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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PAUL BARTENSTEIN

Appeal 2019-006542
Application 15/447,195
Technology Center 3700

Before CHARLES N. GREENHUT, MICHAEL L. HOELTER, and
ANNETTE R. REIMERS, *Administrative Patent Judges*.

REIMERS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–17. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM IN PART.

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 Uponor Innovation Ab. Appeal Brief (“Appeal Br.”) 1, filed Mar. 15, 2019.

CLAIMED SUBJECT MATTER

The claimed subject matter “relates to a system and a method for flushing a drinking-water installation that comprises at least one riser or distribution pipe.” Spec. 1:7–9.²

Claims 1 and 8 are independent. Claim 1 is illustrative of the claimed subject matter and recites:

1. A system for flushing a drinking-water installation, said system comprising
at least one riser or distribution pipe,
a plurality of branch pipes connected to the riser or distribution pipe,
consumer devices and flushing stations connected to the branch pipes, and
measuring devices, wherein each of the measuring devices is at least one of integrated into a flushing station and installed in said drinking water installation independently of said flushing station, wherein each of said measuring devices measures at least one of temperature change in the branch pipe and through-flow through the branch pipe
wherein the system further comprises a control unit that is connected to the measuring devices by data cables or by radio,
wherein the control unit has an evaluation module for evaluating data, said data having been transmitted by the measuring devices, and
wherein the evaluation module is set up to determine, on the basis of the data, how many flushing stations need to be flushed simultaneously in order for the riser or distribution pipe to be flushed.

² Appellant’s Specification (“Spec.”), filed May 4, 2017.

REJECTIONS

- I. Claims 7 and 16 stand rejected under 35 U.S.C. § 112(a), as failing to comply with the written description requirement.
- II. Claims 1–7, 13, and 15–17 stand rejected under 35 U.S.C. § 112(b) as indefinite.
- III. Claims 1–9, 12, 13, and 15–17 stand rejected under 35 U.S.C. § 103 as unpatentable over Applicant’s Admitted Prior Art (“AAPA”)³ and Petzolt (DE 102006017807 A1, published Oct. 18, 2007).⁴
- IV. Claims 10, 11, and 14 stand rejected under 35 U.S.C. § 103 as unpatentable over AAPA, Petzolt, and Taylor (US 9,151,023 B2, issued Oct. 6, 2015).

ANALYSIS

Rejection I – Written Description

The Examiner finds that the Specification fails to disclose the subject matter of claims 7 and 16. Final Act. 9.

Appellant states that “[u]pon entry of the Rule 41.33 amendment, claims 7 and 16 will be cancelled, thus rendering the rejection moot.”

Appeal Br. 42; *see also id.* at 28, 32.

Rule 41.33(b)(1) permits “[*a*]mendments filed on or after the date of filing a brief. . . to cancel claims. . .” *See* 37 C.F.R. § 41.33(b)(1) (emphasis

³ The Examiner cites to “at least page 1, line 15 - page 2, line 12” of the Specification of the subject application as being indicative of Applicant’s Admitted Prior Art (“AAPA”). *See* Final Office Action (“Final Act.”) 11, dated Oct. 29, 2018.

⁴ The Examiner provides an English-language, machine-generated translation of Petzolt’s Description, to which we shall refer to hereinafter.

added). However, the Claims Appendix to an appeal brief is *not* an “amendment.” “Amendments” must be made in accordance with 37 C.F.R. § 1.121 entitled “Manner of making amendments in applications.” Paragraph (c) of § 1.121 sets forth specific requirements for making amendments to the claims and paragraph (h) requires such amendments to begin on a separate sheet of paper. This requirement is important “to facilitate separate indexing and electronic scanning of each section of an amendment document for placement in an image file wrapper.” MPEP § 714(II)(A). Furthermore, 37 C.F.R. § 41.37(c)(2) expressly states, with emphasis added, “[a] *brief* shall not include any new or non-admitted amendment.” Due to Appellant’s failure to comply with the requirements of 37 C.F.R. § 1.121, the amendment Appellant wanted entered pursuant to 37 C.F.R. § 41.33(b)(1) was not entered. As a consequence, the Written Description rejection remains outstanding.⁵

