

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HERBERT BARTHEL,
HORST DAAR and
HARTMUT SCHUETZ

Appeal No. 97-2723
Application 08/320,091¹

ON BRIEF

Before KRASS, JERRY SMITH and RUGGIERO, Administrative Patent
Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134

¹ Application for patent filed October 7, 1994.

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from the examiner's rejection of claims 2-7, which constitute all the claims remaining in the application.

The invention pertains to the redundant control of two modular automation systems.

Representative claim 5 is reproduced as follows:

5. A redundant automation system comprising, two modular automation systems; each comprising:

a central unit;

a plurality of peripheral units;

a device bus coupling said plurality of peripheral units;

a processing module, including,

a processor,

a memory,

device a blockable bus coupling element coupled to said bus,

a blockable central unit coupling element,

a communication interface, and

the and a module bus connecting the processor, the memory, coupling elements and the communication interface;

a communication system coupling the communication interfaces of the processing modules of the respective modular automation systems.

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The examiner relies on the following references:

Dummermuth et al. (Dummermuth)	4,442,504	Apr. 10, 1984
Klug et al. (Klug)	5,226,152	July 06, 1993

Claim 6 stands rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the invention. Claims 2-7 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Dummermuth alone or Dummermuth in view of Klug.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner, the arguments in support of the rejections and the evidence of obviousness relied upon by the examiner as support for the obviousness rejection. We have, likewise, reviewed and taken into

consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that claim 6 does not particularly point out the invention in a manner which complies with 35 U.S.C. § 112. We are also of the view that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 2-7. Accordingly, we affirm-in-part.

We consider first the rejection of claim 6² under the second paragraph of 35 U.S.C. § 112. The examiner's rejection states the following:

As per claim 6, the preamble is
misdescriptive because there is no
operating step in the body of the
claim. Furthermore, the claim appears

² We note that claim 7, which depends from claim 6, has not been included in this rejection. Although this rejection of claim 6 under 35 U.S.C. § 112 would apply equally to claim 7, we limit our consideration to the rejection of claim 6 since that is the only claim rejected on this basis.

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to claim both a method and a system;
therefore, it is vague and indefinite
[answer, page 3].

Appellants argue that claim 6 is clearly a method claim as recited in its preamble. They also argue that a method claim is not improper because it recites system-type claim elements to establish the environment in which the method operates. Finally, appellants assert that claim 6 clearly recites functions being performed, and these functions constitute the method of the claim [brief, page 8].

The general rule is that a claim must set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the disclosure as it would be by the artisan. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed in light of the specification. Seattle Box Co. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984).

To the extent that appellants argue that there is

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nothing inherently indefinite with combining method steps and system elements in a claim, we agree. There are no per se rules of indefiniteness. Each claim must be considered on its own merits. A claim must make it clear, however, what subject matter is encompassed by the claim as well as making clear the subject matter from which others would be precluded. In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970).

Claim 6 purports to be directed to a method, but there is no active, positive step recited within the claim. After reciting a plurality of system components which define the environment of the invention, the "method" is defined by a wherein clause which describes a property of the system components. The scope of a method claimed is measured by the sequence of active, positive steps recited therein. In the absence of any recited steps, we fail to see how a method has been properly defined by claim 6. Therefore, claim 6 does not particularly point out and distinctly claim the invention as required by 35 U.S.C. § 112.

We now consider the rejections under 35 U.S.C. § 103. In rejecting claims under 35 U.S.C. § 103, it is incumbent

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upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24

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USPQ2d 1443, 1444 (Fed. Cir. 1992).

Claims 2-5 have been rejected under Section 103 as unpatentable over Dummermuth taken alone³. Although the examiner admits that there are several features of independent claim 5 which are not explicitly disclosed in Dummermuth, the examiner asserts that the missing features "must be included" in the processing module of Dummermuth [answer, page 3]. The examiner also asserts that it would have been obvious to duplicate the parts of Dummermuth.

Appellants argue that Dummermuth fails to disclose or suggest the redundancy of the elements as recited in the claims as well as the interaction between the processing modules of the redundant systems whereby the processing modules perform synchronization for each other [brief, page 5]. We agree with appellants.

Dummermuth is clearly not a redundant system where

³ Claims 6 and 7 were also rejected on this basis in the final rejection but have not been included in the statement of the rejection in the answer.

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synchronization is even a concern. Although certain modules of Dummermuth can be replicated, the modules are not operated to be in synchronization with each other nor do they communicate with each other to achieve this result. The examiner's per se rule that to make a system redundant is necessarily obvious fails to consider the advantages obtained by the claimed invention when the processing modules are connected in the claimed manner. Thus, there is neither any basis to duplicate the automation system of Dummermuth or to interconnect duplicated processing modules in the claimed manner. Therefore, we do not sustain the rejection of claims 2-5 under 35 U.S.C. § 103.

Claims 6 and 7 have been rejected under Section 103 as unpatentable over Dummermuth in view of Klug. As noted above, the scope of independent claim 6 cannot be properly determined as required by 35 U.S.C. § 112. Prior art rejections cannot be made where the claimed invention can only be based upon speculation and conjecture as to what is being claimed. In re Steele,

305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962).

Therefore,

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we do not sustain the rejection of claims 6 and 7 under 35
U.S.C.

§ 103.

In summary, the rejection of claim 6 under 35 U.S.C.
§ 112 is sustained. The rejection of claims 2-7 under 35
U.S.C. § 103 is not sustained. Accordingly, the decision of
the examiner rejecting claims 2-7 is affirmed-in-part.

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

	ERROL A. KRASS)	
	Administrative Patent Judge)	
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	JERRY SMITH)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
	JOSEPH F. RUGGIERO)	

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Administrative Patent Judge)

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KENYON & KENYON
One Broadway
New York, NY 10004