

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte CHARLES HAUSER

Appeal No. 2001-0158
Application No. 08/873,250

ON BRIEF

Before STAAB, MCQUADE, and CRAWFORD, Administrative Patent Judges.
CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 15 to 26, 29, 30 and 32 which are all of the claims pending in this application. Claims 1 to 14, 27, 28, 31, 33 and 34 have been canceled.

The appellant's invention relates to a slicing center adapted to produce slices from ingots to be sliced (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Iwakiri et al. (Iwakiri)	5,537,325	Jul. 16, 1996
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The rejection

Claims 15 to 26, 29, 30 and 32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Iwakiri.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 15, mailed September 9, 1999) and answer (Paper No. 18, mailed February 29, 2000) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 17, filed December 30, 1999) and reply brief (Paper No. 19, filed April 24, 2000) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art reference, and to the

respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The appellant's invention is a slicing center which includes a positioning subgroup unit, a slicing subgroup unit and a processing subgroup unit. Each of the subgroups includes a "first means" for carrying out the function of the subgroup, and a "second means" for interconnecting the first means in a physically operative manner so as to form a subgroup unit. The slicing center also includes an additional "interconnecting means for interconnecting" the positioning, slicing and processing subgroup units in a physically operative hierarchically organized assembly. This additional interconnecting means includes means for storing, means for manipulating, and means for transporting the slices.

The examiner has rejected the claims under 35 U.S.C. § 103. We initially note that 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, 458 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, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., Grain Processing Corp. v. American Maize-Prods. Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

With this as background, we analyze the prior art applied by the examiner in the rejection of the claims on appeal. In support of the rejection, the examiner states:

Iwakiri discloses the claimed invention except for the multiple positioning units, slicing units, processing units and final treatment units being integrated together and controlled by a computer It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide multiple units for increasing productivity, since it has been held that the mere duplication of the essential working parts of a system device involves only routine skill in the art [final rejection at page 2].

Iwakiri discloses an apparatus for manufacturing semiconductor wafers which includes means for identifying each wafer and storing the identification information. The history of each wafer, such as how the wafer was transferred and how the wafer was processed, is stored. Iwakiri discloses that the various steps in the wafer processing operation are controlled by a computer and that the various computers are connected to a host computer through a computer network. A correspondence between the quality information reported on the wafer basis and associated wafers is made and put into the database of the host computer.

Iwakiri does not disclose or suggest the claimed “second means” for interconnecting a first means in a physically operative manner so as to form the respective subgroup units. In addition, Iwakiri does not disclose or suggest the claimed additional “interconnecting means for interconnecting” the various subgroups, which additional means includes means for storing the slices, means for manipulating the slices and means for transporting the slices. This additional “interconnecting means for interconnecting” provides the means for integrating the various subgroup operations of the slicing center.

The examiner has not shown that these two claimed means, namely, the “second means” and the additional “interconnecting means for interconnecting” are disclosed or suggested in the prior art. As such, the examiner has failed to establish a prima facie case of obviousness.

In view of the foregoing, we will not sustain the examiner's rejection. The decision of the examiner is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 15 to 26, 29, 30 and 32 under 35 U.S.C. § 103 is reversed.

REVERSED

LAWRENCE J. STAAB
Administrative Patent Judge

JOHN P. MCQUADE
Administrative Patent Judge

MURRIEL E. CRAWFORD
Administrative Patent Judge

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CRAWFORD

APPEAL NO. 2001-0158 - JUDGE

APPLICATION NO. 08/873,250

APJ CRAWFORD

APJ STAAB

APJ MCQUADE

DECISION: **REVERSED**

PREPARED: Jun 19, 2003

OB/HD

PALM

ACTS 2

DISK (FOIA)

REPORT