

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID M. SIEFERT

Appeal No. 2001-1995
Application 08/646,567

ON BRIEF

Before THOMAS, HAIRSTON, and BARRY, Administrative Patent Judges.
THOMAS, Administrative Patent Judge.

ORDER VACATING REJECTIONS AND REMAND TO THE EXAMINER

Pursuant to 37 CFR § 196(a) and the Manual of Patent Examining Procedure (MPEP) § 1211, this application is remanded to the examiner for appropriate action with respect to the matters discussed below. Because the present rejections of the claims on appeal are considered by us to be not ripe for our review, we VACATE all rejections of the claims on appeal and REMAND the application in view of the following. The instant record is not

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in a form that permits reaching a reasoned decision at this time. When the Board vacates an examiner's rejection, the rejection is set aside and no longer exists. Cf. Ex parte Zamborano, 58 USPQ2d 1312, 1313 (BPAI 2001).

There is no statement of any rejection of any claim on appeal in the answer. Additionally, the answer does not make reference to the final rejection or any other prior Office action for a statement of rejection on which to rely. Furthermore, the top of page 3 of the final rejection merely states that the rejections previously stated in the last Office action (Paper No. 11), December 10, 1999, were maintained and incorporated by reference. This practice violates MPEP § 1208 which requires the examiner to set forth grounds of rejection in the answer or to directly reference the final rejection or any single prior Office action.

We are also unconvinced and question whether the examiner has substantially and procedurally set forth any prima facie case of anticipation within 35 U.S.C. § 102 of claim 6 and of the three separately stated rejections of claims 1 and 7-11 under 35 U.S.C. § 103. The responsive arguments portion at pages 4-6 of the answer merely repeats verbatim of a corresponding portion in paragraphs 8-12 at pages 3-5 of the final rejection. These

appear to be merely cursory responses which fail to address any/all of the arguments made by appellants in the principal brief on appeal as to each of the four separately stated art rejections of the claims on appeal. The examiner has in effect not presented for our benefit any substantive response to the 27 pages of argument presented in the principal brief on appeal.

As indicated earlier, the last complete statement of any rejection of the claims on appeal occurred in Paper No. 11 mailed on December 10, 1999. At page 3 thereof the examiner took Official Notice "that it was well known to use either the address bus or the data bus to transmit the polling message." Appellant challenges this assertion at pages 14-16 of the principal brief on appeal. Regarding the assertion that the examiner's belief that a data bus and an address bus are interchangeable, appellant requested citation of evidence showing the interchangeability under MPEP § 2144.03 at the top of page 15 of the principal brief on appeal. The answer does not address this assertion or the requirements placed upon the examiner by the noted MPEP section.

Our reviewing court has made it clear in In re Lee, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002), and In re Zurko, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997), that rejections must be supported by substantial evidence in the administrative record and that where the record is lacking in evidence, this Board cannot and should not resort to unsupported speculation. As

indicated in Lee, 277 F.3d at 1343-44, 61 USPQ2d at 1433-34, the examiner's finding of whether there is a teaching, motivation or suggestion to combine the teachings of the applied references must not be resolved based on "subjective belief and unknown authority," but must be "based on objective evidence of record." The court in Lee requires evidence for the determination of unpatentability by clarifying that "common knowledge and common sense," as mentioned in In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969), may only be applied to analysis of the evidence, rather than be a substitute for evidence. Lee, 277 F.3d at 1345, 61 USPQ2d at 1435. See Smiths Indus. Med. Sys., Inc. v. Vital Signs, Inc., 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1421 (Fed. Cir. 1999) (Bozek's reference to common knowledge "does not in and of itself make it so" absent evidence of such knowledge).

Although we do not have before us an assertion of common knowledge and common sense in the art as in In re Lee, the examiner has made an analogous assertion that the feature of the interchangeability of a data bus and an address bus in a computer was notoriously old and well known in the art. Correspondingly, the examiner's assertion appears to us to be a substitute for actual evidence to prove the examiner's assertion. More recently, however, the court expanded its reasoning in In re

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Thrift, 298 F.3d 1357, 1364, 63 USPQ2d 2002, 2007 (Fed. Cir. 2002).

The above leads us to conclude that we have no choice but to VACATE the present rejections of the claims on appeal due to the noted substantive and procedural improprieties to put the prosecution of this application back in a proper procedural posture. The examiner remains free to institute or reinstitute well-founded and well-reasoned rejections on the same and/or additional, new prior art not presently relied upon. As such, the application is accordingly remanded to the examiner for further action consistent with the foregoing.

VACATED AND REMANDED

James D. Thomas)	
Administrative Patent Judge)	
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Kenneth W. Hairston)	BOARD OF PATENT
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