The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HARTMUT FUHRMANN, DIRK PROBIAN,
ROLAND HOLL, KLAUS PETER REICHARDT,
KARSTEN WENDT, THOMAS WEISS
and ALBRECHT VOLZ

Appeal No. 2001-1417
Application No. 09/042,520

ON BRIEF

Before HAIRSTON, JERRY SMITH, and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1, 2, 4, 6-8, 10-16, and 18-24. Claims 3, 5, 9, and 17 have been canceled. The Examiner approved entry of an after final amendment filed January 18, 2000 but denied entry of the after final amendment filed October 10, 2000.

The claimed invention is directed to a printing machine having a stationary laser imaging device, which is shared by at least two form cylinders, that emits laser pulses in a beam bundle along a beam path. Further provided is light diversion apparatus movable in the beam path for dividing the beam bundle into partial beams and selectively deflecting the laser pulses onto the circumferential surfaces of respective ones of the form cylinders.

Claim 1 is illustrative of the invention and reads as follows:

1. A printing machine, comprising:

at least two form cylinders;

a stationary imaging device having a laser unit operative to emit laser pulses in a beam bundle along a beam path for imaging printing forms on the form cylinders; and light diversion means movable in the beam path for dividing the beam bundle into partial beams and selectively deflecting the laser pulses produced by the laser unit onto one of the at least two form cylinders.

The Examiner relies on the following prior art:

Ketley	3,867,150	Feb. 18, 1975
Goldberg	4,383,261	May 10, 1983
Williams et al. (Williams)	5,351,617	Oct. 04, 1994
Bronstein	5,526,107	Jun. 11, 1996
Nishioka et al. (Nishioka)	5,642,182	Jun. 24, 1997 (filed Dec. 28, 1995)

Claims 1, 2, 4, 6-8, 10-16, and 18-24 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the Examiner offers Bronstein in view of Ketley, Nishioka, and Williams with respect to claims 1, 2, 4, 6-8, 10-16, 18-21, 23, and 24, and adds Goldberg to the basic combination with respect to claim 22.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief (Paper No. 17 and Answer (Paper No. 19) for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Brief along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1, 2, 4, 6-8, 10-16, and 18-24. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to the obviousness rejection of independent claim 1, Appellants assert the Examiner's failure to establish a prima facie case of obviousness since all of the claim limitations are not taught or suggested by the applied prior art references. In particular, Appellants assert (Brief, pages 10 and 11) that the Examiner has misinterpreted the disclosure of Bronstein as disclosing a stationary imaging device as claimed.

After careful review of the Bronstein reference, we are in general agreement with Appellants' position as stated in the Brief. As asserted by Appellants, we find no basis for the Examiner's conclusion that the unlabeled box between the spinner 190 and the sensor 110b represents a stationary imaging device. In our view, the passages at column 4, lines 16-18 and column 8, lines 18-20 of Bronstein, cited by the Examiner in support of the asserted interpretation, merely indicate that a laser beam is scanned across the cylinder drum surface with the aid of a spinner. We find no indication in the cited passages, or elsewhere in the disclosure of Bronstein, of the nature of the source of the laser beam pulse, let alone any description which would satisfy the stationary imaging device limitation in the specific combination set forth in appealed claim 1. In order for us to sustain the Examiner's rejection, we would need to resort

to impermissible speculation or unfounded assumptions or rationales to supply deficiencies in the factual basis of the rejection before us. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968), rehearing denied, 390 U.S. 1000 (1968).

We recognize that the Examiner (Answer, pages 5 and 6) offers an alternative approach in which, assuming Bronstein is not construed as disclosing a stationary imaging device, the skilled artisan would nevertheless have found it obvious to modify Bronstein to use a stationary imaging device such as the stationary laser devices of Ketley and Nishioka. The Examiner further asserts (id.) that Williams, added to the proposed combination to address the "beam bundle" limitation of claim 1, also discloses a stationary imaging device as illustrated in the Figure 9 embodiment described beginning at column 11, line 10 of Williams.

In our view, the disclosures of Ketley, Nishioka, and Williams merely establish that stationary imaging devices exist in printing devices. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260,

1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The Examiner's statement of the grounds of rejection at page 6 of the Answer, is lacking in any rationale as to why the skilled artisan would modify Bronstein to add the stationary imaging devices of the prior art. Nowhere does the Examiner identify any suggestion, teaching, or motivation to combine the Ketley, Nishioka, or Williams references with Bronstein nor does the Examiner establish any findings as to the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that would support a proper obviousness analysis. See, e.g., Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 37 USPQ2d 1626 (Fed. Cir. 1996). In our opinion, the problems attendant to synchronizing the operation of a printing device in which two or more form cylinders share a single light directing spinner device such as in Bronstein simply do not exist in the single form cylinder devices of Nishioka and Williams or the printing device using a flat optical mask such as in Ketley. Given these deficiencies in the applied prior art references, it is our view that any suggestion to combine the references in the manner proposed by the Examiner could only come from Appellants' own disclosure and not from any teaching in the references themselves.

We have also reviewed the disclosure of Goldberg applied by the Examiner to address the form cylinder preheating unit limitations of dependent claim 22. We find, nothing, however in the disclosure of Goldberg which would overcome the deficiencies of Bronstein, Ketley, Nishioka, and Williams discussed supra.

In view of the above discussion, it is our view that, since all of the limitations of the appealed claims are not taught or suggested by the applied prior art references, the Examiner has not established a prima facie case of obviousness. Accordingly, the Examiner's 35 U.S.C. § 103(a) rejection of independent claim 1, as well as claims 2, 4, 6-8, 10-16, and 18-24 dependent thereon, is not sustained.

In conclusion, we have not sustained the Examiner's rejection of any of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1, 2, 4, 6-8, 10-16, and 18-24 is reversed.

REVERSED

KENNETH W. HAIRSTON Administrative Patent Judge	
JERRY SMITH Administrative Patent Judge	BOARD OF PATENT APPEALS AND INTERFERENCES
JOSEPH F. RUGGIERO Administrative Patent Judge	

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