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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/162,727	05/24/2016	Matthew R. Feulner	93405US01; 67097-3386PUS1	8006
54549	7590	06/30/2020	EXAMINER	
CARLSON, GASKEY & OLDS/PRATT & WHITNEY 400 West Maple Road Suite 350 Birmingham, MI 48009			BURKE, THOMAS P	
			ART UNIT	PAPER NUMBER
			3741	
			NOTIFICATION DATE	DELIVERY MODE
			06/30/2020	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MATTHEW R. FEULNER

Appeal 2019-005106
Application 15/162,727
Technology Center 3700

Before NATHAN A. ENGELS, ERIC C. JESCHKE, and
RICHARD H. MARSCHALL, *Administrative Patent Judges*.

JESCHKE, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

Appellant¹ filed a Request for Rehearing under 37 C.F.R. § 41.52 seeking reconsideration of a prior Decision, dated April 13, 2020 (“Dec.”), in which we (1) reversed the Examiner’s decision to reject claims 1, 3–5, 8–10, 17, 18, and 20 under 35 U.S.C. § 103, (2) affirmed the Examiner’s decision to reject claims 11–16 under 35 U.S.C. § 103, designating the affirmance as a new ground of rejection, and (3) entered a new ground of

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identified United Technologies Corporation as the real party in interest. Appeal Br. 1 (dated Feb. 18, 2019).

rejection of claims 1 and 17 (and claims 3–5, 8–10, 18, and 20 based on their dependence from either claim 1 or 17) under 35 U.S.C. § 112(a) for failure to comply with the written description requirement. We have jurisdiction over the Request for Rehearing under 35 U.S.C. § 6(b).

For the reasons below, we *deny* the Request.

DISCUSSION

Appellant requests reconsideration of the new ground of rejection of claims 1, 3–5, 8–10, 17, 18, and 20 under 35 U.S.C. § 112(a), but does not otherwise assert error in the prior Decision.² *See* Req. Reh’g 4 (briefly addressing the obviousness rejections). Because our rules allow an appellant, in a request for rehearing, to present “[n]ew arguments responding to a new ground of rejection designated pursuant to §41.50(b)” (37 C.F.R. § 41.52(a)(3) (2019)), we turn to the substance of Appellant’s arguments.

Appellant notes certain passages from paragraph 39 of the Specification quoted in the prior Decision, and states, “the Board did not consider the sentences immediately prior to this selection[,] which explain that”:

[t]he rotation of the fan 130 affects the temperature and pressure of the air at each of the inlet sensor locations 152a–d. The specific affect on the temperature and pressure is dependent upon the rotational speed of the fan 130, the operating conditions of the engine, and any number of other knowable factors.

Req. Reh’g 3 (quoting Spec. ¶ 39); *see also* Dec. 10 (quoting portions of paragraph 39 of the Specification). According to Appellant, the

² The prior Decision advised Appellant of the right to either request rehearing upon the same record or reopen prosecution to further develop the record through the submission of amendments or new evidence. Dec. 20–21 (citing 37 C.F.R. 41.50(b)). Appellant chose to request rehearing.

Appeal 2019-005106
Application 15/162,727

Specification “clearly establishes that there is a thermodynamic relationship between the inlet temperature and the temperature at the claimed temperature sensor location.” Req. Reh’g 2. Appellant argues that “[o]ne of skill in the art, having the benefit” of the second of the two sentences in the block quote above, “would reasonably conclude that Appellant possessed the ability to determine the specific affect using the rotational speed of the fan, the operating conditions of the engine, and the knowable factors and reverse the specific affect to synthesize the inlet temperature from the measured temperature.” *Id.* at 3. Thus, according to Appellant, “one of skill in the art, having the benefit of Appellant’s disclosure, would be able to reasonably conclude that Appellant possessed the invention at the time of filing.” *Id.*

As noted in the prior Decision, the test for compliance with the written description requirement is “whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). “The written description requirement is not met if the specification merely describes a ‘desired result.’” *Vasudevan Software, Inc. v. MicroStrategy, Inc.*, 782 F.3d 671, 683 (Fed. Cir. 2015) (quoting *Ariad*, 598 F.3d at 1349). When assessing whether the subject matter of computer-implemented claims have adequate written description support, one should determine “whether the specification shows possession by the inventor of how [the claimed functionality] is achieved.” *Id.*; *see also* Examining Computer-Implemented Functional Claim Limitations for Compliance with 35 U.S.C. 112, 84 Fed. Reg. 57, 62 (Jan. 7, 2019) (“If the specification does not provide a disclosure of the computer and algorithm(s) in sufficient detail to demonstrate to one of ordinary skill in the art that the inventor possessed

the invention that achieves the claimed result, a rejection under 35 U.S.C. 112(a) for lack of written description must be made.”).

