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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOSEPH E. CHILDS,
ROGER W. ROGNLI, and
BROCK M. SIMONSON

Appeal 2018-001656
Application 13/680,581
Technology Center 3700

Before MICHAEL L. HOELTER, JEREMY M. PLENZLER, and BRANDON J. WARNER, *Administrative Patent Judges*.

HOELTER, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant[1] appeals from the Examiner's decision to reject claims 1–26. Appeal Br. 1 (Title page). Appellant's counsel presented oral argument on October 17, 2019. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM IN PART the Examiner's rejection of these claims and we also issue a new ground of rejection.

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[1] We use the word "Appellant" to refer to "applicant" as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as "Cooper Technologies Company." Appeal Br. 2.

CLAIMED SUBJECT MATTER

The disclosed subject matter "relates generally to improving energy efficiency of heating, ventilating, and air-conditioning systems." Spec. 1:9–10. Apparatus claims 1, 16, 18, and 25, and method claim 10, are independent. Claim 1 is illustrative of the claims on appeal and is reproduced below.

> 1. A load control device for improving energy efficiency of a heating, ventilating, and air-conditioning (HVAC) system by controlling shed durations of an electrically-powered compressor of the HVAC system, the load control device comprising:
>
> a compressor cutoff switch including a first terminal adapted to receive a control signal from a temperature control device of the HVAC system;
>
> a second terminal connectable to the first terminal and adapted to transmit the control signal to a device controlling power to the compressor;
>
> the compressor cutoff switch adapted to selectively cause the compressor to be disconnected from a power source by disconnecting the first terminal from the second terminal to interrupt transmission of the control signal to the device;
>
> a sensing circuit in electrical communication with the second terminal to detect the presence of the control signal and transmit a signal representative of the control signal; and
>
> a processor in electrical communication with the sensing circuit and the compressor cutoff switch, the processor configured to receive the signal representative of the control signal, determine a subsequent mandatory shed duration and a mandatory minimum run duration for a subsequent operating cycle of the compressor based on the run duration and the shed duration of the previous operating cycle of the compressor, and cause the compressor cutoff switch to disconnect the first terminal from the second terminal for a period of time based upon the determined subsequent mandatory shed duration of the previous operating cycle, the period of time following the previous operating cycle, which causes the compressor run

duration of the subsequent operating cycle to increase, thereby increasing an energy efficiency of the heating or cooling system.

EVIDENCE

Paddock	US 4,292,813	Oct. 06, 1981
Hammer et al.	US 4,345,162	Aug. 17, 1982
Anderson et al.	US 4,389,577	June 21, 1983
Ng	US 2009/0216382 A1	Aug. 27, 2009
Fleck et al.	US 2010/0070103 A1	Mar. 18, 2010
Jeung et al.	US 2010/0256821 A1	Oct. 07, 2010

REJECTIONS[2]

Claims 1–9 are rejected under 35 U.S.C. § 112(a) or 35 U.S.C. § 112 (pre-AIA), first paragraph, as failing to comply with the written description requirement.

Claims 1–3, 5, 6, 8, 10–19, 21, 22, and 24 are rejected under pre-AIA 35 U.S.C. § 103(a) as unpatentable over Hammer and Paddock.

Claims 4 and 20 are rejected under pre-AIA 35 U.S.C. § 103(a) as unpatentable over Hammer, Paddock, and Jeung.

[2] "The rejections pursuant to 35 U.S.C. 112(a) or 35 U.S.C. 112 (pre-AIA), second paragraph have been withdrawn in light of the amendments filed." Final Act. 2. The Examiner's above statement contains a typographical error by referencing "112(a)" rather than the correct statute, "112(b)," since the rejection withdrawn pertains to indefiniteness, and not to a lack of written description. This is confirmed by the Examiner, in responding to Appellant's indefiniteness arguments, stating, "Applicant's arguments are moot because the arguments do not apply to the Office Action that is the subject of this Appeal." Ans. 8. Further, the Examiner separately presented a written description rejection (*see* Final Act. 2–3) to which Appellant has responded (*see* Appeal Br. 25–29).

