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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW LILBURN

Appeal No. 2005-1766
Application 10/050,167

HEARD: September 15, 2005

Before GARRIS, WARREN and TIMM, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge.*

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellant, in the brief and reply brief, and based on our review, find that we cannot sustain the grounds of rejection advanced on appeal: appealed claims 1 through 6, 18 and 31 under 35 U.S.C. § 103(a) as being unpatentable over Lilburn (answer, page 3); appealed claims 7 through 17, 19 through 30 and 32 under 35 U.S.C. § 103(a) as being unpatentable over Lilburn as applied to claim 1, and further in view of Lewis, with or without Justus and Ely, Sr. (answer, pages 3-4); and appealed claim 33 under 35 U.S.C. § 103(a) as being unpatentable over Lilburn as applied to claim 1, and further in view of Bossen (answer, page 4).[1,]

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[1] Appealed claims 1 through 33 are all of the claims in the application upon entry of the amendment filed May 3, 2004 (*see* answer, page 2). See the appendix to the brief.

The dispositive issue in this appeal is whether the terms in the claim language "detecting conductivity of the wet web entering the wet end section," considered in the context of the preambular language "monitoring dewatering in a wet end section of a web production machine" and the language in the limitation "determining a water balance from the measured quantities, which is indicative of dewatering in the wet end," of appealed claim 1 when given the broadest reasonable interpretation in their ordinary usage as they would be understood by one of ordinary skill in the art in light of the written description in the specification, including the drawings, as interpreted by this person, and without reading into the claims any limitation or particular embodiment disclosed in the specification, *see, e.g.*, *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), must be interpreted as "detecting conductivity of the wet web *entering* the wet end section, not the conductivity of the wet web in the wet end section, as apparently interpreted by the Examiner," as framed by appellant (reply brief, page 2; original emphasis).

We determine that one of ordinary skill in this art would consider the language "a wet end section of a web production machine" in the context of any web production machine as described in the specification, to mean monitoring a whole section of the "wet end" of that machine, such as the press section, and not with respect to a part of a section, such as the nip of a set of press rolls in the press section. Indeed, we find no disclosure in the written description from which it can even reasonably be inferred that the determination of a water balance is based on less than the whole of a wet end section being monitored, which requires detecting the conductivity of the wet web prior to its entry into the section. *See* specification, e.g., [0002], [0017], [0034], [0036], [0038], [0046], [0047], and [0056]. Accordingly, we are of the view that the claim language "detecting conductivity of the wet web entering the wet end section" must be given its plain meaning of detecting the conductivity of the wet web before it enters a whole wet end section being monitored.

In applying Lilburn to the appealed claims, the examiner relies on the determination of a water balance by a method which includes determining the wet web conductivity by measurement or calculation after it passes through a roller nip in the press section of a paper machine, arguing that the reference teaches "using the wet web conductivity of the web coming into the press using **measured** or calculated values from the previous nip" which is "equivalent

to measuring the conductivity of the web into the nip as the conductivity does not change as the web passes directly from one nip to the next" (answer, page 5; original emphasis). The examiner further takes the position that "the use of the various calculations into and out of the nip to determine the water balance of the press would have been routine calculations to one of ordinary skill in the art" (*id.*).

We agree with appellant that "in Lilburn, because conductivity of the web is measured from the previous nips, which are already within the wet section, the initial conductivity measurement is not until after the first press" and is "the conductivity of the wet web in the wet end section" (brief, page 10, original emphasis deleted; reply brief, page 2). Indeed, Lilburn would have disclosed to one of ordinary skill in the art that the initial determination of conductivity involves "measuring the electrical conductivity of the water entering a press section means entrained in one or more press felts," this step being illustrated by electrical conductivity sensors **21**,**22** positioned against the respective felts in the drawing, and provides the basis for "Wet Web conductivity measured or calculated from previous press nip" (page 4, ll. 18-19, page 5, ll. 3-5, page 6, ll. 19-21, page 7, l. 12, and abstract).

Thus, while Lilburn provides evidence in support of the examiner's position, that position does not apply Lilburn to each and every limitation of the invention encompassed by appealed claim 1 as we have interpreted this claim above. *See, e.g., In re Geerdes*, 491 F.2d 1260, 1262-63, 180 USPQ 789, 791-92 (CCPA 1974) (In considering grounds of rejection under 35 U.S.C. §§ 103 and 112, "*every* limitation in the claim must be given effect rather than considering one in isolation from the others."). To the extent that the examiner takes the position that it would have been obvious to determine the conductivity of the wet web as it enters the press section, we fail to find in the answer a scientific explanation for this determination based on the disclosure of Lilburn as well as a showing establishing the motivation leading one of ordinary skill in the art to modify the teachings of Lilburn do so. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998)\ ("hindsight" is inferred when the specific understanding or principal within the knowledge of one of ordinary skill in the art leading to the modification of the prior art in order to arrive at appellant's claimed invention has not been explained); *B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996) ("When obviousness is based on a particular prior art

reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. [Citation omitted.] This suggestion or motivation need not be expressly stated. [Citation omitted.]”). We do not find evidence supporting the examiner’s position in the other applied references.

Thus, on this record, we find that the examiner has not established a *prima facie* case of obviousness based on Lilburn alone or as combined with the other applied references, and therefore, we reverse the grounds of rejection advanced on appeal.

The examiner’s decision is reversed.

Reversed

BRADLEY R. GARRIS Administrative Patent Judge	)	
CHARLES F. WARREN Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
CATHERINE TIMM Administrative Patent Judge	)	

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