Even after having reconsidered the Specification in its entirety, including the sentences in paragraph 39 highlighted by Appellant in the Request for Rehearing, we maintain our prior determination that the disclosure does not show that, as of the filing date, the inventor possessed the claimed subject matter at issue—i.e., a “controller” that uses data from a sensor disposed “on a radially inward surface of a bypass duct” “aft of [a/the] fan” to synthesize the temperature at the engine inlet. *See* Dec. 10–11. Instead, paragraph 39 lists certain “factors” and “operating condition variables” used as inputs in the synthetization of engine inlet temperature and states that the result would then be used “to schedule engine operations.” *See* Spec. ¶ 39.

To the extent that this disclosure indicates “a thermodynamic relationship between the inlet temperature and the temperature at the claimed temperature sensor location” (Req. Reh’g 2), the record does not support that the inventor had possession of the *specific nature* of that relationship—i.e., how to achieve the synthetization of engine inlet temperature. *See, e.g., Vasudevan*, 782 F.3d at 683 (stating that, when assessing whether the subject matter of computer-implemented claims have adequate written description support, one should determine “whether the specification shows possession by the inventor of how [the claimed functionality] is achieved”).

Notably, the Specification makes clear that other, *undisclosed* “factors” and “operating condition variables” may *also* be necessary inputs. Spec. ¶ 39 (“The specific affect on the temperature and pressure is dependent upon the rotational speed of the fan 130, the operating conditions

of the engine, *and any number of other knowable factors*. . . . In some examples the synthesizing of a temperature or pressure includes accounting for one or more operating condition variables, such as engine operational mode, engine altitude, current fan speed, *and the like*, by at least incorporating one or more operating condition variables in a synthetization process.” (emphasis added)). Appellant has not identified evidence in the current record showing that one of ordinary skill in the art would—without additional disclosure—*already know* (1) the identity of the undisclosed “factors” and “operating condition variables” and (2) how to achieve the required synthetization of engine inlet temperature. *Cf. S3 Inc. v. NVIDIA Corp.*, 259 F.3d 1364, 1371 (Fed. Cir. 2001) (discussing an indefiniteness rejection of a means-plus-function term, and stating: “The law is clear that patent documents need not include subject matter that is known in the field of the invention and is in the prior art, for patents are written for persons experienced in the field of the invention.”); *In re Hayes Microcomputer Prod., Inc. Patent Litig.*, 982 F.2d 1527, 1534 (Fed. Cir. 1992) (“Disclosing a microprocessor capable of performing certain functions is sufficient to satisfy the requirement of section 112, first paragraph, when one skilled in the relevant art would understand what is intended *and know how to carry it out*.” (emphasis added)). Appellant’s argument that the Specification demonstrates possession of the limitations at issue is a conclusion without record support. *See, e.g.*, Req. Reh’g 3 (fourth and fifth paragraphs).

For these reasons, and those in the prior Decision, we maintain the rejection of claims 1, 3–5, 8–10, 17, 18, and 20 under 35 U.S.C. § 112(a) for failure to comply with the written description requirement.

CONCLUSION

The Request for Rehearing is *denied*.

DECISION SUMMARY

Outcome of Decision on Rehearing:

Claim(s)	35 U.S.C. §	Reference(s)/Basis	Denied	Granted
1, 3–5, 8–10, 17, 18, 20	112(a)	Written Description	1, 3–5, 8–10, 17, 18, 20	
Overall Outcome			1, 3–5, 8–10, 17, 18, 20	

Final Outcome, after Rehearing, as to all appealed claims:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 3, 4, 8–12, 14, 16	103	Chapman, Thorpe, Gilson, Keim	11, 12, 14, 16	1, 3, 4, 8–10
5, 13, 15	103	Chapman, Thorpe, Gilson, Keim, Hillel	13, 15	5
17, 20	103	Chapman, Gilson, Keim		17, 20
18	103	Chapman, Gilson, Keim, Thorpe, Hillel		18
1, 3–5, 8–10, 17, 18, 20	112(a)	Written Description	1, 3–5, 8–10, 17, 18, 20 ³	
Overall Outcome			1, 3–5, 8–18, 20	

³ This Rejection is “Affirmed” in that, on rehearing, we do not modify the new ground of rejection from our prior Decision.

Appeal 2019-005106
Application 15/162,727

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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

DENIED