As the merits of this rejection are not contested, we summarily affirm the rejection. *See In re Berger*, 279 F.3d 975 (Fed. Cir. 2002) (Affirming the Board’s affirmance of an uncontested rejection, holding that the appellant had waived the right to contest the rejection by not presenting

⁵ In the Response to the Notice of Non-Compliant Appeal Brief filed April 11, 2019, Appellant requests entry of the previously submitted “Rule 41.33 Amendment” and further states that “if the amendment is not entered, Applicant reserves the option of filing a substitute appeal brief to present arguments for both the § 112 rejections and the prior art rejections of those claims.” Appellant cannot reserve the right to make arguments not included in the brief. *See* 41.37(c)(1)(iv) (“any arguments or authorities not included in the appeal brief will be refused consideration by the Board.”).

arguments on appeal to the Board); *Hyatt v. Dudas*, 551 F.3d 1307, 1314 (Fed. Cir. 2008) (“the applicant can waive appeal of a ground of rejection”).

Rejection II – Indefiniteness

The Examiner determines that claim 1 is indefinite because claim 1 is directed to an apparatus but recites a method step, namely, “wherein each of said measuring devices *measures* at least one of temperature change in the branch pipe and through-flow through the branch pipe.” Final Act. 3 (citing Appeal Br. 45 (Claims App.) (emphasis added), 10 (citing MPEP § 2173.05(p)(II)).

MPEP § 2173.05(p)(II) cites to *In re Katz Interactive Call Processing Patent Litigation*.⁶ Appellant contends that the claim in *Katz Interactive Call Processing Patent Litigation* “is different from the appealed claim because the appealed claim does not involve a step of requiring a user to use any part of the system being claimed.” Appeal Br. 43. As such, Appellant contends that the rejection is deficient for this reason. *See id.* at 42–43.

To the extent Appellant is arguing *Katz Interactive Call Processing Patent Litigation* stands for the proposition that an apparatus claim *must* explicitly recite a user using a part of the claimed apparatus to render the claim indefinite, we disagree. The claim language at issue is not a structural limitation but instead, is a method step that, under the broadest reasonable interpretation, invokes a user’s action to carry out the recited step. Here, a seller of a system for flushing a drinking-water installation comprising the

⁶ *In Katz Interactive Call Processing Patent Litig. v. Am. Airlines, Inc.*, 639 F.3d 1303 (Fed. Cir. 2011).

components recited in claim 1 would not know if the claim requires actual measurements of actual temperature changes by each of the measuring devices before being infringed or alternatively, simply making, using, selling, or importing a system that has the capacity to make such measurements. Additionally, Appellant appears to rely on the language “is set up to” to invoke a functional limitation with respect to the recited “measuring devices,” yet such language is not recited in the “wherein” clause that recites the stand-alone term “measures.” *See* Appeal Br. 42; *see also id.* at 45 (Claims App.). As a consequence of this inconsistency, a skilled artisan would not know if the term “measures” invokes a functional limitation with respect to the recited “measuring devices.”⁷

Appellant also argues that the recited “wherein” clause recites a structural feature of one of the components of the system and thus, is not indefinite. Appeal Br. 42. To the extent Appellant is arguing all “wherein” clauses are not indefinite by virtue of reciting a structural feature, Appellant does not cite authority for this proposition. *Id.*

For these reasons, we agree with the Examiner that the recitation of “each of said measuring devices *measures* at least one of temperature change in the branch pipe and through-flow through the branch pipe” is a method

⁷ We note this deficiency could be remedied by changing the recited “measures” language to “is configured to measure” or “is set up to measure” much like the language used in other portions of the claim. *See e.g.*, Appeal Br. 45 (Claims App.) (“wherein the evaluation module is *set up to* determine, . . . how many flushing stations need to be flushed simultaneously” (emphasis added)).

step thereby rendering the metes and bounds of claim 1 unclear. *See* Ans. 17; *see also* Final Act. 3, 10.