Claims 7 and 23 are rejected under pre-AIA 35 U.S.C. § 103(a) as unpatentable over Hammer, Paddock, and Ng.

Claim 9 is rejected under pre-AIA 35 U.S.C. § 103(a) as unpatentable over Hammer, Paddock, and Fleck.

Claims 25 and 26 are rejected under pre-AIA 35 U.S.C. § 103(a) as unpatentable over Anderson, Fleck, and Paddock.

ANALYSIS

The rejection of claims 1–9 as failing to comply with the written description requirement

The Examiner addresses the limitation "determine a subsequent mandatory shed duration and a mandatory minimum run duration." Final Act. 3. The Examiner finds that such language "is not sufficiently described in the specification" because Appellant's Specification "is silent to determining a mandatory minimum run duration." Final Act. 3. The Examiner explains that Appellant's Specification "speaks to the subsequent mandatory shed duration based upon a predetermined minimum run time and not a mandatory minimum run duration" as recited. Final Act 3.

Appellant disagrees with this assessment, stating "[w]ritten description support for this claim element is found throughout the Application." Appeal Br. 26 (referencing Spec. 24:22–25:4 (which encompasses Equation 1 and the definition of the variables used therein)). Appellant contends, "by the very definition of T, the subsequent run duration R is set recursively to have a minimum." Appeal Br. 26; *see also id.* at 27–28 where further citations to Appellant's Specification are provided. In view of these identified excerpts, and the definitions of the variables employed in Equation 1, it is asserted that "Applicant conceived of and described

increasing a mandatory minimum run duration based on the previous run time and shed time durations, as claimed." Appeal Br. 28. Appellant further states, "the lack of verbatim use of a claim term" is not sufficient to support a written description rejection (i.e., no "*in haec verba*" requirement). Appeal Br. 28 (referencing MPEP § 2163.02).

The Examiner acknowledges that, as regarding the limitation "mandatory minimum run duration," "a reading and/or search of the specification does not reveal the existence of said limitation," and further, Appellant's Specification "does not necessarily disclose where [this limitation] is implied." Ans. 7. Thus, the Examiner reiterates "that the limitation 'mandatory minimum run duration' is not supported by the as filed specification." Ans. 8.

We agree with Appellant that time element T is a required element of Equation 1, and that its definition "is the duration of a minimum preferred compressor run time." Spec. 25:1. Although T could equal zero, that would result in the compressor not running. This may improve efficiency (i.e., no power to run the compressor would be consumed) but then the ambient environment of the facility may be inhospitable to occupation. The Examiner has not established this as a reasonable scenario one skilled in the art would contemplate when addressing the operating efficiency of an HVAC system. *See* Spec. 1:9–10. In other words, the Examiner does not explain why any selected non-zero time T fails to satisfy the limitation "mandatory minimum run duration" as defined and recited.

Accordingly, based on the record presented and Appellant's various citations to the Specification, the Examiner has not established by a preponderance of the evidence that the limitation "mandatory minimum run

duration" lacks written description support. We do not sustain the Examiner's rejection of claim 1, or dependent claims 2–9, as lacking written description support.

The rejection of claims 1–3, 5, 6, 8, 10–19, 21, 22, and 24 as unpatentable over Hammer and Paddock

