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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte ROBERT D. DANNENBERG

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Appeal No. 1997-1783
Application No. 08/421,016[1]

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HEARD: December 6, 1999

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Before HAIRSTON, BARRETT, and DIXON, **Administrative Patent Judges**.

DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-8, which are all of the claims pending in this application.

We REVERSE.

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[1] Application for patent filed April 12, 1995. According to appellant, this application is a continuation of serial number 08/130,038, filed September 30, 1993.

BACKGROUND

The appellant's invention relates to a system for programming response speed of electronically-controlled gauges wherein a single type of gauge can be used for various applications with varied needle responsiveness. An understanding of the invention can be derived from a reading of exemplary claim 1[2], which is reproduced below.

1. In a microprocessor-based instrument gauge, comprising;

A) an instrument gauge having an electromechanical movement;

B) a microprocessor comprising,

i) input means for receiving data,
ii) memory means for storing data,
iii) processing means for processing data,
iv) and output means for delivering processed data;

C) means supplying gauge programming data to said input means and means supplying gauge signal data to said input means;

D) said memory means storing gauge programming data that is used by said processing means to create gauge movement data at said output means;

E) gauge movement drive circuit means operatively coupling said output means with said gauge movement for causing said gauge movement to be operated by said gauge movement data;

[2] We note that clause (A) of claim 1 is not present in the amendment filed Feb. 14, 1995 (Paper no. 7), which was entered by preliminary amendment in the continuation application. This appears to be a clerical oversight, therefore we have included the limitation in our consideration.

F) said microprocessor being configured to store as gauge programming data, one or more various parameters relevant to operation of the gauge movement; the improvement which comprises:

G) said means supplying gauge programming data to said input means comprising means supplying to said input means movement speed data defining speed at which the gauge movement is to move when the microprocessor acts on gauge signal data commanding a change in the position of the gauge movement;

H) said microprocessor memory means comprising an EEprom that is programmed from said means supplying gauge programming data for erasably storing as one of said various parameters, the movement speed data supplied to said input means; and

I) said processing means acting on the movement speed data stored in said EEprom of said memory means to create gauge movement data at said output means for causing the gauge movement to move at speed determined by the stored movement speed data when said processing means acts on gauge signal data commanding a change in position of the gauge movement.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Dannenberg	4,875,041	Oct. 17, 1989
Luitje	4,939,675	Jul. 03, 1990

Computer Dictionary, second edition, Microsoft Press, Redmond, WA (1994).

Claims 1-8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dannenberg in view of Luitje, further in view of Computer Dictionary.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 20, mailed Aug. 7, 1996) and the letter (Paper No. 23, mailed Dec. 17, 1996) for the examiner's reasoning in support of the rejections, and to the appellant's brief (Paper No. 19, filed Jul. 22, 1996) and reply brief (Paper No. 22, filed Oct. 15, 1996) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Appellant presents various points of argument throughout the brief and reply brief and the examiner provides similar arguments in response. We find the major points of appellant's arguments which need be addressed span pages 2-3 of the reply brief. Appellant argues that:

> The Examiner seemingly fails to appreciate that the update rate is simply one factor of the Luitje Delta Equation algorithm that defines the gauge speed of movement. In contrast, Applicant's [claimed] invention programs that actual speed at which a gauge is to move as a programming input, and therefore does not have to rely on repeated execution of an algorithm, as Luitje does, to define the gauge speed each time that the gauge is to move. Once programmed, Applicant's [claimed] invention uses the same speed of gauge movement each time the gauge is to move, **regardless of the distance to be moved**. (emphasis in original)

We agree with appellant. Elements (G), (H) and (I) of claim 1 are neither taught nor suggested by the prior art. Appellant admits that elements (A)-(F) are taught by their own prior art patent to Dannenberg and have framed the claim in Jepson format to show the improvement over the prior art device. We agree with appellant.

Appellant further argues that the inclusion of an EEPROM into the combination of Dannenberg and Luitje would not have been obvious as maintained by the examiner to replace the firmware taught by Luitje. (See brief at pages 12.) We agree with appellant. We find that the examiner has not provided a convincing line of reasoning why it would have been obvious to one of ordinary skill in the art at the time of the invention to replace the firmware of Luitje with an EEPROM which is reprogrammable. The examiner has not provided a motivation for such a substitution/modification of the

programming and we find no suggestion in Luitje, Dannenberg or the definition of EEPROM. We agree with appellant that the examiner is combining these teachings using improper hindsight reconstruction. Moreover, even if the proposed combination were properly combined, the combination still does not teach or suggest the invention set forth in the language of claim 1.

As pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." ***In re Hiniker Co.***, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). We find that the examiner has not provided a teaching or convincing line of reasoning why one skilled in the art would have desired to have the program input to the erasable storage and to store the "movement speed data defining speed at which the gauge movement is to move when the microprocessor acts on gauge signal data commanding a change in the position of the gauge movement" (See claim 1, paragraph (G).) (See brief at pages 9-11.) Appellant argues that the DELTA calculation in Luitje is different from the operation of the claimed invention and that the update rate of Luitje is not the movement speed of the gauge. **Id**. We agree with appellant.

"To reject claims in an application under section 103, an examiner must show an unrebutted prima facie case of obviousness. **See In re Deuel**, 51 F.3d 1552, 1557, 34

USPQ2d 1210, 1214 (Fed. Cir. 1995). In the absence of a proper prima facie case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. **See In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness." **In re Rouffet**, 149 F.3d 1350, 1355, 47 USPQ2d 1453 (CAFC 1998). Here, we find that appellant has over- come the ***prima facie*** case of obviousness by showing insufficient evidence by the examiner of nonobviousness. Therefore, we will not sustain the rejection of claim 1 nor its dependent claims 2 and 3.

Similarly, independent claims 4 and 7 contain language to the programming and storage of movement speed data defining speed at which the gauge movement is to move when the microprocessor acts on gauge signal data commanding a change in the position of the gauge movement. Therefore, we will not sustain the rejection of claims 4 and 7 and their dependent claims 5, 6, and 8.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-8 under 35 U.S.C. § 103 is reversed.

REVERSED

KENNETH W. HAIRSTON Administrative Patent Judge	)
LEE E. BARRETT Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
JOSEPH L. DIXON Administrative Patent Judge	)

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