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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* NANCY G. WOODBRIDGE

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Appeal 2020-001468  
Application 14/678,725<sup>1</sup>  
Patent 7,606,951 B2  
Technology Center 3900

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Before ALLEN R. MacDONALD, ERIC B. CHEN, and  
JENNIFER L. MCKEOWN, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant appeals from a Final Rejection of claims 26 and 29–42.<sup>2</sup> Claims 1–25, 27, and 28 have been cancelled. Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

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<sup>1</sup> Filed April 3, 2015, as a reissue continuation of Application 13/277,963, now Reissue RE 454547, issued April 7, 2017, originally filed October 20, 2011, seeking to reissue U.S. Patent 7,606,951 B2, issued October 20, 2009, based on Application 10/988,417, filed November 12, 2004.

<sup>2</sup> Appellant identifies the real party in interest is Micron Technology, Inc. Appeal Br. 2.

### CLAIMED SUBJECT MATTER

Reissue claim 26 on appeal is illustrative of the claimed subject matter (emphasis and bracketed material added):

Claim 26. (Reissue claim) A computer-implemented method, comprising:

[A.] receiving, at a host, device configuration data from a connected device having a plurality of possible configurations, the device configuration data identifying a current configuration selected from the plurality of possible configurations;

[B.] determining, by the host, a resource requirement at the host to support transmitting requested data between the host and a plurality of devices connected to the host;

[C.] *selecting a memory configuration based on the device configuration data and the resource requirement;*

[D.] *calculating a memory map for a plurality of endpoints of the memory configuration;* and

[E.] allocating unallocated memory to the plurality of endpoints in accordance with the memory map.

### REJECTIONS

#### A. Section 112

The Examiner rejected claims 26 and 29–42 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Final Act. 3.

We select claim 26 as representative. Appellant does not argue separate patentability for remaining claims 29–42. Appeal Br. 5–8. Except for our ultimate decision, we do not discuss this section 112, first paragraph, rejection of claims 29–42 further herein.

The Examiner also rejected claims 26 and 29–42 under 35 U.S.C. § 112, second paragraph, “as being indefinite.” Final Act. 3–4. We do not find where the Appeal Brief presents arguments for the 35 U.S.C § 112, second paragraph, rejection of claims 26 and 29–42.<sup>3</sup> Therefore, we affirm *pro forma* the Examiner’s 35 U.S.C § 112, second paragraph, rejection. Except for our ultimate decision, we do not discuss this 35 U.S.C § 112, second paragraph, rejection of claims 26 and 29–42 further herein.

#### B. Section 251 — Defective Declaration

The Examiner also rejected claims 26 and 29–42 under 35 U.S.C. § 251 as being based upon a defective reissue declaration. Final Act. 2–4.

We select claim 26 as representative. Appellant does not argue separate patentability for remaining claims 29–42. Appeal Br. 8–10. Except for our ultimate decision, we do not discuss this 35 U.S.C § 251 rejection of claims 29–42 further herein.

#### C. Section 251 — New Matter

The Examiner also rejected claims 26 and 29–42 under 35 U.S.C. § 251 as being based on new matter. Final Act. 4–5.

We select claim 26 as representative. Appellant does not argue separate patentability for remaining claims 29–42. Except for our ultimate

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<sup>3</sup> Although Appellant appears to set forth a § 112, second paragraph argument at page 4 (second paragraph) of the Reply Brief, such argument is untimely. (“Any argument raised in the reply brief which was not raised in the appeal brief, or is not responsive to an argument raised in the examiner’s answer, []will not be considered by the Board for purposes of the present appeal, unless good cause is shown.”). *See* 37 C.F.R. § 41.41(b)(2).

decision, we do not discuss this 35 U.S.C § 251 rejection of claims 29–42 further herein.

## OPINION

We have reviewed the Examiner’s rejections in light of Appellant’s Appeal Brief and Reply Brief arguments that the Examiner has erred.

### A. Section 112, First Paragraph

The Examiner rejects claim 26 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Final Act. 3.

The limitations “selecting (select) a *memory configuration* based on the device configuration data and the resource requirement” and “calculating (calculate) a memory map for a plurality of endpoints of the *memory configuration*” recited in the respective claims 26, 33, and 38 were not described in the specification of the [7,606,951] Patent.

Final Act. 3 (emphasis added).

Appellant points to column 3, lines 9–54 of the 7,606,951 Patent and asserts (Appeal Br. 5–8) the “device configuration” discussed therein

conveys to an ordinary person skilled in the art the claimed features of “selecting a memory configuration based on the device configuration data and the resource requirement [at the host to support transmitting requested data between the host and a plurality of devices connected to the host]” and “calculating a memory map for a plurality of endpoints of the memory configuration”.

Appeal Br. 8.

Appellant’s following argument is illustrative:

In response to the device informing the host of the current device configuration, the configuration selected by the host can include endpoint/memory configuration. For example, Col. 3,

lines 17-19, of the Application states “The cell phone informs the host that the cell phone is running off battery power so the host will select a low power configuration with *limited* bandwidth, power and *endpoints*. This might include *two or three active endpoints*” [Emphasis Added]. For example, Col. 3, lines 21-28, of the Application states “In the second exemplary configuration in which the cell phone is hooked up to AC power . . . since there are no power concerns . . . All of the endpoint memory can be used and *many endpoints enabled*” [Emphasis Added]. For example, Col. 3, lines 28-33, of the Application states “if the cell phone is hooked up to an AC power source and in the second configuration and the power source to the cell phone is unplugged, the cell phone informs the host which selects a new configuration, reallocation of the *endpoint memory* may be performed for *a new set of endpoints*”.

Appeal Br. 6.

Contrary to Appellant’s argument, column 3 of the 7,606,951 Patent does not support claim 26. Appellant begins (first sentence) by stating the host can include “endpoint/memory configuration.” Appellant attempts to equate endpoint configuration with memory configuration. We find no support for this reading. Rather, as to a memory the endpoint configuration is merely the data stored in that memory.

The term “endpoint” refers to the logical measure of a port. Each USB device has a certain number of endpoints. If there is a need to send a certain type of data, an endpoint is allocated. If data is to be sent at other speeds then another endpoint is allocated. In this manner, one or more logical connections are made between a USB host, which may be located, for example, on a motherboard of a PC, and a USB client.

USB typically uses 15 programmable endpoints and one non-programmable endpoint, and uses one configuration at a time. In current USB client controllers each endpoint is allocated a fixed, exclusive *memory block for storage of endpoint data*.

*See* '951, col. 1, ll. 51–63 (emphasis added). At best, lines 9–54 of column 3 states, without further detail, that selecting a new endpoint configuration leads to a reallocation of memory.

Our review finds that the 7,606,951 Patent separately introduces the concept of memory configuration.

In some embodiments the allocation and control of *the configuration of a USB device memory* that is used to store endpoint data is implemented in a manner such that the memory space is reused by multiple endpoints. The reuse of the endpoint memory space of a USB device allows the size of the memory array required to support multiple endpoints to be reduced.

*See* '951, col. 3, ll. 55–61. However, like the Examiner, we are unable to find a disclosure of the detailed “memory configuration” steps Appellant now claims and which are objected to by the Examiner. That is, we find the disclosure lacks a written description of the details recited at steps C and D of above claim 26.

Thus, we are unpersuaded by Appellant’s 35 U.S.C § 112, first paragraph, arguments.

#### B. Section 251 – Defective Declaration

The Examiner rejects claim 26 under 35 U.S.C. § 251 as being based upon a defective reissue declaration. Final Act. 2–4.

[T]he inventor declares that at least one error upon which reissue is based is a failure to present claims directed to the subject matter related to determining and adjusting memory allocation based on the requirements of both the connecting device and the host. . . .

