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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/923.630	06/21/2013	Sigram SCHINDLER	070285.000014	5620
20230	7590	11/30/2016	EXAMINER	
Vorys, Sater, Seymour and Pease LLP 1909 K St., NW 9th Floor WASHINGTON, DC 20006-1152			SMITH, PAULINHO E	
			ART UNIT	PAPER NUMBER
			2129	
			NOTIFICATION DATE	DELIVERY MODE
			11/30/2016	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SIGRAM SCHINDLER

Appeal 2016-002734
Application 13/923,630
Technology Center 2100

Before ROBERT E. NAPPI, CATHERINE SHIANG, and ALEX S. YAP,
Administrative Patent Judges.

YAP, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1–30, which are all the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ According to Appellant, the real party in interest is Sigram Schindler Beteiligungsgesellschaft mbH. (App. Br. 1.)

STATEMENT OF THE CASE

Introduction

Appellant's invention relates to a system and method that "automatically prompt[s a] user through exploratively checking [whether it is] meeting the requirements stated" in 35 U.S.C. §§ 101, 102, 103, and 112. (June 21, 2013 Specification ("Spec."), Abstract.) Claim 1 is illustrative, and is reproduced (with minor formatting changes) below:

1. A computer-implemented method for updating a given data structure PTR^{CT} -DS in a BAD-KR, both in given formats, by a set of Binary Elementary Disclosed ("BED") inventive concepts of PTR's TT.0, called BED-TT.0, input to it by the user and by appendices to the BED-TT.0 and to BAD-KR for controlling an Innovation Expert System IES – the method (performing, for a claimed invention of PTR, its refined claim construction by first disaggregating its compound inventive concepts, if these are not yet elementary) using a memory for storing the so updated PTR^{CT} -DS, generated by executing this method on TT.0's compound inventive concepts BAD-X.0.n of TT.0 representing their mirror predicates BAD-X.0.n of its X.0.n, $1 \leq n \leq N$ the method comprising:

(a) writing the PTR^{CT} -DS in a given BAD-KR into the memory

(b) automatically prompting the user to determine the KR_R&S_S to be obeyed during execution of the method, being

(b)1 either given by the IES as a default KR_R&S_S for both strategies, based on the BAD-KR of (a),

(b)2 or a KR_R&S_S input, in a given notation, by the user additionally to the BAD-KR of (a);

(c) automatically identifying in said PTR^{CT} -DS and said KR_R&S_S, in given formats,

(c)1 for a given $0 \leq I \leq |RS|$, all document.i's and all their doc.i-MUIs, $0 \leq i \leq I$, and

(c)2 the document.CT in doc.0 and all its doc.CT-MUIs, and

(c)3 all elements $X.0.n$ and their predicates $BAD-\underline{X}.0.n$, $1 \leq n \leq N$, for any $BAD-KR$ in $KR_R\&S_S$;

(d) automatically performing for any $BAD-KR$ in $KR_R\&S_S$, controlled by this $KR_R\&S_S$, the steps **(d).1**-**(d).6**:

(d)1 prompting the user to input a set of $BED-cr-C.0.k$'s – in a given notation – of $TT.0$, $1 \leq k \leq K$, and

(d)2 prompting the user to disaggregate any $BAD-\underline{X}.0.n$, $1 \leq n \leq N$, into a set $\{BED-cr-\underline{C}.0.k^n | 1 \leq k^n \leq K^n\} \subseteq \{BED-cr-\underline{C}.0.k | 1 \leq k \leq K\}$: $BAD-\underline{X}.0.n = \bigwedge_{1 \leq k^n \leq K^n} BED-cr-\underline{C}.0.k^n$,

whereby $BED-cr-\underline{C}.0.k^n \neq BED-cr-\underline{C}.0.k^n' \forall n \neq n'$, and $|\bigcup_{1 \leq n \leq N} \{BED-cr-\underline{C}.0.k^n | 1 \leq k^n \leq K^n\}| = K$,

(d)3 prompting the user to input, in a given notation, $\forall BAD-\underline{X}.0.n$ a set of justifications by doc.0-/.CT-MUIs of this disaggregation into $\{BED-cr-\underline{C}.0.k^n | 1 \leq k^n \leq K^n\}$, denoted as $SoJUS^{dagr}(BAD-\underline{X}.0.n)$, $1 \leq n \leq N$;

(d)4 automatically appending any $SoJUS^{dagr}(BAD-\underline{X}.0.n)$ to $BAD-\underline{X}.0.n$, $1 \leq n \leq N$;

(d)5 automatically generate $BED-TT.0:: = \{\{BED-cr-C.0.k | 1 \leq k \leq K\}\} \cup \{\{BED-cr-C.0.k^n | 1 \leq k^n \leq K^n\} | 1 \leq n \leq N\}$;

(d)6 automatically updating the PTR^{CT} -DS in the memory as of **(a)**, according to **(d).4** and **(d).5**.

(App. Br. 14–15 (Claims App'x).)

Prior Art and Rejections on Appeal

The following table lists the prior art relied upon by the Examiner in rejecting the claims on appeal:

Szygenda et al. ("Szygenda")	US 2008/0086507 A1	Apr. 10, 2008
Manual of Patent Examining Procedure, 8 th ed., Rev. 1 ("MPEP")		Aug. 2001

Claims 1–30 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. (*See* Final Office Action (mailed Sept. 26, 2014) ("Final Act.") 2–3.)

Claims 1–30 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. (*See* Final Act. 3–4.)

Claims 1–30 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to comply with the definiteness requirement. (*See* Final Act. 4–6.)

Claims 1–30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Szygenda in view of MPEP. (*See* Final Act. 5–7.)

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellant's arguments that the Examiner has erred. We are not persuaded that the Examiner erred in rejecting claims 1–30 for failing to comply with the enablement and definiteness requirements of 35 U.S.C. § 112. We are persuaded that the Examiner erred in rejecting claims 1–30 for failing to comply with the written requirement of 35 U.S.C. § 112. We also do not sustain the Examiner's rejection under 35 U.S.C. § 103 because we find the claims indefinite.

Written Description

The Examiner finds that claims 1–30 do not comply with the written description requirement because these claims “are replete with acronyms, terms and expression that are [not] explained or described in the [S]pecification in a way that would convey to one of ordinary skill what the terms mean or how to perform such steps.” (Final Act. 3.) According to the Examiner, “the [S]pecification fails to give enough detail [on how to] perform the steps of the independent claims [and, therefore, fail] to reasonabl[y] convey to one skilled in the art at the time that the applicant had possession of the claimed invention.” (Ans. 6.)

To satisfy the written description requirement, “the [original] specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). The claimed invention need not be recited *in haec verba* in the original Specification to satisfy the written description requirement. *Id.* at 1352. “[T]he written description requirement is satisfied by the patentee’s disclosure of ‘such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention.’” *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 969 (Fed. Cir. 2002) (quoting *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997)). We agree with Appellant that because these are original claims and are, therefore, part of the original Specification (App. Br. 9), they are supported by the original disclosure.

Accordingly, we do not sustain the Examiner's rejection of claims 1–30 as failing to comply with the written description requirement under 35 U.S.C. § 112, first paragraph.

Enablement

The Examiner finds that claims 1–30 do not comply with the enablement requirement because these claims “contain[] subject matter[,] which was not described in the [S]pecification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.” (Final Act. 3–4.) Appellant contends that “the Examiner has not considered any factor[s] listed in *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988),] in reaching the conclusion that the disclosure does not satisfy the enablement requirement.” (App. Br. 7–8; Reply Br. 1–3.) According to Appellant, the factors to be considered:

include, but are not limited to:

1. the breadth of the claims,
2. the nature of the invention,
3. the state of the prior art,
4. the level of one of ordinary skill,
5. the level of predictability in the art,
6. the amount of direction provided by the inventor,
7. the existence of working examples, and
8. the quantity of experimentation needed to make or use the invention based on the content of the disclosure.

(*Id.* at 7.)

Appellant has not persuaded us that the Examiner erred. We adopt the Examiner's findings in the Answer (Ans. 3–5) and Final Action (Final Act. 3–4) and we add the following primarily for emphasis. It is well-established

law that the test for compliance with the enablement requirement in the first paragraph of 35 U.S.C. § 112 is whether the disclosure, as filed, is sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. *In re Wands*, 858 F.2d at 737 (setting forth eight factors to be considered to evaluate whether a disclosure would require undue experimentation). As an initial matter, we note that an Examiner is not required to provide a discussion as to every *Wands* factor. Here, while the Examiner has not couched the rejection under one or more of the *Wands* factors, it is clear from the Examiner's discussion that the Examiner considered some of these *Wands* factors. For example, the Examiner finds that "[t]here is no direction in the [S]pecification given to how a user or person would go about accomplishing the steps of a-pp as well as how a computer would automatically accomplish these same steps." (Ans. 4.) This shows that the Examiner has considered factors 6 (the amount of direction provided by the inventor) and 7 (the existence of working examples) of the *Wands* factors. As another example, the Examiner also finds that:

The [S]pecification also treats the terms BID, which stands for "Binary Independent disclosed[,] []and BED, which stands for "Binary Elementary Disclosed", in the same manner as it does BAD *wherein it fails to give a clear definition of how one determines these terms and what they encompass, but merely states they found and used.* Another example would the step of how a user would go about disaggregate any BAD-X.0.n, into $\{\text{BED-cr-C.0.k}^n | 1 \leq k^n \leq K^n\}$ or how the system automatically generates $\text{BED-TT.0} ::= \{\{\text{BED-cr-C.0.k} | 1 \leq k \leq K\}\} \cup \{\{\text{BED-cr-C.0.k}^n | 1 \leq k^n \leq K^n\} | 1 \leq n \leq N\}$. There is no clear description or instructions in the [S]pecification to enable a user to complete the step of disaggregating a BAD into BED. The [S]pecification simply states these septs are done.

(Ans. 5, emphasis added.) This shows that the Examiner has considered factors 1 (the breadth of the claims), 6 (the amount of direction provided by the inventor) and 7 (the existence of working examples) of the *Wands* factors. Appellant, however, contend that one of ordinary skill in the art, which according to Appellant is “a Ph. D in Artificial Intelligence, semantic research or equivalents with significant experience and/or equivalent experience,” would “be able to practice the invention without undue experimentation upon reading the [S]pecification as a whole with the various terms fully described as referred to in the terms index filed of record.” (App. Br. 8.) Appellant’s assertion in this regard, does not address the specific findings by the Examiner, and is mere attorney argument, a conclusory statement, which is unsupported by factual evidence. Thus, this argument is entitled to little probative value. *In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011); *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984).

Accordingly, we sustain the Examiner’s rejection of claims 1–30 as failing to comply with the enablement requirement under 35 U.S.C. § 112, first paragraph.

Indefiniteness

The Examiner finds that claims 1–30 do not comply with 35 U.S.C. § 112, second paragraph because it is unclear what some of the claims encompass. (Final Act. 5–6.) According to the Examiner:

claims 1-30 [are] replete with acronyms, symbols, notation, formulas and relations that render the claims indefinite because it is unclear what the terms mean and encompass. As there are many acronyms, symbols, notations, formulas and relations in the claims that indefinite, the [E]xaminer will list a few to provide examples on why these terms are indefinite. The

terms: “BAD”, “BAD-KR”, “PTR”, “PTR-DS”, “PTR^{CT}-DS”, “TT.0”, “BED-TT.0”, “BADX.0.n”, “BAD-X.0.n”, “X.0.n”, “ $1 \leq n \leq N$ ”, “KR_R&S_S”, “ $0 \leq |RS|$ ”, “doc.i-MUIs”, “document.CT”, “doc.CT-MUIs”, “BED-cr-C.0.k’s”, “ $1 \leq k \leq K$ ”, K^n , K^M , SoJUS^{dagr}(BAD-X.0.n), SoDIS(BED-C.0.kⁿ), DIS^{sel}(BED-cr-C.O.kⁿ), and etc.

None of the terms in the claims are terms of art and readily known by a person of ordinary skill in the art. In addition there is not clear definition of these terms given in the [S]pecification to describe or define what the terms mean as well as what they encompass. At most the [S]pecification gives acronyms and what the acronyms stand for without defining the terms clear. For example

(Ans. 7–8, emphasis added.) Appellant disagrees and contend that the “Answer has ignored Appellant’s explanation at pages 9 and 10 of the main brief, explaining in detail where the various terms are in fact described in the [S]pecification [and that t]he Answer fails to even address these citations, and thus Appellant’s argument stands unrebutted on the record.” (Reply 5.)

Section 112, second paragraph, requires that “[t]he specification . . . conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” “As the statutory language of ‘particular[ity]’ and ‘distinct[ness]’ indicates, claims are required to be cast in clear—as opposed to ambiguous, vague, indefinite—terms.” *In re Packard*, 751 F.3d 1307, 1313 (Fed. Cir. 2014);²

² Our reviewing court has held that when the USPTO has initially issued a well-grounded rejection that identifies ways in which the language in a claim is ambiguous, vague, incoherent, opaque, or otherwise unclear in describing and defining the claimed invention, and thereafter the applicant fails to provide a satisfactory response, the USPTO can properly reject the claim as failing to meet the statutory requirement that the claims be definite. *Id.* at 1313-1314. The court explained a satisfactory response can take the form of modification of the language identified as unclear, a separate definition of

see also In re Hammack, 427 F.2d 1378, 1382 (CCPA 1970) (“the essence of [the] requirement [under 35 U.S.C. § 112, second paragraph] is that the language of the claims must make it clear what subject matter they encompass.”).

On the record before us, we do not find Appellant has met the burden to resolve the ambiguity of the claims identified by the Examiner. We adopt the Examiner’s findings in the Answer (Ans. 7–8) and Final Action (Final Act. 5–6) and we add the following primarily for emphasis. The Examiner finds that the:

phrase “BAD-KR” renders the claim 1 and 16 indefinite because it is unclear what this term encompasses. In the instant [S]pecification the term “BAD” is defined as “Binary[^]aggregated[^]disclosed[.]” However there is no definition on what exactly “BAD” or “BAD-KR” is or encompasses. It also is not clear if these terms are the same or entirely different.