Appellant argues the rejection of these claims together, such as when addressing the combination of Hammer and Paddock, or Hammer alone. *See* Appeal Br. 20–25, 31–33. When addressing these claims in smaller groups or individually, Appellant relies on arguments previously presented. *See* Appeal Br. 33, 35–37. Accordingly, we select claim 1 for review, with the remaining claims (i.e., 2, 3, 5, 6, 8, 10–19, 21, 22, and 24) standing or falling therewith. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Claim 1 recites "[a] load control device" for an HVAC system comprising several components (i.e., a "compressor cutoff switch," first and second terminals allowing compressor power to be disconnected, "a sensing circuit," and "a processor" configured to "cause the compressor cutoff switch to disconnect the first terminal from the second terminal"). The Examiner relies on Hammer for the structural limitations recited and relies on Paddock for teaching the recited "temperature control system." Final Act. 8–9; *see also* Ans. 3 ("Hammer teaches the basic structure of the invention"), 4 ("Paddock, drawn to a temperature control system which adjusts a duty cycle"), 6 (Hammer's "control step does not factor into the analysis"). The Examiner identifies where Paddock teaches operating a system in an "optimum manner." Final Act. 9 (referencing Paddock 2:59–3:3 ("The control system thus permits the sometimes competing considerations . . . to be balanced in a controlled, more optimum manner

than is practical in conventional systems.")). *See also* Paddock 2:32–40; 9:9–13. The Examiner relies on "increasing an energy efficiency . . . in view of the teachings of Paddock" for the motivation to combine the structure of Hammer with "a system that operates in an optimal manner" as taught by Paddock. Final Act. 10; *see also* Ans. 4. As such, the Examiner determines that claim 1 is unpatentable over Hammer and Paddock. *See* Final Act. 8–10.

Appellant initially contends the Examiner relied on "improper hindsight" for combining Hammer and Paddock (*see* Appeal Br. 20), but this is not persuasive in view of the Examiner's findings and conclusions regarding energy efficiency expressed above.

Appellant further contends,

> It is not possible to adapt to a changing environment as taught by Paddock while also ensuring that power consumed does not rise above the level that persisted just prior to receipt of a signal as taught by Hammer. The main technical features of these two references are completely incompatible with one another.

Appeal Br. 20; *see also id.* at 22. It is not self-evident that adapting to a changing environment precludes ensuring that power consumed does not rise above a certain level. Appellant fails to explain why the two references cannot be combined in the manner suggested by the Examiner.[3] Other than attorney argument, Appellant presents no evidence in its briefs that Hammer and Paddock are "incompatible with one another" as asserted. Accordingly, Appellant's contentions are not persuasive of Examiner error.

[3] "Hammer is relied upon to teach the basic structure of the invention (See the rejection of at least Claim 1 for detailed discussion) and was not relied upon to teach the control step as recited in at least Appellant's claim 1." Ans. 6.

Appellant also contends the Examiner failed to provide "any 'rational underpinning' to explain why it would be obvious to combine [the] two references." Appeal Br. 21; *see also* Reply Br. 2–3. However, as stated above, the Examiner's motivation for the combination is premised on Paddock's teaching of efficiency and optimal performance (*see* Final Act. 10; Ans. 4), even in the face of "sometimes competing considerations of maximum energy efficiency and minimum temperature fluctuation." Paddock 2:67–3:2. Appellant does not make clear how these motives fail to provide articulated reasoning with rational underpinning which support the conclusion of obviousness. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Accordingly, Appellant's contentions above are not persuasive of Examiner error.

Appellant further appears to infer that the Examiner failed "to understand . . . the difference between the distinct concepts of art which is analogous, and art which would be obvious to combine." Appeal Br. 21. It is not disputed that both Hammer and Paddock are analogous art, only that the Examiner has yet to provide a "satisfactory explanation of why these references would have been obvious to combine." Appeal Br. 22. This assertion does not address the Examiner's reliance on increasing energy efficiency of an HVAC system, as detailed above.

Appellant additionally argues that "*Hammer teaches away*" because "the solution presented by Hammer is diametrically opposed to the solution embodied in claim 1." Appeal Br. 24. Here, it appears Appellant is not addressing Hammer's structure, but is instead focusing on Hammer's method of operation. However, as clearly explained by the Examiner,

Hammer's "control step does not factor into the analysis." Ans. 6. Instead, Paddock is relied upon regarding "a temperature control system which adjusts a duty cycle." Ans. 4 (referencing Paddock 1:6–9).

