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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* TARA CHAND SINGHAL

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Appeal 2018-002468  
Application 13/374,503  
Technology Center 3700

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Before DANIEL S. SONG, EDWARD A. BROWN, and  
NATHAN A. ENGELS, *Administrative Patent Judges*.

ENGELS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from a rejection of claims 1–13. Claims 14–18 are withdrawn. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

### ILLUSTRATIVE CLAIM

Appellant's invention relates to an integrated blood-glucose measurement device with a test-strip-count system. Spec. 1:29–31. According to Appellant, using prior art blood-glucose meters required users to carry a storage container, the meter, and a lancet with them for testing multiple times each day. Spec. 7:4–17. Appellant's invention "provide[s] improvements by integrating these different items into a single compact blood glucose measuring device, that reduces the number of items as well as the steps [required for use] in the prior art." Spec. 7:17–20.

Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A test strip use count system in a blood glucose meter, comprising:
  - a. a handheld blood glucose meter and housed within the meter body a central processing unit (CPU), a display unit, a memory, and a test strip electrical interface, and operating in the CPU and the memory is a meter logic, wherein the meter logic includes a test strip count logic and a test strip count display logic;
  - b. the meter logic operates the meter including a function that senses intake of blood sample on a test strip and on sensing intake of blood sample sends a test strip use signal to the test strip count logic;
  - c. the test strip count logic on receiving the test strip use signal, maintains a test strip use count in the memory and the test strip count logic displays the test strip use count on the display unit of the blood glucose meter.

### THE REJECTIONS

Claims 1–4, 9–11, and 13<sup>1</sup> stand rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Cohen et al. (US 2002/0019707 A1; Feb. 14, 2002) and Wohland (US 2008/0145277 A1; June 19, 2008).

Claims 5–8 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Cohen, Wohland, and Funke et al. (US 2009/0277923 A1; Nov. 12, 2009).

### ANALYSIS

The Examiner finds that Cohen discloses a blood-glucose meter that teaches each limitation of claim 1 except that Cohen does not expressly disclose a test-strip-count logic that displays the test-strip count on the display unit of the blood-glucose meter, as claimed. Final Act. 4–5 (citing Cohen ¶¶ 26, 35, 74, 75). In combination with Cohen’s teachings, however, the Examiner cites Wohland for its teachings of a blood-glucose meter that calculates and displays a test-strip count. Final Act. 5 (citing Wohland ¶ 40).

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<sup>1</sup> The Office Action Summary in the Final Action identifies claim 13 as rejected, and the Appeal Brief acknowledges this rejection and indicates only claims 14–18 have been withdrawn. However, the Examiner’s listing of claims rejected in view of Cohen and Wohland does not list claim 13. The limitation recited in dependent claim 13 is substantially the same as that recited in dependent claim 4, and the Examiner’s rejection addresses that limitation. Final Act. 5–6. Because the substance of the Examiner’s rejection includes the limitation of claim 13 and Appellant does not address claim 13, we understand claim 13 to be among the claims rejected in view of Cohen and Wohland and treat claim 13’s omission from the list of rejected claims as a typographical error.

Appellant argues that the processor in Cohen’s handheld glucose meter would not have been capable of performing the functions recited in claim 1. Appeal Br. 17. Specifically, Appellant argues that in light of Cohen’s June 26, 2000 priority date, technology limitations of the processor in Cohen’s handheld glucose meter required use of a remote processing center, and Appellant notes that it was the remote processing center that tracks the test-strip-use count, not the handheld glucose meter. Appeal Br. 17–18.

As an initial matter, Appellant’s arguments incorrectly focus on the time of Cohen’s invention; the obviousness analysis centers on the patent applicant’s time of invention, not on the priority date(s) of the prior art reference(s). As provided by pre-AIA 35 U.S.C. § 103(a),<sup>2</sup> a patent may not issue if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time *the patent applicant’s invention* was made to a person having ordinary skill in the art.

