

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ZAINUDIN BIN MOHAMED

Appeal 2008-1640
Application 10/452,341
Technology Center 3600

Decided: June 30, 2008

Before JENNIFER D. BAHR, LINDA E. HORNER, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

This application is remanded to the Examiner, pursuant to 37 C.F.R. § 41.50(a)(1), for appropriate action with regard to the following issues.

Zainudin Bin Mohamed (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 19 and 21. Claims 1-18 and

20 have been canceled. We have jurisdiction over this appeal under 35 U.S.C. § 6 (2002).

Claims 19 and 21 stand rejected under 35 U.S.C. §103(a) as unpatentable over Matsuda (US 6,328,169 B1, issued Dec. 11, 2001) in view of Katsuura (US 5,593,046, issued Jan. 14, 1997). Appellant's claimed method includes a number of specific limitations. It is elementary that to support an obviousness rejection all words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). In support of the rejection of claims 19 and 21, the Examiner takes the position that the "primary reference [Matsuda] teaches all of the methods as claimed by the appellant, [except] they do not teach one structural element...namely the type of lock for holding the relative width of the cassette" (Ans. 4). Using the teachings of Katsuura the Examiner concludes that "it would have been obvious to one of ordinary skill in the art, at the time of invention to provide the device taught by Matsuda et al. with a spring actuated lock as taught by Katsuura et al. in order to positively lock the sliding portions in place without having to move a cam to do so" (Ans. 4).

However, we find that the Examiner's rejection fails to identify with any particularity where Matsuda teaches every limitation of the rejected claims. Section 706.02(j) of the Manual of Patent Examining Procedure (8th Edition, Revision 6th) (2007) states that when making a rejection under 35 U.S.C. §103(a), "the Examiner should set forth in the Office action: (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,..." (underlining added).

In describing the teachings of Matsuda the Examiner has not pointed with specificity (column and line number) to the structural elements in Matsuda that correspond to the structural elements of the Appellant's claimed invention (Ans. 3-4).

Further, it is not clear to us which embodiment of Matsuda the Examiner is relying on to support the conclusion of obviousness. For example, the Examiner refers to "adjustable sliding assemblies on the top and bottom" (Ans. 3), which appear to correspond to connecting plates 3 and 4 of the first embodiment in Matsuda (col. 3, ll. 15-24 and fig. 2 of Matsuda). On the other hand, the Examiner also refers to a cam that locks the sliding portions in place (Ans. 4), which appears to correspond to the lock lever 83 with cam surface 84 of the second embodiment in Matsuda (col. 5, ll. 36-48 and fig. 9 of Matsuda).

Furthermore, the Examiner has not explained and has not explicitly pointed to the structural element in Matsuda which is being replaced with the spring actuated lock of Katsuura.

We find that the Examiner does not clearly articulate the basis of the rejection and does not identify the evidentiary basis that supports the conclusion of obviousness. As such, we are unable to resolve the issues presented before us for review without resorting to speculation.

This application is therefore being remanded to the Examiner to clearly state, on the record, the factual basis which led to the conclusion that the Appellant's claims 19 and 21 are unpatentable under 35 U.S.C. §103(a) over the combination of Matsuda in view of Katsuura. In so doing, the Examiner must articulate: (1) which structural elements in Matsuda correspond to the structural elements of the Appellant's claimed invention;

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(2) which embodiment from Matsuda is being relied upon to support the conclusion of obviousness; and (3) which structural element in Matsuda is being replaced with the spring actuated lock of Katsuura.

This remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

REMANDED

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