specified distance from the detector*, receives user input confirming that the portable communications device is within the first specified distance from the detector, responsive to receiving the user input confirming that the portable communications device is within the first specified distance from the detector, *activates the circuitry to emit the test mode entry audio output, receives user input confirming that the detector is in test mode, causes the portable communications device to emit instructions to the user to move the portable communications device within a second specified distance from the detector*, receives user input confirming that the portable communications device is within the second specified distance from the detector, *responsive to receiving the user input confirming that the portable communications device is within the second specified distance from the detector, causes the portable communications device to emit instructions to the user to provide user input related to a detector test, receives the user input related to the detector test, and responsive to receiving the user input related to the detector test, activates the circuitry to emit the selected glass break detector signal*.

("Wherein" clause contested limitations emphasized).

Rejections

R1. Claims 1–3 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of FG-701 (*FG-701 Glassbreak Simulator*, HONEYWELL (2009) (hereinafter "FG-701")), Moberg et al. ("Moberg") (US 2012/0099829 A1, pub. Apr. 26, 2012), and Albayrak et al. ("Albayrak") (US 6,662,163 B1, issued Dec. 9, 2003).

R2. Claims 4 and 5 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of FG-701, Moberg, Albayrak, and Holub (US 2010/0289835 A1, pub. Nov. 18, 2010).

R3. Claim 6 stands rejected under 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of FG-701, Moberg, Albayrak, Holub, and Piel et al. ("Piel") (US 2008/0310254 A1, pub. Dec. 18, 2008).

R4. Claims 7–10 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of FG-701, Moberg, Albayrak, Holub, and Billman (US 8,466,800 B1, pub. June 18, 2013).

R5. Claims 14–18 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of FG-701, Piel, Billman, Moberg, and Albayrak.

R6. Claims 19 and 20 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of FG-701, Billman, Moberg, and Albayrak.

Claim Grouping

Based on Appellants' arguments (App. Br. 9–19), we decide the appeal of the various rejections on the basis of the following claim groupings:

Rejection R1 of claims 1–3 based on representative claim 1.

Rejection R5 of claims 14–18 based on representative claim 14.

Rejection R6 of claims 19 and 20 based on representative claim 19.

We decide the appeal of Rejections R2–R4 of claims 4–10, not separately argued, *infra*. *See* 37 C.F.R. § 41.37(c)(1)(iv).

ANALYSIS

We have considered all of Appellants' arguments and any evidence presented. (App. Br. 9–19; Reply Br. 2–4). We find Appellants' arguments unpersuasive for the reasons discussed *infra*. We adopt as our own: (1) the findings and legal conclusions set forth by the Examiner in the action from which this appeal is taken, and (2) the findings, legal conclusions, and explanations set forth in the Answer in response to Appellants' arguments (Ans. 18–23). We highlight and address specific findings and arguments for emphasis in our analysis below.

***Issue*:** Under 103, did the Examiner err by finding the cited references would have taught or suggested the contested "wherein" clause functional limitations, including the limitation: "the executable software causes the portable communications device to emit instructions to a user," within the meaning of representative claim 1?[1]

Appellants contend:

> FG-701 teaches away from the claimed invention by providing test instructions that are otherwise provided *automatically*

[1] We give the contested claim limitations the broadest reasonable interpretation consistent with the Specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

> through a portable device under the claimed invention. FG-701 is also structurally different because the detectors of FG-701 must be manually set to a test mode.

(App. Br. 9, emphasis added.)

Appellants further contend:

> [M]odifying FG-701 based upon the teachings of Moberg et al. Albayrak et al. would change a principle of operation of FG-701. The principle of operation of FG-701 is the specific steps of manual operation of the glassbreak simulator described in the operation instructions of FG-701.

(App. Br. 10.)

