The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 37

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte JAMES W. RUDOLPH

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Appeal No. 2003-1362
Application No. 09/178,399

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HEARD: December 11, 2003

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Before BARRETT, GROSS, and BLANKENSHIP, ***Administrative Patent Judges***.

GROSS, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 14, which are all of the claims pending in this application.

Appellant's invention relates to a method and apparatus for measuring weight during a CVI/CVD process. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A method to determine the change in weight of parts in a furnace during a CVI/CVD process, comprising the step of: measuring the change in weight of the entire furnace, including contents, during the CVI/CVD process.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Swartzendruber	4,044,920	Aug. 30, 1977
Spoor	4,217,785	Aug. 19, 1980
Yano et al. (Yano)	4,375,838	Mar. 08, 1983
Yoshida et al. (Yoshida)	4,964,734	Oct. 23, 1990
Golecki et al. (Golecki)	5,348,774	Sep. 20, 1994
Piroozmandi	5,770,823	Jun. 23, 1998

Claims 1 through 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Golecki in view of Yoshida, Yano, Spoor, Piroozmandi, and Swartzendruber.

Reference is made to the Examiner's Answer (Paper No. 30, mailed September 12, 2002) for the examiner's complete reasoning in support of the rejection, and to appellant's Brief (Paper No. 29, filed August 22, 2002) and Reply Brief (Paper No. 31, filed November 13, 2002) for appellant's arguments thereagainst.

OPINION

As a preliminary matter, we note that appellant indicates on page 7 of the Brief that the claims do not stand or fall together. However, appellant has provided no separate argument for any claim. 37 C.F.R. § 1.192(c)(7) states:

> For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do

> not stand or fall together ***and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable.*** Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable. (Emphasis ours)

Thus, we will treat the claims as a single group with claim 1 as representative.

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellant and the examiner. As a consequence of our review, we will affirm the obviousness rejection of claims 1 through 14.

Appellant asserts (Brief, page 9) that "[o]ne of ordinary skill in the art would not combine the references as suggested by the Examiner." More specifically, appellant contends (Brief, page 10) that "[t]here is absolutely no reason to combine Golecki with any secondary reference since Golecki describes the optional use of weighing devices." In a related argument, appellant suggests (Reply Brief, page 2) that "if Golecki wanted to weigh the entire furnace, he simply would have disclosed such an embodiment." We disagree. First, if Golecki disclosed an embodiment in which the entire furnace was weighed, Golecki would anticipate the claimed invention. If we required such a teaching in Golecki to combine other references therewith, there would be

no need for combining. Additionally, although Golecki may not specify using a weighing device as a preferred embodiment, Golecki does teach an embodiment including an in-situ weighing device **13**, as shown in Figure 1. Accordingly, the skilled artisan would have used the teachings of the secondary references as better methods of weighing for that embodiment of Golecki.

Appellant further argues (Brief, pages 10-11) that "[t]he secondary references do not deal with a method of weight gain of a substrate in a CVI process or the weighing of an entire furnace" and, therefore, "are consequently not in the field of the applicant's endeavors." Appellant asserts (Brief, page 11 and Reply Brief, page 3) that the secondary references do not deal with the problem appellant was concerned with, namely determining the weight change in the parts during processing of the parts in a CVI/CVD furnace.

We agree with appellant that the secondary references may not be in appellant's field of endeavor. However, we disagree with appellant's characterization of the problem solved, and thus with the conclusion that the references do not deal with the same problem as that which concerned appellant. Appellant did not solve the problem of continuously weighing the parts during processing in a CVI/CVD furnace, as Golecki teaches such

continuous weighing. The problem actually solved by appellant is more accurately weighing the parts inside the furnace. All of the secondary references deal with problems associated with weighing parts inside a vessel and/or with weighing parts in a heated environment (which would include a furnace). Accordingly, the secondary references all relate to weighing accuracy and, therefore, are analogous art according to the second criteria of ***In re Clay***, 966 F.2d 656, 658, 23 USPQ2d 1058-59, 1060 (Fed. Cir. 1992), that the reference be pertinent to the particular problem being solved.

Appellant further states (Brief, page 11, and Reply Brief, page 5) that "[e]ven if the references were combined in the manner suggested by the Examiner, they still would not render obvious the Appellant's invention." However, appellant fails to explain exactly what would be missing if all of the references were combined as proposed by the examiner. Instead appellant (Brief, pages 11-12) summarizes what each reference discloses and then concludes that the combination would not be the same as appellant's invention. Such unsupported conclusions are not convincing.

Last, appellant (Brief, page 12) "submits that the Examiner is not one of ordinary skill in the art," and that the examiner

consequently should not be allowed to rely upon "knowledge available to one of ordinary skill in the art." See also Reply Brief, page 5. We agree that a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusionary statements of the examiner. ***See In re Lee***, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Accordingly, "knowledge available to one of ordinary skill in the art" would be insufficient motivation to combine the references. However, although the examiner appears to rely upon such "knowledge," the examiner actually relies upon specific teachings in the references.

In particular, Yano at column 1, lines 39-42, and Spoor at column 1, lines 20-44, teach that devices measuring weight are adversely affected by changes in temperatures, thereby suggesting that the measurements of Golecki would be more accurate if done outside of the furnace. Further, Piroozmandi at column 2, lines 30-42, and Swartzendruber at column 1, lines 34-36, and column 2, lines 50-58, teach that the accuracy in weighing material inside a vessel is improved by measuring the weight of the vessel with its contents through installation of load cells under the vessel. Although both references deal with the weighing of bulk materials, when combined with the teachings of Yano and Spoor,

they suggest that the entire furnace should be weighed rather than only the contents inside the furnace to increase the accuracy of the measurements. The level of the skilled artisan should not be underestimated. ***See In re Sovish***, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985). Accordingly, appellant has not convinced us of any error in the examiner's rejection, and we will sustain the rejection of claims 1 through 14.

CONCLUSION

The decision of the examiner rejecting claims 1 through 14 under 35 U.S.C. § 103 is affirmed.

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

AFFIRMED

LEE E. BARRETT Administrative Patent Judge	)	
ANITA PELLMAN GROSS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
HOWARD B. BLANKENSHIP Administrative Patent Judge	)	

AG/RWK

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