

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. 43

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* RODNEY C. HEMMINGER and MARK L. MUNDAY

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Appeal No. 2001-1866  
Application No. 08/478,606

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ON BRIEF

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Before JERRY SMITH, GROSS, and BARRY, *Administrative Patent Judges*.  
BARRY, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

A patent examiner rejected claims 3-38. The appellants appealed therefrom under 35 U.S.C. § 134(a). We affirmed-in-part and entered new grounds of rejection. *Ex parte Hemminger*, No. 2001-1866, slip op. at 1 (Bd.Pat.App. & Int. Oct. 8, 2002). The appellants now ask us to reconsider our decision to affirm the rejection of claims 3-15 and 25-38 under § 103(a) and our decision to reject claims 16-24 under 35 U.S.C. § 112, ¶¶ 1 and 2. (Req. Reh'g at 2.)

At the outset, we recall that claims that are not argued separately stand or fall together. *In re Kaslow*, 707 F.2d 1366, 1376, 217 USPQ 1089, 1096 (Fed. Cir. 1983)

(citing *In re Burckel*, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979)). When the patentability of a dependent claim is not argued separately, in particular, the claim stands or falls with the claim from which it depends. *In re King*, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986) (citing *In re Sernaker*, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983); *In re Burckel*, 592 F.2d 1175, 1178-79, 201 USPQ 67, 70 (CCPA 1979)). Furthermore, "[m]erely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable." 37 C.F.R. § 1.192(c)(7).

Here, rather than arguing the patentability of claim 25, the appellants assert, "[i]ndependent claim[] . . . 25 recite[s] similar features" (Appeal Br. at 6), to those of independent claim 3. Although they point out differences in what "certain," unspecified dependent claims cover, (*id.* at 8), this is not an argument why the claims are separately patentable. Therefore, claims 4-15 and 25-38 stand or fall with representative claim 3, and claims 17-24 stand or fall with representative claim 16.

With this representation in mind, we address the following rejections:

- rejection of claims 3-15 and 25-38 under § 103(a)
- rejections of claims 16-24 under 35 U.S.C. § 112, ¶¶ 1 and 2.

Rejection of Claims 3-15 and 25-38 under § 103(a)

Rather than reiterate the positions of the Board or appellants *in toto*, we address the latter's main point of contention. Admitting that "the Board correctly notes that Johnston transmits information about kilowatt hours and kilowatt demand," (Req. Reh'g at 4), the appellants argue, "kilowatt hours and kilowatt demand do not represent 'various power measurements' from which the 'selected power measurement' is obtained. . . ." (*Id.* at 3.) They explain, "it clear [sic] from the specification of the instant application that the term 'various power measurements' . . . refers to these well known types of electrical power - real power (watts), reactive power (VAR), and apparent power (VA)." (*Id.* at 4.)

"Analysis begins with a key legal question -- *what* is the invention *claimed*? Claim interpretation . . . will normally control the remainder of the decisional process." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question, "the Board must give claims their broadest reasonable construction. . . ." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

Here, claim 3 specifies in pertinent part "various power measurements. . . ." Despite the appellants' argument, the various power measurements of the claim are not limited to real power, reactive power, and apparent power. Had the appellants intended to limit the scope of claim 3 so, they could have recited expressly the various power measurements of real power, reactive power, and apparent power as they did in claim 16 ("generate various power measurements including real power, reactive power, and apparent power. . . ."). The appellants chose not to do so, seeking a broader claim. We will not read the omitted limitations into claim 3 thereby narrowing it. If the appellants choose to have these limitations included, they can amend the claim "*during the examination of [their] patent application. . . .*" *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969).

In addition, the doctrine of claim differentiation supports an interpretation of "various power measurements" that is not limited to the specification's real power, reactive power, and apparent power. "This doctrine, which is ultimately based on the common sense notion that different words or phrases used in separate claims are presumed to indicate that the claims have different meanings and scope," *Karlin Tech., Inc. v. Surgical Dynamics, Inc.*, 177 F.3d 968, 971, 50 USPQ2d 1465, 1468 (Fed. Cir. 1999) (citing *Comark Comms. Inc. v. Harris Corp.*, 156 F.3d 1182, 1187, 48 USPQ2d 1001, 1005 (Fed. Cir. 1998)), "normally means that limitations stated in dependent

claims are not to be read into the independent claim from which they depend." *Id.* at 972, 50 USPQ2d at 1468 (citing *Transmatic, Inc. v. Gulton Indus., Inc.*, 53 F.3d 1270, 1277, 35 USPQ2d 1035, 1041 (Fed. Cir. 1995)).

Here, claim 4 depends from, and further limits, claim 3. More specifically, the dependent claim recites that "the various power measurements include real power, reactive power and apparent power. . . ." Because these specific power measurements are stated in claim 4, these are not to be read into claim 3, from which claim 4 depends. Giving the representative claim its broadest, reasonable construction, therefore, the limitations merely require at least two measurements of power.

Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious. The question of obviousness is "based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently. . . ." *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966); *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ 1614, 1616 (Fed. Cir. 1999); *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995)). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of

ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, Johnston discloses "a programmable AC electric energy meter 10. . . ." Col. 5, l. 1. "The meter 10 includes a programmable time based measuring system 15 including a metering sequence logic control circuit 16." *Id.* at ll. 5-8. We find that the latter circuit ascertains the power measurements of kilowatt hours and kilowatt demand. Specifically, "circuit 16 totalizes and stores in the data RAM memory 34 the values of the electric energy parameters to be measured including **kilowatt hours** and **kilowatt demand** for the predetermined high rate, mid rate and low rate periods during each day." Col. 6, ll. 22-27 (emphases added).