As an initial matter of claim construction, we note Appellants attempt to distinguish the limitations in *apparatus* claim 1 in terms of *function*, not *structure*. Regarding apparatus claims generally, our reviewing court guides the patentability of an apparatus claim "depends on the claimed structure, not on the use or purpose of that structure." *Catalina Marketing Int'l., Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 809 (Fed. Cir. 2002). "It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable." *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997) (citations omitted). As addressed by the court in *Paragon Solutions, LLC v. Timex Corp.*, 566 F.3d 1075, 1090 (Fed. Cir. 2009),

> The problem with construing "displaying real-time data" as used in the claims of the '759 patent to preclude "contextually meaningful delay" is that such a construction injects a use limitation into a claim written in structural terms. "[A]pparatus claims cover what a device is, not what a device does." *Hewlett–Packard Co. v. Bausch & Lomb, Inc.*, 909 F.2d 1464, 1468 (Fed.Cir.1990).
>
> . . .

> Absent an express limitation to the contrary, any use of a device that meets all of the limitations of an apparatus claim written in structural terms infringes that apparatus claim . . . *see also Roberts v. Ryer*, 91 U.S. 150, 157, 23 L.Ed. 267 (1875) ("The inventor of a machine is entitled to the benefit of all the uses to which it can be put, no matter whether he had conceived the idea of the use or not."). Construing a non-functional term in an apparatus claim in a way that makes direct infringement turn on the use to which an accused apparatus is later put confuses rather than clarifies, frustrates the ability of both the patentee and potential infringers to ascertain the propriety of particular activities, and is inconsistent with the notice function central to the patent system.

Id. at 1091.

Here, we conclude the structural claim limitations "*circuitry* to emit a test mode entry audio output" and "*circuitry* to emit a selected glass break detector test signal" are not limited to any *particular* circuit. (Claim 1). We conclude the scope of the claimed "circuitry" broadly but reasonably covers circuits of *any design* which are capable of performing the recited intended functions. (Claim 1). Similarly, we conclude the contested "wherein" clause functional limitations do not further limit the claim to a *particular* structure.[2] (Emphasis added).

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[2] *See* MPEP § 2111.04 regarding "wherein" clauses: ***Claim scope is not limited by claim language*** that suggests or makes optional but does not require steps to be performed, or by ***claim language that does not limit a claim to a particular structure***. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

(A) "adapted to" or "adapted for" clauses;

(B) ***"wherein" clauses***; and

(C) "whereby" clauses.

(MPEP § 2111.04 Ninth Ed., Nov. 2015.) (Emphasis added).

We also conclude the dual recitations of "circuitry to emit . . ." are directed to statements of *intended use* for the claimed apparatus: "*circuitry to emit* a test mode entry audio output; and *circuitry to emit* a selected glass break detector test signal . . . ." (Claim 1).[3] As a further matter of claim construction, we broadly but reasonably construe the *informational content* of the recited "*instructions*" emitted "*to the user*" as non-functional descriptive material (NFDM) merely intended for human perception. (*id.*).[4, 5]

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[3] Our reviewing court guides: "An intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates." *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003). Although "[s]uch statements often . . . appear in the claim's preamble" (*In re Stencel*, 828 F.2d 751, 754 (Fed. Cir. 1987)), a statement of intended use or purpose can appear elsewhere in a claim. *Id.*

[4] The Manual of Patent Examining Procedure (MPEP) guides: "where the claim as a whole is directed [to] conveying a message or meaning to a human reader independent of the intended computer system, and/or the computer-readable medium merely serves as a support for information or data, no functional relationship exists." MPEP § 2111.05 (III.) (9th Ed., Rev. 07.2015, Last Revised Nov. 2015).

[5] The PTAB has provided guidance in decisions on the appropriate handling of claims that differ from the prior art only based on "non-functional descriptive material." *See Ex parte Nehls*, 88 USPQ2d 1883, 1889 (BPAI 2008) (precedential) ("[T]he nature of the information being manipulated does not lend patentability to an otherwise unpatentable computer-implemented product or process."); *Ex parte Mathias*, 84 USPQ2d 1276, 1279 (BPAI 2005) (informative) ("[N]onfunctional descriptive material cannot lend patentability to an invention that would have otherwise been anticipated by the prior art."), *aff'd*, 191 Fed. App'x 959 (Fed. Cir. 2006) (Rule 36); *Ex parte Curry*, 84 USPQ2d 1272, 1274 (BPAI 2005) (informative) ("Nonfunctional descriptive material cannot render

Given all of the aforementioned considerations, a question arises as to how much patentable weight, if any, should be given to the contested intended functional limitations. Assuming, *arguendo*, that our reviewing court may give full patentable weight to the contested functional statements of intended use, and the NFDM "instructions" recited in claim 1, we fully consider Appellants' arguments on the merits.

