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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte NABIL NASR and MICHAEL THURSTON

Appeal 2020-003631
Application 13/861,000
Patent 7,925,472 B2
Technology Center 3900

Before ALLEN R. MacDONALD, JOHN A. JEFFERY, and
MICHAEL J. ENGLE, *Administrative Patent Judges*.

ENGLE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting reissue claims 1–10, 12–26, 28–42, 44–73, and 75, which are all of the claims pending in the reissue application. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies Vnomics Corp. as the real party in interest. Appeal Br. 2.

TECHNOLOGY

The application relates to “optimizing utilization of one or more assets” based on “historical maintenance data and life-cycle data.” Spec. 1:28–34.

ILLUSTRATIVE CLAIM

Reissue claim 1 is illustrative and reproduced below with annotations indicating language changed from issued claim 1 of US 7,925,472 B2:

1. A method for optimizing utilization of one or more assets, the method comprising:

obtaining at an optimization processing apparatus operational data and physical condition data for one or more elements of at least one of the assets and specification data, historical maintenance data and life-cycle data for the one or more elements of the at least one of the assets;

conducting with the optimization processing apparatus one or more diagnostics on the one or more elements of the at least one of the assets based on the obtained the operational data, the physical condition data, and the retrieved specification data, wherein the one or more elements each comprise one or more components;

conducting with the optimization processing apparatus one or more prognostics on the one or more elements of the at least one of the assets based on the obtained operational data, the physical condition data, the specification data, the historical maintenance data and the life-cycle data;

determining one or more optimization instructions with optimization processing apparatus for the at least one asset based on the conducted diagnostics and prognostics and a plurality of probabilities relating to a plurality of characteristics, with respect to at least one of the components within the at least one of the elements of the at least one of the assets, of the at least one of the components completing a second operational duration relating to

one of the characteristics after completing a first operational duration relating to another of the characteristics based on each operational duration of each component having an associated probability of completion, wherein at least one of the conducting one or more diagnostics and the conducting one or more prognostics further comprises determining one or more maintenance needs related to at least one of the one [of the one] or more elements of the at least one of the assets in a near term comprising before a first designated period of time and over a long term comprising after the first designated period of time and wherein the one or more optimization instructions are further based on the determined near term and long term maintenance needs; and

displaying with the optimization processing apparatus the determined one or more optimization instructions.

REJECTIONS ON APPEAL

Claims 1–10, 12–26, 28–42, 44–73, and 75 stand rejected under 35 U.S.C. § 251 as being based upon new matter added to the patent for which reissue is sought. Non-Final Act. 4.

Claims 1–10, 12–26, 28–42, 44–73, and 75 stand rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Non-Final Act. 6.

Claim 75 stands rejected under 35 U.S.C. § 112, second paragraph as indefinite. Non-Final Act. 8.

The Examiner withdrew the rejections under § 103. Ans. 4.

ISSUES

1. Did the Examiner err in finding that “a plurality of probabilities relating to a plurality of characteristics . . . of the at least one of the components completing a second operational duration relating to one of the

characteristics after completing a first operational duration relating to another of the characteristics based on each operational duration of each component having an associated probability of completion,” as recited in claim 1, constituted new matter under § 251 and lacked sufficient written description support under § 112, first paragraph?

2. Did the Examiner err in concluding that “balancing near term and long term maintenance needs against both operational requirements and at least one of status of consumables, operational readiness, and degradation or failures of at least one of the one or more elements of the at least one of the assets” rendered dependent claim 75 indefinite?

ANALYSIS

New Matter (§ 251)

Reissue claim 1 recites “a plurality of probabilities relating to a plurality of characteristics . . . of the at least one of the components completing a second operational duration relating to one of the characteristics after completing a first operational duration relating to another of the characteristics based on each operational duration of each component having an associated probability of completion.” This limitation was added during reissue and does not appear in issued claim 1. Similar limitations appear in the other independent reissue claims, namely reissue claims 17, 33, 49, 50–57, and 64. Appeal Br. 65.

By statute, “[n]o new matter shall be introduced into the application for reissue.” 35 U.S.C. § 251(a). Here, the Examiner finds that the

Specification does not support this limitation and the limitation therefore constitutes new matter under § 251. Non-Final Act. 5.

Appellant relies on the Specification's disclosure of one example about predicting "an X % [chance] the battery will need to be recharged . . . in two days and . . . a Y % chance the battery will no longer be able to sufficiently hold a charge in two months." Appeal Br. 27–28 (quoting Spec. 7:36–49). Appellant argues this provides probabilities ("X %"; "Y %") for characteristics ("required maintenance" of recharging the battery; "exceed life expectancy") of components ("alternator, starter, and/or battery"). *Id.* at 28. Appellant further argues that the completion of the "two months" (for the Y %) comes "after" the completion of the "two days" (for the X %). Reply Br. 3–4.

