

Recent Board Decisions in Group 2100

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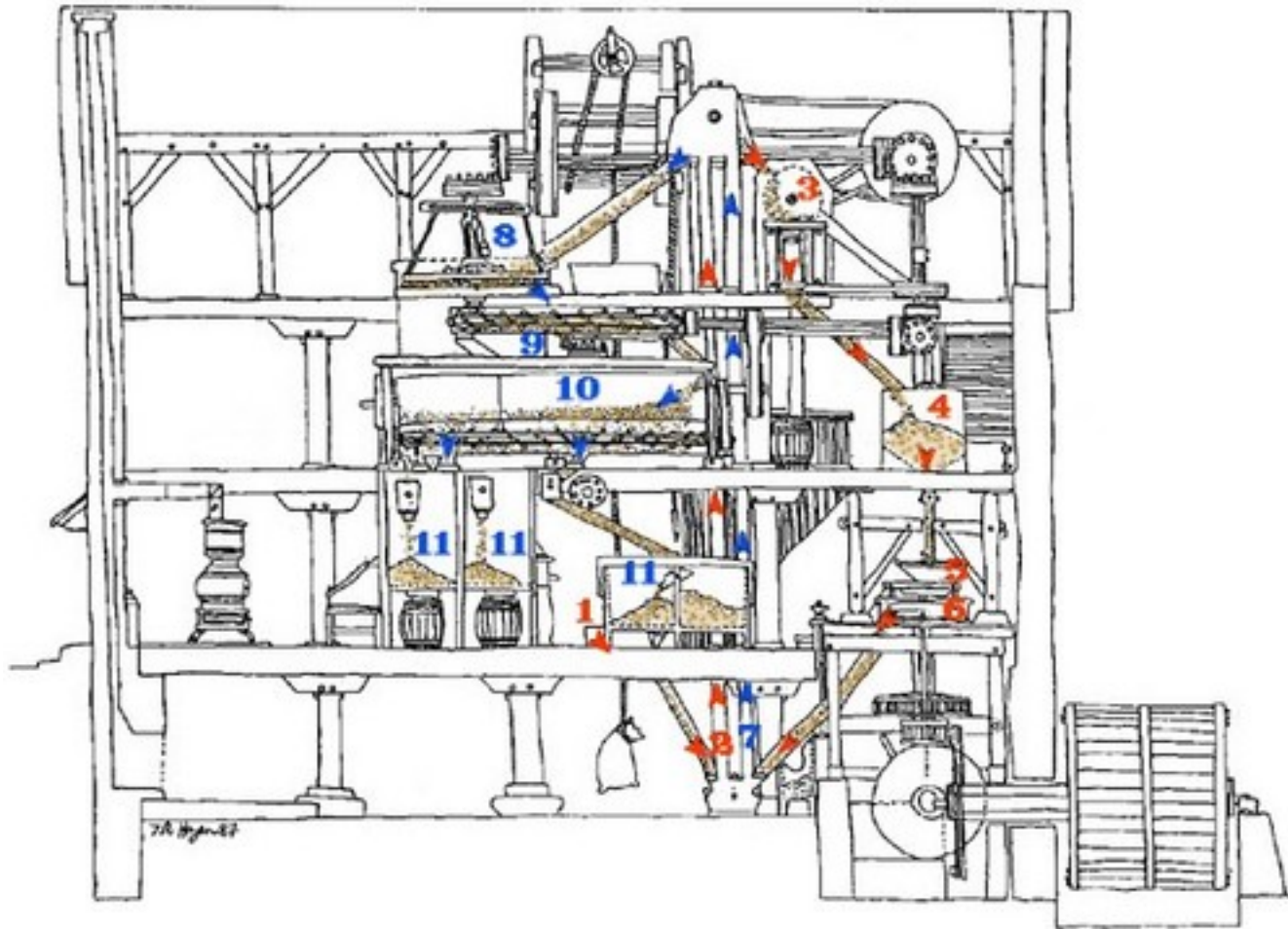


Birch
Stewart
Kolasch
Birch LLP

Colvin Mill – Great Falls, Va



Oliver Evans – Automated Flour Mill (Patented 1790)



Oral Hearing

- 37 C.F.R. 41.47; **MPEP 1209**

“An oral hearing should be requested only in those circumstances in which appellant considers such a hearing **necessary** or desirable for a proper presentation of the appeal.”

