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Dobbin IP Law, P.C. Attn: Geoffrey E. Dobbin 2250 S Redwood Road, Ste 5 West Valley City, UT 84119-1355			BULLINGTON, ROBERT P	
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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* CHRISTOPHER J. IHARA

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Appeal 2020-001617  
Application 14/959,987<sup>1</sup>  
Technology Center 3700

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Before MURRIEL E. CRAWFORD, BRUCE T. WIEDER, and  
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

WIEDER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1–12. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> 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 Christopher J. Ihara. (Appeal Br. 3.)

### CLAIMED SUBJECT MATTER

Appellant's "invention relates to the field of training equipment and more particularly relates to a selection system whereby drivers are trained to make split-second choices as to operation and direction of a vehicle."

(Spec. 1, ll. 10–12.)

Claims 1 and 9 are the independent claims on appeal. Claim 1 is illustrative. It recites:

1. A driving training system comprising:
  - a. a plurality of lane indicator signals positioned at a single intersection, the intersection comprising at least one entry lane and a plurality of exit lanes with each of the plurality of lane indicator signals being positioned over an exit lane while being viewable from the entry lane;
  - b. a control unit in operable communication with the lane indicator signals;
  - c. at least one speed sensor, in operable communication with the control unit;
  - d. at least one position sensor in operable communication with the control unit;wherein the at least one lane indicator signals are positioned in a manner to present a simulated driving experience in a test area, the at least one position sensor is positioned to record a position of a vehicle as it enters the test area, the at least one speed sensor records a speed of the vehicle as it enters the test area and the control unit activates the lane indicator lights in a manner to give a pre-determined reaction time, according to the simulated driving experience.

### REJECTIONS

Claims 1–12 are rejected under 35 U.S.C. § 112(a) as failing to comply with the written description requirement.

Claims 1–12 are rejected under 35 U.S.C. § 112(b) as indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor regards as the invention.

Claims 1–9 and 12 are rejected under 35 U.S.C. § 102(a)(1) as anticipated by Golenski (US 3,991,485, iss. Nov. 16, 1976).

Claims 10 and 11 are rejected under 35 U.S.C. § 103 as unpatentable in view of Golenski.

Claims 1–12 are rejected under 35 U.S.C. § 102(a)(1) as anticipated by Appellant’s admitted prior art.

#### ANALYSIS

##### *The § 112(a) and § 112(b) rejections*

Appellant does not appeal these rejections. (*See* Appeal Br. 4.) Therefore, we summarily affirm these rejections.

##### *The § 102(a)(1) and § 103 rejections in view of Golenski*

Appellant does not appeal these rejections. (*See id.*) Therefore, we summarily affirm these rejections.

##### *The § 102(a)(1) rejection in view of Appellant’s admitted prior art*

On July 5, 2018, Appellant filed an Information Disclosure Statement that disclosed, in relevant part:

After filing the Application, Applicant realized the potential import that two prototype systems, which were sent to two different entities, might have on this Application. In both circumstances, the prototypes were “sold” at the basic cost for parts in exchange for information regarding the performance of the prototypes in extreme environmental conditions so that

production models could be perfected. The basic facts are outlined below.

1. One unit was sent to the Gilroy Police Force in Gilroy, California, in 2013. The purpose of sending the prototype to this location was to evaluate its performance under the extremely high RF traffic in the region as well as particularly prevalent inclement weather. It should be noted that there was an initial test of the system at Gilroy, CA before this time where the prototype had totally failed to perform due to the extreme environment [sic].
2. The second unit was delivered to Peele Police Department in Ontario, Canada, on November 27, 2013. The purpose of sending the prototype to this location was to evaluate performance and storage under cold-weather conditions.

(Information Disclosure Statement filed July 5, 2018, as part of Response to Non-final Office Action and Amendment, at 7 (hereinafter “IDS”).)

The Examiner finds that “[a]s best understood, claim [sic] 1-12 are disclosed by Applicant [sic] admitted prior art in Applicants [sic] IDS submitted on 7/5/2018.” (Final Action 5.) Based on the IDS, the Examiner finds that “Applicant’s invention was sold on November 27, 2013, prior to the one year grace period of December 4, 2013, as it applies to the provisional application filed on December 4, 2014 and subsequent utility application filed on December 4, 2015.” (*Id.* at 5–6.)

Appellant argues that the sale to the Peele Police Department “falls under the experimental use exception, regardless of the private final transaction between parties to cover construction costs of the invention.” (Appeal Br. 6.) The Appeal Brief includes an Evidence Appendix containing several purported emails between Appellant and the Peele Police Department. (Appeal Br. 15–34 (Exhibits A–F).)

As an initial matter, we note that on September 4, 2019, Appellant submitted several “emails in support of his contention that the exchange of the product embodying the invention in [sic] November 27<sup>th</sup>, 2013 was not a sale for purposes of § 102.” (Exhibits for Appeal filed September 4, 2019 at 1 (hereinafter “Exhibits”).) A declaration attesting to the authenticity of the emails was included. (Exhibits at 2.) The emails attached to Exhibits are marked “XX2001–XX2048.” (*See Exhibits.*)<sup>2</sup>

Appellant’s Notice of Appeal was filed April 5, 2019.

37 C.F.R. § 41.33 recites:

(d)(1) An affidavit or other Evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date of filing a brief pursuant to § 41.37 may be admitted if the examiner determines that the affidavit or other Evidence overcomes all rejections under appeal and that a showing of good and sufficient reasons why the affidavit or other Evidence is necessary and was not earlier presented has been made.

(2) All other affidavits or other Evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i), and 41.50(b)(1).

The Examiner did not determine that the evidence overcame all rejections under appeal. Therefore, § 41.33(d)(1) does not apply in this instance. With regard to § 41.33(d)(2), the exceptions recited in §§ 41.39(b)(1), 41.50(a)(2)(i), and 41.50(b)(1) also do not apply in this instance. Therefore, under § 41.33(d)(2), the evidence filed on

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<sup>2</sup> The documents attached to the Appeal Brief as Exhibits A–F are marked as, e.g., “Email 2021,” “Email 2022,” etc. However these documents are not the same documents as included in the Exhibits, nor is there a declaration attesting to the authenticity of the documents marked as Exhibits A–F.

September 4, 2019, nearly 5 months after the date of filing the appeal, will not be admitted.<sup>3</sup> We are, however, left with Appellant’s apparent admission that “Appellant’s ‘sale’ to the Peele Police Department” (Appeal Br. 7) on November 27, 2013, was “of the product embodying the invention” (Exhibits 1).

Appellant argues that the “‘sale’ to the Peele Police Department . . . was primarily for the purpose of sending the prototype to a location with cold weather conditions to evaluate the systems [sic] performance under low temperatures, as well as the system’s ability to survive storage in cold climates” (Appeal Br. 7), i.e., that the sale “falls under the experimental use exception” (*id.* at 6).

[T]he on-sale bar applies when two conditions are satisfied before the critical date. First, the product must be the subject of a commercial offer for sale. . . .

Second, the invention must be ready for patenting. That condition may be satisfied in at least two ways: by proof of reduction to practice before the critical date; or by proof that prior to the critical date the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention.

*Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 67–68 (1998).

Proof of experimental use serves “as a negation of the statutory bars.” *EZ Dock v. Schafer Sys., Inc.*, 276 F.3d 1347, 1352 (Fed. Cir. 2002). A use may be experimental if its purpose is: “(1) [to] test claimed features of the invention or (2) to determine whether an invention will work for its intended purpose—itsself a

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<sup>3</sup> Unlike, e.g., §§ 41.37 and 41.41, § 41.33 includes no provision for extensions of time to file affidavits or other evidence.

requirement of patentability.” *Clock Spring, L.P. v. Wrapmaster, Inc.*, 560 F.3d 1317, 1327 (Fed. Cir. 2009).

*Polara Eng’g Inc. v. Campbell Co.*, 894 F.3d 1339, 1348 (Fed. Cir. 2018).

“However, experimentation conducted to determine whether the invention would suit a particular customer’s purposes does not fall within the experimental use exception. *Allen Eng’g [Corp. v. Bartell Indus., Inc.]*, 299 F.3d 1336, 1355 (Fed. Cir. 2002)] (citing *In re Theis*, 610 F.2d 786, 792 (CCPA 1979)).” *Atlanta Attachment Co. v. Leggett & Platt, Inc.*, 516 F.3d 1361, 1366 (Fed. Cir. 1995). Furthermore,

“[t]esting or experimentation performed with respect to non-claimed features of the device does not show that the *invention* was the subject of experimentation.” *W. Marine Elecs., Inc. v. Furuno Elec. Co.*, 764 F.2d 840, 847 (Fed.Cir.1985). In other words, an experimental use only negates a statutory bar when the inventor was testing claimed features of the invention. *In re Theis*, 610 F.2d 786, 793 (CCPA 1979) (“It is settled law that ... [an] experimental sale ... does not apply to experiments performed with respect to non-claimed features of an invention.”); *LaBounty Mfg. Inc. v. U.S. Int’l Trade Comm’n.*, 958 F.2d 1066, 1074 (Fed.Cir.1992); *In re Brigance*, 792 F.2d 1103, 1109 (Fed.Cir.1986).

*SmithKline Beecham Corp. v. Apotex Corp.*, 365 F.3d 1306, 1317–18 (Fed. Cir. 2004). For example, in *Polara Engineering*, “Polara contend[ed] that it was testing claimed features, *i.e.*, the ‘digital data signals’ limitation.” *Polara Eng’g Inc.*, 894 F.3d at 1349.