The Examiner, on the other hand, finds that the cited example fails to address the "after completing" limitation. Ans. 5–6. Instead, the Examiner looks to an example from the Specification in which "*after two years* a component may have a 95% chance of still being operational *after another two years.*" Spec. 5:22–26 (emphasis added); Ans. 6. Although this second example may support the "after" portion of the claim language, the Examiner finds it still is deficient because it at best involves the *same* characteristic rather than the claimed "one characteristic" and "another characteristic." Ans. 6.

We agree with the Examiner that Appellant has not sufficiently addressed the entirety of the claim language. Ans. 5–6. The claim does not recite merely that the second duration is longer than the first duration, as Appellant seems to argue. Instead, reissue claim 1 requires "probabilities

. . . of . . . completing a second operational duration . . . *after completing* a first operational duration . . . based on each operational duration . . . having an associated probability of completion.” Appellant’s example of Y % is merely a “probability of completion,” not a probability of completing “after completing” the other duration. As the Examiner notes, Appellant’s Y % chance “has no concern for whether or not it has already completed” the second operational duration (e.g., the battery could die the very first day before the “two days” were even completed). Ans. 5.

Accordingly, we sustain the Examiner’s rejection under § 251 of claim 1, and claims 2–10, 12–26, 28–42, 44–73, and 75, which Appellant argues are patentable for similar reasons. *See* Appeal Br. 28–29; 37 C.F.R. § 41.37(c)(1)(iv).

Written Description
(§ 112, first paragraph)

Appellant makes the same argument for written description under § 112, first paragraph as for new matter under § 251. *See* Appeal Br. 29–33; Reply Br. 5–8. We are not persuaded for the same reasons.

Appellant’s additional conclusory assertion that “the predictable arts are subject to a *lower* written description standard than those in the unpredictable arts” is of no relevance here because Appellant has not shown there is sufficient written description support of reissue claim 1 under any standard. *See* Appeal Br. 31.

Accordingly, we sustain the Examiner’s rejection under § 112, first paragraph of claims 1–10, 12–26, 28–42, 44–73, and 75.

Indefiniteness
(§ 112, second paragraph)

Dependent claim 75 recites “balancing near term and long term maintenance needs against both operational requirements and at least one of status of consumables, operational readiness, and degradation or failures of at least one of the one or more elements of the at least one of the assets.”

The Examiner concludes that “[n]either the claim language nor the specification identify specifically what the act of balancing would entail and how one would determine what constitutes a balance between the near term and long term needs, thus it is impossible to determine the coverage of this claim language, rendering said language indefinite.” Ans. 10. “At best this limitation appears to be a restatement of the overarching goals of the invention” *Id.* at 11.

Although we agree with the Examiner that “verbatim” or “literal support” does not necessarily resolve this rejection because this is an indefiniteness rejection rather than a written description rejection, *see* Ans. 10, we agree with Appellant that a person of ordinary skill in the art would have understood the limitation. *See* Appeal Br. 32–33. The claim as written may be extremely broad, but “breadth is not indefiniteness.” *SmithKline Beecham Corp. v. Apotex Corp.*, 403 F.3d 1331, 1341 (Fed. Cir. 2005) (quotation omitted). “Merely claiming broadly does not . . . prevent the public from understanding the scope of the patent.” *Ultimax Cement Mfg. Corp. v. CTS Cement Mfg. Corp.*, 587 F.3d 1339, 1352 (Fed. Cir. 2009).

Accordingly, we do not sustain the Examiner’s rejection under § 112, second paragraph of claim 75.

DECISION

The following table summarizes the outcome of each rejection:

| Claims Rejected | Statute | Basis | Affirmed | Reversed |
|-------------------------------|----------------|-----------------------|-------------------------------|-----------------|
| 1-10, 12-26, 28-42, 44-73, 75 | § 251 | New matter in reissue | 1-10, 12-26, 28-42, 44-73, 75 | |
| 1-10, 12-26, 28-42, 44-73, 75 | § 112(a) | Written description | 1-10, 12-26, 28-42, 44-73, 75 | |
| 75 | § 112(b) | Definiteness | | 75 |
| OVERALL | | | 1-10, 12-26, 28-42, 44-73, 75 | |

TIME TO RESPOND

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. § 1.36(a)(1)(iv).

AFFIRMED