- Limited to hearings before merits panels

Oral Hearing

- 37 C.F.R. 41.47(d)
“oral argument will ordinarily be limited to **twenty minutes** for appellant and fifteen minutes for the primary examiner unless otherwise ordered”
- 20 minutes with interruptions

Oral Hearing

- “If the Board decides that a hearing is not necessary, the Board will so notify appellant”

Oral Hearing

- Audience: 35 U.S.C. 6
- “The administrative patent judges shall be persons of competent legal knowledge and scientific ability who are **appointed by the Secretary, in constitution with the Director.**”
- “Each appeal ...shall be heard by at least three members of the Patent Trial and Appeal Board”

Oral Hearing - Procedure

- Judges are assigned Roles as, Number 1, Number 2, and Number 3
- After Judge Number 1 has studied the appeal materials, a **conference** is held with other judges assigned to the appeal (the conference may include one other, or all members of the panel)
- If the Judge assigned the Role of Number 1 is not part of the majority, one of the judges assigned the role of Number 2 or Number 3 will author the majority opinion
- **Your Goal should be to convince the Judges Number 2 and Number 3**

Oral Hearing - Preparation

- Be ready to answer the question:

Why are you here?

- Do Not go if you cannot promote the interest of the client
- Common misconception – **The Board has already made its decision and the oral hearing is just a formality**
- Know the audience

Oral Hearing - Preparation

- **Bad Reasons/Introductory Comments:**

I am here because the client asked me to appear.

I was not the Attorney who prosecuted the application (implying: and do not completely agree with the position that was taken), but ...

I am not totally familiar with this application, but I'll try to answer any questions you might have.

I'm sure you have already made a decision, so I don't have anything further to say.

Oral Hearing - Preparation

- A good reason can be just to “explain the invention”; **Keep in mind that:**
- Typically only one of the Board members has thoroughly read the materials
- Decisions are based on a majority
- Not all judges have the same viewpoint
- Number 1 Judge must obtain approval of senior member
- The Judges are struggling with close issues just as you might have

Oral Hearing - Preparation

“Be Prepared”

- If you are not prepared, you will do more harm than good; on the other hand, this is your best chance to get a majority vote in your favor
- The oral hearing is a “fact finding session”; you will be interrupted
- Be prepared to point out where claim language is discussed in the specification and/or shown in the drawings (prepare a Claim Chart for claims that will likely be discussed)
- Be prepared to distinguish over the references; if there is a subtle difference, be able to show where it is described in the specification and in the Brief

Oral Hearing - Preparation

- Be prepared to present your **best argument** and to show where it is argued in the Brief; Avoid presenting arguments that have clearly not been addressed in the Brief (i.e., **avoid** getting into discussions of **new issues**)
- Be prepared to address your **weakest argument**; Do not ignore weaknesses; the judges want to hear what you have to say; thus, address them with a positive statement: “Such and such may appear to be a minor difference, but ...outweighed with the following facts”; Do not assume that the Board will understand any point you tried to make in the Appeal Brief with respect to the weakest argument; explain the perspective that you want them to consider

Oral Hearing - Preparation

- Be prepared to explain the scope of the **Broadest Claim**
- Be prepared to answer any questions pertaining to the **Appeal Brief**
- Be prepared to answer questions about **other parts of the references** not relied on by the Examiner

Oral Hearing - Preparation

- **Be on time**
- Be an **educator**; present facts in a conversational tone
- Avoid nervous habits and other distractions
- Be prepared to be **interrupted**
- **Listen** carefully to questions and comments; request clarification if you do not understand (the best presenters are ones that have good answers to their questions)

Oral Hearing - Presentation

- Be aware that questions/comments may be expressed because the judge is considering a new grounds of rejection.
- Be aware that the judge may be asking the question in order to assist him in convincing the other judges of a fact (Decision is based on a majority).
- Speak to judges that will not prepare the decision (typically the judge that leads the hearing is the one preparing the decision)

Oral Hearing - Presentation

- **Common Questions:**

Meaning of claim terms (claim scope); e.g., What is the meaning of this term and where is it discussed in the specification?

Explain Prior Art teaching; e.g., What is your interpretation of this section/teaching in the X reference?

Explain statements in the present specification and/or Brief; e.g., Can you explain the meaning of the statement on page X, line Y, of the specification (Brief)?

