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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* NEIL L. MCCLURE and RALPH DAVID WIELAND

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Appeal 2018-005806  
Application 14/738,800  
Technology Center 2600

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Before ALLEN R. MacDONALD, ADAM J. PYONIN, and  
PHILLIP A. BENNETT, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a Non-Final rejection of claims 1–64.<sup>2</sup> We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM.

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<sup>1</sup> Appellants indicate the real party in interest is the inventors Neil L. McClure and Ralph David Wieland. Appeal Br. 1.

<sup>2</sup> We find no basis for Appellants’ statement that “[c]laim 3 is withdrawn from consideration as being directed to a non-elected species.” Appeal Br. 3.

*Illustrative Claims*

Illustrative claims 1 and 17 under appeal read as follows (emphasis, formatting, and bracketed material added):

1. A system comprising:

- [A.] a monitor that is ***constructed and arranged for communicating*** with a mobile device;
- [B.] an alert device separate from the mobile device;
- [C.] a software application running on the mobile device for programmatic control of communication with the monitor;
- [D.] wherein the software application periodically communicates its operational status to the alert device, and
- [E.] the alert device being programmed with logic for delivery of notification commensurate with the operational status of the software application.

17. A system, comprising:

- [A.] a central monitoring system with wireless communication capability used for monitoring an entity or process;
- [B.] ***at least one*** mobile device in communication with the central monitoring system, said communication containing parameters associated with the monitored entity or process;
- [C.] the mobile device being capable of communicating the parameters through a software application that presents the parameters to a user through a graphical user interface of the mobile device;
- [D.] an independent alert device in communication with the mobile device;

[E.] wherein the communication between the mobile device and the independent alert device indicates of the operational status of the mobile device and/or the software application;

[F.] the independent alert device producing an alarm condition if the operational status of the mobile device and/or the software application indicates an error condition.

*Reference*<sup>3</sup>

Ballantyne et al. US 2013/0317837 A1 Nov. 28, 2013

*Rejections*<sup>4</sup>

A.

The Examiner rejected claims 1–8, 12, 13, 15–24, 28–40, 44–56, and 60–64 under 35 U.S.C. § 103 as being unpatentable over Ballantyne. Non-Final Act. 6–32, 39, 41–56, 59–61, and 64–65.

Although the Examiner structures this § 103 rejection based solely on Ballantyne as fifteen separate § 103 rejections, it is in fact a single ground of rejection with fifteen analyses. The Appellants acknowledge:

In essence, Issue 1 encompasses the independent claims 1, 33 and 49. The language of these claims contain common features such that they may be discussed as a unit that stands or falls together on appeal. Thus, the Board’s determination on Issue 1 is dispositive as to claims 1-16 and 33-64, which include the independent claims 1, 33 and 49 plus the related dependent claims. . . .

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<sup>3</sup> All citations herein to this reference are by reference to the first named inventor only.

<sup>4</sup> All citations herein to the “Non-Final Action” are to a Non-Final Action mailed on August 3, 2017.

Of the independent claims, only independent claim 17 lacks the [*ipsissimis*] *verbis* recitations of elements found in claims 1, 33 and 49; however, claim 17 presents essentially the same concepts stated in alternative language. Accordingly, claims 17-32 are broken out as a separate group for purposes of this appeal. Even so, the Office Action under appeal utilizes the same language and bases for rejecting both groups of claims so the same arguments apply equally to both groups of claims.

Appeal Br. 12.

Appellants argue separate patentability for claim 1, 17, and 30. To the extent that Appellants discuss claims 2–8, 12, 13, 15, 16, 18–24, 28, 29, 31–40, 44–56, and 60–64, Appellants merely repeat or reference the arguments directed to claims 1 and 17. Such a repeated argument (or referenced argument) is not an argument for “separate patentability.” Thus, Appellants do not present separate arguments for claims 2–8, 12, 13, 15, 16, 18–24, 28, 29, 31–40, 44–56, and 60–64. We select claims 1, 17, and 30 as the representative claims for this rejection. Except for our ultimate decision, we do not address claims 2–8, 12, 13, 15, 16, 18–24, 28, 29, 31–40, 44–56, and 60–64 further herein.

