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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EVREN ERYUREK

Appeal No. 2005-0108
Application No. 10/099,828

ON BRIEF

Before BARRETT, DIXON and LEVY, **Administrative Patent Judges**.

DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-10, 22, and 26-28, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to a communication technique for field devices in industrial processes. An understanding of the invention can be derived from a reading of exemplary claims 1 and 22, which are reproduced below.

1. A process device adapted to couple to a fluid process control loop, the device comprising:

loop interface circuitry adapted to couple to the process control loop to send and receive loop signals on the process control loop;

processor circuitry coupled to the loop interface circuitry and adapted to provide global internet-compatible data to the loop interface circuitry for transmission upon the process control loop; and

a memory coupled to the processor circuitry and adapted to store data related to global internet communication.

22. A program on a computer readable medium comprising:

a data access routine for obtaining fluid process data;

a formatting routine for formatting the fluid process data in accordance with a transmission protocol;

an addressing routine for adding a destination internet address to the formatted data; and

a loop formatting routine for adding a process loop destination address to the formatted data and internet address.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Burns et al. (Burns)	5,970,430	Oct. 19, 1999 (filed Sep. 3, 1997)
Papadopoulos et al. (Papadopoulos)	6,282,454	Aug. 28, 2001 (filed Sep. 10, 1997)

Claim 22 stands rejected under 35 U.S.C. § 102 as being anticipated by Burns. Claims 1-10 and 26-28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Burns in view of Papadopoulos.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 18, mailed Apr. 21, 2004) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 16, filed Jan. 30, 2004) for appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we make the determinations which follow.

35 U.S.C. § 102

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. **Verdegaal Bros. Inc. v. Union Oil Co.**, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), **cert. denied**, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in **Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), **cert. denied**, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it." While all elements of the claimed invention must appear in a single reference, additional references may be used to interpret the anticipating reference and to shed light on its meaning, particularly to those skilled in the art at the relevant time. **See Studiengesellschaft Kohle v. Dart Indus.**, Inc., 726 F.2d 724, 726-727, 220 USPQ 841, 842-843 (Fed. Cir. 1984). Here the examiner maintains that columns 5 and 6 of Burns teach the use of an internet address. (See answer at pages 3-4.) Yet from our review of those specific portions of Burns, we cannot agree with the examiner. Furthermore, while we do find that Burns suggests the use of the internet at column 34, lines 50-54, for the downloading of software, we find no express or inherent teaching of the use for data transmission. Therefore, while we deem it to be an obvious

modification of the teachings of Burns, we cannot find that Burns anticipates independent claim 22, and we cannot sustain the rejection of independent claim 22.[1]

35 U.S.C. § 103

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a ***prima facie*** case of obviousness. **See In re Rijckaert**, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A ***prima facie*** case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is ***prima facie*** obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. **See In re**

[1] **See** New Grounds of Rejection under 35 U.S.C. § 103, **infra**.

Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination `only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.'" **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 999-1000, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d

1362,1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the language of independent claim 1.

Independent claim 1 requires “processor circuitry coupled to the loop interface circuitry and adapted to provide global internet-compatible data to the loop interface circuitry for transmission upon the process control loop; and a memory coupled to the processor circuitry and adapted to store data related to global internet communication.” We find that Burns teaches the use of the internet for transmission of software to the microprocessor (Figures 1, 6, and 7 and column 34, lines 50-54). Therefore, we rationalize that if the system can receive data and software via the internet as a means of communication, it would have been obvious to one of ordinary skill in the art at the time of the invention (and within the level of ordinary skill) to also transmit monitoring data via the internet using global internet address and that these addresses would necessarily have been stored within the system memory.

While the examiner has not relied upon the above specific teaching in Burns, we do agree with the examiner’s findings that the teachings of Papadopoulos with respect to the use of internet communication and the basic structure of the communication would have suggested the combination as maintained by the examiner. We find that the suggestion of the use of the internet in Burns at column 34 clearly suggests the combination of the teachings of Burns and Papadopoulos.

Appellant argues that the nature of devices of the two references are drastically different. (See brief at page 5.) Appellant argues that the PLCs of Papadopoulos are miniature in size and not subject to harsh environments. Nor are they required to operate on constrained power budgets, as compared to the field devices of Burns. (See brief at page 5.) While appellant's arguments appear to distinguish between PLCs and field devices in these specific features, we do not find that these arguments are commensurate with the general scope of appellant's broad claim language. Specifically, we find no limitation in independent claim 1 with respect to the size of the devices, or a specific harsh environment. Nor do we find a limitation independent claim 1 as to the power budgets or manner in which the device is powered. Therefore, we do not find these arguments to be persuasive.

Moreover, we note that Burns specifically discloses at column 8, lines 15-20, that "bus 34 supports or allows two-way, purely digital communication and may also provide a power signal to any or all of the devices connected thereto, such as the field devices 16-32. Alternatively, any or all of the devices 12-32 may have their own power supplies or may be connected to external power supplies via separate wires (not shown)." We find this teaching of Burns to suggest that bus 34 may provide "a power signal to any or all of the devices connected thereto" which includes both the field devices and the PLC's or that all of the devices may have sources of power separate from the bus as an alternative within the level of skill in the art.

Appellant argues that the examiner mischaracterizes the devices of Burns and and Papadopoulos as analogous because these devices are "typically field hardened robust devices that are mounted in harsh environments and are typically required to operate on severally [sic, severely] constrained power budgets." [Emphasis added.] Again, we find that appellant's arguments are not commensurate with the language of independent claim 1 and appellant has only asserted a general argument without support in the teachings of the prior art.