Oral Hearing - Presentation

- **Unusual Questions** to look out for:

Considering **remand** – series of questions pertaining to appellants interpretation of Examiner's rejection

Considering **new rejection** – questions pertaining to other references that are not part of the rejection or rejections that have not been made by the Examiner

- Be ready to persuade them in a certain direction

Oral Hearing - Presentation

- **Visual Aids:**
- Keep in mind that the panel members have all references, specification, drawings, etc, before them already
- If used, use only a few to make a specific point; do not make entire presentation based on visual aids
- Must be large enough to be seen; note that some of the judges are color blind

Oral Hearing - Strategy

- Present a Summary of the Invention in terms of the most specific claim (Claim having strongest position)
- Address a few key issues; Speak to judges that will not prepare the decision
- Give examples of points where the Examiner is clearly wrong with respect to these issues
- Present a point that requires re-explaining (in other words) to make sure the members understand your position on that issue
- Present an explanation for your weakest argument(s).

Recent Cases – Affirmed

- Ex parte Richard L. Sitzmann, et al.
- Appeal 2011-008989
- Art Unit 2111
- Judges:
 - Robert E. Nappi
 - Carolyn D. Thomas
 - Larry J. Hume*

Recent Cases – AU 2111

- Munitions Control Unit
- Intro: “We only consider those arguments actually made by Appellants in reaching this decision, and we do not consider arguments which Appellants could have made but chose not to make in the Briefs so that any such arguments are deemed to be waived. 37 C.F.R. § 41.37(c)(1)(vii).”

Recent Cases – AU 2111

- “We disagree with Appellant's conclusions with respect to claims 1-5, 7-9, 11-14, and 16-32, and we adopt as our own (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken and (2) the reasons and rebuttals set forth by the Examiner in the Examiner's Answer in response to Appellant's Arguments.”

Recent Cases – AU 2111

- Appellants contend Sexton is in a different field of endeavor than Ebertl because Sexton relates to industrial controls, including programmable logic controllers (PLC), while Ebertl pertains to military aircraft and associated weapons stores. App. Br. 11.

Recent Cases – AU 2111

- Appellants:
- “The mapping function of Sexton 's PLC does not address any of the problems of conventional HIAK's as identified in Ebert”

Recent Cases – AU 2111

- We are not persuaded by Appellants' arguments. Appellants' **challenge to the references individually is not convincing** of error in the Examiner's position. See *In re Keller*, 642 F.2d 413, 426 (CCPA 1981) ("one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references")

Recent Cases – AU 2111

- Further, "[u]nder the correct [obviousness] analysis, **any need or problem** known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 420 (2007)

Recent Cases – AU 2111

- Examiner:
- , the Examiner points out **Appellants incorrectly inserted an image of Figure 3 of the Ebert2 reference in their Brief**, rather than Figure 3 of the Ebert3 reference, as relied upon by the Examiner in the rejection of claim 25.
Ans. 27.

Recent Cases – AU 2111

- Conclusion:
- Accordingly, Appellants have not provided sufficient evidence or argument to persuade us of any reversible error in the Examiner's reading of the contested limitations on the cited prior art.

Lessons Learned

- Judges will most likely not consider arguments that the Appellant could have made.
- Should at least address the Examiner's arguments.
- Judges are considering reversible errors in the Examiner's rejection.

Recent Cases – Affirmed-in-Part

- Ex Parte Michael L. Behm, et al.
- Appeal 2011-007679
- AU 2155
- Judges:
 - Debra K. Stephens
 - Michael J. Strauss
 - Larry J. Hume (*Per curiam*)

Recent Cases – AU 2155

- 1. A computer implemented method for selecting a test case, the computer implemented method comprising:
- determining by a simulation submission system whether it is time to calculate test case scores for a plurality of test cases based on a predetermined time interval basis;
- responsive to determining that it is time to calculate the test case scores for the plurality of test cases based on the predetermined time interval basis, querying by the simulation submission system a database for stored simulation performance and coverage data for the plurality of test cases to find all coverage events previously unhit within a specified period of time;
- calculating by the simulation submission system the test case scores for the plurality of test cases using the stored simulation performance and coverage data to determine a set of test cases that will hit all the coverage events previously unhit within the specified period of time;

Recent Cases – AU 2155

- selecting by the simulation submission system a test case from the set of test cases that will hit all the coverage events previously unhit within the specified period of time with a highest calculated test case score to form a selected test case;
- running by the simulation submission system a simulation job on a device under test on a plurality of processors located in a cluster of computing devices connected via a network using the selected test case;

Recent Cases – AU 2155

- 15. The computer implemented method of claim 1, wherein the highest calculated test case score is a high probability score, and wherein the high probability score is proportional to an assigned test case score for the selected test case relative to a sum of all calculated test case scores.

Recent Cases – AU 2155

- according to Appellants, Victor does not teach selecting a test template with a highest calculated test template score from the set of test templates that contributed to covering the hard-to-hit events or that will cover all events previously uncovered within a specified period of time.

