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for publication and is not binding precedent of the Board.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

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte HARALD HEINRICH et al.

Appeal No. 2002-0377
Application No. 09/123,908

ON BRIEF

Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 25, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a transport system and to a method for controlling the transport system (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

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

Perry	3,530,571	Sept. 29, 1970
Head, III	4,884,674	Dec. 5, 1989

Claims 1 to 25 stand rejected under 35 U.S.C. § 112 as being based on an inadequate disclosure.[1]

Claims 1 to 11 and 15 to 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Perry in view of Head.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final

[1] We assume that this rejection is based on the enablement requirement found in the first paragraph of 35 U.S.C. § 112. That is, the specification fails to adequately teach how to make and/or use the invention.

rejection (Paper No. 16, mailed December 15, 2000), the answer (Paper No. 22, mailed July 20, 2001) and the response to remand (Paper No. 24, mailed July 17, 2002) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 21, filed July 12, 2001) and response to the examiner's response to remand (Paper No. 25, filed September 23, 2002) for the appellants' arguments thereagainst.

OPINION

Initially we note that the drawing objection raised by the examiner on page 4 of the final rejection relates to a petitionable matter and not to an appealable matter. See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201. Accordingly, we will not review the drawing objection issue raised by the appellants on pages 26-27 of the brief.

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. As a consequence of our review, we make the determinations which follow.

The rejection under 35 U.S.C. § 112

We will not sustain the rejection of claims 1 to 25 under 35 U.S.C. § 112.

The basis for the examiner's rejection of claims 1 to 25 under 35 U.S.C. § 112 is set forth on page 3 of the final rejection[2] as follows:

> All claims are based on an inadequate disclosure as to structurally how the system is designed to have and use the internal list of claims 1, 18 and their dependents. It is also inadequately disclosed in all of the claims as to how the system is structurally designed to perform the decentralized control of the conveying devices, the branching devices and how the information on the information medium is functionally and structurally used by the decentralized control system to enable conveyance of items to distant work stations. The claims are also based on an inadequate disclosure as to structurally how one branching device is selected based on the activities of the neighboring branching devices. Struturally how do you determine what activities are occuring [sic, occurring]. The disclosure of structurally how the functions of claims 3, 6, 7, 12, 13, 16, 17 and 21-25 are achieved is further inadequate. With regard to claim 6, if only unreachable destinations are in the internal list, the branching device can not feed to a destination and the system would be inoperative. With regard to claim 20, if the second address is not used until after processing at the first address, why record it early?

The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. See United States v. Telectronics, Inc., 857 F.2d 778, 785, 8

[2] The rejection of claims 13 and 14 as being indefinite set forth in the last sentence of this rejection was withdrawn by the examiner on page 4 of the response to remand.

USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976).

As to the examiner's rejection based on the enablement requirement, it is our view that the examiner has not met the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention.[3] A disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.[4]

In applying the above-noted test for enablement, factors which must be considered by the examiner in determining whether a disclosure would require undue

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[3] See In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure).

[4] As stated by the court in In re Marzocchi, 439 F.2d 220, 223, 224, 169 USPQ 367, 370 (CCPA 1971)

> it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.

experimentation include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. See In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) citing Ex parte Forman, 230 USPQ 546, 547 (Bd. Pat. App. & Int. 1986).

Our review of the record reveals that the examiner has not applied the above-noted factors to determine that undue experimentation would be required to practice the invention or provided an explanation that clearly supports such a determination. Since the examiner has not weighed the factors, the examiner's conclusion of nonenablement cannot be sustained.

Furthermore, we agree with the appellants' view (brief, pp. 28-32) that a person skilled in the art would know how to make and use the invention as set forth in claims 1 to 25 under appeal based on the functional description set forth in the application. While the appellants have not set forth structurally how all the functions are accomplished, such is not required unless the examiner can establish by use of the above-noted factors that one skilled in the art could not make and use the claimed invention from the disclosure coupled with information known in the art without undue

experimentation. In this case, the examiner has merely stated that the disclosure is inadequate. This is clearly not sufficient to meet the examiner's initial burden to establish a reasonable basis to question the enablement provided for the claimed invention.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 25 under 35 U.S.C. § 112 is reversed.

The rejection under 35 U.S.C. § 103

We will not sustain the rejection of claims 1 to 11 and 15 to 22 under 35 U.S.C. § 103.

The basis for the examiner's rejection of claims 1 to 11 and 15 to 22 under 35 U.S.C. § 103 is set forth on pages 2-3 of the final rejection. In essence the examiner concluded that it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified Perry's system to have a decentralized control of the local conveyors in view of the teachings of Head.

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).

The appellants argue (brief, pp. 33-37) that the above-noted modification of Perry by the teachings of Head does not arrive at the claimed invention. Specifically, the appellants point out that the modified system of Perry still lacks the claimed branching devices.[5] We agree.

On pages 3-4 of the response to remand, the examiner correctly points out that the turnstiles 31 of Perry (i.e., the branching devices) selectively branch the pallets 33 based on both the address device 35 on each pallet and the number of pallets in queue at a work station (see column 6, lines 34-49). However, the claimed branching devices are not readable on the turnstiles 31 of Perry since the turnstiles are not adapted to

[5] Claim 1 recites that each branching device is adapted to selectively branch the items dependent upon neighboring ones of the branching devices for optimizing transport distance and time. Claim 18 recites that under a decentralized control, setting a branching direction of the branching device depending on a result obtained in the comparing step and depending upon activities of neighboring ones of the branching devices.

selectively branch the items dependent upon neighboring ones of the turnstiles as claimed.

Since the examiner's proposed combination of the applied prior art does not arrive at the claimed invention for the reasons set forth above, the decision of the examiner to reject claims 1 to 11 and 15 to 22 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 25 under 35 U.S.C. § 112 is reversed and the decision of the examiner to reject claims 1 to 11 and 15 to 22 under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT Administrative Patent Judge	)
JOHN P. McQUADE Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)

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