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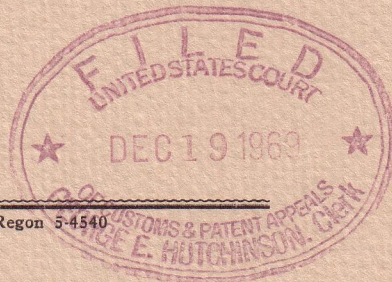
IN THE
**United States Court of Customs
and Patent Appeals**

Patent Appeal Docket No. 8376

In the Matter of the Application of
GARY R. BENSON and ARTHUR C. TABBOT

REPLY BRIEF FOR APPELLANTS

ROBERT O. NIMTZ
Attorney for Appellants



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I. Introduction

This Reply Brief is filed in response to the Brief for the Commissioner of Patents filed on September 18, 1969, in the above-identified Patent Appeal.

A new issue¹ has been raised for the first time by the Commissioner's Brief. This issue can be stated as follows:

“Can appellants' claims be rejected under 35 U.S.C. 112 for an alleged inconsistency where the inconsistency consists of an admission that the claims could be read on a paper and pencil implementation and a later argument that the same claims could *not* be read on a paper and pencil implementation, but where the two pencil and paper implementations are, in fact, substantially different?”

This new issue will be taken up first.

¹ This is in addition to the previously raised original issue (Br-4) under 35 U.S.C. 112, based on the theory that the claims read on nonstatutory as well as statutory subject matter.

II. Appellants' "Admission"

In the Brief for the Commissioner of Patents, the Solicitor chose to rely primarily on a new form of rejection under 35 U.S.C. 112, the principal argument supporting this rejection being an alleged admission by appellants.² The Solicitor's reliance on this "admission" is totally misplaced.

Specifically, the Solicitor mistakenly equates a paper and pencil implementation suggested by appellants at an earlier stage of the prosecution with a paper and pencil implementation suggested by the Board of Appeals. Appellants' paper and pencil implementation was described in response to an inherent function rejection (since made moot by *In re Tarczy-Hornoch*, 55 CCPA 1441, 397 F.2d 856, 158 USPQ 141 (1968)). This implementation did *not* involve mental steps.³ The portion of the Board's proposed implementation which appellants now contest, on the other hand, specifically *did* involve mental steps.⁴

It can thus be seen that the alleged admission (C.Br-4) and the inconsistency (C.Br-6) are the outgrowth of erroneously equating these two paper and pencil implementations. The Solicitor has taken appellants' arguments concerning mental steps as if they were meant to apply to pencil and

² The recent case of *In re Prater and Wei*, 56 CCPA , F. 2d , 162 USPQ 541, 1969, is cited in support of this new form of rejection.

³ The original "admission" was to a method "carried out by hand, the shifting and adding operations being manual." (R-23). In response to the Examiner's objection (R-29-30) that these steps were mental rather than manual, appellants noted that "binary summation can be accomplished with simple mechanical, hydraulic and optical devices, as well as electronic devices" (R-35) and further that the step of adding single binary digits could be effected with a simple look-up table (R-35) and thus "the method can be practiced without any mental effort whatsoever."

⁴ ". . . an implementation in which a human being makes pencil notations on a piece of paper and manipulates the meaning of these notations by intellectual effort (mental steps)." (Br-15).

paper implementations generally, and specifically, as if they were meant to apply to a purely manual implementation or to a manual implementation with the aid of simple tools. Since this entire argument of the Patent Office Brief is founded on the equivalence of these two implementations, this argument collapses without such equivalence.⁵

It appears that the Solicitor has confused this new form of rejection under Section 112 (inconsistency) and the original form argued by the Examiner and the Board of Appeals (undue breadth). The former is based solely on admission of appellants while the latter is based, *inter alia*, on the legal conclusion that nonstatutory subject matter is actually encompassed by the claims. Insofar as the arguments support the original form of rejection, they will be taken up hereafter.

III. Absence of Factual Support for Allegation of Nonstatutory Subject Matter

The original issue under Section 112, i.e., whether or not the claims are unduly broad because they read on nonstatutory as well as statutory subject matter, requires the prior determination that the claims actually do read on nonstatutory subject matter. Very little is said in the Commissioner's Brief about the nonstatutory subject matter alleged to be covered by the claims. The Solicitor is content with attempting to demonstrate that paper and pencil could be involved in an implementation of the claims. No argument is made that such paper and pencil implementation actually involves

⁵ It should be noted that, in *Prater and Wei, supra* note 1, the appellants in that case admitted, during the course of the appeal, that their claims *did* read on a mental step implementation. Appellants here do not now, nor have they ever, made such an admission. Indeed, appellants have always and consistently held the position that the appealed claims do *not* read on "mental steps."

mental steps.⁶ Without this basic ingredient, this entire argument also collapses.

The Solicitor did state (C.Br-9) that the “actual work stuff of appellants’ methods is merely mathematical abstractions, viz., numbers.” The actual “work stuff” of claim 8, however, is “signals” and of claim 13 is “representations”. Numbers, as such, are indeed abstract. The claims were therefore intentionally limited to “signals” and “representations” to avoid claiming operations on abstractions.

IV. Absence of Legal Support for Decision Requested by the Commissioner

The only case cited by the Commissioner in support of the proposition that claims reading on nonstatutory as well as statutory subject matter fail to meet the requirements of the second paragraph of Section 112 is *Graver v. Linde*.⁷ No such holding can be gleaned from this decision. In fact, this case is totally inapposite since it dealt with process claims based on a non-proven phenomenon, and with composition of matter claims to a genus containing inoperative species. No such claims are present in this application. This issue of undue breadth (C.Br-9) continues to be one of first impression.

V. Patent Office’s Failure to Argue All Issues

Appellants’ main brief presented four alternative arguments (Br-3, 4). The resolution of any one of these arguments in appellants’ favor should result in a reversal of the decision affirming the rejection of the claims. Since the Commissioner’s Brief is completely silent on the second

⁶ Appellants have spent considerable space in their original brief arguing that such an implementation does *not* involve “mental steps.” (Br-18-25).

⁷ 336 U.S. 271, 80 USPQ 451 (1949).

and third of these arguments, it is assumed that the Commissioner now takes no issue with the appellants on these alternative arguments and has abandoned the position against which these arguments were directed (*In re Kirchner*, 49 CCPA 1234, 305 F.2d 897, 134 USPQ 324 (1962)).

In view of this failure, a reversal of the decision of the Board of Appeals is believed to be in order independent of the Court's opinion on the undue breadth issue under Section 112.

VI. Conclusion

Based on the foregoing, it is respectfully requested that this Court reverse the decision of the Board of Appeals rejecting claims 8 and 13 in the present case as previously requested in appellants' original brief.

Respectfully submitted,

ROBERT O. NIMTZ
Attorney for Appellants

Bell Telephone Laboratories, Incorporated

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