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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MATTHEW EARLEY

Appeal 2019-000815
Application 12/925,235
Technology Center 2800

Before ROMULO H. DELMENDO, RAE LYNN P. GUEST, and MERRELL C. CASHION, JR., *Administrative Patent Judges*.

DELMENDO, *Administrative Patent Judge*.

SECOND DECISION ON REQUEST FOR REHEARING

The Appellant[1] requests a rehearing, based upon the same record pursuant to 37 C.F.R. § 41.50(b)(2) (Second Request for Rehearing filed February 12, 2020; "Second Req. Reh'g"), of our first Decision on Request for Rehearing Appeal entered January 27, 2020 ("First Dec. Req. Reh'g").[2] We have jurisdiction under 35 U.S.C. § 6. For the reasons given below, we deny the Appellant's second Request for Rehearing.

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[1] We use the word "Appellant" to refer to "applicant" as defined in 37 C.F.R. § 1.42. The Inventor, Matthew Earley, is the Applicant and also the real party in interest (Appeal Brief filed February 8, 2018 ("Appeal Br.") at 3).

[2] In our first Decision on Request for Rehearing, we reaffirmed the Primary Examiner's final decision to reject claims 26–29 but designated our decision as including a new ground of rejection given the Appellant's *pro se* status and the complex nature of this prosecution (First Dec. Req. Reh'g. 2).

According to the Appellant, the arguments in the second Request for Rehearing are "directed exclusively at independent claim 26 with a focus on disclosed and inherent characteristics of prior art related to size, function, operation, and structure of the claimed invention" (Second Req. Reh'g 1). Therefore, all claims on appeal stand or fall with claim 26. 37 C.F.R. § 41.37(c)(1)(iv).

We have fully considered the Appellant's arguments in this Second Request for Rehearing, but these arguments are unpersuasive to establish that we misapprehended or overlooked any point in our First Decision on Request for Rehearing. 37 C.F.R. § 41.52(a).

The Appellant argues that Simon,[3] which the Examiner cites for the "induction generator" limitations in claim 26 (Final Act. 9), "is sized to reach rated power at approximately 12 m/s" and, therefore, "would not permit the production of increasing amounts of electrical energy through 24 m/s as is accomplished in the claimed invention" (Second Req. Reh'g 2). According to the Appellant, "[a]n induction generator with a 12 m/s rating would render the claimed invention inoperable for its intended use"—i.e., where "[t]he claimed invention is unique in its ability to generate increasing amounts of energy through 24 m/s" (*id.* at 2–3).

The Appellant's argument regarding Simon's induction generator, however, is not supported by objective evidence (e.g., a sworn declaration).[4]

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[3] US 2010/0207396 A1, published August 19, 2010.

[4] *In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984) ("Mere argument or conclusory statements in the specification does not suffice."); *In re Lindner*, 457 F.2d 506, 508 (CCPA 1972) ("[M]ere conclusory statements in the specification and affidavits are entitled to little weight when the Patent Office questions the efficacy of those statements.").

Simon teaches that an induction generator provides a cost-effective machine for converting rotational energy to electricity for power to an electric grid (Simon ¶ 26). According to Simon, "[t]he input energy from [a] turbine . . . provides rotational power to the output . . . that attempts to force the induction generator to rotate faster than its reference speed" and that "[t]his places the induction generator in a positive slip condition and causes it to generate power" (*id.*). Given that (i) Simon does not place any limitations on wind speed (*id.* ¶ 63 (teaching that "[s]pecific sizing of the generators is dependent upon turbine size and efficiency" and also showing an exemplary turbine size of 10 m radius and 45% efficiency only), and (ii) Earley teaches that the centrifugal weight control (CWC) described therein permits additional energy to be transformed into electricity at higher than conventional flow speeds (Earley, col. 1, ll. 15–33; col. 2, ll. 14–20), we conclude that a person having ordinary skill in the art would have found it obvious to size and select an induction generator as suggested by Simon to match the enhanced capabilities of Earley's CWC.[5] The Appellant does not offer objective evidence that such a modification of Earley's system would have been beyond the technical grasp of a person having ordinary skill in the art.[6] Thus, although we appreciate that claim 26's preamble language recites a new capability rather than merely an intended use, this capability was

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[5] *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 420 (2007) ("[F]amiliar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.").