Appellant further contends that the Examiner failed "to even allege that the mandatory minimum run duration is determined for a subsequent operating cycle of the compressor." Appeal Br. 31; *see also* Reply Br. 3–4. There is some merit to this assertion in that, upon initial examination, the Examiner appears to be silent as to the limitation "mandatory minimum run duration" as regarding claim 1. However, we note that the Examiner addresses this limitation in the rejection of dependent claim 2. *See* Final Act. 10. We further note that, when explaining the rejection of dependent claim 7 (dependent upon claim 2), the Examiner addresses "minimum run duration" and states "[a]s modified in Claim 1 above, see the rejection of claim 2 for detailed discussion." Final Act. 15. Thus, as understood, this claim phrase was discussed vis-à-vis claim 2, and the Examiner also (albeit subsequently) applied this same discussion regarding claim 2 to claim 1. *See* Final Act. 15. Consequently, it is not altogether accurate for Appellant to assert that the Examiner failed "to even allege" or address this limitation with respect to claim 1. Instead, it appears Appellant was provided notice as to the basis of the rejection of this claim limitation.

It is further noted that when the Examiner addressed the limitation "minimum run duration," the Examiner identified where Hammer provides similar teachings. *See* Final Act. 10; *see also* Hammer 7:1–2 ("minimum and maximum ON and OFF times the compressor is allowed to have"), 7:59–61; 8:51–63; 13:29–30 ("a minimum or default duty cycle strategy"); Fig. 4D and Paddock 2:32–36. Accordingly, despite the admittedly

convoluted route laid out by the Examiner, we do not agree with Appellant that the Examiner was silent regarding this limitation with respect to claim 1.

Appellant further contends that this "minimum run duration" limitation was not "determined for a subsequent operating cycle of the compressor." Appeal Br. 32. However, Hammer teaches a "sequence" that is followed, one step being to ascertain time on and time off. *See* Hammer 8:51; Fig. 4D. Appellant does not explain how such time is not of a previous cycle so that a time for a subsequent cycle can be determined.

Appellant also states, "[t]he preamble of each independent claim recites improving efficiency." Reply Br. 4. Such usage of "'improving energy efficiency' in the preamble . . . gives life and meaning to the claim by providing a 'statement of intended use.'" Reply Br. 4. Although not disputing Appellant's usage of this phrase in the preamble of claim 1, or that this statement may be an expression of intended use, Appellant does not explain how, based on these statements, the Examiner's similar reliance on "increasing an energy efficiency" so that the system "operates in an optimum manner" (as the basis for combining Hammer's structure with Paddock's method of operation), might be in error.

In summation, and as noted above, claim 1 is directed to "[a] load control device" for an HVAC system that operates in a certain manner. In this vein, Appellant is not persuasive that Hammer's structure cannot be operated in accordance with Paddock's methodology, so as to increase energy efficiency, despite possible competing considerations. *See supra*. Accordingly, Appellant is not persuasive that it is improper for these references to be combined in the manner suggested. As such, Appellant is not persuasive the Examiner erred in finding claims 1–3, 5, 6, 8, 10–19, 21,

22, and 24 unpatentable over Hammer and Paddock. We sustain the Examiner's rejection of these claims for the reasons expressed above.

The rejection of claims 4 and 20 as unpatentable over Hammer, Paddock, and Jeung

Each of claims 4 and 20 (that ultimately depend from different independent claims) recites "wherein the sensing circuit comprises a trigger sense circuit." The Examiner relies on Jeung for teaching this additional limitation. *See* Final Act. 14; Ans. 5. The Examiner reasons that it would have been obvious to modify the combination of Hammer and Paddock "to have . . . the sensing circuit comprise[] a trigger sense circuit in view of the teachings of [Jeung] in order to provide a current feedback signal to a controller." Final Act. 14; *see also* Ans. 5.