(Final Act. 5.) Appellant contends that “the term ‘BAD-KR’ is clearly explained as referring to Knowledge Representation of a Binary-Aggregated-Disclosed inventive concept. See [S]pecification at page 15, lines 1 – 27 and page 25, lines 25 – 30.” (App. Br. 10, emphasis omitted.) However, a review of the citations provided by Appellant confirms the Examiner’s finding that it is unclear “what exactly ‘BAD’ or ‘BAD-KR’ is or encompasses” and it “is not clear if these terms are the same or entirely different.” (Final Act. 5.) Specifically, we agree with the Examiner’s further clarification that:

the unclear language, or, in appropriate circumstances, “persuasive explanation for the record of why the language at issue is not actually unclear.” *Id.* at 1311.

The term BAD is also used many times in the [S]pecification with many variations of it such as BAD-X.0.n, BAD-KR, BAD-X.0.n. The [S]pecification cites the acronym BAD stands for Binary-Aggregated Disclosed inventive concept, but gives no description on detail enabling a user to know how to find them or what does BAD entails. Pages 15 lines 1–27 and page 25 lines 25–30 do not give a clear definition on BAD or how a user or system would identify them, these passages merely state that BAD stands Binary-Aggregated Disclosed Inventive concept and BAD's are identified. The [S]pecification also treats the terms BID, which stands for “Binary Independent disclosed” [and BED, which stands for “Binary Elementary Disclosed”, in the same manner as it does BAD wherein it fails to give a clear definition of how one determines these terms and what they encompass, but merely states they found and used. Another example would the step of how a user would go about BAD-X.0.n, $\{BED-cr-C.0.k^n | 1 \leq k^n \leq K^n\}$ BED-TT.O ::= $\{\{BED-cr-C.0.k | 1 \leq k \leq K\} \cup \{\{BED-cr-C.0.k^n | 1 \leq k^n \leq K^n\} | 1 \leq n \leq N\}$.

(Ans. 7–8.) Appellant does not address these specific findings by the Examiner, but instead contends in its Reply that “[t]he Answer has ignored Appellant’s explanation at pages 9 and 10 of the main brief, explaining in detail where the various terms are in fact described in the [S]pecification.”

(Reply 5.) We are also not persuaded by Appellant’s contention that “[t]he Answer fails to even address these citations, and thus Appellant’s argument stands un rebutted on the record.” (*Id.*)

Accordingly, we sustain the Examiner’s rejection of claims 1–30 as failing to comply with the definiteness requirement under 35 U.S.C. § 112, second paragraph.

Prior Art Rejection

The Examiner finds claims 1–30 unpatentable over Szygenda in view of MPEP under 35 U.S.C. § 103(a). (*See* Final Act. 5–7.) Based on the above analysis, however, the prior art rejections of claims 1–30 under

35 U.S.C. § 103(a) must fall because they are necessarily based on a speculative assumption as to the meaning of these claims. *See In re Steele*, 305 F.2d 859, 862–63 (CCPA 1962) (holding that the Examiner and the board were wrong in relying on what at best were speculative assumptions as to the meaning of the claims and basing a rejection under 35 U.S.C. § 103 thereon). It should be understood, however, that our decision in this regard is based on the indefiniteness of the claimed subject matter, and does not reflect on the adequacy of the prior art evidence applied in support of the rejection.³

Accordingly, we do not sustain the Examiner’s rejection of claims 1–30 under 35 U.S.C. § 103(a).

DECISION

We sustain the decision of the Examiner to reject claims 1–30 for failing to comply with the enablement and definiteness requirements of 35 U.S.C. § 112.

³ We note that Appellant’s briefs fail to address the Examiner’s specific findings regarding the prior art rejection. *In re Lovin*, 652 F.3d at 1357 (holding that “the Board reasonably interpreted Rule 41.37 to require more substantive 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.”); *In re Geisler*, 116 F.3d at 1470; *In re De Blauwe*, 736 F.2d at 705. In fact, Appellant has not presented any cogent arguments sufficient to address the Examiner’s detailed position and instead assert, without elaboration or specific criticism of the Examiner’s detailed findings, that the references do not disclose the limitations of the independent claims. Furthermore, should there be further prosecution, we recommend that the Examiner also review the claims under *Alice Corp. Ptd. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347 (2014).

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We do not sustain the decision of the Examiner to reject claims 1–30 for failing to comply with the written requirement of 35 U.S.C. § 112.

We also do not sustain the Examiner’s rejection under 35 U.S.C. § 103 because we find the claims indefinite.

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