

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**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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**Ex parte STEVE MODICA**

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Appeal No. 2005-2569  
Application No. 10/200,828

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ON BRIEF

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Before BARRETT, RUGGIERO, and DIXON, **Administrative Patent Judges**.  
DIXON, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 1-3, 6-12 and 14-20, which are all of the claims pending in this application. The examiner has indicated that claims 4, 5 and 13 would be allowable if rewritten in independent form.

We AFFIRM-IN-PART.

## BACKGROUND

Appellant's invention relates to an external fan and method for exchanging air with modular bricks in a computer system. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A modular computing system comprising:
  - an enclosure;
  - a rack mounted inside the enclosure;
  - a modular brick that includes electronic components, the modular brick being supported by the rack; and
  - a primary fan outside the enclosure, the primary fan exchanging air with the modular brick to cool the electronic components in the modular brick.

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

Bishop et al. (Bishop)	6,535,382	Mar. 18, 2003 (Filed Apr. 12, 2001)
Benavides	6,185,098	Feb. 6, 2001

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the answer (mailed Nov. 29, 2004) for the examiner's reasoning in support of the rejections, and to the brief (filed Sep. 24, 2004) for appellant's arguments thereagainst.

## OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Appellant has argued that the claims should be considered separately and presented arguments to these groupings. Therefore, we will address appellant's groupings as the arguments are set forth in the brief. (Brief at page 5.) After reviewing the examiner's analysis, it is our opinion that the stated position is sufficiently reasonable that we find that the examiner has at least satisfied the burden of presenting a *prima facie* case of obviousness. The burden is, therefore, upon appellant to come forward with evidence and/or arguments which persuasively rebut the examiner's *prima facie* case. Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived (see 37 CFR § 41.37(c)(1)(vii)).

### 35 U.S.C. § 103

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,

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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 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 the 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 999-1000, 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 of independent claim 1. Appellant argues that neither applied reference teaches or suggests a fan outside an enclosure that exchanges air inside the enclosure to cool the modular bricks that contain electronics. The examiner maintains that the fans in Figure 2 of Benavides are outside of the enclosure and that appellant has not

limited the claimed invention to exclude fan assemblies that are mounted to the enclosure. (Answer at pages 4 and 5.) We agree with the examiner.

Appellant argues that the fans of Benavides are “integrated with the top of the cabinet and are part of the enclosure. (Brief at page 7.) We disagree with appellant and find that Figure 2 of Benavides is one embodiment that has these four additional fans attached to the exterior of the enclosure and are separate and distinct from the enclosure. Therefore, this argument is not persuasive. Appellant argues that the examiner has not provided a showing for a motivation to combine the teachings of Bishop and Benavides. (Brief at pages 12-14.) We find that the examiner has set forth a sufficient analysis of the teaching of Bishop which has a lack of detail as to the source of the air flow and that it would have been obvious to one of ordinary skill in the art at the time of the invention look to the teachings of Benavides with respect to the use of fans as oriented therein. Therefore, this argument is not persuasive, and we will sustain the examiner’s *prima facie* case of obviousness of independent claim 1 and dependent claims 2 and 3 which have not been separately argued.

With respect to dependent claims 6 and 8, appellant argues that appellant “cannot find in the cited combination” where the primary fan is part of the floor tile that supports the enclosure of the computing system or where the floor tile includes plural fans. (Brief at pages 8-9.) The examiner maintains that it would have been obvious to

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one of ordinary skill in the art at the time of the invention to have modified the teachings of Benavides in light of the teachings of Bishop with respect to the supply of cooling air from the floor to motivate skilled artisans to move the fans from the top of the enclosure of Benavides to the bottom (we assume into the tile). While we would find the modification to be a reasonable modification, if the fans were relocated to the bottom of the enclosure which is supported or suggested by the teachings of Bishop, we can not agree with the examiner's conclusion that the supporting floor tile would contain the fan or fans. We would agree with the examiner's premise in the rejection that the fans would have then been reversed to push cool air into the enclosure rather than to pull the hot air out of the enclosure. Here, we find no teaching or suggestion that the fans would be removed from the enclosure/rack and placed into the floor support. While we could speculate as to the variations of obtaining and moving cool air through the floor, it would be mere unsupported speculation, which we will not do. Therefore, we agree with appellant that the examiner has not shown in the prior art a teaching or provided a convincing line of reasoning as why it would have been obvious to one of ordinary skill in the art to have placed the fan in the support tile, and we find that the examiner has not established a ***prima facie*** case of obviousness of dependent claims 6 and 8 and claims 7 and 9 which depend therefrom.

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With respect to dependent claim 10, appellant argues that appellant “cannot find in the cited combination” where the primary fan is connected to the modular brick by conduits. (Brief at page 9.) The examiner maintains that Bishop teaches and suggests the use of conduits to supply cooling air to the electronics. (Answer at page 4.) We agree with the examiner that Bishop fairly suggests the use of conduits to supply cooling air from the floor into the enclosure.

With respect to independent claim 11, appellant again argues that the fans of Benavides are not outside the enclosure. (Brief at page 10.) Again, we do not find this argument persuasive as discussed above, and we will sustain the rejection of independent claim 11 and dependent claims 12, 14, 15, and 19 which appellant has not set forth separate arguments for patentability.

With respect to dependent claims 16-18, appellant argues that appellant “cannot find in the cited combination” where the “the primary fan located outside the enclosure to exchange air with the modular brick includes positioning the enclosure above a floor tile that includes the primary fan.” (Brief at page 11.) As discussed above with respect to claim 6, we agree with appellant and do not find that the examiner has established a ***prima facie*** case of obviousness, and we cannot sustain the rejection of claims 16-18.

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With respect to independent claim 20, appellant argues that appellant argues that appellant “can not find [in, sic] the Bishop and/or Benavides” a floor tile supporting the enclosure that includes a plurality of fans. (Brief at page 11.) As discussed above with respect to claims 6 and 16, we agree with appellant and do not find that the examiner has established a *prima facie* case of obviousness, and we cannot sustain the rejection of claim 20.

### **CONCLUSION**

To summarize, the decision of the examiner to reject claims 1-3, 10-12, 14, 15, and 19 under 35 U.S.C. § 103 is affirmed, and the decision of the examiner to reject claims 6-9, 16-18 and 20 under 35 U.S.C. § 103 is reversed.

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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**

LEE E. BARRETT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JOSEPH F. RUGGIERO	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
JOSEPH L. DIXON	)	
Administrative Patent Judge	)	

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