

**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(2) is not binding precedent of the Board.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. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** MASAHIRO SHINBASHI, TAKASHI WAKABAYASHI

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Appeal No. 95-3710  
Application 07/621,005<sup>1</sup>

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HEARD: October 17, 1997

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Before HAIRSTON, BARRETT and FLEMING, ***Administrative Patent Judges.***

FLEMING, ***Administrative Patent Judge.***

***DECISION ON APPEAL***

This is a decision on appeal from the final rejection of  
claims 6 through 8 and 18 through 23. Claims 1 through 5 and 9

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<sup>1</sup>Application for patent filed December 3, 1990. This application is a continuation of application 07/336,614 filed April 6, 1989, now U.S. Patent No. 5,014,261 issued May 7, 1991, which is a continuation of application 07/001,029, filed January 7, 1987.

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through 17 have been canceled. An amendment under 37 C.F.R. § 1.116 amending claim 6 and canceling claim 18 was filed on February 18, 1994. We note that the Examiner has entered this amendment into the record. Therefore, claims 6 through 8 and 19 through 23 are rejected and are on appeal.

The invention relates to a control system for switching between working units and stand-by units. On page 5 of the specification, Appellants disclose that Figure 4A is a block diagram showing the switching system of the present invention. In particular, Appellants disclose that the switching system accommodates m number of working units 1-1 through 1-m. Figure 4A shows that the switching system includes an individual stand-by portion where each of the working units 1-1 through 1-n may be individually switched to a separate stand-by unit 4b. Figure 4A also shows that the switching system includes a common stand-by portion where the working units 1-n+1 through 1-m may be switched to a single common stand-by unit 3A using switch units 5.

Independent claim 6 is reproduced as follows:

6. A switching system for data operation units, able to switch input and output lines from working units to stand-by units and a common stand-by unit, individual comprising:

an electrical wiring arrangement for providing connections from the input and output lines to a plurality of first locations, each provided for one of the working units, and a plurality of second locations, each provided for one of an individual

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stand-by unit and a switching unit, said electrical wiring arrangement providing electrical connections in parallel

to pairs of the first and second locations and between all the second locations and a third location provided for the common stand-by unit, the switching unit, when mounted at one of the second locations, providing switchable connection between the input and output lines for a corresponding working unit and the common stand-by unit in response to a signal.

The Examiner does not rely on any references.

Claims 6 through 8 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention. Claims 6 through 8 and 19 through 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Appellants' prior art Figures 2 and 3.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the briefs<sup>2</sup> and the answers<sup>3</sup> for

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<sup>2</sup>Appellants filed an appeal brief on May 2, 1994. We will refer to this appeal brief as simply the brief. Appellants filed a reply appeal brief on September 28, 1994. We will refer to this reply appeal brief as the reply brief. The Examiner responded to the reply brief in the supplemental Examiner's answer, mailed November 28, 1994, thereby entering the reply brief into the record.

<sup>3</sup>The Examiner responded to the brief with an Examiner's answer, mailed July 26, 1994. We will refer to the Examiner's answer as simply the answer. The Examiner responded to the reply brief with supplemental Examiner's answer mailed November 28, 1994. On March 11, 1995, the application was remanded to the Examiner. In response to the remand, the Examiner provided a second supplemental Examiner's answer, mailed March 18, 1996.

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the details thereof.

**OPINION**

After a careful review of the evidence before us, we do not agree with the Examiner that claims 6 through 8 and 19 through 23 are properly rejected under 35 U.S.C. § 103 as being unpatentable over Appellants' prior art Figures 2 and 3. In addition, we fail to find that the claims 6 through 8 are properly rejected under 35 U.S.C. § 112, second paragraph.

We turn first to the Examiner's rejection of claims 6 through 8 under 35 U.S.C. § 112, second paragraph. Analysis of 35 U.S.C. § 112, second paragraph, should begin with the determination of whether claims set out and circumscribe a particular area with a reasonable degree of precision and particularity; it is here where definiteness of the language must be analyzed, not in a vacuum, but always in light of teachings of the disclosure as it would be interpreted by one possessing ordinary skill in the art. *In re Johnson*, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977), citing *In re Moore*, 439 F. 2d 1232, 1235, 169 USPQ 236, 238 (1971). Furthermore, our reviewing court points out that a claim which is of such breadth that it reads on subject matter disclosed in the prior art is rejected under 35 U.S.C. § 102 rather than under 35 U.S.C. § 112, second

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paragraph. See *In re Hyatt*, 708 F.2d 712, 715, 218 USPQ 195, 197 (Fed. Cir. 1983) and *In re Borkowski*, 422 F.2d 904, 909, 164 USPQ 642, 645-46 (CCPA 1970).

On page 3 of the answer, the Examiner states that it is not clear whether claim 6 recites a switching unit because of the claim language "the switching unit, when mounted at one of the second locations." When reviewing the whole claim in light of the specification, it is clear that the claim is directed to an electrical wiring arrangement and the switching unit is not a positively recited element of the claim. The claim is only directed to a wiring arrangement which is capable of accommodating a switching unit but does not require a switching unit to be an element of the claim. The indefiniteness is reversed.

In regard to the rejection under 35 U.S.C. § 103, the Examiner has failed to set forth a *prima facie* case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983).

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"Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." ***Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.***, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), ***citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.***, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), ***cert. denied***, 469 U.S. 851 (1984).

Appellants argue on pages 6-7 of the brief and pages 2-3 of the reply brief that the Examiner has failed to show that the prior art would have suggested to those skilled in the art to modify the structures illustrated in Figures 2 and 3 to obtain a switching system as recited in Appellants' claims. Appellants point out that the Examiner has only provided conjecture after reading Appellants' specification of what one of ordinary skill in the art would have found obvious. Appellants argue the Examiner is relying upon personal interpretation of what the Examiner considers to be obvious without having submitted any evidence such as a teaching in the prior art or an Affidavit setting forth the Examiner's experience and knowledge as of the effective filing date.

The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner

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does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), *citing In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." *Para-Ordnance Mfg. v. SGS Importers Int'l*, 73 F.3d at 1087, 37 USPQ2d at 1239, *citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13. Without such evidence, we find that the Examiner has not carried the burden of establishing that the prior art would have suggested the desirability of the Examiner's proposed modification. Therefore, we have not sustained the Examiner's rejection of Appellants' claims.

In view of the foregoing, the decision of the Examiner rejecting claims 6 through 8 and 19 through 23 is reversed.

**REVERSED**

KENNETH W. HAIRSTON                    )  
Administrative Patent Judge        )  
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