Accordingly, we sustain the Examiner’s rejection of claims 1–7, 13, and 15–17 as indefinite.

Rejection III – Obviousness over AAPA and Petzolt

The Examiner finds that AAPA discloses a system for flushing a drinking-water installation in which the system comprises at least one riser or distribution pipe, a plurality of branch pipes, consumer devices, flushing stations, and measuring devices. Final Act. 11 (citing Spec. 1:25; 2:2). The Examiner acknowledges that “AAPA does not teach a specific method of measurement by the measurement devices, controller capability, or explicitly teach control mode features or connection types.” *Id.* The Examiner, however, finds that Petzolt discloses, among other things, “measuring the temperature change in the branch pipe” and “determin[ing] which flushing stations to flush.” *Id.* at 11–12 (citing Petzolt ¶¶ 11, 15). The Examiner concludes that it would have been obvious to a skilled artisan to modify the system of AAPA “by insuring that all pipes in the system are purged, or at least able to be purged, as taught by Petzolt . . . in order to achieve the expected result of providing clean water for end use.” *Id.* at 12.

We agree with Appellant that the rejection is deficient, for the following reasons. Independent claim 1 recites “wherein the evaluation module is set up to determine, on the basis of the data, *how many* flushing stations need to be flushed simultaneously in order for the riser or distribution pipe to be flushed.” Appeal Br. 45 (Claims App.) (emphasis added); *see also id.* at 3–4 (Appellant points out that claim 1 “requires

determination of *how many* flushing stations to use when flushing a pipe.”). Independent claim 8 recites similar claim language. *See* Appeal Br. 47 (Claims App.). Even if crediting the Examiner’s determination that Appellant has not defined a “flushing station” such that a valve can be considered a “flushing station” (*see* Ans. 13) and that Petzolt discloses flushing some flushing stations in order to flush a riser or distribution pipe (*id.*), the Examiner has not sufficiently shown how Petzolt discloses any module set up to determine *how many* flushing stations are necessary to flush in order for a riser or distribution pipe to be flushed as well. As Appellant explains, at best, the Examiner merely shows that Petzolt discloses flushing *all* flushing stations, and as such, there would be no need for any module to determine the number of flushing stations to use. *See* Appeal Br. 4, 6 (“The claim recites determining how many flushing stations to use based on certain data. If one were to carry out the obvious procedure, i.e., flush all of them, such a determination would obviously be pointless. . . . [A]ccording to [Appellant’s] invention, the evaluation module may recommend that only one or two flushing stations be used even when there are dozens available.”), 9 (“[T]he [E]xaminer has not shown how [Petzolt] discloses the possibility of using different numbers of flushing stations to flush a particular riser or pipe.”).

For these reasons, we do not sustain the Examiner’s rejection of claims 1–9, 12, 13, and 15–17 as unpatentable over AAPA and Petzolt.

Rejection IV – Obviousness over AAPA, Petzolt, and Taylor

The Examiner’s rejection of claims 10, 11, and 14 as unpatentable over AAPA, Petzolt, and Taylor is based on the same incorrect findings as

the combination of AAPA and Petzolt discussed above. *See* Final Act. 18–20. The Examiner does not rely on the teachings of Taylor to remedy the deficiencies of AAPA and Petzolt. *Id.* Accordingly, for reasons similar to those discussed above, we do not sustain the Examiner’s rejection of claims 10, 11, and 14 as unpatentable over AAPA, Petzolt, and Taylor.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
7, 16	112(a)	Written Description	7, 16	
1–7, 13, 15–17	112(b)	Indefiniteness	1–7, 13, 15–17	
1–9, 12, 13, 15–17	103	AAPA, Petzolt		1–9, 12, 13, 15–17
10, 11, 14	103	AAPA, Petzolt, Taylor		10, 11, 14
Overall Outcome			1–7, 13, 15–17	8–12, 14

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 IN PART