Appellant acknowledges that "Jeung teaches sensing ***operating*** current" and that "[t]he operating current level at reed relay 112 of Hammer has no effect on the" compressor operation. Appeal Br. 23; *see also id*. at 24, 38. Thus, according to Appellant, "[t]here would be no practical value in measuring a current level at reed relay 112, as proposed."[4] Appeal Br. 23, 38. Appellant appears to have misunderstood the Examiner's rejection. The Examiner is not relying on Hammer's reed relay 112 to provide feedback, but instead Jeung's sensor. *See* Final Act. 14; Ans. 5. Appellant does not explain why it would not have been obvious to employ Jeung's sensor "in order to provide a current feedback signal to a controller" as expressed by the Examiner. Final Act. 14; *see also* Ans. 5. Accordingly, Appellant's argument is not persuasive of Examiner error.

[4] Appellant further asserts that this "current feedback signal would be useless if taken from reed relay 112 of Hammer." Appeal Br. 23, 38.

Appellant further addresses Jeung, questioning whether this reference discloses a "trigger sense circuit" as recited. *See* Appeal Br. 33, 38; Reply Br. 6. Appellant contends, "[t]he trigger of claim 4 is a noise-filtering trigger such as a Schmitt trigger, whereas the current detector 670 of Jeung is a precise, analog detector. The two are not interchangeable." Appeal Br. 33; *see also id.* at 38 (regarding claim 20). More precisely, Appellant argues, "[t]he claimed sensing circuit is a 'trigger,' which is understood by one of ordinary skill to be a noise-filtering sensor with a specific hysteresis curve, such as a Schmitt trigger." Appeal Br. 33 (referencing Spec. 22:4–6). Appellant explains, "[a] trigger is a device that provides an indication of whether signal is present, while removing noise, but does not provide a precise, analog measurement of that signal." Appeal Br. 34.

As noted above, claims 4 and 20 each additionally recite "a trigger sense circuit." Despite Appellant's explanation above as to what a "trigger" device is, Appellant's Specification is silent as to the above requirement that a "trigger" device is "a noise-filtering sensor with a specific hysteresis curve" and "does not provide a precise, analog measurement of that signal." *See* Spec. 22:1–8; Appeal Br. 33, 34. Instead, Appellant's Specification explains that "a sensing circuit may sense the absence or presence of a voltage or current signal" and also that "a sensing circuit may comprise a Schmitt trigger" or, "[i]n other simplified embodiments . . . may merely comprise an electrical connection" for monitoring. Spec. 22:2–8. Although Appellant's Specification distinguishes a "trigger" circuit from more simplified embodiments that merely comprise a connection for monitoring purposes, Appellant's Specification provides no further guidance or explanation as to what the recited "trigger" circuit is to additionally entail

over a more simplified electrical connection. As such, the ability to ascertain whether Jeung's device 670 meets this enhanced or "trigger" limitation as set forth in Appellant's Specification is impeded and, ultimately, foiled. This is because our reviewing court has provided instruction that, before a decision based on 35 U.S.C. § 103(a) can be made, "it is essential to know what the claims do in fact cover." *In re Steele*, 305 F.2d 859, 862 (CCPA 1962). In *Steele*, the court stated that their "analysis of the claims indicates that considerable speculation as to meaning of the terms employed and assumptions as to the scope of such claims were made by the examiner" and that "we do not think a rejection under 35 U.S.C. § 103 should be based on such speculations and assumptions." *Steele*, 305 F.2d at 862.

Accordingly, although we reverse the Examiner's obviousness rejection of claims 4 and 20 for the reasons provided above (i.e., the Examiner relied on speculation and assumptions as to the scope of these claims), we likewise determine claims 4 and 20 to be indefinite for the reasons provided above (i.e., it is not clear what the claims do, in fact, cover). Thus, in order to provide Appellant with a fair opportunity to respond (*see In re Kronig*, 539 F.2d 1300, 1302 (CCPA 1976)), we enter a new ground of rejection with respect to claims 4 and 20. This new ground of rejection is premised on indefiniteness under 35 U.S.C. § 112 (pre-AIA), second paragraph. *See In re Packard*, 751 F.3d 1307 (Fed. Cir. 2014) (affirming Board's conclusion, in context of *ex parte* appeal, that claims were indefinite on grounds that they contain words or phrases whose meaning is unclear).