Recent Cases – AU 2155

- We agree with the Examiner that Victor teaches running 35,000 test-case templates for a period of time and keeping a history of which templates hit PriorityI events (see Victor pg. 550, §4 Coverage Analysis, ¶3). We find PriorityI events are described as events being tracked for completion for release to manufacturing (Victor pg. 550, §4 Coverage Analysis, ¶1). Victor continues to teach the history was kept of templates that *contributed most* to covering "hard-to-hit" events (Victor pg. 550, §4 Coverage Analysis, ¶3 We further find Victor teaches after a specified period of time (six weeks), "the test templates that were not contributing were eliminated" (id.).

Recent Cases – AU 2111

- In light of these findings, we find Victor teaches selecting a test case from the set of test cases (the 35,000 test-case templates) that will hit all the coverage events previously unhit (those test-case templates that contributed most to covering "hard-to-hit") within the specified period of time (six weeks).

Recent Cases – AU 2155

- Claim 15: The Examiner introduced Goldberg as evidence as to what was "well-known" in the art at the time Appellants' invention (Ans. 4).
- we are not persuaded, even given what was "well-known" in the art at the time of the present invention, Victor provides sufficient teaching or suggestion to render the disputed limitation obvious.

Lessons Learned

- Judges may consider teachings in prior art that can be argued to read on claimed features
- Secondary refs not included in the statement of rejection will be considered, but it is the cited reference that must support the prior art itself

Recent Cases – Affirmed

- Ex parte Neil MacDougall
- Appeal 2011-004480
- AU 2194
- Judges:
 - Carolyn D. Thomas
 - Johnny A. Kumar*
 - Larry J. Hume

Recent Cases – AU 2194

- We note that Appellants' arguments amount to no more than reciting the claim features and generally alleging that the cited prior art references are deficient. Merely pointing out certain claim features recited in independent claims 1, 10, and 19-21 and nakedly asserting that none of the cited prior art references teach or suggest such features does not amount to a separate patentability argument. See 37 C.F.R. § 41.37(c)(1)(vii) ("**A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.**");

Recent Cases – Affirmed

- Ex Parte Sherry Guo, et al.
- Appeal 2011-008941
- AU 2114
- Judges:
 - Joseph F. Ruggiero
 - John A. Evans
 - Larry J. Hume*

Recent Cases – AU 2114

- 1. A computer-implemented method for a client application on a client computer system to connect to a failover computer system, comprising:

detecting, by the client application, that a connection between the client computer system and a first computer system has failed, wherein the client application on the client computer system accesses at least one database application hosted by the first computer system through a database driver executed by the client computer system;

Recent Cases – AU 2114

- We note the remaining disputed limitation of claim 1 requires, in pertinent part, "detecting, by the client application, that a connection between the client computer system and a first computer system has failed." We find Tran teaches or suggests such detection by Tran's recognition of its timeout expiration before an acknowledgment is received, resulting in a retransmission of the client message packet by client 140.

Recent Cases – AU 2114

- While Appellants correctly point out Tran teaches a "shadow server" or "shadow CFD" (see Tran, Fig. 3 and App. Br. 12, 13) that appears to take over when the primary server fails, Appellants' arguments are not commensurate with the scope of the claim, which merely requires the client application to detect the failure, which Tran clearly does.

RECENT CASES – Affirmed

- Ex parte Aaron J. Sauve, et al.
- Appeal 2011-008904
- AU 2164
- Judges
 - Donald E. Adams
 - Eric Grimes*
 - Lora M. Green

Recent Cases – AU 2164

- 1. A computer-implemented method comprising:
- receiving user input pertaining to a desired search that a user wishes to conduct at a client browser;
- simultaneously spawning, by the client browser using a multi-threaded approach, an associated search across multiple different data providers in response to the user input, wherein an individual search request is sent to each data provider;
- receiving search results from the search across the multiple different data providers at the client browser; and
- displaying the search results for the user as individual browser tabs within a single browser window at the client browser, wherein each individual browser tab is part of a user interface of the client browser for holding a separate web page, and wherein ***each individual browser tab of the multiple browser tabs is associated with a respective data provider and is associated with a separate thread at the client browser.***

Recent Cases – AU 2164

- The Examiner finds that EarthNavigator teaches most of the limitations of claim 1 but does not teach a multi-threaded approach or that each browser tab is associated with a separate thread (id. at 5-6). The Examiner finds that Malone teaches a multi-threaded approach to simultaneous searches (id. at 6) and that Eich teaches using multi-threaded technology to deliver information between web servers and web browsers.

