

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERT W. BRUNING

Appeal 2007-3457
Application 09/888,899
Technology Center 3600

Decided: February 7, 2008

Before WILLIAM F. PATE, III, TERRY J. OWENS and
JOHN C. KERINS, *Administrative Patent Judges*.

KERINS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Gert W. Bruning (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-13. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE and REMAND, pursuant to 37 C.F.R. § 41.50(a)(1) (2007).

THE INVENTION

Appellant's claimed invention is to a method for selling lighting solutions and a lighting solutions system which involve installing a lighting system, measuring either lumen output or changes in the light spectrum output, and determining a customer's light usage fee based upon the measurement taken. Claims 1, 5 and 10, reproduced below, are representative of the subject matter on appeal.

1. A method for selling lighting solutions comprising:

installing a lighting system for a customer;

measuring lumens generated from the lighting system; and

determining a customer's light usage fee based on the lumens.

5. A method for selling lighting solutions comprising:

installing a lighting system for a customer;

measuring changes of light spectrum generated by the lighting system; and

determining a customer's light usage fee based on the changes of light spectrum.

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10. A lighting solutions system comprising:
- means for measuring lumen output of a lighting system; and
- means for determining a fee based on the lumen output.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Lys	US 6,211,626 B1	April 3, 2001
Yablonowski	US 6,535,859 B1	March 18, 2003

The following rejection is before us for review:

Claims 1-13 stand rejected under 35 U.S.C. § 103(a) as being obvious over the Lys patent in view of the teachings of the Yablonowski patent.

ISSUES

The principal issue raised in this appeal is whether Appellant has shown that the Examiner erred in rejecting Claims 1-13 under 35 U.S.C. § 103(a) as being obvious in view of the Lys and Yablonowski references.

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. The Lys patent discloses at least several environments in which its lighting system may be used, which environments would generally involve the lighting system being installed for a customer. (Lys, Figs. 60, 65; several examples discussed in Columns 34-38).

2. The Yablonowski patent discloses a method for installing or retrofitting power-conserving lighting equipment in a facility, and establishing a fee agreement whereby the customer is charged a fee that is a function of the difference between an original power consumption and the power consumption of the newly operating lighting system. (Yablonowski, Col. 1, l. 54-Col. 2, l. 22). Yablonowski discloses that this method may be performed by one or more entities, including, for example, an Engineering Firm/Project Manager, a Construction Manager/Contractor, a wholesale light fixture company, a lighting service company, and others. (Yablonowski, Col. 5, ll. 50-65)

3. The Lys patent discloses embodiments in which the emitted light intensity is measured (Lys, Col. 42, ll. 3-11, for example), and

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embodiments in which changes in light spectrum are measured. (Lys, Col. 52, ll. 33-43, for example). These measurements enable monitoring for proper operation of the lighting units, and/or enable the lighting units to be controlled in different operating modes. (Lys, Col. 9, ll. 53-65; Col. 13, ll. 10-22, for example).

PRINCIPLES OF LAW

In *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18, (1966), the Supreme Court set out a framework for applying the statutory language of § 103:

[T]he scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.”

While the sequence of these questions might be reordered in any particular case, the factors continue to define the inquiry that controls. If a court, or patent examiner, conducts this analysis and concludes the claimed subject matter was obvious, the claim is invalid or unpatentable under § 103. *See KSR Int’l v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). To facilitate review, this analysis should be made explicit. *Id.* at 1741. It can be important to identify a reason that

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would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed invention does. This is so because inventions in most, if not all, cases rely upon building blocks long since uncovered. *Id.*

ANALYSIS

Rejection of claims under 35 U.S.C. § 103(a)

All of Claims 1-13 on appeal stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Lys patent, in view of the Yablonski patent.

