

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NORBERT BARGELE,
RUDIGER BUDDRUSS AND THORSTEN LORENZEN

Appeal No. 97-3752
Application No. 08/293,322¹

ON BRIEF

Before STONER, Chief Administrative Patent Judge, NASE and
CRAWFORD, Administrative Patent Judges.

NASE, Administrative Patent Judge.

¹ Application for patent filed August 22, 1994.

Appeal No. 97-3752
Application No. 08/293,322

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 18, which are all of the claims pending in this application.²

We REVERSE.

² Independent claims 3 and 4 have been amended subsequent to the final rejection.

BACKGROUND

The appellants' invention relates to a method of processing fish fillets and apparatus for carrying out the method. An understanding of the invention can be derived from a reading of exemplary claims 1, 3 and 4, which appear in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Townsend 1955	2,715,427	Aug. 16,
Braeger 1994	5,288,264	Feb. 22,

Claims 1 through 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Townsend.

Claims 11 through 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Townsend in view of Braeger.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted

rejections, we make reference to the final rejection (Paper No. 8, mailed June 23, 1995) and the examiner's answer (Paper No. 16, mailed August 1, 1996) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 15, filed April 23, 1996) and reply brief (Paper No. 17, filed October 1, 1996) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all 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 with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 through 18 under 35 U.S.C. § 103. Our reasoning for this determination follows.

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 the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual 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). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt

that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

Townsend discloses an apparatus for removing the fat and the skin from a ham. As shown in Figures 1 and 2, the apparatus includes a feed roll 14 provided with grooves 15 and teeth 16, a pressure shoe 18, a skinning blade 20 and a fattening attachment having a fattening blade 21. As shown in Figure 1, the fattening blade 21 is slanted from one side of the apparatus to the other side of the apparatus. In addition, as shown in dotted lines in Figure 2, it is desirable to have the fattening blade 21 nearly contact the skinning blade 20. Townsend teaches (column 2, lines 5-11) that (1) in addition to skinning hams, it is quite often desirable to "fat" them (i.e., remove fat from the ham), (2) the fattening of ham is usually performed either is some other machine or by hand, and (3) the fattening attachment permits fattening the ham simultaneously with the skinning operation.

Claim 1

Independent claim 1 recites a method for processing fish fillets including the steps of (1) separating a superficial layer from the fillet and (2) separating skin from the superficial layer, wherein the skin is removed from the superficial layer at a time no later than concurrently with the separation of the superficial layer from the fillet.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on our analysis and review of Townsend and claim 1, it is our opinion that the differences are the limitations that (1) a fish fillet is being processed, and (2) the skin is removed from the superficial layer at a time no later than concurrently with the separation of the superficial layer from the fillet.

With regard to these differences, the examiner determined (answer, pp. 3-4) that (1) processing of fish fillets is old and well known in the butchering art and consequently, the use of Townsend's apparatus to process fish instead of ham would have been obvious, and (2) the alignment of Townsend's blades (20, 21) cause the "initial" cuts not to be concurrent, nevertheless, the claimed time sequence is not precluded by Townsend's apparatus.

The appellants argue (brief, pp. 5-11) that (1) processing fish fillets is characteristically different from processing ham, (2) Townsend does not teach or suggest separating the skin from the superficial layer (the fat of the ham) at a time no later than concurrently with the separation of the superficial layer from the ham, and (3) there is no suggestion in the applied prior art to modify the position of Townsend's fattening blade 21 with respect to the fattening blade 20 to provide the claimed relationship.

In our view, the examiner has not set forth a sufficient factual basis to establish obviousness with respect to claim

1. First, the fact that processing of fish fillets is old and well known in the butchering art does not, in our opinion, provide any motivation to one skilled in the art to have used Townsend's apparatus to process fish fillets instead of ham. Second, the examiner's statement that the claimed time sequence is not precluded by Townsend's apparatus provides no factual basis as to why one skilled in the art would have made such a modification. Thus, it appears to us that the examiner has resorted to speculation, unfounded assumption and hindsight reconstruction to supply deficiencies in the factual basis for the rejection.

For the reasons set forth above, the decision of the examiner to reject claim 1 under 35 U.S.C. § 103 is reversed.

Claims 3 and 4

Independent claims 3 and 4 recite an apparatus comprising, inter alia, a conveying roller means, a pressing means, a first knife means and a second knife means. The

first knife means is arranged to be "fixed" and the second knife means is arranged to be "driven."³

Based on our analysis and review of Townsend and claims 3 and 4, it is our opinion that one difference is the limitation that the second knife means is arranged to be "driven."

With regard to this difference, the examiner determined (answer, pp. 4-5) that the limitation arranged to be "driven" is (1) inferentially recited in the claims and consequently, this limitation is not given patentable consideration, and (2) obvious since a driven skinner blade is known.

The appellants argue (brief, pp. 11-12 and reply brief, pp. 3-4) that the claimed second knife means being arranged to be "driven" is (1) not disclosed in Townsend, and (2) not suggested by a driven skinner blade.

³ "Driven" as used in the appellants' specification means that the second knife means is moving (e.g., oscillating) while cutting. "Fixed" as used in the appellants' specification means that the first knife means is not moving while cutting.

Once again, it is our view that the examiner has not set forth a sufficient factual basis to establish obviousness with respect to claims 3 and 4. First, all words in a claim must be considered in judging the patentability of that claim against the prior art. See In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Thus, the limitation that the second knife means is arranged to be "driven" must be given patentable consideration. Second, the examiner's determination that this limitation (i.e., the second knife means is arranged to be "driven") was obvious since a driven skinner blade is known is without factual basis as to why one skilled in the art would have modified Townsend's fattening blade 21 to be driven. If anything, a teaching of a driven skinner blade would have suggested driving Townsend's skinning blade 20, not the fattening blade 21. Thus, it appears to us that the examiner has resorted to speculation, unfounded assumption and hindsight reconstruction to supply deficiencies in the factual basis for the rejection.

For the reasons set forth above, the decision of the examiner to reject claims 3 and 4 under 35 U.S.C. § 103 is reversed.

Claims 2 and 5 through 18

The decision of the examiner to reject dependent claims 2 and 5 through 18 under 35 U.S.C. § 103 is reversed for the reasons set forth above with regard to their respective parent independent claim.⁴

⁴ We have also reviewed Braeger but find nothing therein which makes up for the deficiencies of Townsend discussed above.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 18 under 35 U.S.C. § 103 is reversed.

REVERSED

BRUCE H. STONER, JR., Chief)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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MURRIEL E. CRAWFORD)	
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APPLICATION NO. 08/293,322

APJ NASE

CAPJ STONER

APJ CRAWFORD

DECISION: **REVERSED**

Prepared By: Delores A. Lowe

DRAFT TYPED: 24 Jun 98

FINAL TYPED: