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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD L. KNIGHT and DAVID L. KRELL

Appeal No. 2003-1155
Application No. 08/821,995

ON BRIEF

Before COHEN, FRANKFORT, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a final decision on claims 1 to 17, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

BACKGROUND

The appellants' invention relates to an agricultural irrigation line. A copy of the claims under appeal is set forth in the appendix to the appellants' amended brief (Paper No. 13, filed March 8, 1999).

This application was previously before this panel of the Board of Patent Appeals and Interferences in Appeal No. 2000-0288. On February 20, 2001, we issued a decision (Paper No. 17) affirming the decision of the examiner to reject claims 1 to 3, 5 to 10 and 12 to 17 under 35 U.S.C. § 103 and reversing the decision of the examiner to reject claims 4 and 11 under 35 U.S.C. § 103.[1] In addition, we remanded this application to the examiner to consider the patentability of the subject matter of claims 4 and 11 under 35 U.S.C. § 103. In making this remand, we noted that 37 CFR § 1.196(e) provided that

> [w]henever a decision of the Board of Patent Appeals and Interferences includes or allows a remand, that decision shall not be considered a final decision. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board of Patent Appeals and Interferences may enter an order otherwise making its decision final.

and that regarding any affirmed rejection, 37 CFR § 1.197(b) provided that

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[1] Claims 1 to 13 were rejected under 35 U.S.C. § 103 as being unpatentable over Malott (U.S. Patent No. 3,929,197, issued Dec. 30, 1975) in view of Di Palma (U.S. Patent No. 3,984,052, issued Oct. 5, 1976). Claims 14 to 17 were rejected under 35 U.S.C. § 103 as being unpatentable over Malott in view of Di Palma as applied to claims 1 and 9 above, and further in view of Unruh (U.S. Patent No. 4,626,984, issued Dec. 2, 1986.)

> Appellant may file a single request for rehearing within two months from the date of the original decision . . . .

We therefore deferred the effective date of our affirmance of the rejection of claims 1 to 3, 5 to 10 and 12 to 17 under 35 U.S.C. § 103 until conclusion of the proceedings before the examiner unless, as a mere incident to the limited proceedings, the affirmed rejection was overcomed. Since the proceedings before the examiner did result in a second appeal, this case is before the Board of Patent Appeals and Interferences for final action on the affirmed rejections of claims 1 to 3, 5 to 10 and 12 to 17.

In response to our remand, the examiner rejected claims 4 and 11 under 35 U.S.C. § 103 as being unpatentable over Malott in view of Di Palma (see Paper No. 18, mailed December 17, 2001 and Paper No. 20, mailed June 4, 2002).[2] In this rejection, the examiner concluded that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a DC electrical motor operable with a maximum drive voltage of from about 12 to about 24 volts, since it was known in the art to size the drive voltage of a DC electrical motor and battery power supply depending on the type application or use in which the motor is to be

[2] The Office action mailed December 17, 2001 did not include the approval of the Technology Center Director. MPEP §§ 1002.02(c) and 1214.04 appear to require such approval.

applied and requires only routine skill in the art. The examiner further concluded that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a DC electrical motor operable with a maximum drive voltage of from about 12 to about 24 volts, since it has been held that discovering an optimum value of a result effective variable (in this case, the optimum voltage for the DC motor) involves only routine skill in the art.

In response to this rejection, the appellants filed a declaration from David L. Krell, dated March 18, 2002, and traversed the examiner's reliance on "known in the art" and requested, in accordance with MPEP 2144.03, the examiner cite and apply a prior art reference (see Paper No. 19, filed March 18, 2002 and Paper No. 21, filed September 9, 2002).

OPINION

Claims 4 and 11

In reaching our decision in this appeal with respect to claims 4 and 11, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants in their brief (Paper No. 24, filed September 9, 2002) and the examiner in the answer (Paper

No. 25, mailed January 13, 2003). As a consequence of our review, we will not sustain the rejection of claims 4 and 11 under 35 U.S.C. § 103 for the reasons that follow.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993).

The applied prior art (i.e., Malott and Di Palma) does not teach or suggest the use of a 12-24 volt DC motor as recited in claims 4 and 11. While the examiner has concluded that the use of a 12-24 volt DC motor as recited in claims 4 and 11 would have been obvious at the time the invention was made to a person having ordinary skill in the art, the examiner has not cited any evidence to support such conclusion as requested by the appellants.[3] When an applicant seasonably challenges a factual

[3] Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg., Inc. v. SGS Importers Int'l., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), cert. denied, 117 S. Ct. 80 (1996), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. A broad conclusory statement regarding the obviousness of

(continued...)

assertion as not properly officially noticed or not properly based upon common knowledge, the examiner must support the finding with adequate evidence.[4] See In re Chevenard, 139 F.2d 711, 713, 60 USPQ 239, 241 (CCPA 1943) and MPEP 2144.03.

Since the applied prior art (i.e., Malott and Di Palma) does not teach or suggest the use of a 12-24 volt DC motor as recited in claims 4 and 11, the decision of the examiner to reject claims 4 and 11 under 35 U.S.C. § 103 is reversed.[5]

Claims 1 to 3, 5 to 10 and 12 to 17

The decision of the examiner to reject claims 1 to 3, 5 to 10 and 12 to 17 under 35 U.S.C. § 103 is affirmed for the reasons set forth in our previous decision (Paper No. 17, mailed February 20, 2001).[6] This affirmance is final for purposes of judicial review.

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[3](...continued)
modifying a reference, standing alone, is not "evidence." Thus, when an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002). See also In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

[4] On page 4 of the answer (Paper No. 25), the examiner refers to two references that have not been applied in the rejection under appeal. These references will be given no consideration since they were not included in the statement of the rejection. See Ex parte Raske, 28 USPQ2d 1304, 1305 (Bd. Pat. App. & Int. 1993).

[5] Accordingly, there is no need for us to weigh the declaration from David L. Krell, dated March 18, 2002. However, we wish to point out to the examiner that the issues of long-felt need and non-analogous art are pertinent and relevant to the patentability of claims 4 and 11 and should have been fully addressed by the examiner. See page 4 of the answer (Paper No. 25) wherein the examiner states that these issues are not pertinent to the rejection of claims 4 and 11.

[6] The declaration from David L. Krell, dated March 18, 2002 submitted in response to the limited reopening of prosecution of claims 4 and 11 is not evidence before us in the rejection of claims 1 to 3, 5 to 10 and 12 to 17.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 3, 5 to 10 and 12 to 17 under 35 U.S.C. § 103 is affirmed and the decision of the examiner to reject claims 4 and 11 under 35 U.S.C. § 103 is reversed.

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

IRWIN CHARLES COHEN Administrative Patent Judge	)
CHARLES E. FRANKFORT Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)

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