Recent Cases – AU 2164

- Appellants contend that Eich does not disclose that each browser tab is associated with a separate thread (App. Br. 11-12) and the Examiner has not articulated reasoning with rational underpinning to support the conclusion that this limitation would have been obvious.

Recent Cases – AU 2164

- ...the Examiner's position is that associating a separate thread with each browser tab is an **inherent feature** of a multi-threaded approach in which separate browser tabs simultaneously run a search on different search engines.

Recent Cases – AU 2164

- We conclude that the Examiner's position is supported by the evidence of record. **Appellants' Specification itself** states that when "multiple different searches are spawned using a multi-threaded approach ... each individual tab is associated with its own thread"

Lesson Learned

- Judges may look to the appellant's own spec for evidence of inherency

Recent Cases – Reversed

- Ex parte Gregory J. Boss, et al.
- Appeal 2011-004639
- AU 2142
- Judges:
 - Toni R. Scheiner
 - Eric Grimes
 - Jeffrey N. Fredman*

Recent Cases – AU 2142

The Examiner rejected claims 21-23, 60, 62-64, 67-70, and 73 under 35 U.S.C. § 103(a) as obvious over Snapper,² Fung,³ Gennaro,⁴ and Murase⁵.

Recent Cases – AU 2142

- We find that Appellants have the better position because it is not sufficient to simply identify separate teachings of claimed elements. The Examiner has provided no reason or explanation as to why the person of ordinary skill would append an answer to a challenge question as in Gennaroto a user ID as in Murase and incorporate the combined elements into the web browser software of Snapper. **The Examiner does not rely upon any of the seven rationales supporting obviousness found in MPEP § 2141 (III)**, which find legal basis in the KSR Supreme Court decision.

Recent Cases – AU 2142

- As the Federal Circuit has explained, "[c]are must be taken to avoid hindsight reconstruction by using `the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.'" *In re NTP, Inc.*, 654 F.3d 1279, 1299 (Fed. Cir. 2011) (quoting *Grain Processing Corp. v. Am.-Maize Prods. Co.*, 840 F.2d 902, 907 (Fed. Cir. 1988)).

Recent Cases – Reversed

- Ex parte Timothy S. Stevens
- Appeal 2011-008666
- AU 2168
- Judges:
 - Robert E. Nappi
 - Carla M. Krivak
 - Michael J. Strauss*

Recent Cases – AU 2168

- Appellants:
- "Reber . . . fails to . . . disclose *iteratively* finding each section in the *template* and executing any query in that section to return a selection of media objects (emphasis added)' as further required by claim 22 or similarly required by claim 27."

Recent Cases – AU 2168

- While Reber describes a table of relationships containing media equivalency relationships, **the Examiner has not addressed how Reber teaches iteratively** (i.e., repeatedly) finding each section of the table (i.e., template).

Recent Cases – New Grounds

- Ex parte Michael Kohut, et al.
- Appeal 2011-002464
- AU 2156
- Judges:
 - David M. Kohut
 - Jason V. Morgan
 - Johnny A. Kumar*

Recent Cases – AU 2156

- 1. A method for managing a plurality of content items, wherein each content item of the plurality of content items includes, at least in part, a recording of a live presentation, the method comprising:
 - (a) for each content item of the plurality of content items,
 - (1) *generating metadata* corresponding to that content item
 - (2) *while recording* at least part of a live presentation;

Recent Cases – AU 2156

- Claims 1-3, 5-13, 16, 17, 19-21, 23-30, 33-40 and 55-60 stand rejected under **35 U.S.C. § 102(e)** as being anticipated by Landeck (US 6,782,394 B1, Aug. 24, 2004, filed Sep. 25, 2000). Ans. 3-7.
- Claims 1-3, 5-13, 16, 17, 19-21, 23-30, 33-40 and 55-60 stand rejected under **35 U.S.C. § 103(a)** as being unpatentable over Landeck in view of Omoigui (US 7,305,384 B2, Dec. 4, 2007; filed Nov. 30, 2004). Ans. 8-12.

Recent Cases – AU 2156

- The Examiner has not provided sufficient evidence showing how Omoigui cures the deficiencies of Landeck, nor has the Examiner answered Appellants' particular arguments directed toward Omoigui.

Recent Cases – AU 2156

- We enter the following new ground of rejection pursuant to our authority under **37 C.F.R. § 41.50(b)**. Claims 1 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Landeck and Fuller (U.S. 6,833,865 B1; Dec. 21, 2004; filed July 29, 1999).

Comments

- Thank you!