UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DON T. MAK, KEVIN M. MONAGLE, SRI RAMANATHAN, JEAN-GAEL F. REBOUL, MATTHEW A. TERRY, and MATTHEW B. TREVATHAN

Appeal 2018-005932
Application 12/984,191
Technology Center 3600

Before CAROLYN D. THOMAS, HUNG H. BUI, and SCOTT RAEVSKY, *Administrative Patent Judges.*

RAEVSKY, *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 23, 24, and 30–36. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

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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 International Business Machines Corporation. Appeal Br. 2.

CLAIMED SUBJECT MATTER

The claims relate to a system and method for managing events in a smart grid. *See* Spec., Abstract. Claim 23, reproduced below, is illustrative of the claimed subject matter:

> 23. A method of managing electrical consumption, comprising:
>> providing a computer infrastructure, being operable to:
>> send, by a smart meter of a subscriber, a Session Initiation Protocol (SIP) register message to a remote register in a network;
>> monitor, by the smart meter, electrical consumption and potential critical electrical events of at least one electrical device connected to the smart meter;
>> record, by the smart meter, the electrical consumption and a critical electrical event of the at least one electrical device at a client specified location, wherein the critical electrical event comprises at least one of a malfunction, a problem, and an electrical fault with the at least one electrical device;
>> send, by the smart meter, a SIP notify message comprising presence information of the critical electrical event of the at least one electrical device at the client specified location, to a remote presence server in the network, wherein the presence server is configured to store presence information of the smart meter and a subscriber device of the subscriber;
>> receive, by the smart meter, from a remote watcher device in communication with the presence server, at least one rule set by the subscriber wherein the at least one rule comprises at least one action to take in response to the critical electrical event; and
>> perform, by the smart meter, the at least one action to take in response to the critical electrical event to initiate changes to the at least one electrical device.

REJECTIONS

Claims 23, 24, and 30–36 stand rejected under 35 U.S.C. § 112 (pre-AIA), second paragraph, as being indefinite. Final Act. 2.

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Claims 23 and 30–36 stand rejected under pre-AIA 35 U.S.C § 103(a) over Nacke (US 8,340,832 B1, Dec. 25, 2012), Batterberry (US 2010/0138363 A1, June 3, 2010), and Yamamoto (US 2009/0015711 A1, Jan. 15, 2009). *Id.* at 3 –4.

Claim 24 stands rejected under pre–AIA 35 U.S.C. § 103(a) as being unpatentable over Nacke, Batterberry, Yamamoto, and Tu (US 2008/0270542 A1, Oct. 30, 2008). *Id.* at 9.

We review the appealed rejections for error based upon the issues identified by Appellant and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential).

ANALYSIS

Rejection under § 112

In the Final Action, the Examiner finds the following limitation of claim 23 (and a similar limitation in claim 33) indefinite: "perform[,] by the smart meter, the at least one action to take in response to the critical electrical event to initiate changes to the at least one electrical device." Final Act. 2. The Examiner finds this limitation "unclear because it is inconsistent with Applicant's specification." *Id.* The Examiner points to the Specification's teaching of "send[ing] a rule comprising at least one action to take in response to the monitored state of the at least one electrical device, to the smart meter" and finds "this does not [mean] that the smart meter actual[ly] performs some action as required by the claim." *Id.* at 2–3 (citing Spec. ¶¶ 3–7, 57).

Appellant contends, "the Examiner appears to be arguing that the claim phrase at issue is not supported by the specification, which is not an argument applicable to a § 112 indefiniteness rejection." Appeal Br. 5. In

any event, Appellant contends, "[o]ne of ordinary skill in the art would understand that the smart meter actually performs an action to take." *Id.* Appellant points to the following portions of the Specification as support:

> For example, the subscriber (user) device 210 can send notifications to the utility manager 105 regarding the managing of electrical consumption in a house or other location, via the use of the smart meter 205. Illustratively, through SIP messaging, <u>the subscriber (e.g., user) 210 can instruct the utility manger 105 to turn off an appliance, e.g., air conditioner, *using the logic of the smart meter* 205</u>.

> At step S445, the watcher 340 may send the rule indicating the *actions to take to the smart meter* 205 or may perform (initiate) actions necessary to make changes in the smart grid, such as control the smart meter 205.

> In another example, the subscriber can react to a notification "in-band," e.g., send an SIP message via a smartphone *to his or her smart meter at home to decrease a thermostat temperature*.

Id. at 5–6 (quoting Spec. ¶¶ 30, 57, 48) (certain emphasis added).

The Examiner responds, "Applicant's specification does not describe structure with the smart meter that would have accomplished 'the smart meter performs action' as recited by the claim." Ans. 12. The Examiner also finds that paragraph 48 of the Specification (quoted above) "does not require that the smart meter necessarily or inherently perform[] actions." *Id.* Yet the Examiner also states the rejection "is not [an] attempt to introduce 112 first paragraph as Appellant assert[s]." *Id.*

We disagree. The Examiner's rejection is plainly a rejection under § 112, first paragraph, "under the guise of a [§] 112, second paragraph rejection." *See* Reply Br. 2. Regardless, Appellant's citations to the

Specification persuade us that the Specification supports the disputed claim language. *See* Appeal Br. 5 (quoting Spec. ¶¶ 30, 57, 48).

Therefore, we do not sustain the Examiner's § 112 rejection.

Rejections under § 103(a)

Appellant contends the combination of Nacke, Batterberry, and Yamamoto fails to teach or suggest "wherein the critical electrical event comprises at least one of a malfunction, a problem, and an electrical fault with the at least one electrical device," as recited in claim 23. *See* Appeal Br. 13.

Appellant contends that neither Nacke nor Batterberry teach determining any problem with an electrical device connected to a smart meter. *Id.* at 14. Rather, Appellant contends, "Batterberry teaches optimizing energy consumption based on *pricing information*." *Id.* Appellant also contends that Batterberry's price report module 245, which sends the pricing information, "is not a smart meter and would not inherently have knowledge of some critical event of a remote electrical device, and therefore, the pricing information coming from the price report module 245 would not inherently include some critical event." *Id.* (internal citation omitted). Batterberry, Appellant contends, "is concerned with balancing energy supplies using energy prices," not "with any critical electrical events of an electrical device at a client specified location (e.g., air conditioner)." *Id.*

In response, the Examiner takes the position that "the pricing signal would . . . inherently include some critical event compris[ing] at least a problem in order to trigger the smart meter [to] perform the turning off

(action) for the device." Ans. 18. The Examiner also finds, "there is no restriction on what type of a problem and since 'a problem' is broad as being recited, therefore the problem could also be the cost of electricity as shown in Batterberry as [t]he Examiner indicated above." *Id.*

In the Reply, Appellant argues, "the pricing signal indicated by the Examiner in Nacke is a signal that is sent <u>to</u> the smart meter 240 of Batterberry, it is not a signal <u>from</u> the smart meter 240 and does not concern 'a critical electrical event' recorded by the smart meter 240." Reply Br. 6. Appellant also contends, "the Examiner's assertion that the smart meter would capture data indicating a problem of the device is mere speculation, and inconsistent with the teachings in Batterberry." *Id.* at 7. Further, Appellant disagrees with the Examiner's finding of inherency, contending, "it would not be reasonable to interpret 'the cost of electricity' as 'a critical electrical event <u>of the at least one electrical device</u> at a client specified location' wherein the critical electrical event comprises 'a problem . . . with the at least one electrical device." *Id.* at 8; *see also* Appeal Br. 13–14 (contesting Examiner's similar inherency findings in the Final Action).

We agree with Appellant. In general, a limitation is inherent if it is the "'natural result flowing from' the explicit disclosure of the prior art." *Schering Corp. v. Geneva Pharms.*, 339 F.3d 1373, 1379 (Fed. Cir. 2003) (citation omitted). "Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient." *MEHL/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1362, 1365 (Fed. Cir. 1999) (quoting *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981)). The Examiner incorrectly finds inherency here, as the claimed "critical electrical event" is not the natural result flowing from

Batterberry's disclosure of a "pricing signal." To the contrary, Batterberry's "real-time pricing" is "determined . . . based on energy usage forecasts . . . us[ing] a probabilistic or statistical model to evaluate the behavior of one or more groups of energy consumers 210 over time," not based on a "critical electrical event" as claimed. Batterberry ¶ 33.

We also agree with Appellant that "the Examiner's assertion that the smart meter would capture data indicating a problem of the device is mere speculation, and inconsistent with the teachings in Batterberry." *See* Ans. 18; Reply Br. 7. Further, we agree with Appellant that "it would not be reasonable to interpret 'the cost of electricity' as 'a critical electrical event <u>of the at least one electrical device</u> at a client specified location' wherein the critical electrical event comprises 'a problem . . . with the at least one electrical device." Reply Br. 8.

We note the Examiner has not relied on any of the other cited references to teach this element. Accordingly, we do not sustain the Examiner's rejection of claim 23 and its corresponding dependent claims. Independent claim 33 recites identical language to the above-quoted limitation of claim 23. Accordingly, we also do not sustain the Examiner's rejection of claim 33 and its corresponding dependent claims.

We do not reach Appellant's further allegations of error because we find the issue discussed above to be dispositive of the rejection of all the pending claims.

CONCLUSION

In summary,

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
23, 24, 30–36	112 ¶ 2	Indefiniteness		23, 24, 30–36
23, 30–36	103(a)	Nacke, Batterberry, Yamamoto		23, 30–36
24	103(a)	Nacke, Batterberry, Yamamoto, Tu		24
Overall Outcome:				23, 24, 30–36

<u>REVERSED</u>