Here, Appellant argues that the system sold to the Peele Police Department was for purposes of cold weather testing and storage. (Appeal Br. 7, 9.) Appellant does not point to any particular claim limitation(s), *i.e.*, Appellant does not indicate what claimed features were being tested. Moreover, Appellant’s argument indicates that the experimentation was to



determine whether the invention would suit the purposes of the Peele Police Department or, more generally, the purposes of customer's in cold climates. Therefore, we do not find Appellant's argument persuasive.<sup>4</sup>

Additionally, the Federal Circuit has identified a number of factors to be considered in assessing whether a use is experimental:

(1) the necessity for public testing, (2) the amount of control over the experiment retained by the inventor, (3) the nature of the invention, (4) the length of the test period, (5) whether payment was made, (6) whether there was a secrecy obligation, (7) whether records of the experiment were kept, (8) who conducted the experiment, (9) the degree of commercial exploitation during testing, (10) whether the invention reasonably requires evaluation under actual conditions of use, (11) whether testing was systematically performed, (12) whether the inventor continually monitored the invention during testing, and (13) the nature of contacts made with potential customers.

*Id.* at 1348–49 (quoting *Clock Spring, L.P.*, 560 F.3d at 1327 (internal quotation marks and citations omitted)).

The Examiner finds that

[r]egarding factor (6), a Non-disclosure agreement(s) neither exists nor was/were never [sic] provided as evidence of a secrecy obligation. Regarding factor (7), records of the “experimentation” were never kept, nor provided as evidence.

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<sup>4</sup> In the Reply Brief, Appellant argues, for the first time in this appeal, that an update completed in July 2014 “is what has enabled the Inventor to claim the methodology in claims 9-12 and the use described in claim 1.” (Reply Br. 3.) We do not find this persuasive. Appellant does not indicate to which claim limitation(s) this argument applies, and it relies on evidence not properly before us. This argument was not raised in the Appeal Brief, is not responsive to an argument raised in the Answer, and Appellant has not shown good cause for why we should consider this late argument. *See* 37 C.F.R. § 41.41(b)(2).

Regarding factor (8), it is not clear who specifically performed the “experimentation.” Nor are any names recorded indicating otherwise. Regarding factor (11), it is not clear what testing is being performed and if it was done in a systematic manner.

(Answer 13.)<sup>5</sup>

Appellant addresses these 13 factors arguing, e.g., with regard to factor 6, that “Appellant and the Peele Police Department had a confidentiality obligation, the testing occurred at a facility closed to the public, and employees involved in testing were required to keep the information regarding the system and testing confidential.” (Appeal Br. 9.) Appellant, however, points to nothing in the record to support this argument. Indeed, page 9 of the Appeal Brief presents arguments regarding all 13 factors. But Appellant includes no citations to the record (or to the Exhibits) in support of any of these arguments. (*See id.*)<sup>6</sup>

In view of the above, we are not persuaded of error.

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<sup>5</sup> The Examiner appears to have taken the Exhibits into consideration in making additional findings regarding some of the other factors, e.g., “with regard to factor (2), it is implied that the inventor had no control over the experiment, per the statement in ‘Exhibit B - Email 2012’” and “[r]egarding factor (12), it is reasonably implied that the inventor did not continually monitor the invention during testing, per the statement in ‘Exhibit B - Email 2012’ . . . and as found in ‘Exhibit D - Email 2002.’” (Answer 13–14.) However, for the reasons discussed above, we do not consider the Exhibits as having properly been admitted. Therefore, we do not consider the Exhibits or the Examiner’s findings based on the Exhibits.

<sup>6</sup> The IDS states that “[b]oth locations kept the prototypes in confidence.” (IDS 7.) But neither the IDS nor the Appeal Brief point to any confidentiality obligation or requirement. (*See* Appeal Br. 9.)

CONCLUSION

The Examiner's rejection of claims 1–12 under 35 U.S.C. § 112(a) is summarily affirmed.

The Examiner's rejection of claims 1–12 under 35 U.S.C. § 112(b) is summarily affirmed.

The Examiner's rejection of claims 1–9 and 12 under 35 U.S.C. § 102(a)(1) as anticipated by Golenski is summarily affirmed.

The Examiner's rejection of claims 10 and 11 under 35 U.S.C. § 103 as unpatentable in view of Golenski is summarily affirmed.

The Examiner's rejection of claims 1–12 under 35 U.S.C. § 102(a)(1) as anticipated by Appellant's admitted prior art is affirmed.

Specifically:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1–12	112(a)	Written Description	1–12	
1–12	112(b)	Indefiniteness	1–12	
1–9, 12	102(a)(1)	Golenski	1–9, 12	
10, 11	103	Golenski	10, 11	
1–12	102(a)(1)	Appellant's Admitted Prior Art	1–12	
<b>Overall Outcome</b>			1–12	

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