B.

The Examiner rejects claims 9–11, 14, 25–27, 41–43, and 57–59 under 35 U.S.C. § 103(a) as being unpatentable over Ballantyne in various combinations with additional references. Non-Final Act. 32–38, 40–41, 56–59, and 62–64.

To the extent that Appellants discuss claims 9–11, 14, 25–27, 41–43, and 57–59, Appellants merely repeat or reference the arguments directed to claims 1 and 17. Again, such a repeated argument (or referenced argument) is not an argument for “separate patentability.” Thus, Appellants do not present separate arguments for claims 9–11, 14, 25–27, 41–43, and 57–59,

and the rejections of these claims turn on our decisions as to claims 1 and 17. Except for our ultimate decision, we do not address the § 103 rejections of claims 9–11, 14, 25–27, 41–43, and 57–59 further herein.

*Issue on Appeal*

Did the Examiner err in rejecting claims 1, 17, and 30 as being obvious?

ANALYSIS

We have reviewed the Examiner’s rejections in light of Appellants’ arguments (Appeal Brief and Reply Brief) that the Examiner has erred. We disagree with Appellants’ conclusions.

1.a.

Appellants contend that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a) because:<sup>5</sup>

The Office Action commits error in the first instance by ***incorrectly determining that Ballantyne teaches the use of a mobile device*** when, in fact, the language that the Office Action relies upon is in paragraph 544 of Ballantyne and ***actually teaches away from using a mobile device***.

Appeal Br. 13 (emphasis added).

The Office Action commits a fundamental error by mischaracterizing Ballantyne when it says, in regard to the embodiment of Fig. 18 (the “first embodiment” of this rejection), that “[m]onitoring client 1302 can be a tablet, a smart phone, or a PDA as stated in par. 544” (see the Office Action at p. 4, last paragraph) and that “the tablet, the smart phone, and the PDA are

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<sup>5</sup> Although Appellants present this contention in alternative forms, we reproduce only this one. The result is the same for each alternative for the same reasons.

all monitoring clients usable in the configuration shown in Fig. 18[”] page 3 of the Office Action, last paragraph. *The Office Action fails to point to any passage that says the tablet, smart phone or PDA of the first embodiment is a monitoring client*, so Ballantyne does not provide the asserted support for the rejection. In particular, the Examiner’s interpretation is backwards from the actual language of Ballantyne at paragraph 544, which states:

The monitoring client 1302 may be substituted for any monitoring client described herein, such as monitoring clients 1, 4, or 11 of FIGS. 1, 3, 5, 7, 8, monitoring clients 9, 4, or 11 of FIG. 9, a tablet, a smart phone, a PDA, or the like.

Appeal Br. 16 (emphasis added).

The Examiner responds:

Examiner respectfully disagrees with Appellant’s argument. Ballantyne states in par. 544, “monitoring client 1302 may be substituted for any monitoring client described herein, such as . . . a tablet, a smart phone, a PDA, or the like”, wherein the monitoring client 1302 is a monitoring client described herein such as a table, a smart phone, a PDA, or the like. Par. 544 explicitly states that any monitoring client described herein are such as a tablet, a smart phone, a PDA, or the like.

Furthermore, Ballantyne states in par. 95, “monitoring client may be one of a desk-based device, a portable device, a hand-held controller, a notebook PC, a netbook PC, a tablet PC, and a smart phone (~mobile devices).

Ans. 7–8 (emphasis omitted).

Appellants further contend as to paragraph 544 of Ballantyne:

None of the rejections on appeal can be sustained if Ballantyne does not teach the use of a mobile device as claimed. Page 3 of the Examiner’s Answer correctly quotes Ballantyne as saying that monitoring client 1302 may be “substituted **for** [emphasis added]” a tablet, smart phone or PDA. *The word “for” connotes a one-way substitution* where the mobile devices of a

tablet, smart phone or PDA are replaced by the new monitoring client 1302, which is used in lieu of those devices. It necessarily follows that the monitoring client cannot be a tablet, smart phone or PDA because those are the things being replaced. Therefore, the embodiment of Fig. 18 does not include the mobile device as claimed.