We now address Appellants' contentions:

We are not persuaded by Appellants' argument that "FG–701 teaches away from the claimed invention" merely because the "test instructions" are "provided automatically" under the claimed invention, whereas FG-701 provides written instructions the user reads himself. (App. Br. 9.)

"[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007) (citation omitted). However, merely teaching an alternative or equivalent method, does not teach away from the use of a claimed method. *See In re Dunn*, 349 F.2d 433, 438 (CCPA 1965). Moreover, "[a] finding that two inventions were designed to resolve different problems . . . is insufficient to demonstrate that one invention teaches away from another." *Nat'l Steel Car, Ltd. v. Canadian Pac. Ry., Ltd.*, 357 F.3d 1319, 1339 (Fed. Cir. 2004).

This reasoning is applicable here. First, we note claim 1 is *silent* regarding the term "automatically," as argued by Appellants.[6] (App. Br. 9).

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nonobvious an invention that would have otherwise been obvious."), *aff'd*, No. 06-1003 (Fed. Cir. June 12, 2006) (Rule 36).

[6] *Cf. with* dependent claim 10: ("or automatic adjustment circuits"). Our reviewing court guides: "[w]hen different words or phrases are used in

To the extent the claim language may infer *automatic* functions, it is well-settled that merely providing a mechanical or automatic means to replace manual activity to accomplish the same result is an obvious improvement. *See In re Venner*, 262 F.2d 91, 95 (CCPA 1958). Nor have Appellants shown that automatically emitting instructions to a user would have been uniquely challenging or otherwise beyond the level of skill possessed by ordinarily skilled artisans. *See Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007).

Regarding Appellants' arguments directed to the purported improper combination of FG-701, Moberg, and Albayrak (App. Br. 10), we find the prior art does not teach away, or change a principle of operation of FG-701, merely because the cited art teaches a *manual* way of providing instructions to a user. *See Venner*, 262 F.2d at 95. We are not persuaded that FG-701 teaches away from the claimed invention, because "the mere disclosure of alternative designs does not teach away" and "just because better alternatives exist in the prior art does not mean that an inferior combination is inapt for obviousness purposes." *In re Mouttet*, 686 F.3d 1322, 1334 (Fed. Cir. 2012) (citations omitted).

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separate claims, a difference in meaning is presumed." *Nystrom v. TREX Co., Inc.*, 424 F.3d 1136, 1143 (Fed. Cir. 2005). Under the doctrine of claim differentiation, "the presence of a dependent claim that adds a particular limitation gives rise to a presumption that the limitation in question is not present in the independent claim." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005). This "presumption is especially strong when the limitation in dispute is the only meaningful difference between an independent and dependent claim, and one party is urging that the limitation in the dependent claim should be read into the independent claim." *SunRace Roots Enterprise Co., Ltd. v. SRAM Corp.*, 336 F.3d 1298, 1303 (Fed. Cir. 2003).

We conclude the contested "wherein" clause limitations would have been obvious at the time of the invention, because, given the evidence cited by the Examiner (Non-final Act. 2–5), we find Appellants have "asserted no discovery beyond what was known to the art" and "[a] known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). "All of the disclosures in a reference must be evaluated for what they fairly teach one of ordinary skill in the art." *In re Boe*, 355 F.2d 961, 965 (CCPA 1966). "[I]n a section 103 inquiry, 'the fact that a specific [embodiment] is taught to be preferred is not controlling, since all disclosures of the prior art, including unpreferred embodiments, must be considered.'" *Merck & Co. v. Biocraft Labs., Inc.*, 874 F.2d 804, 807 (Fed. Cir. 1989) (quoting *In re Lamberti*, 545 F.2d 747, 750 (CCPA 1976)).

