The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALEXANDRE PIMENTA, CLAUDENE PARAVELA, JR., DELCIO PRIZON, GERALDO ZANAROTTI and LELLIS CAMPOS

Appeal No. 1998-3380
Application 08/542,591

ON BRIEF

Before FLEMING, LALL and DIXON, Administrative Patent Judges.

LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the final rejection of claims 1-19, which constitute all the claims in the application.[1]

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[1] An amendment after the final rejection was filed as Paper No. 9, however it made no changes to the claims on

The invention is related to an interface device having a circuit which resides within an interface circuit unit and includes a power supply, a driver, a central processing unit (CPU), an oscillator, a modem, and a medium attachment unit (MAU). The power supply and the driver are connected to selected pins of the serial port connector. The MAU is connected to the connectors for connection to a Fieldbus. The power supply provides a power output for powering the other components of the interface circuit. The power supply generates a stabilized DC output from power drawn from the serial port of the computer to which interface device is coupled. Because the interface device is powered entirely from the computer, the interface device does not need to draw any power from the Fieldbus to which it is connected. As such, the interface device does not load down the Fieldbus when it is coupled thereto. The CPU processes data in accordance with the Fieldbus protocol. The modem converts data that has been formatted by the CPU into Fieldbus-compatible signals. Conversely, the modem also converts

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appeal.

Fieldbus-compatible signals into data which the CPU processes for a transmission to the computer. The MAU conditions signals to and from the modem for communication over the Fieldbus. The invention is further illustrated by the following claim.

1. An interface device for interfacing a computer with a Fieldbus, comprising:

a serial port connector for connecting the interface device to a serial port of the computer;

a power supply coupled to the serial port connector for generating, from power supplied by the computer, a stabilized DC voltage for powering the interface device;

a processor coupled to the serial port connector for processing data from the computer and the Fieldbus for communication to the Fieldbus and the computer, respectively; and

a medium attachment unit (MAU) coupled to the processor for connecting to the Fieldbus and for providing predetermined electrical characteristics for signals transmitted to and received from the Fieldbus.

The Examiner relies on the following references:

Warren et al. (Warren)	4,791,356	Dec. 13, 1988
Seigel	5,313,642	May 17, 1994
Kogure	5,412,643	May 2, 1995
Crowder et al. (Crowder)	5,442,639	Aug. 15, 1995

Claims 1-11, and 13-19 stand rejected under 35 U.S.C. §

103 over Crowder, Kogure and Seigel, while claim 12 stands rejected over Crowder, Kogure, Seigel and Warren.

Rather than repeat in toto the positions and the arguments of Appellants and the Examiner, we make reference to the briefs[2] and the answer for their respective positions.

OPINION

We have considered the rejections advanced by the Examiner. We have likewise, reviewed Appellants' arguments against the rejections as set forth in the briefs.

We reverse.

In our analysis, we are guided by the general proposition that in an appeal involving a rejection under 35 U.S.C. § 103, an Examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness, is then determined on the basis of the evidence as a whole and

[2] A reply brief was filed as Paper No. 14, which was entered by the Examiner, without further response, see Paper No. 15.

the relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). We are further guided by the precedent of our reviewing court that the limitations from the disclosure are not to be imported into the claims. In re Lundberg, 244 F.2d 543, 113 USPQ 530 (CCPA 1957); In re Queener, 796 F.2d 461, 230 USPQ 438 (Fed. Cir. 1986). We also note that the arguments not made separately for any individual claim or claims are considered waived. See 37 CFR § 1.192(a) and (c). In re Baxter Travenol Labs., 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991) ("It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobviousness distinctions over the prior art."); In re Wiechert, 370 F.2d 927, 936, 152 USPQ 247, 254 (CCPA 1967)("This court has uniformly followed the sound rule that an issue raised below which is not argued in that court, even of it has been properly brought here by reason of appeal is

regarded as abandoned and will not be considered. It is our function as a court to decide disputed issues, not to create them.”).

Analysis

We note that Appellants have elected, brief at page 4, different groupings of the claims. We will now separately analyze them according to the guidelines set forth above.

Claims 1 and 6-15

These claims are rejected over Crowder as modified by Kogure and Seigel. We take claim 1 as the representative claim of this group. The Examiner gives a lucid explanation of the rejection of this claim on pages 2-3 of the final rejection. We note that, according to the Examiner's rejection, Kogure and Crowder are both used to incorporate a power supply into the probe means shown in Crowder, while the other claimed elements of claim 1 are shown by Crowder alone. Appellants assert, brief at page 7, that "the Crowder Patent in no way discloses that a processor is coupled to a serial port connector, and that a medium attachment unit (MAU) is coupled to the processor, as recited in independent claim 1." We disagree with Appellants' position. We find that Figure 2

is a schematic representation of the layout of various complements on a chip shown in Figure 5 of Crowder. For the probe 7 of Figure 5 (also Figure 2) to function, there inherently must be an interaction among all the complements which are shown in Figure 5. Therefore, we conclude that the components shown in Figure 5 are coupled, contrary to the assertions made by Appellants. Our position is supported by the case law, which states that "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.'" In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-1951 (Fed. Cir. 1999), citing Continental Can Co. v. Monsanto Co., 948 F.3d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result for a given set of circumstances is not sufficient." Id. citing Continental Can Co. v. Monsanto Co., 948 F.3d at 1269, 20 USPQ2d at 1749. In the instant case, this is further buttressed by the disclosure of Kogure at col. 4,

line 23 - col. 5, line 25, where it is taught that for probe 7 to operate properly there must be an interaction among the various components depicted in Figure 5. However, we cannot support the examiner's position regarding the claimed limitation of "a power supply ...., for power supplied by the computer." Specifically, the Examiner suggested the combination of Kogure and Siegel with Crowder to meet this limitation. Appellants argue, brief at page 9, that "the Examiner is relying on such an <u>improper hindsight reconstruction</u>, which cannot be used for rejecting the claims of the present application." We agree with Appellants that an Examiner cannot use an inventor's disclosure as a road map for selecting and combining prior art disclosures.

Therefore, we do not sustain the obviousness rejection of claim 1 over Crowder, Kogure and Seigel. Since the other claims of this group, namely 6-15, each contain at least this limitation, we cannot sustain their rejection over Crowder, Kogure and Seigel.

Parenthetically, we note that with respect to the rejection of claim 12, the examiner also adds Warren to the combination of Crowder, Kogure and Seigel, however, Warren

does not cure the noted problem of improper hindsight reconstruction.

Claims 2-5, and 16-19

We discuss the other three groupings together because they again all involve the issue of impropriety of the modification of Crowder by Kogure and Seigel with respect to claims 2-5, and
16-19. As to claims 2-5 and 16-19, Appellants argue the impropriety of combining Crowder, Seigel and Kogure, see pages 9-14 of the brief. With respect to these claims, the combination of Kogure and Seigel is necessary for the argued limitations of each claim. Id. For example, the combination is needed for the claimed "modem coupled between the processor and the MAU" (claim 2 or 16). However, we find that none of these references has a suggestion for the combination proposed by the Examiner. Crowder is an apparatus for monitoring, detecting and analyzing of signal errors on an electronic communications network. Kogure does show a probe, such as 10 in Figure 2, which can be used to measure variables on a Fieldbus. However, there is no suggestion or reason to combine Kogure with Crowder. Furthermore, Seigel is directed

to yet another type of peripheral device which uses power from within a computer in certain situations. However, there is no connection between Seigel and Kogure and Crowder. Therefore, the suggested combination is improper.

Thus, we cannot sustain the obviousness rejection of claims 2-5 and 16-19 over Crowder, Kogure and Seigel.

In summary, we have reverse the rejection under 35 U.S.C. § 103 of claims 1-11 and 13-19 over Crowder, Kogure and Seigel, and of claim 12 over Crowder, Kogure, Seigel and Warren.

REVERSED

MICHAEL R. FLEMING Administrative Patent Judge	)	
PARSHOTAM S. LALL Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JOSEPH L. DIXON Administrative Patent Judge	)	

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