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12/996,355	01/26/2011	Udo Doebrich	5029-729PUS-307319	6902
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Cozen O'Connor 277 Park Avenue, 20th floor NEW YORK, NY 10172			KARIM, ZIAUL	
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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* UDO DOEBRICH and ROLAND HEIDEL

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Appeal 2016-000941  
Application 12/996,355  
Technology Center 2100

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Before MAHSHID D. SAADAT, CATHERINE SHIANG, and  
LINZY T. McCARTNEY, *Administrative Patent Judges*.

SHIANG, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 10–17, which are all the claims pending and rejected in the application. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

STATEMENT OF THE CASE

*Introduction*

The present invention relates to operating a modular automation device. *See generally* Spec. 1. Claim 10 is exemplary:

10. A method for operating an automation system having a CPU processing a control program to control a technical process of a production plant, and having a power supply

module which supplies electrical energy to units which consume electrical energy, the method comprising:

providing at least one criterion of a respective unit to an analysis unit;

determining, by the analysis unit, a current overall energy requirement based on the provided at least one criterion;

automatically inserting, by the analysis unit, at least one program instruction representing the current overall energy requirement into the control program, or adapting at least one program instruction of the control program, the electrical energy supply for the units being adjusted in accordance with the current overall energy requirement during the control operation based on one of the inserted at least one program instruction and the adapted control program instruction; and

switching units which are no longer needed to control the technical process of the production plant into an energy-saving mode.

### *References and Rejections*

De Nicolo	US 6,134,666	Oct. 17, 2000
Kuchler	US 2005/0174225 A1	Aug. 11, 2005
Orr	US 7,657,762 B2	Feb. 2, 2010

Claims 10–17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over De Nicolo, Orr, and Kuchler.

### ANALYSIS

We have reviewed the Examiner’s rejection in light of Appellants’ contentions and the evidence of record. We concur with Appellants’ contention that the Examiner erred in finding De Nicolo, Orr, and Kuchler collectively teach “switching units which are no longer needed to control the

technical process of the *production plant* into an energy-saving mode,” as recited in independent claim 10 (emphasis added).<sup>1</sup> See App. Br. 4–7; Reply Br. 1–3.

The claimed “production plant” first appears in the preamble (“[a] method . . . to control a technical process of a production plant”), and again appears in the above disputed claim limitation. The Examiner does not specifically map the claimed “production plant” in association with the preamble or the disputed claim limitation. See Final Act. 2–5; Ans. 2–4.

In response to Appellants’ argument that the Examiner failed to map the claimed “production plant” (App. Br. 4–7), the Examiner cites Orr’s column 4, lines 29–61, and Kuchler’s paragraphs 1 and 8, but still does not specifically map the claimed “production plant.” See Ans. 7. The Examiner asserts “Orr and Kuchler[] do disclose a ‘. . . production plant,’” but does not point to any evidence supporting the finding. Ans. 7.

Absent further explanation from the Examiner, we agree with Appellants that the Examiner has not shown the cited references collectively teach “switching units which are no longer needed to control the technical process of the *production plant* into an energy-saving mode,” as required by independent claim 10 (emphasis added). See App. Br. 4–7; Reply Br. 1–3.

Because the Examiner fails to provide sufficient evidence or explanation to support the rejection, we are constrained by the record to reverse the Examiner’s rejection of claim 10.

Independent claim 14 recites a claim limitation that is substantively similar to the disputed limitation of claim 10. See claim 14. Therefore, for

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<sup>1</sup> Appellants raise additional arguments. Because the identified issue is dispositive of the appeal, we do not reach the additional arguments.

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similar reasons, we reverse the Examiner's rejection of independent claim 14.

We also reverse the Examiner's rejection of dependent claims 11–13 and 15–17, which depend from claims 10 and 14.

#### DECISION

We reverse the Examiner's decision rejecting claims 10–17.

REVERSED