Appellants' "change a principle of operation" argument (App. Br. 10) is based on a reading of *In re Ratti*, 270 F.2d 810 (CCPA 1959). We have reviewed that venerable case of the CCPA, and find that much of its holding must be updated by further developments in the law guided by the Supreme Court, as expressed in *KSR*, 550 U.S. 398 (2007). Rather than express obviousness as the physical placement of structure from one reference within the confines of the structure from another reference, the Supreme Court in *KSR* viewed the prior art as a combination of teachings from different sources, and the use of those teachings by a practitioner in the art: "Often, it will be necessary for a court to look to interrelated teachings of multiple patents . . . in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed . . . ." *KSR*

Int'l Co. v. Teleflex Inc., 550 U.S. 398, 418 (2007). These prior art references must be read in context, taking into account "the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art," and "the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR*, 550 U.S. at 418.

This reasoning is applicable here regarding the manual setting to a test mode in FG-701, versus the software-induced operation of the claimed apparatus.[7] (App. Br. 9.) We do not find Appellants' contentions persuasive, because an improved product is obvious if that "product [is] not of innovation but of ordinary skill and common sense." *KSR*, 550 U.S. at 421.

Regarding Appellants' further argument regarding the "wherein" clause of claim 1 ("[t]his context is not taught or suggested by FG-701, Moberg et al. and Albayrak et al." (App. Br. 10–11)), we are not persuaded the Examiner erred. We find Appellants merely recite the claim language and allege it is not taught or suggested by the cited references. *Id.* Such form of conclusory argument fails to comply with 37 C.F.R. § 41.37(c)(1)(iv) ("A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.").[8] Therefore, on this record, we find Appellants fail to present

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[7] *But cf.* claim 1 with dependent claim 10: "An apparatus as in claim 7 where the glassbreak detector includes at least one of a *manually adjustable* input element, or *automatic adjustment* circuits." (Emphasis added). See n.6, *supra*.

[8] *See In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) ("[W]e hold that the Board reasonably interpreted Rule 41.37 to require more substantive

separate, *substantive* arguments and/or evidence traversing the Examiner's specific findings.[9]

Appellants additionally urge: "The reason that the rejections are improper is because none of the cited references are directed to the problem solved by the claimed invention." (App. Br. 19.) However, the references need not recognize the same problem solved by the Appellants. *See In re Kemps*, 97 F.3d 1427, 1430 (Fed. Cir. 1996). As noted above: "A finding that two inventions were designed to resolve different problems . . . is insufficient to demonstrate that one invention teaches away from another." *Nat'l Steel Car, Ltd.,* 357 F.3d at 1339.

For at least the aforementioned reasons, on this record, and by a preponderance of the evidence, we are not persuaded of error regarding the Examiner's underlying factual findings and ultimate legal conclusion of obviousness for representative claim 1. Because Appellants have not persuaded us the Examiner erred, we sustain rejection R1 of representative claim 1, and rejection R1 of the grouped claims 2 and 3, which fall with claim 1. (*See* Grouping of Claims, *supra*.)

Rejections R2 of Claims 4 and 5, R3 of Claim 6, and R4 of Claims 7–10 under 35 U.S.C. § 103(a)

Appellants advance no separate arguments regarding the claims rejected under rejections R2–R4. Arguments not made are considered

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arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.").

[9] *See* Evidence Appendix, "No evidence has been submitted with the appeal." (App. Br. 27).

waived. *See* 37 C.F.R. § 41.37(c)(1)(iv). Therefore, we sustain the Examiner's rejections R2–R4 of claims 4–10.

Rejections R5 of Claims 14–18 and R6 of Claims 19 and 20 under 35 U.S.C. § 103(a)

Although Appellants raise separate arguments urging the patentability of claims 14–18 (rejected under rejection R5), and claims 19 and 20 (rejected under rejection R6) (App. Br. 11–19), we find these arguments are similar to those raised regarding rejection R1 of claim 1. The Examiner has addressed Appellants' arguments, and we find the Examiner's legal conclusion of obviousness is supported by a preponderance of the evidence. (Ans. 18–23). We adopt the Examiner's findings and underlying reasoning, which we incorporate herein by reference. Consequently, on this record, we are not persuaded the Examiner erred regarding rejection R5 of claims 14–18, and rejection R6 of claims 19 and 20.

DECISION

We affirm the Examiner's decision rejecting claims 1–10 and 14–20 under 35 U.S.C. § 103(a).

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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED