

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

Paper No. 68

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD K. FOREST

Appeal No. 2000-1901
Application 08/506,032

REMAND

Before THOMAS, JERRY SMITH and LEVY, Administrative Patent Judges.
THOMAS, Administrative Patent Judge.

ORDER VACATING REJECTION

AND REMANDING TO THE EXAMINER

Pursuant to 37 CFR § 1.196(a) and the Manual of Patent Examining Procedure (MPEP) § 1211, this application is remanded to the examiner for appropriate action with respect to the matters discussed below. Because the present rejection of the claims on appeal is considered by us to be not appropriate and not ripe for our review, we VACATE the rejection of the claims on appeal under

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35 U.S.C. § 103 and remand the application in view of the following. Essentially, we have concluded that the examiner has failed to establish a prima facie case of obviousness as to any claim on appeal.

Preliminarily, we note the following. The present application contains a specification of over 130 pages with 67 drawing figures. There are approximately 150 claims on appeal with 39 of these being independent claims. The brief is approximately 200 pages long and appears to argue each claim on appeal. The reply brief is 72 pages. The examiner relies upon seven references to formulate a rejection under 35 U.S.C. § 103, and the answer is over 20 pages.

At page 3 of the answer, the examiner sets forth the rejection under 35 U.S.C. § 103 by relying upon all seven references together to reject each claim on appeal. Beginning at this page of the answer, the examiner has only briefly detailed some features of each of the respective references relied upon. Initially, at least two separate portions of Ito are discussed briefly. Since the examiner considers this first reference as not explicitly disclosing a certain feature, the examiner then relies upon a second, different reference at page 4 of the answer. This practice is repeated again by asserting that the primary reference does not disclose a different feature and a tertiary reference is therefore found

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obvious to combine with the initial reference to Ito. The statement is made at the top of page 5 that the primary reference to Ito "as modified" does not teach certain features, to which the examiner relies upon two additional references, arguing their combinability within 35 U.S.C. § 103. It is not clear to us in each instance in which the examiner uses the term "Ito as modified," what the examiner is referring to that has been previously recited since this terminology is used in multiple locations. The examiner continues with this approach until all of the seven references have been considered together, each separately with Ito.

Beginning at page 6 of the answer, the examiner then considers various combinations of the references relating to particular independent claims. This appears to conflict with the examiner's assertion at page 3 of the answer, which states that all claims are rejected under 35 U.S.C. § 103 as being obvious in view of all seven references relied on. Moreover, the assertions made with respect to each of the seven references at pages 3-6 of the answer fail to set forth any context or claimed feature of any identifiable claim on appeal for which a specific reference is relied upon to meet. The examiner's attempted correlation beginning at page 6 of the answer to respective independent claims fails to assert what is taught in any given reference with respect to what is claimed in any of these

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independent claims, what is not taught in the reference or references relied on that is claimed, and then what is taught or suggested with respect to each of the additional references relied upon that is set forth in each of these independent claims. The combinability of the references has not been stated with respect to any feature claimed.

The examiner has essentially only set forth a broad-brush approach to reject the claims on appeal. Stated differently, each claim limitation of each independent claim on appeal has not been respectively mapped to each of the reference's teachings and/or showings in the drawings in a detailed manner. Thus, the examiner has not fully explained the rationale for the rejection under 35 U.S.C. § 103 for each of the independent claims on appeal. Following this approach, it is apparent to us that the examiner has not set forth a prima facie case of obviousness for each of the independent claims on appeal.

At page 7 of the answer the examiner makes reference to the dependent claims indicating "they are also rejected for the same reasons as set forth in the rejection above." There is no detailed discussion of the features recited in each of the noted dependent claims with respect to any of the references relied upon as a basis to reject them. Moreover, the examiner has stated at page 8 of the

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answer that "[s]ince appellant has [sic, an] unreasonable number of claims in the file, it is a burden on the examiner to address all single claims, but the examiner has attempted to address all the independent claims." The examiner's "attempt" to address all the independent claims has, as noted above, been found to not set forth a prima facie case of obviousness within 35 U.S.C. § 103.

Similarly, it is apparent that, because of the number of claims on appeal, the examiner has not addressed all the dependent claims because "it is a burden on the examiner to address all single claims." We therefore conclude that the examiner has failed to set forth a prima facie case of obviousness as to all the dependent claims on appeal as well.

The examiner is free to reinstitute any rejections under 35 U.S.C. § 103 on the basis of the presently applied or any new, different prior art. In any event, for each reference relied on in each rejection, the PTO's policy is for the examiner to compare the rejected claims feature-by-feature or limitation-by-limitation with each of the references relied upon in the rejection. This comparison should map the language of the claims to the specific page number, column number, line number, drawing number, drawing reference number, and/or quotation from each

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reference relied upon. Note MPEP § 706.02(j) and MPEP § 1208 for the correct methodologies.

It is not the Board's burden or the burden of any panel of this Board to initially assert and to even formulate the details of a prima facie case of obviousness within 35 U.S.C. 103. This burden of proof rests solely upon the examiner. Note, e.g., In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

The examiner may choose to first avail himself or herself of the provisions of 37 CFR § 1.75(b) and the discussion thereof within MPEP § 2173.05(n) as to the examiner's characterization at page 8 of the answer that there are an "unreasonable number of claims in the file." As noted in subsection (b) of 37 CFR § 1.75, the claims must differ substantially from each other AND not be unduly multiplied. To the extent the examiner may determine that the claims do not differ substantially from each other, then they are in inherently unduly multiplied and not in compliance with this rule. The analysis as to this rule proceeds by first comparing each independent claim for relative compliance with this rule, then to a corresponding comparison of the dependent claims.

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In summary, the present rejection of all claims on appeal under 35 U.S.C. § 103 is VACATED. Additionally, this application is remanded to the examiner for further action consistent with the foregoing.

VACATED AND REMANDED

James D. Thomas)	
Administrative Patent Judge)	
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Jerry Smith)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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