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EXAMINER
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KERRY JOHN ENRIGHT

Appeal 2016-005700
Application 13/793,361[1]
Technology Center 3600

Before NINA L. MEDLOCK, MATTHEW S. MEYERS, and ROBERT J. SILVERMAN, *Administrative Patent Judges*.

SILVERMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1–9. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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[1] According to the Appellant, the real party in interest is Kerry John Enright. Appeal Br. 1.

ILLUSTRATIVE CLAIM

1. A method of systematically performing hierarchical process control, the method comprising:

performing a process element control operation, wherein the process element control operation comprises the addition of elements to the initiate, execute and complete sub-processes;

performing a process order operation, wherein the process order operation comprises controlling the execution order of processes and sub-processes;

performing a sub-process operation, wherein the sub-process operation comprises the initiation, execution and completion of sub-processes;

performing an identification operation, wherein the identification operation comprises the identification of process step, elements, hierarchies and interactions; and

performing a process control operation, wherein the process control operation comprises monitoring, evaluating and controlling processes across hierarchies; [sic]

CITED REFERENCES

The Examiner relies upon the following references:

Knittel et al. US 2003/0217129 A1 Nov. 20, 2003 (hereinafter "Knittel")

Mamou et al. US 2005/0240354 A1 Oct. 27, 2005 (hereinafter "Mamou")

REJECTIONS

I. Claims 1–9 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

II. Claims 1–9 are rejected under 35 U.S.C. § 112(b) as being indefinite for failing to particularly point out and distinctly claim the subject

matter that the Appellant regards as the invention.[2]

III. Claims 1–6 are rejected under 35 U.S.C. § 102(b) as being anticipated by Knittel.

IV. Claims 7–9 are rejected under 35 U.S.C. § 103(a) as unpatentable over Knittel and Mamou.

FINDINGS OF FACT

We rely upon and adopt the Examiner's findings stated in the Final Office Action at pages 4 and 9 and the Answer at pages 10–12. Additional findings of fact may appear in the Analysis below.

ANALYSIS

Indefiniteness Rejection
35 U.S.C. § 112(b)

A patent "specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor . . . regards as the invention." 35 U.S.C. § 112(b). A claim fails to satisfy this statutory requirement and is thus indefinite if its language, when read in light of the specification and the prosecution history, "fail[s] to inform, with reasonable certainty, those skilled in the art about the scope of the invention." *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2124 (2014).

In the instant Appeal, the Final Office Action states that "the metes and bounds of the claims are unknown." Final Action 4. More particularly, "[i]t is unclear how [the steps of claim 1] are performed and what they

[2] The Examiner rejected claims 1–9 under either 35 U.S.C. § 112(b) or 35 U.S.C. § 112 (pre-AIA), second paragraph. Final Action 9. Because the Appellant's application was filed after September 16, 2012 (*see* Appeal Br. 1), the AIA version of 35 U.S.C. § 112 is applied herein.

comprise" and "[n]o apparent structure is evident from these recited steps," thus rendering the claims indefinite. *Id.* at 9. Similarly, dependent claims 2–9 "inherit the deficiency" of claim 1 "and include similar deficiencies." *Id.*

The Examiner further explains that the "element control" recited in claim 1 is not discussed or defined in the Specification and is not described in detail that would permit a person of ordinary skill in the art to discern its meaning. Answer 10. The Examiner points out similar interpretational problems regarding the terms "initiate," "execute," and "complete" (which the Examiner states are "recited by their names only, without any details on how they are performed"), as well as the features of the "prepare" step (claim 2). *Id.*

In response, the Appellant refers to examples of using the claimed embodiments that do not appear in the Specification or claims ("process transition between take-off and combat flight for the F35 program," "numerical process control equipment," and "semiconductor process equipment") (Reply Br. 34, 40), quotes portions of the Specification without providing significant additional explanation (*id.* at 34–35, 38–39), quotes portions of an allegedly related application that are not part of the Specification of the application involved in this Appeal (*id.* at 35–36), and offers personal opinions (Appeal Br. 34, 56; Reply Br. 35–40). In addition, the Appellant cites or quotes legal authorities not directed to the issue of claim indefiniteness. *See* Reply Br. 37–40.

In view of the foregoing, the Appellant's arguments are not persuasive of error in the rejection of the claims for indefiniteness. Accordingly, the rejection of claims 1–9 under 35 U.S.C. § 112(b) is sustained.

Patentable Subject Matter, Anticipation, and Obviousness Rejections 35 U.S.C. §§ 101, 102(b), and 103(a)

We do not reach the merits of the rejections of claims 1–9 under 35 U.S.C. §§ 101, 102(b), or 103(a) at this time. Before a proper review of the rejections under §§ 101, 102(b), and 103(a) can be made, the subject matter encompassed by the claims on appeal must be reasonably understood without resort to speculation. Because claims 1–9 fail to satisfy the requirements under 35 U.S.C. § 112, second paragraph, as explained above, we are constrained to reverse, *pro forma*, the Examiner's rejections under 35 U.S.C. §§ 101, 102(b), and 103(a). *See In re Steele*, 305 F.2d 859, 862 (CCPA 1962) (a prior art rejection cannot be sustained if the hypothetical person of ordinary skill in the art would have to make speculative assumptions concerning the meaning of claim language). The reasoning of *In re Steele* applies likewise to rejections under 35 U.S.C. § 101, when, as here, the scope of the claims must be understood in order to determine whether they encompass ineligible subject matter.

It should be understood that the decision to reverse the rejections of claims 1–9 under 35 U.S.C. §§ 101, 102(b), and 103(a) is based solely on the indefiniteness of the claims, and does not reflect on the merits of the underlying rejections.

DECISION

We REVERSE, *pro forma*, the Examiner's decision rejecting claims 1–9 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

We AFFIRM the Examiner's decision rejecting claims 1–9 under 35 U.S.C. § 112(b).

We REVERSE, *pro forma*, the Examiner's decision rejecting claims 1–9 under 35 U.S.C. § 102(b).

We REVERSE, *pro forma*, the Examiner's decision rejecting claims 1–9 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).

AFFIRMED