

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* MICHAEL KINALSKI and MARKUS DITZEL
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11 Appeal 2007-4096
12 Application 10/198,545
13 Technology Center 3600
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16 Decided: February 19, 2008
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19 *Before* WILLIAM F. PATE, III, TERRY J. OWENS, and
20 JENNIFER D. BAHR, *Administrative Patent Judges*.

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22 PATE, III, *Administrative Patent Judge*.

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24 DECISION ON APPEAL
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26 STATEMENT OF CASE

27 The Appellants appeal under 35 U.S.C. § 134 (2002) from a Final
28 Rejection of claims 25 to 39. In response to the Final Rejection of
29 September 10, 2004, claims 1 to 24 initially filed with the original disclosure
30 were canceled and new claims 25 to 39 were submitted by the Amendment
31 of November 8, 2004 which was filed together with a Request for Continued

1 Examination. The new claims 25 to 39 were rejected by the Examiner in the
2 Final Rejection of April 21, 2005 and are the subject of the present Appeal.
3 We have jurisdiction under 35 U.S.C. § 6(b) (2002).

4 The Appellant claims a toner dispensing system for refiling a toner
5 cartridge. Independent claim 25 reads as follows:

6 25. A toner dispensing system comprising:
7 at least one toner reservoir;
8 a receptacle for receiving a removable toner cartridge;
9 a controller;
10 a user interface in communication with said controller;
11 a display coupled to said controller; and
12 a feed system adapted to transfer toner from said reservoir to
13 said cartridge in response to said controller.
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15 Independent claim 36 recites a method for refilling a cartridge
16 utilizing a dispensing system including limitations recited in claim 25.

17 The prior art relied upon by the Examiner in rejecting the claims is:

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|----|----------|---------------|---------------|
| 18 | Bradbury | 4,929,818 | May 29, 1990 |
| 19 | Midgley | 5,283,613 | Feb. 1, 1994 |
| 20 | Farrell | 5,461,469 | Oct. 24, 1995 |
| 21 | Serber | 6,233,410 | May 15, 2001 |
| 22 | Brown | 6,578,763 | Jun. 17, 2003 |
| 23 | Matthews | 6,585,009 | Jul. 1, 2003 |
| 24 | Oikawa | JP 409269646A | Oct. 14, 1997 |

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1 The Examiner rejected claims 25, 26 and 29-39 under 35 U.S.C.
2 § 103(a) as unpatentable over Serber, Farrell, Brown, Bradbury, Matthews,
3 and Oikawa.

4 The Examiner also rejected claims 27 and 28 under 35 U.S.C.
5 § 103(a) as unpatentable over Serber, Farrell, Brown, Bradbury, Matthews,
6 and Oikawa in further view of Midgley.

7 We REMAND for further proceedings.

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ISSUES

10 The following issues have been raised in the present appeal.

11 1. Whether the Appellants have shown that the Examiner erred in
12 rejecting claims 25, 26 and 29-39 as unpatentable in view of the cited prior
13 art.

14 2. Whether the Appellants have shown that the Examiner erred in
15 rejecting claims 25, 26 and 29-39 as unpatentable in view of the prior art of
16 record.

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ANALYSIS

19 The Appellants initially argue that the Examiner's rejection of
20 independent claim 25 and claims 26-35 dependent therefrom should be
21 reversed, stating that "the Examiner failed to address the specific elements
22 of claim 25 and to provide specific citations to passages contained in the
23 cited references" (App. Br. 4, ll. 4-5). The Appellants also refer to the
24 Examiner's Final Rejection of April 21, 2005 and the Examiner's Answer to

1 highlight the fact that the limitations addressed by the Examiner are not
2 present in the pending claims, but instead, relate to the previously canceled
3 claims (App. Br. 4, ll. 25-26; App. Br. 5, ll. 14-15; Reply Br. 1, ll. 8-13;
4 Reply Br. 2, ll. 12-15; Reply Br. 2, l. 31-32). The Appellants further argue
5 that the Examiner’s rejection of independent claim 36 and claims 37-39
6 dependent therefrom should be reversed for the same reason as well (App.
7 Br. 6, ll. 19-21; Reply Br. 3, ll. 21-23).

8 In reviewing the record before us, we concur with the Appellants that
9 the claim limitations addressed by the Examiner in the Final Rejection and
10 Examiner’s Answer are not present in the pending claims 26-39, but were
11 recited in the previously canceled claims 1-24. Whereas the prior art
12 references of record are likely to be relevant to the examination of the
13 pending claims 26-39, it is unclear from the record how the teachings and
14 disclosures of the prior art references are being applied by the Examiner to
15 reject the currently pending claims. In this regard, the Examiner is reminded
16 that:

- 17 1. The examination “shall be complete with respect . . . to the
18 patentability of the invention *as claimed* . . .” 37 C.F.R. § 1.104(a)(1)
19 (emphasis added);
- 20 2. “The reasons for any adverse action . . . will be stated in an
21 Office action and such information or references will be given as may
22 be useful in aiding the applicant . . . to judge the propriety of
23 continuing the prosecution” 37 C.F.R. § 1.104(a)(2); and

1 3. “In rejecting claims for want of novelty or for obviousness, the
2 examiner must cite the best references at his or her command. When
3 a reference is complex . . . , the particular part relied on must be
4 designated as nearly as practicable. The pertinence of each reference,
5 if not apparent, must be clearly explained and each rejected claim
6 specified.” 37 C.F.R. § 1.104(c)(2).

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8 Because of the noted deficiencies in the record, it would be
9 speculative for the Board to undertake a review of the substantive rejections
10 in the present Appeal when the bases for the Examiner’s rejections of the
11 pending claims cannot be readily determined.

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ORDER

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In view of the above, we REMAND the case to the Examiner to make
15 additional factual findings and conclusions of law as to:

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1. Whether prior art references Serber, Farrell, Brown, Bradbury,
18 Matthews, and Oikawa render claims 25, 26 and 29-39 unpatentable under
19 35 U.S.C. § 103(a). The factual findings must specifically identify those
20 elements shown in the prior art that are interpreted by the Examiner to
21 correspond to the recited limitations of pending claims 25, 26 and 29-39.
22 The conclusions of law must include explicit analysis with rational
23 underpinnings as to why the rejected claims would have been obvious to one
of ordinary skill in the art in view of the cited prior art.