The appellants further argue that Johnston's kilowatt hours and kilowatt demand "are different expressions of a *single* power measurement - real power (watts)." (Req. Reh'g at 4.) "Argument in the brief does not take the place of evidence in the record." *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965) (citing *In re Cole*, 326 F.2d 769, 773, 140 USPQ 230, 233 (CCPA 1964)). Here, the reference evidences that its kilowatt hours and kilowatt demand are two measurements of power, which is all that the limitations at issue require. Specifically, Johnston refers to kilowatt hours and

kilowatt demand as different "parameters to be measured. . . ." Col. 6, l. 24 (emphasis added), and as different "values measured. . . ." *Id.* at l. 27 (emphasis added). Having found that teachings from Johnston itself would have suggested at least two measurements of power to a person of ordinary skill in the art, we maintain our affirmance of the obviousness rejection of claim 3 and of claims 4-15 and 25-38, which fall therewith.

Rejections of Claims 16-24 under 35 U.S.C. § 112, ¶¶ 1 and 2

Rather than reiterate the positions of the Board or appellants *in toto*, we address the latter's two points of contention. First, they "submit that nothing prevents claims 16, 22, and 24 from reading on a structure, such as that described in this portion of the specification, where the transmit LED of the optical port is in effect borrowed to provide the test interface function." (Req. Reh'g at 7.)

"[T]he main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. *[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) (quoting Giles S. Rich, *The Extent of the Protection and Interpretation of Claims --American Perspectives*, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499, 501 (1990)).

Here, the appellants added claims 16-24 to their specification by an amendment. (Paper No. 8.) Independent claim 16 specifies in pertinent part the following limitations: "said electronic energy meter comprises a communications interface and one optical test interface. . . ." In summary, the independent claim requires two, distinct elements, viz., (1) a communications interface and (2) an optical test interface. Dependent claim 22 further specifies that "the communications interface is an optical communications port;" dependent claim 24 further specifies that "the test interface is an LED." We are not persuaded that these limitations can be interpreted such that a light-emitting-diode ("LED") of the optical communications port also serves as the optical test interface. To the contrary, the limitations, in combination, require an LED separate from an optical port.

It is uncontested that the original specification, which includes the original claims, fails to disclose an LED separate from an optical port. To the contrary, although the specification acknowledges that "[t]raditionally, electronic meters have provided a single light emitting diode (LED) in addition to an optical port," (Spec. at 16-17), it teaches away from having **both** an optical port and one or more separate test LEDs. Specifically, "[s]uch designs add cost, decrease reliability and limit test capabilities." (*Id.* at 17.) Instead of having both an optical port and one or more separate test LEDs, the specification discloses that the appellants' "invention overcomes these limitations by

multiplexing the various metering function output signals and pulse rates over optical port 40 **alone.**" (*Id.* (emphasis added).) More specifically, the portion of the specification referenced by the appellants explains that the "optical port 40 will echo the watt-hour pulses received by the microcontroller over the transmitting LED 112 to conform to traditional testing practices **without the necessity of an additional LED.**" (*Id.* (emphasis added).) In summary, although added claims 16-24 require an LED separate from an optical port, the original specification discloses using an optical port alone.

Second, observing that their specification discloses that "[m]eter 10 interfaces to the outside world via liquid crystal display 30, *optical port 40, or option connector 38,*" (Req. Reh'g at 7 (emphasis in original)), the appellants argue that "claim 16 can also be read to cover a structure in which the 'communications interface' is provided by an option connector (e.g., option connector 38), while the 'test interface' is provided by an LED (e.g., LED 112 of optical port 40)." (*Id.*)

Although the specification mentions that "[m]eter 10 interfaces to the outside world via . . . option connector 38," (Spec. at 16), the appellants fail to show that the option connector performs the claimed function of "receiving a data command" that identifies a selected "one of the various power measurements" so as to support their

argument. To the contrary, the specification discloses that "[a]ll indicators and test features are brought out . . . either on LCD 30 or through optical communications port 40." (*Id.* at 7.) While the function of the option board connector is vague, the specification's reference to it as "an option board interface 38," (*id.*), implies that the connector is merely a socket for an optional board.

Having found that when the appellants' application was filed, the appellants did not have possession of an "electronic energy meter compris[ing]: a communications interface . . . [and] a test interface," wherein "the communications interface is an optical communications port," and "the test interface is an LED," we maintain our rejection of claims 16-24 as lacking an adequate written description. Having concluded that one skilled in the art would not understand the bounds of the claims when read in light of the specification, we likewise maintain our rejection of claims 16-24 as indefinite.

We have granted the appellants' request to the extent that we have reconsidered our original decision, but we deny the request with respect to making any changes therein. As we noted in our original decision, our affirmances are based only on the arguments made in the briefs. Arguments not made therein are neither before us nor at issue but are considered waived. 37 C.F.R. § 1.192(a). No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a).

DENIED

JERRY SMITH	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
ANITA PELLMAN GROSS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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LANCE LEONARD BARRY	)	
Administrative Patent Judge	)	

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