[6] *KSR*, 550 U.S. at 421 ("When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp.").

already disclosed in Earley, as we recounted above and in our prior Decisions, and when Earley and Simon are combined, the advantages latent in Earley would reasonably be expected to flow from their combination.

The Appellant argues that "[i]n the claimed invention[,] the CWC acts as a buffer, accommodates gear changes, and *plays a minor role* in controlling and stopping the wind turbine as wind speeds approach 25 m/s" (Second Req. Reh'g at 3 (emphasis added)). In addition, referring to arguments offered earlier in the prosecution, the Appellant argues that "current wind turbines" generate increasing amounts of energy up to a wind speed of 15 m/s but then energy generation flattens beyond that wind speed (*id.*) (emphasis omitted). With specific reference to Earley's Figures 1 and 3, the Appellant argues that Earley's CWC functions as an air brake and would inhibit the kind of energy production that is quantified in the current application (*id.* at 7). According to the Appellant, the rotating CWC guides, jackscrews, and weights will impart a certain amount of drag that would increase as the weights extend during routine operation (*id.*). This allegation, however, amounts to mere argument, not objective evidence, *relative to Earley's system including an improved CWC.*[7] In this regard, the Appellant's argument appears to be at odds with the disclosures found in Earley and the current Specification (Earley, col. 1, ll. 15–33; col. 2, ll. 14–20; Specification filed October 18, 2010 ("Spec.") 1, ll. 14–16). The Appellant does not direct us to any language in claim 26 that would positively exclude rotating CWC guides, jackscrews, or weights.

The Appellant argues:

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[7] *In re Baxter Travenol Labs.*, 952 F.2d 388, 392 (Fed. Cir. 1991).

> Figure 1 . . . in prior art of Earley discloses CWC with an identical diameter to rotor/blade assembly. In the claimed invention this would be 36 meters. It is inherently a very large air brake. The prior art of Earley discloses both an electro-mechanical and (inherent) aerodynamic means for speed control through 24 m/s.
>
> The claimed invention is operationally unique in that it has no aerodynamic means of controlling rotor speed. It offers two electromechanical means of speed control. They are opposing torque of the induction generator rated at 25 m/s and CWC. CWC in the claimed invention is at the bottom of the tower; has a ten ft. diameter; extends and retracts weights totaling 8 thousand pounds.
>
> Examiner does not modify the induction generator so that it would be effective in the claimed invention. Per figure 6 of the claimed invention the Simon generator sized for rated power at 12 m/s would have a rating of 479 kW. The induction generator employed in the claimed invention would have a rating of approximately 2,308 kW. (See fig. #6 / power column – in specification).

(Second Req. Reh'g 5).

Again, the Appellant's argument is based merely on conclusory statements that are not accompanied by any objective evidence (e.g., declaration evidence) providing detailed specifics of the systems used for comparison.[8] But even if this argument had been supported by objective evidence, claim 26 does not recite any of the argued features (e.g., a limitation on air brake size, the exclusion of an aerodynamic means, a CWC diameter, ability to extend or retract weights totaling eight thousand pounds,

[8] *De Blauwe*, 736 F.2d at 705; *Lindner*, 457 F.2d at 508.

or induction generator rating) relied on for patentability.[9] Also, the Appellant points to Figure 6 of the subject application, but that Figure is described as "a 20-year projection for a 36-meter system with power totals at 15 m/s for current solution and 25 m/s for the discussed solution" (Spec. 1, ll. 20–21). The specific details of the "current solution" and the "discussed solution" are not provided, so a meaningful comparison of the claimed invention against the closest prior art, which is Earley, cannot be undertaken.

For these reasons and those provided in our earlier Decisions, we uphold the Examiner's rejection.

IV. CONCLUSION

In summary:

Outcome of Decision on Rehearing

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Denied	Granted
26–29	103(a)	Earley, Carter, Simon	26–29	

Outcome of Appeal after Rehearing:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
26–29	103(a)	Earley, Carter, Simon	26–29	

[9] *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) ("[A]ppellant's arguments fail from the outset because . . . they are not based on limitations appearing in the claims.").

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

DENIED