Claims 1, 5, and 10 are independent claims. Appellant presents arguments under separate subheadings that purport to address the patentability of Claims 5 and 10 separate and apart from the patentability of Claim 1. However, with respect to Claim 10, the arguments presented in these sections do not address claim elements that are peculiar to or specific to that claim, and instead address elements that are common with Claim 1. Accordingly, we will treat Claim 10 as standing or falling with Claim 1 in the instant appeal. None of the dependent claims were separately argued, therefore these claims will also either stand or fall with the claims from which they depend. We will take Claims 1 and 5 as the representative claims in determining whether Appellant has established that the rejection of the claims is in error.

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Claim 1 is directed to a method for selling lighting solutions including the steps of installing a lighting system, measuring the lumens generated from the lighting system, and charging a light usage fee based upon the measured lumens. Claim 5 differs in that the method requires measuring changes in the light spectrum output by the lighting system, and charging a usage fee based on the spectrum changes.

The rejection of the claims is based on assertions that the Lys patent discloses a lighting system that (1) is installed for a customer, and (2) measures the intensity of the illumination generated by the lighting system. The rejection further asserts that it would have been obvious, in view of the Yablonowski patent, to charge a customer a usage fee based upon the measured intensity of the illumination (*i.e.*, based on the lumens). (Answer 3-5).

Appellant contends that the rejection is erroneous because the Lys patent does not teach or suggest installing a lighting system for a customer, and because the combined teachings of Lys and Yablonowski do not render obvious the charging of a usage fee to a customer based upon the measured lumens or measured change in light spectrum. (Appeal Br. 6-9).

The first contention lacks merit. The Lys patent was cited as disclosing “initially placing the modular LED unit...in an environment.” (Answer 9). Appellant states that this “is not the same

as installing a lighting system for a customer,” in that “an environment” could be simply a bench in a laboratory. (App. Br. 9, Reply Br. 3). Appellant fails to note, however, that the disclosed “environment” can be a motion picture theater (Fig. 60), a subway tunnel (Fig. 65), or any of the several other environments that Lys explicitly discloses. Lys does not explicitly state that the LED unit manufacturer would or could install these devices for a customer, however, it is plainly apparent that, in at least several of the disclosed environments, a lighting contractor or subcontractor would install the lighting system for a customer (*e.g.*, the owner of the movie theater, the operator of the subway system).¹ (Finding of Fact 1).

Appellant also asserts (Appeal Br. 6-9) that the Examiner has not demonstrated how the Yablonowski patent teaches or suggests a system or method by which a customer is charged based upon measuring the light output (the lumens) of a lighting system, or, as it

¹ As discussed in greater detail in the section below ordering remand to the Examiner, the claims should be examined, in their broadest reasonable interpretation, with consideration being given to the possibility that a single entity might not perform all of the steps of the claimed method, and/or that the manufacturer of the lighting units in Lys might not be involved in performing any of the steps. For example, in Yablonowski, the business entity installing the power conservation equipment and then measuring power consumption and charging the customer based upon the savings in power consumption, is not necessarily involved in manufacturing any of the installed components. (Finding of Fact 2).

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pertains to Claim 5, based upon measuring changes in the light spectrum output by the lighting system. Here, we agree with Appellant.

The Lys patent does monitor or measure, in various embodiments, the intensity of the illumination, and the light spectrum output of the lighting system, in order to ensure proper operation of, and to allow for specific control modes of, the system. (Finding of Fact 3). Yablonowski, on the other hand, is directed to a method which involves installing a more efficient lighting system including power saving devices, and charging the customer a fee that is based in some way upon the energy savings of the new system as compared to the previous system. (Finding of Fact 2).

The Examiner's position is that, since the Lys system does go about measuring the lumen output, and since the manufacturer of the Lys system requires funds to operate its business, the teachings of Yablonowski would suggest to persons of ordinary skill in the art that the manufacturer of the Lys devices could generate such income by charging a usage fee based upon the lumen output or the changes in light spectrum. The rejection is deficient in providing persuasive reasoning as to how or why a person of ordinary skill in the art would find it obvious for an equipment manufacturer (the entity in Lys) to forego a traditional means of generating income (such as selling to wholesalers or retailers), and to adopt the income-generating system

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of Yablonowski. In addition, no persuasive reasoning is provided addressing the obviousness of modifying that system to charge fees based not on energy or power savings, but instead on system output characteristics, *e.g.*, the amount of lumens output or changes in the light spectrum. Such reasoning may exist, we simply do not find it in the record before us.