...

The Answer next refers to Paragraph 95 of Ballantyne to propose that that a “monitoring client” may be a mobile device as claimed. See the Answer in the first paragraph of page 5. Paragraph 95 resides in the Summary portion of Ballantyne and *merely describes “another embodiment” that is not necessarily the embodiment of Fig. 18*. This use of Paragraph 95 is unwise. The phrase “another embodiment” is not directed towards any particular embodiment, especially when it is understood that Ballantyne contains many different embodiments that are disclosed in 157 total figures and 823 written paragraphs. Significantly also, Paragraph 95 of Ballantyne provides no guidance *why* the substitution should be made in such a manner as to ignore the “for” word as discussed above. As to the embodiment shown in Fig. 18 of Ballantyne, *the word “for” is controlling and negates the more general guidance* of Paragraph 95, which is best read as applying to other embodiments.

Reply Br. 4–5 (emphasis added).

As to Appellants’ assertion, we disagree. Appellants’ argument is premised on a strained “one-way” reading of Ballantyne’s paragraph 544 while discounting Ballantyne’s paragraph 95. We conclude that both premises are contrary to our reviewing courts guidance. “A person of ordinary skill is also a person of ordinary creativity, not an automaton.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007). A reference may be relied upon for all that it would have reasonably suggested to one having

ordinary skill the art, including non-preferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804 (Fed. Cir. 1989).

We agree with the Examiner’s findings that (a) “Ballantyne teaches a system comprising: a dock attached to a monitor that is constructed and arranged for communicating with a mobile device (In fig. 18, Patient-Care Device (element 1320/1318) is a monitor that communicates with a mobile device (Monitoring Client, element 1302)” (Non-Final Act 6), and (b) Ballantyne at paragraph 95 teaches “monitoring client may be one of a desk-based device, a portable device, a hand-held controller, a notebook PC, a netbook PC, a tablet PC, and a smart phone.” Further, contrary to Appellants’ assertion that Ballantyne “teaches away” from using a mobile device, we conclude that Ballantyne explicitly teaches that a mobile device may be used.<sup>6</sup>

As the United States Court of Appeals for the Federal Circuit has counseled:

A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. . . . [I]n general, a reference will teach away if it suggests that the line of development flowing from the reference’s disclosure is unlikely to be productive of the result sought by the applicant.

*In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). “A reference does not teach away, however, if it merely expresses a general preference for an alternative

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<sup>6</sup> Even if we were to adopt Appellants’ “one-way” reading of Ballantyne, ultimately we would arrive at the same result because an artisan would understand “one-way” substitution to be suggestive of “two-way” substitution.

invention but does not ‘criticize, discredit, or otherwise discourage’ investigation into the invention claimed.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1327 (Fed. Cir. 2009) (quotation omitted).

1.b.

The Examiner Finds:

Patient-Care Device (element 1320/1318) is a monitor that communicates with a mobile device (Monitoring Client, element 1302); “a wireless dock 1306 having a patient-care device (~monitor) 1320” . . . “the wireless dock 1306 wirelessly communicates with the monitoring client 1302 (~mobile device)”, [0546].

Non-Final Act. 6 (emphasis omitted).

Appellants contend that the Examiner erred in this finding because:

The Office Action then ***compounds*** [the Ballantyne teaches the use of a mobile device] ***error by determining that the mobile device communicates directly with the monitor as claimed***, when in fact this is not the case.

What is claimed differs from the disclosure of Ballantyne because the claimed system is designed for a different purpose than is that of Ballantyne where Ballantyne does not permit a user to use a mobile device in monitoring the status of a device, and the multi-path communications system of the claims is more robust for this purpose because ***the mobile device as claimed communicates with the alert device through a separate and independent communication channel than is used for the monitor*** whereas Ballantyne requires the alert device to facilitate communication between the purported mobile device and monitor.

