

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(2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte NICHOLAS T. CHEESEBROW,  
SHAWN D. EGGUM, ROBERT D. KOS  
and RANDY S. WILLIAMS

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Appeal No. 96-3964  
Application 08/225,228<sup>1</sup>

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ON BRIEF

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Before HAIRSTON, KRASS, and RUGGIERO, Administrative Patent  
Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of  
claims 10-20, which constituted all the claims remaining in  
the application. Claims 1-9 were canceled earlier in the

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<sup>1</sup> Application for patent filed April 8, 1994.

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prosecution. An amendment after final rejection was filed on February 1, 1996 which was entered by the Examiner. This amendment canceled claims 17-20. Accordingly, this appeal now involves only claims 10-16.

The claimed invention relates to a disk carrier having a molded body with two pairs of opposing walls for carrying a plurality of wafers. A wall portion of one of the walls includes a recess extending from an edge into the wall portion into which a radio frequency transponder having a readable identification code is inserted. The recess is positioned intermediate the interiorly facing surface and the exteriorly facing surface of the wall portion.

Representative claim 10 is reproduced as follows:

10. A disk carrier for carrying a plurality of wafers, the carrier comprising:

a molded body having two pairs of opposing walls, the pairs of opposing walls joined together to form a generally rectangular body defining an interior, the body having a plurality of interiorly facing channels for receiving wafers in the interior, one of the walls having an integral wall portion with an inwardly facing surface, an opposite exteriorly facing surface, and an edge extending from the interiorly facing surface to the exteriorly facing surface, the wall portion further having a recess extending from the edge into the wall portion, the recess positioned intermediate the interiorly facing surface and the exteriorly facing surface;

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a radio frequency transponder inserted in the elongate recess, the transponder having a unique identification code readable with an external reader unit; and

a cover inserted in the recess for sealably enclosing the transponder within said recess the cover meeting the wall portion at a junction, the recess being elongate into the wall portion whereby the size of the junction is minimized.

The Examiner relies on the following references:

Olsen 1921	1,372,036	Mar. 22,
Hesser 1986	4,588,880	May 13,
Rossi et al. (Rossi) 1989	4,888,473	Dec. 19,

Claims 10-13, 15, and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Rossi in view of Olsen. Claim 14 stands rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Rossi in view of Olsen and Hesser.

We note that the Examiner has included claim 17 in the statement of the grounds of rejection on page 3 of the Answer. From the record before us, however, claim 17 was canceled in an amendment after final rejection as noted above.

Rather than reiterate the arguments of Appellants and the

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Examiner, reference is made to the Briefs<sup>2</sup> and Answer for the respective details thereof.

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<sup>2</sup> The (revised) Appeal Brief was filed May 13, 1996. In response to the Examiner's Answer dated June 11, 1996, a Reply Brief was filed August 7, 1996 which was acknowledged and entered by the Examiner without further comment on September 4, 1996.

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OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, 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 the collective 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 10-16. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent 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

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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.

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

Appellants, at page 3 of the Brief, have identified two sets of claims (i.e. claims 10-16 directed to a disk carrier and claims 17-20 directed to a system for monitoring batches of disks) which do not stand or fall together. Implicit in Appellants' statement of the grouping of claims is that the claims within each set do stand or fall together. As pointed out previously, however, claims 17-20 have been canceled leaving only the set of claims 10-16 directed to the disk carrier on appeal. Consistent with this indication, Appellants have made no separate arguments with respect to any of the claims on appeal. Accordingly, all the claims before us will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

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Therefore, we will consider the rejection against independent claim 10 as representative of all the claims on appeal.

With respect to the rejection of representative claim 10 as unpatentable over the combination of Rossi and Olsen, Appellants assert (Brief, pages 4 and 5) a lack of suggestion or motivation in the references for combining or modifying teachings to establish a prima facie case of obviousness. The Examiner has responded (Answer, pages 4 and 8) with a reference to column 4, lines 50-55 of Rossi which states:

Thus, when the transponder tag is described herein as "attached" to the carrier, it is meant to include any method of attachment which will allow the transponder tag to be securely associated with a particular carrier so that it may be used in this manner.

The Examiner asserts the obviousness of the combination of Rossi and Olsen at page 5 of the Answer which states:

It will be apparent that some methods of attachment would not be obvious under 35 U.S.C. § 103, despite Rossi's stated intention to "include any method of attachment", but the structural attachment of the instant claims is sufficiently close to Rossi's alternatives and Olsen's disclosure to be considered obvious to one of ordinary skill in the art.

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After careful review of the Rossi and Olsen references, we are in agreement with Appellants' stated position in the Brief. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F. 2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). In the present instance, although Olsen does teach a device with an elongated recess extending from an edge into a wall portion, the invention is for use in identifying stolen automobiles. We fail to see how the Olsen device which is designed for paper identification tag insertion would have relevance to the radio frequency tracking system for wafer carriers of Rossi. None of the problems sought to be overcome by Olsen would be expected to exist in the wafer carrier system of Rossi. We are left to speculate why the skilled artisan would employ the elongated recess feature of Olsen in the recited position in Rossi. The only reason we can discern is improper hindsight reconstruction of Appellants' claimed invention. As to the "sufficiently close" argument articulated by the Examiner, we

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are unaware of any such legal

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standard of obviousness and the Examiner has provided no support for such position.

For the reasons discussed above, the rejection of claims 10-13, 15, and 16 as unpatentable over Rossi and Olsen is not sustained.

With respect to the rejection of claim 14 as unpatentable over the combination of Rossi, Olsen, and Hesser, we note that claim 14 is dependent on independent claim 10 and incorporates all the limitations of claim 10 just discussed. Hesser was cited solely to meet the programmable feature of the claimed transponder but does not overcome the innate deficiencies of the combination of Rossi and Olsen. Therefore, we do not sustain the rejection of claim 14 for the reasons discussed above.

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In summary, the decision of the Examiner rejecting  
claims 10-16 is reversed.

REVERSED

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
ERROL A. KRASS	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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	)	
JOSEPH F. RUGGIERO	)	
Administrative Patent Judge	)	

JFR:svt

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