Appellant argues that the PLC's of Papadopoulos are "generally a very different sort of device that is characterized by a high degree of expandability and configurability . . . typically used . . . and very often operate on, for example 110 Volts AC." (Brief at page 8.) Again, we find that appellant is arguing generalities rather than the specific teachings and suggestions of the applied prior art. Therefore, this argument is not persuasive. Burns teaches at column 9, lines 8-10, that the "hosts 12 and 15, the PLC 13, and the controllers 14 may be any type of fieldbus device but, typically, will be link master devices." Therefore, we find that Burns teaches that there is no specific combination of types of devices required or combinable in the system.

Appellant argues that even if the teachings of the two references are analogous, the examiner has not supplied a sufficient suggestion to support the ***prima facie*** case of obviousness. (Brief at pages 8-9.) We disagree with appellant as discussed above. Appellant further argues that Papadopoulos teaches that using proprietary fieldbus

alternatives can be costly. (Brief at page 9.) Appellant argues that every embodiment of appellant's invention use a specialized network and that therefore, Papadopoulos teaches away from using their invention with specialized networks. (Brief at page 9.) Again, we do not find appellant's argument commensurate in scope with the claimed invention. We find no limitation in independent claim 1 as to a specialized network since the claim is directed to a singular process device. Therefore, this argument is not persuasive. Since we find that the examiner has established a ***prima facie*** case of obviousness and appellant has not shown error therein nor adequately rebutted the ***prima facie*** case, we will sustain the rejection of independent claims 1, 2, 8, and 26-28 and their dependent claims 5 and 10 which appellant has elected to group therewith. (Brief at page 4.)

With respect to dependent claim 3, appellant argues that while power from the control loop has been used in the past (Brief at page 9), the examiner's assertion that the PLCs of Papadopoulos could be used on the communication loop is to assume away many of the technical difficulties faced by the designers. (Brief at page 10.) We disagree with appellant since Burns clearly teaches the use of either loop power or separate power and the use of the internet to download software. We find that the teachings of Burns would have suggested the use of the use of the communication loop for power in combination with the use of the internet. Therefore, this argument is not

persuasive, and we will sustain the rejection of dependent claim 3 and claims 4 and 9 which appellant has elected to group therewith. (Brief at page 5.)

With respect to dependent claim 7, appellant argues that the USPTO cannot disregard the corresponding structure disclosed in appellant's specification when addressing means plus function limitations in a claimed invention. While we agree with appellant that the examiner cannot disregard the means plus function limitations in a claimed invention when addressing the claim in a rejection, we do not find that appellant has identified any error in the examiner's application of the prior art. From our review of the examiner's rejection, the examiner has clearly identified what teachings in Burns and Papadopoulos correlate to the claimed limitations. Furthermore, appellant admits that the field devices of Burns are of the type used by appellant (Brief at page 6) and that the powering of these devices by the communication loop was done in the prior art (Brief at page 9), but that there were "technical difficulties" in powering the field devices (Brief at page 10). Therefore, we can at most speculate that it is the "means for providing power . . ." which appellant's contest. We find no specific argument thereto and from our review of appellant's specification, we find no specific structure disclosed thereto. Since we cannot speculate or rationalize as to the basis of appellant's argument, we will sustain the ***prima facie*** case which we find the examiner has set forth in the statement of the rejection.

NEW GROUND OF REJECTION UNDER 37 CFR § 41.50(b)

Claim 22 is rejected under 35 U.S.C. § 103 as being unpatentable over Burns.

We incorporate the examiner's discussion of the teachings of Burns from the rejection with the exclusion of the finding that columns 5 and 6 of Burns teaches the use of an internet address. (See answer at pages 3-4.) From our review of the teachings of Burns, we find that Burns teaches at column 34, lines 50-54,

> [i]f implemented in software, the diagnostics of the present invention may be stored in any computer readable memory such as on a magnetic disk, a laser disk, or other storage medium, in a RAM, ROM, EPROM, etc. of a computer, and the like. Likewise, this software may be delivered to a user or a device via any known or desired delivery method including, for example, over a communication channel such as a telephone line, <u>the internet</u>, etc. [Emphasis added.]

While neither the examiner nor appellant mentions this discussion and suggestion of the use of "the internet," we find that this teaching is a clear suggestion that the "software may be delivered to a user or a device via <u>any known or desired delivery method</u> including, for example, over a communication channel such as a telephone line, <u>the internet</u>" [our emphasis]. We find this direct teaching of the use of the internet as a communication medium which we find to be a strong suggestion to use the internet as a means for the process device to transmit its data to the remainder of the process control system. For the device of system and sub components of the system to receive software via the internet each of the units would have been required

to have a (global) internet address. Therefore, there would have had to have been a protocol in place to receive (and transmit) data according thereto. Therefore, we find that Burns suggests the use of the internet as a means of communication. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to implement an addressing routine for adding a destination internet address to the data.

Appellant argues that the internet address in independent claim 22 is a "piece of data that is handled by the IP stack (OSI layer 3)." (See brief at page 12.) Here, we find that with the use of the internet as clearly suggested by Burns there would have been such an internet address required and skilled artisans would have appreciated such a need in the design of the internet based system. Therefore, we do not find appellant's argument persuasive.

CONCLUSION

To summarize, the decision of the examiner to reject claim 22 under 35 U.S.C. § 102 is reversed, and the decision of the examiner to reject claims 1-10 and 26-28 under 35 U.S.C. § 103 is affirmed. A New Ground of Rejection of claim 22 under 35 U.S.C. § 103 has been entered under 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options

with respect to the new ground-of rejection to avoid termination of the appeal as to the rejected claim:

> (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . . .
>
> (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record . . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRM-IN-PART; 37 CFR 41.50(b)

LEE E. BARRETT Administrative Patent Judge	)
JOSEPH L. DIXON Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
STUART S. LEVY Administrative Patent Judge	)

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