Appeal Br. 13 (emphasis added).

The rejection compounds its error by incorrectly finding that Ballantyne teaches a mobile device communicating with a monitor as claimed. Specifically, Ballantyne’s patient care

device (the Examiner's proposed monitor) 1320 does not communicate with the monitoring client 1302 (the Examiner's proposed mobile device). As construed by the Examiner in combining the first and tenth embodiments of Ballantyne,[] only the wireless dock 1306 communicates with the monitoring client 1302. See page 3 of the Office Action where "[the wireless dock 1306 wirelessly communicates with the monitoring client,]" quoting Ballantyne at paragraph 546. However, the Office Action ignores the language of this same paragraph, which states that the "wireless dock 1306 may be similar to or identical to the dock 1304." Therefore, only the dock 1306/1304, and more specifically, the watchdog 1310 (the Examiner's alert device) that communicates with the patient care device 1320 (the Examiner's monitor) and the monitor client (the Examiner's mobile device). ***The patient care device 1320 does not itself communicate with the monitor client 1302. This communication can only occur via the dock 1306/1304.*** This is because the wireless dock 1306 is merely a wireless device the replicates the functionality of the dock 1304, which includes the watchdog 1310 as the unit providing communications with the monitoring client 1302.

Appeal Br. 18 (emphasis added, footnote omitted).

The Examiner responds:

Examiner respectfully disagrees with Appellant's argument. Ballantyne states in par. 72, "In another embodiment, the patient care device (~monitor) is configured to wirelessly communicate with the monitoring client (~mobile device), and wherein the monitoring client (~mobile device) wirelessly communicates the at least one patient-care parameter with the patient-care device (~mobile device)".

Ans. 8 (emphasis omitted).

Appellants further assert:

[T]he patient care device (the Examiner's monitor) does not communicate ***directly*** with the monitor client 1302 (the Examiner's mobile device) because the wireless communication must go through the dock.

Reply Br. 6 (emphasis added).

As to Appellants' assertion, we disagree. First, Appellants assert "communicates directly" and "a separate and independent communication channel" are not shown in Ballantyne. Appeal Br. 13. However, the argument is not commensurate with the scope of the claim language. The structure of claim 1 is not explicitly so limited, nor do Appellants explain how claim 1 would be inherently so limited, nor do we find alternative language that would similarly mandate the argued limitation. Although, as discussed immediately *infra*, we agree with the Examiner and not with Appellants' restrictive reading of Ballantyne, even if we were to agree with Appellants, Appellants' claim 1 does not preclude communication according to Appellants' restrictive reading that "Ballantyne requires the alert device to facilitate communication between the purported mobile device and monitor." Appeal Br. 13.

Second, we agree with the Examiner's finding that Ballantyne at paragraph 72 teaches a monitor may wirelessly communicate with a mobile device. Ans. 8.

1.c.

Appellants also present a number of other assertions as to claim 1 which we address here.

1.c.i.

Appellants assert:

[T]he Office Action applies a "tenth embodiment of Ballantyne" according to paragraph [0072] thereof, which does not describe a tenth embodiment in context of any drawing or figure. Regardless, this communication configuration does not include an alert device and therefore is irrelevant for citing as a basis of rejection. *Ballantyne utilizes the "monitoring client" in so*

*many ways* that is it impossible to tell from the generic language of paragraph [0072] just what embodiment is being discussed, nor is the paragraph [0072] of particular relevance.

Appeal Br. 16 (emphasis added). Appellants also assert:

It is revealing that the Answer also attempts to conceal the *large number of other embodiments* found in Ballantyne.

Reply Br. 5 (emphasis added).

Essentially, Appellants attack Ballantyne because it teaches too much. Based on this argument, we are not persuaded of Examiner error. “That [a] patent discloses a multitude of effective combinations does not render any particular formulation less obvious.” *Merck v. Biocraft Labs*, 874 F.2d at 807. “The criterion [] is not the number of references, but what they would have meant to a person of ordinary skill in the field of the invention.” *In re Gorman*, 933 F.2d 982, 982 (Fed. Cir. 1991).