However, the inventor had declared this same error in the prior reissue application. . . . and this same error was corrected

by way of presenting the new claims 26-30 that did not have (i) a USB endpoint memory, (ii) a USB host controller, and (iii) allocating in response to the monitoring of the change. In other words, all errors identified in the inventor's declaration from the earlier-filed reissue application are no longer being relied upon as the basis for the instant continuation reissue application.

....

Therefore, there is no error to be corrected under 35 U.S.C. § 251.

Final Act. 2–3.

The Examiner's rejection does not explain how the parent reissue "new claims 26-30 that did not have (i) a USB endpoint memory, (ii) a USB host controller, and (iii) allocating in response to the monitoring of the change" in any way correct an error of "failure to present claims directed to the subject matter related to determining and adjusting memory allocation based on the requirements of both the connecting device and the host." Appellant is not precluded from reusing a reissue declaration when the parent reissue does not correct all errors asserted in that declaration. On their face, the cited "new claims 26-30" of the parent reissue do not appear to correct the particular error asserted. Therefore, further explanation is required from the Examiner to support the rejection.

Therefore, we conclude there is insufficient articulated reasoning to support the Examiner's conclusion that claim 26 is based upon a defective reissue declaration.

## C. Section 251 – New Matter

### C.1. The Statute

The reissue statute expressly permits a patentee to correct an “error” thus permitting patentee to obtain reissue claims broader than the originally issued patent claims at any time within two (2) years from the date the original patent issues. More particularly, 35 U.S.C. § 251(a), (d), provide in pertinent part:

(a) Whenever any patent is, through error, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

(d) No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

### C.2. Appellant’s Argument

Appellant argues the 35 U.S.C § 251 new matter rejection by reference to the arguments as to the § 112, first paragraph, written description rejection.

As discussed above in connection with the rejections under 35 U.S.C. §112, the features of “selecting a memory configuration based on the device configuration data and the resource requirement” and “calculating a memory map for a plurality of endpoints of the memory configuration” are

Appeal 2020-001468  
Application 14/678,725  
Patent 7,606,951 B2

supported by the prior '951 patent. Thus, the rejections under 35 U.S.C. §251 are erroneous.

Appeal Br. 8.

### C.3. Panel's New Matter Determination

As discussed above, we are unpersuaded by Appellant's 35 U.S.C § 112, first paragraph, arguments. Therefore, we are unpersuaded by Appellant's arguments as to the 35 U.S.C § 251 new matter rejection for the same reasons.

### D. Other Issues

As the Examiner has shown all the claims are unpatentable under 35 U.S.C. §§ 112 and 251, we do not also newly reject Appellants' claims 26 and 29–42 under 35 U.S.C. § 251 as also failing to meet the original patent requirement. However, should there be further prosecution of these claims; we direct the Examiner's attention to this issue.

#### D.1. Original Patent ("Same Invention") Requirement

The original patent requirement is well-established, being recognized in the reissue statute and longstanding Supreme Court jurisprudence. . . . Supreme Court cases have recognized this requirement for more than 150 years. . . . The Supreme Court's definitive explanation of the original patent requirement appears in *U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.*, 315 U.S. 668, 62 S.Ct. 839, 86 L.Ed. 1105 (1942).

*Antares Pharma, Inc. v. Medac Pharma Inc.*, 771 F.3d 1354, 1358–59 (2014) (citations omitted).

The Supreme Court's articulation of the "same invention" test in *Industrial Chemicals* was in the context of 35 U.S.C. § 64, which

had slightly different language from the current reissue statute, 35 U.S.C. § 251.

....

Despite the change in language relating to the “same invention” requirement, it appears that no change in substance was intended. There is nothing in the statutory language or legislative history suggesting that Congress intended to overturn the long line of Supreme Court cases culminating in *Industrial Chemicals* by this change in language.

*Antares Pharma*, 771 F.3d at 1360.

[O]ur cases explain[] that the *Industrial Chemicals* standard is analogous to the written description requirement, which, as our en banc decision in *Ariad Pharmaceuticals, Inc. v. Eli Lilly & Co.*, 598 F.3d 1336 (Fed. Cir. 2010) made clear, requires that the patent description “clearly allow persons of ordinary skill in the art to recognize that the inventor invented what is claimed.” *Id.* at 1351. Whether or not the written description requirement of § 112 was satisfied here, *Industrial Chemicals* made clear that, for § 251, “it is not enough that an invention might have been claimed in the original patent because it was suggested or indicated in the specification.” 315 U.S. at 676, 62 S.Ct. 839. Rather, the specification must clearly and unequivocally disclose the newly claimed invention as a separate invention. *Id.*

*Antares Pharma*, 771 F.3d at 1362 (citations omitted, emphasis added).

In *Forum US*, the Federal Circuit reiterated its analysis in *Antares*, stating:

It is well settled that for broadening reissue claims, “it is not enough that an invention might have been claimed in the original patent because it was suggested or indicated in the specification.” *Indus. Chems.*, 315 U.S. at 676, 62 S.Ct. 839 (interpreting 35 U.S.C. § 64 (1934)). The Supreme Court described this standard in nearly identical language almost fifty years before *Industrial Chemicals*. See *Corbin Cabinet Lock Co. v. Eagle Lock Co.*, 150 U.S. 38, 42–43; see also 14 S.Ct. 28, 37

L.Ed. 989 (1893) (“[T]o warrant new and broader claims in a reissue, such claims must not be *merely suggested or indicated in the original [S]pecification, drawings, or models*, but it must further appear from the original patent that they constitute parts or portions of the invention, which were intended or sought to be covered or secured by such original patent.”). Congress codified this long-standing requirement, which became known as the “same invention” requirement. [See] *Antares*, 771 F.3d at 1359–60 (quoting 35 U.S.C. § 64 (1946)); see [also], e.g., Section 53, Patent Act of 1870, 16 Stat. 198 (1870) (“[T]he commissioner shall . . . cause a new patent for the same invention . . . to be issued to the patentee.”).

With the passage of the 1952 Patent Act, Congress revised the statutory language from “the same invention” to “the original patent.” *Antares*, 771 F.3d at 1360; 35 U.S.C. § 251 (1952). Despite this revision, case law has not suggested that the 1952 Patent Act’s revised statutory language substantively changed “the ‘same invention’ requirement or that the standard of Industrial Chemicals has in any way been altered by the legislative changes.” *Antares*, 771 F.3d at 1360–61.

Thus, for broadening reissue claims, the specification of the original patent *must do more than merely suggest or indicate the invention recited in reissue claims*; “[i]t must appear from the face of the instrument that what is covered by the reissue was intended to have been covered and secured by the original.” *Indus. Chems.*, 315 U.S. at 676, 62 S.Ct. 839 (emphasis added). Stated differently, the original patent “*must clearly and unequivocally disclose the newly claimed invention as a separate invention.*” *Antares*, 771 F.3d at 1362.

*Forum US, Inc. v. Flow Valve, LLC*, 926 F.3d 1346, 1351–52 (2019)  
(emphasis added).

## D.2. Panel’s Advisory Original Patent Determination

As a fundamental requirement, any reissue claim must comply with the original patent (“same invention”) requirement of 35 U.S.C § 251. *See* Section D.1. *supra*. That is, the patent specification must disclose, explicitly and unequivocally, the newly claimed invention as a separate invention.

As discussed above, we disagree with Appellant’s assertion that the 7,606,951 Patent Specification shows “possession” of reissue claim 26, i.e., meets the written description requirement of 35 U.S.C. § 112, first paragraph.<sup>4</sup> However, even if we did agree, the “original patent” standard and the written description requirement are not the same.<sup>5</sup> Where the written description requirement is based on what the skilled artisan would have understood was within the possession of the inventor, recent Federal Circuit

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<sup>4</sup> Where a reissue claim fails to comply with the 35 U.S.C § 112, first paragraph, written description requirement due to new matter in the reissue claim, such reissue claim inherently fails to comply with the 35 U.S.C § 251 no new matter requirement. Separately, that reissue claim also inherently fails to comply with the 35 U.S.C § 251 original patent requirement.

