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for publication and is not binding precedent of the Board.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 STANLEY M. HERZOG, RONALD A. SCHMITZ,
IVAN E. BOUNDS and RANDY L. POGGEMILLER

Appeal No. 2003-0811
Application No. 09/285,290

HEARD: August 19, 2003

Before ABRAMS, FRANKFORT, 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 14 and 15, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a GPS-based system for controlling logistics in connection with a vehicle (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:

Sennott et al. (Sennott)	5,390,125	Feb. 14, 1995
Bounds	5,657,700	Aug. 19, 1997
Gimenez et al. (Gimenez)	5,809,448	Sep. 15, 1998
Smith et al. (Smith)	6,161,986	Dec. 19, 2000

Claim 14 stands rejected under 35 U.S.C. § 103 as being unpatentable over Sennott in view of Bounds and Smith.

Claim 15 stands rejected under 35 U.S.C. § 103 as being unpatentable over Sennott in view of Bounds, Smith and Gimenez.

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. 16, mailed December 20, 2001) and the answer (Paper No. 19,

mailed September 3, 2002) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 18, filed June 3, 2002) and reply brief (Paper No. 20, filed November 13, 2002) 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 14 and 15 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 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 throughout both briefs that the applied prior art does not suggest the claimed subject matter. We agree.

All the claims under appeal require a logistics system to control application of ballast along a selected section of railroad and comprising, inter alia, (1) a railroad car including a ballast hopper and a pair of hopper doors engaged with the hopper and operable to open and close to, thereby control discharge of ballast from the hopper; (2) a global positioning system (GPS) receiver engaged with the railroad car and operative to generate a location signal representing a location of the railroad car, the GPS receiver being adapted to receive GPS coordinate signals from both a GPS satellite constellation and from a differential GPS; (3) the railroad car including a wheel and travel distance measuring means including a wheel encoder with the wheel for counting revolutions and partial revolutions thereof, a travel distance converter receiving input from the encoder, and a travel distance computer connected to and adapted for receiving input from the travel distance converter; (4) a position control subsystem coupled to the GPS receiver, the encoder, and the hopper door actuators, the position control subsystem storing data representing a location of the selected section of the railroad along which application of ballast is desired; and (5) the GPS receiver communicating information relating to the railroad car position to the position control system, the travel distance computer interfacing with the position control system

whereby GPS position information and linear-movement travel distance information therefrom respectively are utilized to cause the position control subsystem to activate the hopper door actuators to open the hopper doors at the beginning of the selected section of the railroad and to retain same along the selected section with the railroad car in motion and only for such a duration in which the GPS receiver detects a location of the car corresponding to the selected section of the railroad.

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every

element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

In our view, the claimed subject matter is not suggested by the applied prior art. In that regard, while individual elements of the claimed invention may be taught in the applied prior art, the invention, as a whole, is not taught or suggested by the applied prior art. In that regard, while the examiner's primary reference to Sennott does disclose a vehicle having both a global positioning system (GPS) receiver and a wheel and travel distance measuring means, Sennott does not disclose any of the above-noted five limitations of the claimed subject matter. Likewise, while Bounds discloses a system for applying ballast along a section of railroad including a railroad car having a ballast hopper and a pair of hopper doors engaged with the hopper and operable to open and close to thereby control discharge of ballast from the hopper, Bounds does not disclose any of the last four limitations of the claimed subject matter noted above.

Smith teaches utilizing GPS information to indicate binder location on a roadway and then to dispense loose aggregate only on portions of the roadway having binder thereon. Smith does not disclose any of the above-noted five limitations of the claimed subject matter. Lastly, Gimenez teaches a position detection system for a railcar utilizing both a global positioning system (GPS) and a beacon recording system. Gimenez does not disclose any of the above-noted five limitations of the claimed subject matter.

In our view, the only possible suggestion for modifying Sennott in the manner proposed by the examiner to arrive at the claimed invention stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d at 1553, 220 USPQ at 312-13.

For the reasons set forth above, the decision of the examiner to reject claims 14 and 15 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 14 and 15 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS Administrative Patent Judge	)	
CHARLES E. FRANKFORT Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)	

RICHARD R. JOHNSON
SHOOK, HARDY & BACON L.L.P.
ONE KANSAS CITY PLACE
1200 MAIN STREET
KANSAS CITY, MO 64105-2118

JVN/jg