1.c.ii.

Appellants also assert:

[W]hat is claimed separates *the two communication channels* for both content and method.

Appeal Br. 20–21 (emphasis added). At page 1 of the Reply Brief,

Appellants present drawings and assert:

The communications structure shown above places the mobile device in *the middle of two communications channels*.

Reply Br. 1 (emphasis added).

This argument is not commensurate with the scope of the claim language. The structure of claim 1 is not explicitly so limited, nor do Appellants explain how claim 1 would be inherently so limited, nor do we find alternative language that would similarly mandate the argued limitation.

1.c.iii.

Appellants further assert:

Paragraphs 551 and 552 of Ballantyne fully considered use of a mobile device in the embodiment of Fig. 18, but the mobile device in actual use there differs from what is claimed because Ballantyne solved a different problem--*a hallmark of nonobviousness*.

Reply Br. 7 (emphasis added).

As to Appellants' assertion, we unpersuaded. "[A]ny need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *KSR*, 550 U.S. at 420. Appellants' argument is directly contrary to the Supreme Court's explicit guidance.

2.

Appellants contend that the Examiner erred in rejecting claim 17 under 35 U.S.C. § 103(a) because:

[T]he patient care device of Ballantyne is not a central monitoring system because it consists of a singular unit that is not centralized in the sense of centrally monitoring *several such individual units*.

Appeal Br. 25 (emphasis added).

This argument is not commensurate with the scope of the claim language. The structure of claim 17 is not explicitly so limited, nor do Appellants explain how claim 17 would be inherently so limited, nor do we find alternative language that would similarly mandate the argued limitation. Claim 17 requires "at least one" unit, not *several* as argued.

3.

3.

Claim 30 recites: “The system of claim 17, wherein the software application communicates its operational status to an alert device.” The Examiner Finds:

Ballantyne teaches wherein a software application communicates its operational status to an alert device (“In the event the monitoring client 1 determines the cable 110 is unavailable as a communications link, the monitoring client 1 may issue an alarm or alert using a speaker and/or a vibration motor, an alarm or alert signal may be sent to the remote communicator 11 to alarm or alert the remote communicator using a speaker and/or a vibration motor”, [0354]).

Non-Final Act. 60 (emphasis omitted).

Appellants contend that the Examiner erred in rejecting claim 30 under 35 U.S.C. § 103(a) because:

Here the Examiner introduces a “remote communicator” as an additional element of the rejection, but this remote communicator is different from the watchdog 1310 of the first and tenth embodiments, and the Examiner fails to explain how this device would be introduced to that combination or even why it would be introduced.

Appeal Br. 29.

Essentially Appellants’ argument is premised on a “physical” or “bodily” incorporation of the “remote communicator” into the other teachings of Ballantyne. This is not the standard. “The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference . . . . Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art.” *In re Keller*, 642 F.2d 413, 425 (CCPA 1981); *see also In re Sneed*, 710 F.2d 1544, 1550 (Fed. Cir. 1983) (“[I]t is

not necessary that the inventions of the references be physically combinable to render obvious the invention under review.”).

The Examiner did not suggest the “remote communicator” should be bodily incorporated. Rather, the Examiner relied on the “remote communicator” to show it is known in the prior art to have “a software application communicate[] its operational status to an alert device.” Non-Final Act. 60. Appellants go beyond this to incorporate features of the entire “remote communicator,” which were not relied upon by the Examiner. Appellants then argue the features the Examiner did not rely upon. We are unpersuaded by this form of argument.

#### CONCLUSIONS

- (1) The Examiner has not erred in rejecting claims 1–64 as being unpatentable under 35 U.S.C. § 103(a).
- (2) Claims 1–64 are not patentable.

#### DECISION

The Examiner’s rejections of claims 1–64 are affirmed.

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