<sup>5</sup> Although some Federal Circuit decisions appear to hold otherwise, this is not the case. *Antares* points out:

The court in *Revolution Eyewear* rejected the “original patent” challenge in a single paragraph, ending with the statement that it was doing so “[b]ecause [it had just] held that the written description requirement [was] satisfied.” 563 F.3d at 1367. That statement cannot be taken to establish as precedent that the standards are the same, but merely reflects the way the parties presented the issue, neither of whom made any reference to *Industrial Chemicals* or argued for a standard different than § 112.

*Antares*, 771 F.3d at 1362 n.8.

case law indicates that the original patent requirement under 35 U.S.C § 251 requires something more:

Whether or not the written description requirement of § 112 was satisfied here, *Industrial Chemicals* made clear that, for § 251, “it is not enough that an invention might have been claimed in the original patent because it was suggested or indicated in the specification.” 315 U.S. at 676, 62 S.Ct. 839. Rather, the specification must clearly and unequivocally disclose the newly claimed invention as a separate invention. *Id.*

*Antares Pharma*, 771 F.3d at 1362 (citations omitted, underlining added).

Thus, for broadening reissue claims, the specification of the original patent must do more than merely suggest or indicate the invention recited in reissue claims; “[i]t must appear *from the face of the instrument* that what is covered by the reissue was intended to have been covered and secured by the original.” *Indus. Chems.*, 315 U.S. at 676 . . . (emphasis added). Stated differently, the original patent “must clearly and unequivocally disclose the newly claimed invention as a separate invention.” *Antares*, 771 F.3d at 1362. We apply the standard set forth in *Industrial Chemicals* and *Antares* to this case and hold that the reissue claims are invalid.

*Forum US, Inc. v. Flow Valve, LLC*, 926 F.3d 1346, 1351–52 (Fed. Cir. 2019) (underlining added).

The issued patent here may contain a general disclosure of a “memory configuration” (col. 3, ll. 55–61), but the face of the issued patent does not describe such detailed “memory configuration” method steps as are recited in above reissue claim 26 steps C and D. We do not find the reissue claim limitations directed to detailed “memory configuration” method steps mentioned in the ’951 Patent’s title, abstract, background, detail description, or figures. The original Specification here does not disclose, in an explicit and unequivocal manner, the particular detailed “memory configuration”

method steps recited in above reissue claim 26 steps C and D so as to meet the *Industrial Chemicals* standard.

#### CONCLUSIONS

The Examiner has not erred in rejecting claims 26 and 29–42 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

The Examiner has not erred in rejecting claims 26 and 29–42 under 35 U.S.C. § 112, second paragraph, as being indefinite.

The Examiner has not erred in rejecting claims 26 and 29–42 under 35 U.S.C. § 251 as being based on new matter.

The Examiner has erred in rejecting claims 26 and 29–42 under 35 U.S.C. § 251 as being based upon a defective reissue declaration.

The Examiner's rejections of claims 26 and 29–42 under 35 U.S.C. § 112, first paragraph, as lacking written description, and under 35 U.S.C. § 112, second paragraph, as being indefinite are **affirmed**.

The Examiner's rejection of claims 26 and 29–42 under 35 U.S.C. § 251 as being based on new matter is **affirmed**.

The Examiner's rejection of claims 26 and 29–42 under 35 U.S.C. § 251 as based upon a defective reissue declaration is **reversed**.

DECISION SUMMARY

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
26, 29-42	112, 1 <sup>st</sup> ¶	Enablement	26, 29-42	
26, 29-42	112, 2 <sup>nd</sup> ¶	Indefiniteness	26, 29-42	
26, 29-42	251	New Matter	26, 29-42	
26, 29-42	251	Defective Declaration		26, 29-42
<b>Overall Outcome</b>			<b>26, 29-42</b>	

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