

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HELMUT WELLNHOFER AND REINHOLD DIRNBERGER

Appeal No. 96-3356
Application 08/235,668¹

ON BRIEF

Before, THOMAS, RUGGIERO and DIXON, **Administrative Patent Judges.**

DIXON, **Administrative Patent Judge.**

REMAND TO THE EXAMINER

Our consideration of the record in this application leads us to conclude that this case is not in condition for a decision on appeal at this time. Accordingly, we remand the application pursuant to 37 CFR § 1.196(a) and MPEP 1211 to the Examiner to consider the following issues and to take appropriate action.

Representative Claim

¹Application for patent filed April 29, 1994.

Claim 1 is a representative of the claimed subject matter and reads as follows:

1. In a method for forming an actuating variable to be output periodically by a control unit in output periods for controlling an apparatus, which includes reading output signals of at least two sensors into the control unit and ascertaining individual components of the actuating variable based on the output signals, the improvement which comprises:

reading in the sensor output signals and determining the individual components periodically at intervals of one read-in period or one determination period being equal to or a multiple of the output period of the actuating variable;

adjusting the read-in period of a sensor output signal to be dependent on a speed of variation of the sensor output signal;

adjusting the determination period of each individual component to be dependent on the read-in periods of the sensor output signals involved in each individual component; and

forming the actuating variable in each output period from all of the individual components with values being valid in that output period.

Reference Relied Upon by the Examiner

Hartford et al. (Hartford) 4,255,789 Mar. 10, 1981

Claims 1-5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hartford.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and

the appellants, we make reference to the brief² and answer³ for the details thereto.

Discussion

The Examiner maintained one ground of rejection in the Examiner's Answer. The Examiner rejects claims 1 - 5 under 35 U.S.C. § 103 as unpatentable over Hartford.

The rejection of claims 1-5 spans pages 3-6 of the Examiner's Answer. Notably lacking from the statement of the rejection is an explanation as to how the reference relied upon would have rendered obvious the subject matter of any single claim of the group of claims rejected. For example, the rejection of claim 1 spans pages 3-5 of the Answer and contains only 7 citations to the Hartford reference. The reference applied against the claims contains 216 figures and 326 columns of disclosure. Moreover, the citation to column 311 of Hartford is cited for the proposition that the program is easily modified, but it is readily apparent that this statement intends to instruct skilled artisans that the disclosed methodology may be programmed in any number of equivalent manners and program languages. The Examiner references "step a" and Step "d" in

² Appellants filed an appeal brief, December 18, 1995, (Paper No. 14). We will refer to this appeal brief as simply the brief. Appellants filed a reply brief, June 10, 1996, (Paper No. 16). We will refer to this appeal brief as simply the reply.

³ The Examiner responded to the brief with an Examiner's Answer mailed April 5, 1996, (Paper No. 15). We will refer to this Examiner's answer as simply the answer. The reply brief was noted in a paper mailed July 30, 1996, (Paper No. 17) indicating that no further response was required.

the rejection, but none are found in the claims. The Examiner has not adequately set forth the relevant portions of the disclosure nor provided a clear application of the teachings of the reference to the language of the claim.

There is no explanation as to how Hartford by itself would have rendered the subject matter of any one of the claims rejected obvious under 35 U.S.C. § 103. The Examiner merely states it would have been obvious to one of ordinary skill in the art at the time of the invention to adjust the periods and then cites to col. 12, lines 29-40, which disclose the actuating variables to be disclosed. Furthermore, the statement of the rejection does not clearly address all of the substantive limitations of the claims. For example, claim 1 requires "forming the actuating variable in each output period from all of the individual components with values being valid in that output period." The Examiner has not clearly addressed this limitation.

Beginning at page 10 of the brief, appellants begin the argument section of the brief. The Argument section consists essentially of an analysis of the system of Hartford as it differs from the disclosed invention. Appellants at no point in the brief present arguments directed to the language of the claimed invention. At page 12

second paragraph, appellants state "[t]he claimed invention thus has the advantage that a substantially reduced number of calculations are performed per output period." The

claim language does not explicitly recite calculating nor set forth a clear basis upon which to determine the number of calculation made by the system. Appellants argue that "every actuating variable . . . [is] updated on the basis of the most quickly varying sensor signals." (See brief at page 12, paragraph 2.) Appellants do not explain this advantage with respect to the claimed invention or explain how the language of the claim achieves this desired result. Pages 13-16 of the brief again states "[i]n returning to the claimed invention . . ." and then again discusses the disclosed invention and then discusses the invention by way of example without discussing how the language of the claimed invention achieves the asserted differences. Assuming that the Examiner has set forth a *prima facie* case, Appellants have not provided rebuttal in the brief. In the reply brief, appellants dispute the citations to the applied reference added by the Examiner in the answer, but still does not provide argument to the language of the claimed invention upon which we may decide whether the Examiner presented a prima facie case of obviousness. The Examiner summarily noted the reply brief and entered it into the file and forwarded the case to the Board of Patent Appeals and Interferences without comment/clarification as to the citations.

Upon return of the application, the Examiner is expected to review the merits of this rejection and clarify the Examiner's position as to why each claim included in the

Appeal No. 96-3356
Application 08/235,668

rejection is unpatentable under this section of the statute. In so doing, we suggest the Examiner use the model set forth in the Manual of Patent Examining Procedure (MPEP)

§§ 706.02(j); 1208 TOPIC "A" (7th edition, July 1998), in rewriting the rejection under 35 U.S.C. § 103. Adherence to this model would result in a more coherent, understandable statement of the rejection.

We do not remand this case lightly. We understand that this application has been pending in the Patent and Trademark Office and at this Board for a relatively long length of time. However, the unfocused application of a very lengthy applied reference to the claimed invention obfuscates the relevance of Hartford in determining the patentability of at least claim 1. We emphasize that we have not taken a position on the merits of the matter. However, as set forth above, the significance of Hartford in determining the patentability of claims such as claim 1 on appeal has not been fully explained and appreciated by the Examiner and appellants. The Examiner and appellants are expected to focus on how the language of the claimed invention does or does not distinguish over the prior art of Hartford.

This application, by virtue of its "special" status, requires an immediate action. MPEP § 708.01(d). It is important that the Board be informed promptly of any action

Appeal No. 96-3356
Application 08/235,668

affecting the appeal in this case.

REMAND

JAMES D. THOMAS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
JOSEPH L. DIXON)	
Administrative Patent Judge)	

vsh

Appeal No. 96-3356
Application 08/235,668

LERNER & GREENBERG
P.O. BOX 2480
HOLLYWOOD , FL 33022-2480