Here, the obviousness analysis requires considering the teachings and suggestions of the prior art, including Cohen, through the lens of a person having ordinary skill at the time of Appellant’s invention, which claims priority to a May 31, 2011 Application. We agree with the Examiner that, in contrast to Appellant’s arguments, a person of ordinary skill would have

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<sup>2</sup> Although not applicable to Appellant’s Application because it was filed before March 16, 2013, § 103 now reads, in relevant part: “A patent for a claimed invention may not be obtained, . . . if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious *before the effective filing date of the claimed invention* to a person having ordinary skill in the art to which the claimed invention pertains . . . .” 35 U.S.C. § 103 (emphasis added).

recognized that in 2011, handheld devices included processors capable of performing the recited functions even if Cohen’s handheld blood-glucose meter relied on a remote processing center for additional processing capabilities. *See* Ans. 3; *see also* Cohen ¶ 24 (describing that “optionally” the handheld device’s processor can perform certain processing functions). As explained by the Examiner, Cohen recognizes that connecting to the remote processing center is inconvenient, which would have motivated a person of ordinary skill to use the improved processing capabilities available in 2011 as an improvement to the processing capabilities of the handheld device available at the time of Cohen’s disclosure. *See ZUP, LLC v. Nash Mfg., Inc.*, 896 F.3d 1365, 1371 (Fed. Cir. 2018) (explaining that a motivation to combine may be found “explicitly or implicitly in market forces; design incentives; the ‘interrelated teachings of multiple patents’; ‘any need or problem known in the field of endeavor at the time of invention and addressed by the patent’; and the background knowledge, creativity, and common sense of the person of ordinary skill”) (quoting *Plantronics, Inc. v. Aliph, Inc.*, 724 F.3d 1343, 1354 (Fed. Cir. 2013)).

We also disagree with Appellant’s arguments that the prior art fails to teach or suggest the claimed meter logic “that senses intake of blood sample on a test strip and on sensing intake of blood sample sends a test strip use signal to the test strip count logic,” as claimed. *See* Appeal Br. 18. According to Appellant, “[the] prior art teaches away from generating a test strip use signal only when the blood sample is detected and teaches generating a test strip use signal when the test strip is inserted in the glucose meter.” Appeal Br. 18. Contrary to Appellant’s arguments, Cohen teaches that its handheld blood-glucose meter, upon receiving a blood-glucose

measurement, sends signals (including the user’s blood-glucose measurements) to the remote processing center, and the remote processing center uses those signals to count the number of strips that have been used. *See* Ans. 4–5; Cohen ¶¶ 21–24, 33, 74 (“as the processing center 40 receives glucose measurements, a count is maintained of the number of test strips processed from each lot”). Based on the cited disclosures, we agree with the Examiner’s findings that Cohen teaches or at least reasonably suggests the claimed logic and signals.

Finally, we disagree with Appellant’s arguments based on *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966) and *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 402 (2007). Appeal Br. 20–21. As explained in *KSR*, *Graham* set out a framework for applying the statutory language of § 103, and, prior to *KSR* under that framework, courts had applied a “teaching, suggestion, or motivation” test that required “some motivation or suggestion to combine the prior art teachings [to] be found in the prior art.” *KSR*, 550 U.S. at 406–07 (internal quotation and citations omitted). Contrary to Appellant’s arguments that a teaching, suggestion, or motivation “is a necessary pre-requisite to be able to combine . . . prior art references” (Appeal Br. 20; Reply Br. 7), *KSR* expressly rejected a “rigid” application of the “teaching, suggestion, or motivation” test (*KSR*, 550 U.S. at 415). Regardless, we agree with the Examiner that Cohen does provide a teaching, suggestion, or motivation that would have lead a person of ordinary skill in the art at the time of Appellant’s invention to combine the teachings of the prior art to arrive at the claimed invention—Cohen expressly recognizes the inconvenience of relying on a remote processing center. *See* Ans. 3 (citing Cohen ¶ 35). As explained above, we agree with the Examiner that at the

time of Appellant's invention, a person of ordinary skill would have recognized the benefit of using the improved processing capabilities available at that time to use a handheld device's processor to perform the functions that had previously (inconveniently) required the use of a remote processing center.

As Appellant does not address the Examiner's findings regarding what a person of ordinary skill would have understood from the combined teachings of the prior art at the time of Appellant's invention, Appellant has not persuasively rebutted the Examiner's findings and conclusions of obviousness. Having considered the Examiner's rejection in light of each of Appellant's arguments and the prior art of record, we disagree with Appellant and agree with the Examiner's findings and conclusions. Accordingly, we sustain the Examiner's rejection of claim 1, as well as the rejections of claims 2–13, for which Appellant relies on the arguments advanced for claim 1.

#### DECISION

We affirm the Examiner's rejection of claims 1–13.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED