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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte NIGEL KELLY

Appeal 2018-006129
Application 14/600,700
Technology Center 3700

Before PHILLIP J. KAUFFMAN, JEREMY M. PLENZLER, and
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

FINAMORE, *Administrative Patent Judge*.

DECISION ON REHEARING

STATEMENT OF THE CASE

Pursuant to 37 C.F.R. § 41.50(b)(2), Appellant filed a Request for Rehearing on August 7, 2019 (“Req. Reh’g”) seeking reconsideration of our Decision on Appeal mailed June 7, 2019 (“Dec.”), which includes new grounds of rejection. We have jurisdiction over the Request for Rehearing under 35 U.S.C. § 6(b).

ANALYSIS

A 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.” 37 C.F.R. § 41.50(b)(2). Arguments not raised and evidence not previously relied upon in the briefs on appeal are not permitted on rehearing, except an appellant may present new arguments responding to a new ground of rejection in a decision on appeal. *Id.* § 41.52(a)(3).

Appellant argues the Board misconstrued the term “predefined criteria” recited in independent claims 17 and 21. Req. Reh’g 1–4. More specifically, Appellant contends the Board mistakenly determined “predefined criteria” means criteria independent of the data being compared thereto, i.e., data representative of the banknote. *Id.* at 1–2 (citing Dec. 7). According to Appellant, “the plain meaning of ‘predefined’ properly includes a temporal element.” *Id.* at 3. Appellant argues “[the Specification’s] illustrated embodiments (showing scanning/determining data immediately followed by the comparison), along with the temporal aspect inherent to the word ‘predefined’ necessitates that claims 17 and 21 require that the criteria must be defined prior to scanning the banknote.” *Id.* at 4 (referencing Spec., Figs. 3–4). Appellant further argues that “once the temporal element of the term ‘predefined’ is properly considered, the qualification numbers of Parham cannot be considered ‘predefined’ at all, as they occur immediately before the comparison happens (and after the scanning has occurred).” *Id.* at 3.

When construing claims,

the PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification.

In re Morris, 127 F.3d 1048, 1054 (Fed. Cir. 1997); *see also Chef Am., Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371 (Fed. Cir. 2004) (explaining claim terms are to be given their ordinary meaning, absent any indication that their use in a particular context changes their meaning). The Federal Circuit also has explained:

“Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment.”

Superguide Corp. v. DirectTV Enters., Inc., 358 F.3d 870, 875 (Fed. Cir. 2004); *see also Liebel-Flarsheim Co. v. Medrad Inc.*, 358 F.3d 898, 906 (Fed. Cir. 2004) (explaining the court has expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment).

We agree with Appellant that “predefined” includes a temporal element. The ordinary meaning of “predefine” is to “define in advance.” *Predefine*, Collins English Dictionary – Complete and Unabridged (12th ed. 2014). There is no definition of “predefined” in the Specification or any indication that the term is used in a manner different from its ordinary meaning.

In view of this meaning of “predefined,” the term “predefined criteria” requires that the criteria be defined in advance. Yet, neither the term, nor the remaining claim language, specifies in advance of what. The Specification does not include the term “predefined criteria,” but does include two instances of a similar term, “predetermined criteria.” Namely, the Specification explains that “the image recognition module 20 generates

an output signal 21, which is fed to a decision-making module 22 in which is run an algorithm for comparing the data 21 received from the image recognition module 20 against predetermined criteria.” Spec.¹ 5:14–16. The Specification also explains “the criteria for whether or not a promotional reward is to be offered is based on the face value of the note, so the determined face value is then compared against the predetermined criteria for offering a promotional reward.” *Id.* at 6:20–23. The Specification, however, does not describe when the predetermined criteria is defined. As neither the claim language nor the Specification explains when the predefined criteria is defined, Appellant’s assertion that “predefined criteria” means criteria defined in advance of scanning a banknote impermissibly reads a limitation into the claims.

Although the term “predefined criteria” does not specify in advance of what the criteria is defined, the criteria must be defined in advance of at least the comparison to the criteria. *See* Req. Reh’g 1–2 (agreeing with the Board’s determination that predefined criteria must be defined before the comparison, “as in order for a comparison to take place, the two things being compared must obviously be known prior to the comparison”). It is also significant that the criteria is independent of the data compared thereto, i.e., the banknote data. Dec. 7 (“[W]hat is significant is that the data representative of the banknote is compared to criteria independent of the data.”). Pursuant to the broadest reasonable interpretation, “predefined criteria” means criteria defined before the comparison and independent of the data compared thereto. Giving “predefined criteria” its broadest reasonable interpretation, Parham’s randomly-generated qualification

¹ Specification filed Jan. 20, 2015.

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numbers disclose the recited “predefined criteria” for the reasons in the Decision on Appeal. *Id.* Accordingly, Appellant has not shown error in the new ground of rejection of independent claims 17 and 21.

DECISION

Upon consideration of Appellant’s arguments on rehearing, we deny the request to modify the outcome of the Decision on Appeal.

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

DENIED

Notice of References Cited	Application/Control No.	Applicant(s)/Patent Under Patent Appeal No.	
	Examiner	Art Unit	Page 1 of 1

U.S. PATENT DOCUMENTS

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precurer (pri:'kɜ:tə) *n* archaic a precursor, forerunner

precurse (pri:'kɜ:s) *n* archaic a foreshadowing or precursing ▷ *vb* (tr) **2** literary to foreshadow or be a precursor of, to herald ■ **precursor** (pri:'kɜ:sə) *n* 1 a person or thing that precedes and shows or announces someone or something to come; harbinger **2** a predecessor or forerunner **3** a chemical substance that gives rise to another more important substance [C16: from Latin *praecursor* one who runs in front, from *praecurrere*, from *prae* in front + *currere* to run] ■ **precursory** (pri:'kɜ:səri) or **precursive** *adj* 1 serving as a precursor **2** preliminary or introductory

precut (pri:'kʌt) *n* 1 any precut item **2** an initial cut made in a coalface prior to the main mining process ▷ *adj* **3** cut in advance (of a building) made of precut materials ▷ *vb* (tr) **5** to cut (esp building materials) to the desired shape and size in advance **6** to make an initial cut into (a coalface) before mining the coal

pred. abbreviation for predicate

predacious or **predaceous** (pri:'deɪʃəs) *adj* 1 (of animals) habitually hunting and killing other animals for food **2** preying on others [C18: from Latin *praeda* plunder; compare PREDATORY] ▷ **predaciousness**, **predaceousness** or **predacity** (pri:'deɪʃɪtɪ) *n*

predate (pri:'deɪt) *vb* (tr) 1 to affix a date to (a document, paper, etc) that is earlier than the actual date **2** to assign a date to (an event, period, etc) that is earlier than the actual or previously assigned date of occurrence **3** to be or occur at an earlier date than; precede in time

predation (pri:'deɪʃən) *n* a relationship between two species of animal in a community, in which one (the predator) hunts, kills, and eats the other (the prey)

predatism ('predətɪzəm) *n* the state of preying on other animals; the behaviour of a predator

predative ('predətɪv) *adj* another word for **predatory**

predator ('predətə) *n* 1 any carnivorous animal **2** a predatory person or thing ■ **predatory** ('predətəri, -trɪ) *adj* 1 zoology another word for **predacious** (1) **2** of, involving, or characterized by plundering, robbing, etc [C16: from Latin *praedātorius* rapacious, from *praedāri* to pillage, from *praeda* booty] ▷ **predatorily** *adv* ▷ **predatoriness** *n* ■ **predatory pricing** *n* commerce offering goods or services at such a low price that competitors are forced out of the market

predawn (pri:'dɔ:n) *n* 1 the period before dawn ▷ *adj* **2** before dawn ▷ *adv* **3** before dawn

predeath (pri:'deθ) *adj* occurring before or in the lead-up to death; of or pertaining to the period immediately prior to death

predebate (pri:'di:'beɪt) *adj* occurring or produced before a given debate; of or pertaining to the period leading up to a given debate

predecease (pri:'di:'si:s) *vb* 1 to die before (some other person) ▷ *n* **2** rare earlier death

predecessor ('pri:di:'sesə) *n* 1 a person who precedes another, as in an office **2** something that precedes something else **3** an ancestor; forefather [C14: via Old French from Late Latin *praedecessor*, from *prae* before + *dēcedere* to go away, from *dē* away + *cēdere* to go]

prededuct (pri:'di:'dʌkt) *adj* 1 US preceding deduction, done or carried out prior to a deduction being made ▷ *vb* (tr) **2** to deduct beforehand

predefine (pri:'di:'fai) *vb* (tr) to define in advance ■ **predefinition** (pri:'di:'fɪ'nɪʃən) *n* the process or action of defining in advance; an advance definition

predelivery (pri:'di:'lɪvəri) *n* 1 the act of delivering in advance of need, use or expectation of the thing delivered ▷ *adj* **2** of, pertaining to or occurring in the period prior to a delivery being made

predella (pri:'delə; Italian *pre'della*) *n*, pl **-le** (-li; Italian **-le**) 1 a painting or sculpture or a series of small paintings or sculptures in a long narrow strip forming the lower edge of an altarpiece or the face of an altar step or platform **2** a platform in a church upon which the altar stands [C19: from Italian: stool, step, probably from Old High German *bret* board]

predentate (pri:'dentetɪ) *adj* 1 of an infant whose teeth have not yet developed; occurring during or pertaining to this period of development **2** of or pertaining to the *Predentata* (also called *Ornithischia*), an order of dinosaur possessing a predatory bone

predeparture (pri:'di:'pɑ:tʃə) *adj* of, pertaining to or implemented during the stage prior to departure

predeposit (pri:'di:'pɒzɪt) *vb* (tr) to deposit beforehand or for future use

predesign (pri:'di:'zai) *vb* (tr) to design beforehand or in advance

predesignate (pri:'deɪzɪnət) *adj* 1 logic in the terminology of Sir William Hamilton, of a proposition or term that has been explicitly quantified ▷ *vb* (tr) **2** to designate in advance **3** logic in the terminology of Sir William Hamilton, explicitly to assign a quantity to (a proposition or term) ■ **predesignation** (pri:'deɪzɪn'eɪʃən) *n* 1 the action of designating in advance; an instance thereof, an advance designation **2** logic in the terminology of Sir William Hamilton, an indication or sign of quantity affixed to a proposition or term ■ **predesignatory** (pri:'deɪzɪn'eɪtəri) *adj* logic in the terminology of Sir William Hamilton, (of a sign) affixed to a proposition or term to indicate quantity

predestine (pri:'destɪn) or **predestinate** *vb* (tr) 1 to foreordain; determine beforehand **2** *theol* (of God) to decree from eternity (any event, esp the final salvation of individuals) [C14: from Latin *praedestināre* to resolve beforehand, from *destināre* to determine, DESTINE] ▷ **predestinable** *adj*

■ **predestinarian** (pri:'destɪ'nɛəriən) *theol n* 1 a person who believes in divine predestination ▷ *adj* **2** of or relating to predestination, or characterizing those who believe in it ▷ **predestinarianism** *n*

■ **predestinate** *vb* (pri:'destɪ,neɪt) (tr) another word for **predestine** ▷ *adj* (pri:'destɪnɪt, -neɪt) **2** predestined or foreordained **3** *theol* subject to predestination; decided by God from all eternity ■ **predestination** (pri:'destɪ'neɪʃən) *n* 1 *theol a* the act of God foreordaining every event from eternity **b** the doctrine or belief, esp associated with Calvin, that the final salvation of some of mankind is foreordained from eternity by God **2** the act of predestining or the state of being predestined ■ **predestinative** (pri:'destɪnətɪv) *adj* predestinating; of the nature of or concerned with predestination ■ **predestinator** (pri:'destɪ,neɪtə) *n* 1 *theol* God, regarded as the entity that predestines or foreordains **2** a person who predestines or foreordains **3** another word for **predestinarian** ■ **predestined** (pri:'destɪnd) *adj* foreordained or determined beforehand ■ **predestiny** (pri:'destɪnɪ) *n* predestination; pre-determined destiny

predetermine (pri:'di:'tɜ:mɪn) *vb* (tr) 1 to determine beforehand **2** to influence or incline towards an opinion beforehand; bias ▷ **predetermination** *n* ▷ **predeterminative** *adj* ▷ **predeterminer** *n* ■ **predeterminable** (pri:'di:'tɜ:mɪnəbəl) *adj* able to be predetermined; able to be determined in advance ■ **predetermine** (pri:'di:'tɜ:mɪnɪt, -neɪt) *adj* determined beforehand; predetermined ▷ **predeterminately** *adv* ■ **predetermined** (pri:'di:'tɜ:mɪnd) *adj* 1 determined beforehand **2** influenced or inclined towards an opinion beforehand; biased ■ **predeterminism** (pri:'di:'tɜ:mɪnɪzəm) *n* the belief that everything is predetermined