The rejection of claims 7 and 23
as unpatentable over Hammer, Paddock, and Ng

Claim 7 depends from claim 2, which depends from independent claim 1. Claim 23, on the other hand, depends from claim 22, which depends from independent claim 18. Appellant does not separately argue the rejection of claims 7 and 23. *See* Appeal Br. 34, 38–39. Instead, Appellant states, "Ng does not remedy the deficiencies of Hammer and Paddock previously described with respect to claim" 1 or 18. Appeal Br. 34, 38–39.

As noted above, we find no deficiencies in the Examiner's rejection of claim 1 (or claim 18) based upon the combination of Hammer and Paddock. *See also* Ans. 10. Accordingly, we sustain the Examiner's rejection of claims 7 and 23 as being obvious over Hammer, Paddock, and Ng.

The rejection of claim 9
as unpatentable over Hammer, Paddock, and Fleck

Claim 9 depends directly from independent claim 1 and includes the additional limitation of "wherein the processor is further configured to determine a system efficiency of the HVAC system." The Examiner relies on Fleck for such teachings, and provides a reason for combining Fleck with that of Hammer and Paddock. *See* Final Act. 16; Ans. 11. Appellant contends "that efficiency is never determined, either at the cited portions of Fleck or anywhere else." Appeal Br. 35.

The Examiner relies primarily on Paragraph 66 of Fleck. *See* Final Act. 16; Ans. 11. Paragraph 66 addressing the gathering of "information to evaluate and modify the algorithm" employed so as "to execute a load shedding strategy during subsequent load control events." "This increases

the efficiency of the load control unit during subsequent events and improves the overall performance of the unit at these times." Fleck ¶ 66. In view of such express disclosure of evaluating and modifying for efficiency, and overall performance purposes, Appellant's contention "that efficiency is never determined" (Appeal Br. 35) is not persuasive. We sustain the Examiner's rejection of claim 9 as being obvious over Hammer, Paddock, and Fleck.

The rejection of claims 25 and 26 as unpatentable over Anderson, Fleck, and Paddock

Appellant addresses the limitation in independent claim 25 (from which claim 26 depends) which recites, "the processor configured to determine a system energy efficiency of the HVAC system." Appeal Br. 39. As with respect to claim 9 above, the Examiner relies on the teachings of Fleck for support. *See* Final Act. 17; Ans. 18. Appellant repeats the contention that none of the cited art "teaches or even suggests determining a system energy efficiency of an HVAC system" and that "Fleck never teaches determining any system efficiency." Appeal Br. 39. For reasons similar to those provided above, we are not persuaded by Appellant's contentions. We sustain the Examiner's rejection of claims 25 and 26 as being unpatentable over Anderson, Fleck, and Paddock.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)Basis	Affirmed	Reversed	New Ground
1–9	112 (pre-AIA), first paragraph	Written Description		1–9	
1–3, 5, 6, 8, 10–19, 21, 22, 24	103(a)	Hammer, Paddock	1–3, 5, 6, 8, 10–19, 21, 22, 24		
4, 20	103(a)	Hammer, Paddock, Jeung		4, 20	
4, 20	112 (pre-AIA), second paragraph	Indefiniteness			4, 20
7, 23	103(a)	Hammer, Paddock, Ng	7, 23		
9	103(a)	Hammer, Paddock, Fleck	9		
25, 26	103(a)	Anderson, Fleck, Paddock	25, 26		
Overall Outcome			1–3, 5–19, 21–26	4, 20	4, 20

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

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