

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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOSEPH J. HARDING  
and RICHARD O. BATZEL

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Appeal No. 2001-2636  
Application No. 09/160,127

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HEARD: November 9, 2001

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Before MCCANDLISH, Senior Administrative Patent Judge, PATE  
and BAHR, Administrative Patent Judges.

MCCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 47 through 91.<sup>1</sup> No other claims are pending in the application.

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<sup>1</sup> Contrary to appellants' statement concerning the status of amendments as set forth on page 2 of the brief, an amendment (Paper No. 16) was filed on August 24, 2000 after the final office action dated August 4, 2000 (Paper No. 15). In the advisory office action dated September 8, 2000 (Paper No. 17), the examiner indicated that the amendment of August 24, 2000 would be entered upon filing an appeal. As indicated in the remarks in the amendment of August 24, 2000 and as confirmed by the examiner in the

(continued . . .)

The invention disclosed in appellants' application relates to "a controller suitable for use in monitoring and providing diagnostics for one or more [packaging material] conversion machines . . ." (specification, page 3, lines 12-13).

A copy of the appealed claims is appended to appellants' brief.

The following references are relied upon by the examiner as evidence of obviousness in support of his rejections under 35 U.S.C. § 103:

Neri	4,607,252	Aug. 19, 1986
Moldovansky et al. (Moldovansky)	5,504,779	Apr. 02, 1996
Ratzel	5,571,067	Nov. 05, 1996

Claims 47-72 and 74-91 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ratzel in view of Neri, and claim 73 stands rejected under 35 U.S.C. § 103 as being unpatentable over Ratzel in view of Neri and Moldovansky. With regard to the rejection of claims 47-72 and 74-91, the examiner concludes that the teachings of Neri would have

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(. . . continued)  
advisory office action of September 8, 2000, the amendment of August 24, 2000 is identical to the amendment filed June 16, 2000 (Paper No. 14). The claims on appeal are therefore the same as the claims finally rejected in the final office action of August 4, 2000.

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made it obvious to provide Ratzel's machine with a control processing means "to monitor a machine away from [sic, at a location remote from?] the actual machine being monitored" (answer, page 4). Reference is made to the examiner's answer for further details of the rejections.

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 would have led one of ordinary skill in the art 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) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Upon evaluation of the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness. Accordingly, we will not sustain the examiner's rejections of the appealed claims.

In the present case, independent claims 47 and 75 are limited to the retrieval of machine information from a

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remote conversion machine (claim 47) or from a memory device of a controller for the conversion machine (claim 75), while claims 56 and 80, the only other independent claims on appeal, are limited to the storage of machine information in a memory. Machine information is expressly defined in appellants' specification (see pages 7-8) as being information related to the conversion machine "such as a serial number, software revision number and date, physical site location, customer data and a conversion machine number or identifier." The appealed claims are therefore limited to this special definition of machine information. Note Lantech, Inc. v. Keip Machine Company, 32 F.3d 542, 547, 31 USPQ2d 1666, 1670 (Fed. Cir. 1994).

The applied references do not teach or suggest the retrieval or storage of machine information as defined in appellants' specification. Furthermore, the examiner's dismissal of the claim limitations pertaining to the machine information as being "a matter of design choice" (answer, page 6) is unconvincing especially in light of the fact that the storage and retrieval of such machine information solve problems relating to the identification and other particulars pertaining to machines in the field.

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Compare In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975). In the final analysis, the examiner's rejections must fail for lack of an adequate factual basis to support his position. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967).

The examiner's decision to reject claims 47-91 under 35 U.S.C. § 103 is reversed.

REVERSED

HARRISON E. MCCANDLISH	)	
Senior Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
WILLIAM F. PATE, III	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

HEM/sld

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