The rejection of Claims 1-13 under 35 U.S.C. § 103(a) will thus be reversed.

Remand to the Examiner

We are of the view that one source of error in the § 103(a) rejection above is that the claims were incorrectly interpreted and/or that the proper scope of the claims was not fully understood. Accordingly, we will remand the case to the Examiner for further consideration of the application, addressing the issues set forth below.

The proper scope of Claims 5-9, 12, and 13, was not taken into account in the rejection of those claims. These claims involve steps of measuring changes of a light spectrum and determining a light usage fee based on such changes. In presenting the ground of rejection relative to these claims, the Examiner erroneously attempted to apply a teaching of determining a customer light usage fee “based on the lumens”. (Answer 4, section addressing Claim 5). The Examiner instead must assess whether the Lys patent or any other prior art

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teaches or suggests what is actually claimed, in particular, method steps involving measuring changes in a light spectrum generated by a lighting system, and determining a customer light usage fee based at least in part on the changes in spectrum. The rejection of Claim 5 and claims depending therefrom nowhere evidences that this claim element was taken into account.

Further, it appears that the Examiner may not have given the claims their broadest reasonable interpretation in examining the claims for patentability. In particular, method Claims 1 and 5, and the claims depending therefrom, are not limited such that the steps must be performed by a lighting equipment manufacturer or by any other single entity, for that matter. The grounds of rejection set forth in the Examiner's Answer were premised on the lighting equipment manufacturer (the entity in Lys) performing the entire claimed method. This led to the unsound conclusion that the manufacturer would find it obvious to generate its income by charging user fees for its equipment, rather than the more traditional business practice of selling products outright.

The Examiner should evaluate the prior art to determine if the claimed method, as performed by an entity other than a manufacturer, or by more than one entity, is disclosed or rendered obvious. In this regard, we note that the Yablonski patent describes that its business approach may involve one or more entities, including entities from

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among the following categories: Engineering Firm/Product Manager; Construction Manager/Contractor; wholesale fixture company, and/or a lighting service, or others. (Finding of Fact 2).

Appellant's claims leave open the possibility that the installation step could be performed by an entity other than the manufacturer of the lighting system (*e.g.*, a general contractor or an electrical contractor or subcontractor). In addition, an entity different than the installer, such as a utility company, for example, could, within a reasonable interpretation of the scope of the claims, perform the remaining steps of measuring lumens or changes of light spectrum, and determining the customer's light usage fee based on the measurement. The prior art should be reassessed in light of these considerations.

It appears further that another element of the claims was likely interpreted more narrowly than it should have been. Specifically, the claimed determination of a fee "based on the lumens" (Claim 1), or "based on the changes of light spectrum" (Claim 5), or "based on the lumen output" (Claim 10), appears to have been interpreted as the determination being based *solely* or *exclusively* on that parameter or factor, whereas a broader reasonable interpretation might allow for the determination of the fee to be based only *in part* on that parameter or factor. The Examiner should address this, including whether Yablonowski or other prior art involves determining a customer's fee

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that is based at least in part on the measured lumens or the measured change in light spectrum.

CONCLUSIONS OF LAW

We conclude that Appellant has established that reversible error occurred in the rejection of Claims 1-13 under 35 U.S.C. § 103(a). We further conclude that remand of the case to the Examiner under 37 C.F.R. § 41.50(a)(1) is appropriate in order to have the proper scope of the claims considered.

ORDER

The decision of the Examiner to reject Claims 1-13 under 35 U.S.C. § 103(a) is REVERSED.

The application is REMANDED to the Examiner for appropriate action in accordance with the matters discussed above.

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

REVERSED; REMANDED, 37 C.F.R. § 41.50(a)(1)

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