Paper No. 17

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES M. FRARY

Appeal No. 1996-3084
Application 08/168,167[1]

HEARD: OCTOBER 5, 1999

Before THOMAS, FLEMING and FRAHM, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner's final rejection of claims 1 through 18, which constitute all the claims in the application.

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[1] Application for patent filed December 17, 1993.

Representative claim 16 is reproduced below:

16. A physical volume comprising:

a housing;

a computer readable medium mounted in said housing for storing data; and

an electromagnetic transponder, attached to said housing, having a non-volatile memory configured to store data associated with the physical volume.

The following reference is relied on by the examiner:

Juengel 4,742,470 May 3, 1988

Claims 1 through 18 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Juengel alone.[2]

Rather than repeat the positions of the appellant and the examiner, reference is made to the brief and the answer for the respective details thereof.[3]

OPINION

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[2] An outstanding rejection of certain claims under the second paragraph 35 U.S.C. § 112 as set forth in the final rejection was withdrawn by the examiner as noted at pages 2 and 5 of the answer.

[3] Appellant's reply brief filed on March 25, 1996 has been denied entry by the examiner in the communication dated April 5, 1996, as well as the Interview Summary form issued on April 17, 1996. Therefore, we have not considered it in our deliberations.

For the reasons set forth by the examiner in the answer, we sustain the rejection as to claims 1 through 16, but reverse the rejection as to claims 17 and 18 for reasons that will be apparent in the ensuing discussion.

At the outset, we note that with respect to appellant's arguments at pages 10 and 11 of the brief asserting that the applied prior art Juengel patent does not solve the same problem as appellant addresses in accordance with the disclosed and claimed invention, it is noted that in an obviousness determination, the prior art need not suggest solving the same problem set forth by appellant. In re Dillon, 919 F.2d 688, 692-93, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990)(in banc) (overruling-in-part In re Wright, 848 F.3d 1216, 1120 6 USPQ2d 1959, 1962 (Fed. Cir. 1988)); cert. denied, 500 U.S. 904 (1991).

To the extent the prior art as a whole includes appellant's discussion with respect to the prior art at the bottom of page 1 through the top of page 3 of the disclosed invention, appellant's arguments between pages 8 and 10 of the brief on appeal relate principally to known prior art

disadvantages already identified in this portion of the specification. Principally, the major disadvantage known to the prior art is that a table-lookup system was necessary to identify various parameters of prior art cartridges associated with automated cartridge systems in a host computer rather than in or on the claimed “physical volume” or cartridge per se.

Juengel is significant in two respects with respect to this understanding of the prior art. First, from an artisan's perspective, both embodiments in Jeungel relate to the particular item in question, in this case, a “machine tool bit” carrying in an enclosed memory therein information relating to the item or tool bit itself. Thus, in contrast to the prior art deficiencies noted earlier in this opinion in the early portions of the specification as filed requiring such information to be located in tables external to the “physical volume” itself, the series of problems associated with this deficiency of the prior art is specifically addressed in the teachings in this reference.

It is noted further that appellant admits at the bottom of page 8, as well as at the bottom of page 11 of the brief,

that transponders of the type claimed have been utilized to identify various types of objects in the prior art. On the other hand, Juengel himself identifies in a general way that the teachings of his invention may be applicable to other types of utilities outside the machine tool environment as expressed initially at column 2, lines 1 through 4 and at column 4, lines 25 through 34.

As to the argument presented at page 9 of the brief that the claimed and disclosed invention permits information relative to the claimed physical volume to be determined without loading the physical volume itself in a drive, this advantage over prior art systems is also met by the teachings in Juengel. Most notably, the discussion associated with Figure 7 and the showing thereof indicates that a computer numerical control machine tool system 100 has associated with it a tool rotating drum or magazine 102 on which various tools 104 are rotatable for selection by the machine tool system itself for use on a selective basis. There is no need to load the tool into the machine tool to determine the nature of the tool or its various data attributes stored in the memory

internal to it in the transponder 112 of Juengel since the transceiver 114 associated with the machine tool reads the data remotely by electromagnetic and/or electrostatic, passive means. The discussion of Figure 7 begins at column 4, line 35. Note also the discussion of prior art tool holder pickup stations at column 3, lines 4 through 9.

To the extent appellant further argues at page 9 of the brief that the claimed and disclosed invention does not require the physical volume be tied to a particular system, it is noted that Juengel also solves these problems inherently and it has generally been known in accordance with the discussion in the background of Juengel's invention at column 1, lines 30 through 35 that a flexible manufacturing system environment allows machine tools to exchange or share tools between themselves.

Juengel presents to the artisan a second major advantage within an assessment of the prior art as a whole. To the extent the earlier discussion has directly addressed the noted deficiencies of the prior art recognized by appellant in the early pages of the specification as filed, Juengel has further significance to the artisan since the physical corollary of

the claimed type of “automated cartridge system” is often in the art called a “jukebox” cartridge storage system, where Juengel presents in Figure 7 to the artisan an analogous structure since the tool rotating drum or magazine 102 in this figure associated with the computerized numerical control machine tool system 100 is physically analogous to prior art “jukebox” systems utilized to store and search various tape cartridge mechanisms. Thus, there would have been an obvious logical commendation among the teachings of Juengel which would have been clearly pertinent to an inventor's attention in considering the problems or deficiencies of the prior art as set forth in In re Clay,
966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992). The discussion in the paragraph bridging columns 4 and 5 of Juengel also lists various advantages to the approach taken according to both embodiments set forth in this reference.

In accordance with appellant's claim grouping, the above arguments have been principally addressed to the rejection set forth of independent claims 1 and 16. No arguments have been presented by appellant with respect to dependent claims 2 through 8. It is noted that independent claim 9 is identical

to the subject matter of claim 1 with the further feature recited that additional elements permit determining the relative positioning of the transceiver means and the selected label based on attributes of the signal received by the transceiver means from the transponder. We sustain the rejection of this claim for the reasons set forth by the examiner and note further that appellant has presented no arguments with respect to dependent claims 10 through 15.

Even a brief study of Juengel indicates that at least with respect to the showing in Figure 7 of the transceiver 114 communicating with each of the tools 104 via transponder unit 112 therein as they rotate about the drum or magazine 102 for selection of the tool in accordance with the known prior art teachings identified as conventional in the art in the discussion beginning at column 4, line 49, the ability to select between rotation tool bits determines relative position based upon received signals. Appellant's brief summary of Juengel at the top of page 8 even recognizes that Juengel is an interrogation-response-based system which generally even uses the term “transponder and transceiver” indicating bidirectional communications exist between transceiver 114 and

transponder 112. Relative position is obviously taught within 35 U.S.C. § 103 in Juengel in the manner claimed based upon the selectability or non-selectability of an individual tool bit as it rotates around past the transceiver 114.

We reach an opposite conclusion and reverse the rejection of independent claim 17 and its dependent claim 18 since this method claim goes beyond a mere determination of relative position of the robotic hand assembly to include the adjustment of the relative position based upon the return signal from the transponder at the transceiver. Even in view of the examiner's arguments with respect to the adjustability feature, Juengel is silent as to utilizing any signals received by the transceiver 114 from the transponder 112 for relative position adjustments.

In view of the foregoing, we sustain the rejection of claims 1 through 16, but reverse the rejection of claims 17 and 18. Therefore, the decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

James D. Thomas Administrative Patent Judge	)	
Michael R. Fleming Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Eric S. Frahm Administrative Patent Judge	)	

JDT/cam

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