

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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** MICHAEL R. CONBOY, PATRICK J. RYAN, and  
ELFIDO COSS JR.

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Appeal No. 2004-0588  
Application No. 09/387,174

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ON BRIEF

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Before DIXON, BLANKENSHIP, and SAADAT, **Administrative Patent Judges**.  
DIXON, **Administrative Patent Judge**.

### **DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 1-12, which are all of the claims pending in this application.

We REVERSE.

## BACKGROUND

The appellants' invention relates to a scheduling method for automated work-cell transfer system. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method for routing material in a computer controlled manufacturing environment having a plurality of alternate locations for a plurality of manufacturing processes, wherein at least two objects meet at a junction of at least two routes, the method comprising:

establishing a distribution of events indicative of the alternate locations at which material is processed;

in response to establishing the distribution of events, formulating a routing decision for the at least two objects;

determining an interval at which to re-establish the distribution of events;

in response to determining the interval, re-establishing the distribution of events and reformulating a routing decision for the two objects.

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

Burney	4,829,445	May 9, 1989
Lin et al. (Lin)	5,880,960	Mar. 9, 1999

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Claims 1-12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lin in view of Burney.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 12, mailed Sep. 9, 2003) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 11, filed Jul. 7, 2003) and reply brief (Paper No.13, filed Oct. 27, 2003) for appellants' arguments thereagainst.

#### **OPINION**

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which 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 by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as

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shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See **In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in art would lead that individual to combine the relevant teachings of the references.'" **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory

statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 999, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362,1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations set forth in independent claim 1.

The examiner maintains that Lin teaches most of the claimed invention but for the at least two objects meet at a junction of at least two routes. (See answer at pages 3-5.) Appellants argue that there is no teaching in the prior art (and no specific assertion in the Office action) that at least two objects or SIP's meet at the allegedly corresponding junction. (See brief at page 4.) We agree with appellants that the portions of Burney cited by the examiner do not clearly teach that two objects meet at a junction. Additionally, appellants argue that the examiner has not made a showing of reformulating a routing decision in Lin would be inherent in the teachings of Lin. (See brief at page 4 and answer at page 4.) We agree with appellants and find that the system of Lin is directed more towards adapting the tools and personnel to reduce work

in progress rather than the movement of material. Therefore, we find the examiner's inherency argument tenuous at best.

Therefore, we find that the examiner has not established a *prima facie* case of obviousness since the examiner has not shown in the statement of the rejection and arguments that all the claimed elements are taught or fairly suggested by the applied prior art references.<sup>1</sup>

Appellants argue that there is no motivation to combine the teachings of Lin and Burney. (See brief at page 5.) The examiner maintains that both references relate to balancing work in a manufacturing line (answer at page 9) and because the combination would increase production yield by minimizing material handling losses (answer at page 7). We disagree with the examiner and agree with appellants that the system of Lin is directed more to adapting the tools and personnel to optimize the production and Burney is directed more to adapting the material handling. While the combination of the two would optimize the overall system, they would be directed to two very different parts of the overall system. We do not find that the examiner has made a persuasive showing as to why it would have been obvious to one of ordinary skill in the art at the

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<sup>1</sup> We do note that the teachings of Burney are more in line with appellants' claimed invention than the examiner has applied, but we do not make any findings thereto. For example, we direct the examiner's attention to Figures 5, 6, 8, 11, 14, and 15 and column 3, line 54+, column 4, line 57+, column 6, line 4+, column 18, line 45+ (shell game), column 22, line 34+(path arbitration), and column 24, line 63-column 25, line 18. These portions tend to imply that the carriers may be dynamically redirected. We leave it to the examiner to fully consider the totality of the teachings of Burney more fully than in the present rejection.

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time of the invention to combine the two teachings regarding only the material handling as with the claimed invention. Therefore, we find that the examiner has not established a *prima facie* case of obviousness of the combination of teachings since the examiner has not shown in the statement of the rejection and arguments a convincing line of reasoning for the asserted combination. Therefore, we will not sustain the rejection of independent claims 1, 7, and 12 and their dependent claims.

### **CONCLUSION**

To summarize, the decision of the examiner to reject claims 1-12 under 35 U.S.C. § 103 is reversed.

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**REVERSED**

JOSEPH L. DIXON	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
HOWARD B. BLANKENSHIP	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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MAHSHID D. SAADAT	)	
Administrative Patent Judge	)	

JD/RWK

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