predevaluation (pri:'di:'vælju:'eɪʃən) *adj* of or pertaining to the period prior to devaluation of a given thing

predevelop (pri:'di:'veləp) *vb* (tr) to develop in advance ■ **predevelopment** (pri:'di:'veləpmənt) *n* 1 advance development; the action of developing in advance ▷ *adj* **2** of or pertaining to the period prior to the development of a given thing; occurring or implemented during this period

predevote (pri:'di:'vəʊt) *adj* 1 archaic predestined, predetermined ▷ *vb* (tr) **2** to devote or dedicate beforehand

prediabetes (pri:'daɪə:'bi:tɪs, pri:'daɪə:'bi:tɪz) *n* the early stages of diabetes; preclinical diabetes ■ **prediabetic** (pri:'daɪə:'betɪk) *med n* 1 a person suffering from prediabetes ▷ *adj* **2** of or pertaining to prediabetes; (of a person) suffering from prediabetes, liable to develop diabetes

predial ('pri:diəl) *adj* a variant spelling of **praedial**

predicament (pri:'dɪkəmənt) *n* 1 a perplexing, embarrassing, or difficult situation **2** ('predɪkəmənt) *logic obsolete* one of Aristotle's ten categories of being **3** archaic a specific condition, circumstance, state, position, etc [C14: from Late Latin *praedīcāmentum* what is predicated, from *praedīcāre* to announce, assert; see PREDICATE] ■ **predicamental** (pri:'dɪkə'mentəl) *adj* 1 of or relating to a predicament or situation **2** (esp in Aristotelian philosophy) of or relating to a category or predicament

predicant ('predɪkənt) *adj* 1 of or relating to preaching ▷ *n* **2** a member of a religious order founded for preaching, esp a Dominican **3** (pri:'dɪkənt) a variant spelling of **predikant** [C17: from Latin *praedīcāns* preaching, from *praedīcāre* to say publicly; see PREDICATE]

predicate (pri:'dɪ,keɪt) (mainly tr) 1 (also intr; when tr, may take a clause as object) to proclaim, declare, or affirm **2** to imply or connote **3** (followed by *on* or *upon*) to base or found (a proposition, argument, etc) **4** logic **a** to assert or affirm (a property, characteristic, or condition) of the subject of a proposition **b** to make (a term, expression, etc) the predicate of a proposition ▷ *n* ('predɪkɪt) **5** grammar **a** the part of a sentence in which something is asserted or denied of the subject of a sentence; one of the two major components of a sentence, the other being the subject **b** (as modifier): a predicate adjective **6** logic **a** an expression that is derived from a sentence by the deletion of a name **b** a property, characteristic, or attribute that may be affirmed or denied of something. The categorial statement *all men are mortal* relates two predicates, *is a man* and *is mortal* **c** the term of a categorial proposition that is affirmed or denied of its subject. In this example *all men* is the subject, and *mortal* is the predicate **d** a function from individuals to truth values; the truth set of the function being the extension of the predicate ▷ *adj* ('predɪkɪt) **7** of or relating to something that has been predicated [C16: from Latin *praedīcāre* to assert publicly, from *prae* in front, in public + *dīcere* to say] ▷ **predication** *n* ■ **predicable** ('predɪkəbəl) *adj* 1 capable of being predicated or asserted ▷ *n* **2** a quality, attribute, etc, that can be predicated **3** logic obsolete one of the five Aristotelian classes of predicates (the five heads of predicables), namely genus, species, difference, property, and relation [C16: from Latin *praedīcābilis*, from *praedīcāre* to assert publicly; see PREDICATE, PREACH] ▷ **predicability** or **predicableness** *n* ■ **predicate calculus** *n* the system of symbolic logic concerned not only with relations between propositions as wholes but also with the representation by symbols of individuals and predicates in propositions and with quantification over individuals. Also called: **functional calculus**. See also **propositional calculus** ■ **predicative** (pri:'dɪkətɪv) *adj* 1 grammar relating to or occurring within the predicate of a sentence: a predicative adjective. Compare **attributive** **2** logic (of a definition) given in terms that do not require quantification over entities of the same type as that which is thereby defined. Compare **impredicative** ▷ **predicatively** *adv* ■ **predicator** ('predɪ,keɪtə) *n* (in systemic grammar) the part of a sentence or clause containing the verbal group; one of the four or five major components

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