The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WARREN B. JACKSON, DAVID K. BIEGELSEN,
TAD H. HOGG, CHEE WE NG,
ANDREW A. BERLIN,
KOENRAAD F. VAN SCHUYLENBERGH,
and CARLOS MOCHON

Appeal No. 2004-1981
Application No. 09/404,692

ON BRIEF

Before RUGGIERO, GROSS, and LEVY, Administrative Patent Judges.
LEVY, 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 1-10, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to distributed control of non-linear coupled systems with a single output. An understanding of

the invention can be derived from a reading of exemplary claim 1, which is reproduced as follows:

> 1. A control method for non-linear coupled systems of producing units having a single consumer output, the method comprising the steps of
>
> setting each producing unit to have an output responsive to a continuously provided analog signal representative of a market price,
>
> connecting each producing unit to a marketwire carrying the analog signal, with the changes in the analog signal on the marketwire representing changes in the market price and dependent upon the output response of each producing unit.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Clearwater	5,394,324	Feb. 28, 1995

Claims 1-10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Clearwater.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 20, mailed February 6, 2004) for the examiner's complete reasoning in support of the rejection, and to appellants' brief (Paper No. 19, filed December 22, 2003) for appellants' arguments thereagainst. Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could

have made but chose not to make in the brief have not been considered. See 37 CFR 41.37(c).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejection advanced by the examiner, and the evidence of anticipation relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we reverse, essentially for the reasons set forth by appellants. We begin with claim 1.

To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). As stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting Hansgirg v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)) (internal citations omitted):

> Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

The examiner's position is set forth on pages 3-5 of the answer. Appellants assert (brief, pages 4 and 5) that Clearwater fails to teach two elements of the claimed invention. Firstly, appellants assert (brief, page 4) Clearwater does not teach or suggest[1] the claimed marketwire element. Appellants argue (id.) that Clearwater does not teach "that it is the same control signal or circuit that goes to each of the producing units and consuming units." Appellants further argue (brief, page 5) that "the signal provided in Clearwater is a control signal that does not inherently represent a market price." Secondly, appellants assert (brief, page 5) that Clearwater fails to teach a producing unit that is itself responsive to a market price signal. Appellants argue that in the system of Clearwater, the auction controller determines the market price and then sends a signal to the producing unit, rather than the producing unit itself responding to the market price.

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[1] Appellants' assertion regarding "suggestions" of Clearwater are misplaced as the claims have not been rejected under 35 U.S.C. § 103(a).

The examiner responds (answer, page 12) that the first element, the marketwire, is disclosed by the “compound signals from the multiple thermostats.” The examiner argues (answer, page 13) that the independent claims do not “specifically define how the marketwire signal is routed to and from the producing units and the consuming units.” The examiner further argues (id.) that the market price is continuously present because Clearwater discloses that the signals from the thermostats contain both a volume and price component. The examiner asserts (answer, page 14) that Clearwater teaches the second element, a producing unit responsive to a market price, because “[t]he controller of Clearwater merely aggregates the signals from the multiple thermostats and provides this aggregate signal to the producing unit.”

From our review of Clearwater, we find that Clearwater discloses (col. 1, lines 10-12) “a method and apparatus for efficiently distributing a resource based on a computerized auction.” Clearwater further discloses (col. 4, lines 28-30) that “[t]he signal generated by each of the microprocessors is classified as either a buy bid or a sell bid.” Clearwater also teaches (col. 6, lines 8-10 and lines 18-20) that the “respective buy bids and sell bids are plotted to form a demand curve 60 and

a supply curve," and that the final auction price is the "point where the supply curve 62 meets the demand curve." Using this calculated price (col. 6, lines 48-50), "the central workstation 50 (auctioneer) transmits a signal to each respective room taking place in a consummated sale." Finally, Clearwater discloses (col. 7, lines 52-55) that "should there be a net selling or buying of a resource, such as cold air, the total amount of temperature supplied by the HVAC plant (or other resource supplier) can be adjusted."

From this disclosure of Clearwater, we find, for the reasons which follow, that Clearwater does not teach the first element at issue, the marketwire, as asserted by the examiner. We agree that in appellants' claims 1, 5 and 8, (brief, page 4) "the same control signal and/or circuit represented by the marketwire is connected to each of the producing units and consuming units." Therefore, the disclosure in Clearwater of control signals being sent from the central workstation and thermostats during the auction process does not teach the marketwire. We also agree with appellants (brief, page 5) that "the signal provided in Clearwater is a control signal that does not inherently represent a market price," because the signals sent by the thermostats in Clearwater represent buy and sell bids

for a particular room. These bids do not represent the market price, but rather are used by the central controller in the auction process to determine the market price. Therefore, we find that Clearwater fails to teach the marketwire element as recited in claim 1.

We find that Clearwater also does not teach the second element at issue, a producing unit that is itself responsive to a market price signal. Clearwater discloses how the central controller calculates the auction price based on the buy and sell bids, and from this disclosure, we do not agree with the examiner (answer, page 14) that "[t]he controller of Clearwater merely aggregates the signals from the multiple thermostats and provides this aggregate signal to the producing unit." In Clearwater, the resource supplier adjusts its output in response to a signal from the central controller. This signal is not "representative of the market price," as recited in claim 1. We therefore agree with appellants (brief, page 6) that "there is no suggestion from Clearwater of the producing units having the ability to interpret a market price."

From all of the above, we find that the examiner has failed to establish a prima facie case of anticipation of claim 1. Accordingly, the rejection of claim 1, and dependent claims 2-4,

is reversed. As independent claims 5 and 8 recite "providing producing units connected to a marketwire," the rejection of claims 5 and 8, and dependent claims 6, 7, 9, and 10, is also reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-10 under 35 U.S.C. § 102(b) is reversed.

REVERSED

JOSEPH F. RUGGIERO Administrative Patent Judge	)	
ANITA PELLMAN GROSS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
STUART S. LEVY Administrative Patent Judge	)	

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