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for publication and is not binding precedent of the Board.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.19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRITZ HOSEL

Appeal No. 2004-0664
Application 09/756,683

ON BRIEF

Before STAAB, McQUADE and NASE, Administrative Patent Judges,

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Fritz Hosel appeals from the final rejection of claims 1 through 14, all of the claims pending in the application.

THE INVENTION

The invention relates to "a method and an apparatus for examining a fiber web advanced in a fiber processing machine such as a card or a roller card unit" (specification, page 1). Representative claims 1 and 2 read as follows:

1. An apparatus for evaluating a fiber web running in a card, comprising:

    (a) a camera for scanning the fiber web along a length and width portion thereof to detect useful fibers and empty locations in the fiber web and to generate signals representing the useful fibers and empty locations; and

    (b) evaluating means connected to said camera for determining a distribution of useful fibers per area unit in the fiber web from signals.

2. A method of evaluating a fiber web running in a card, comprising the following steps:

    (a) scanning with a camera the fiber web along a length and width portion thereof;

    (b) detecting useful fibers and empty location in the fiber web by the camera;

    (c) generating signals representing the useful fibers and empty locations;

    (d) applying the signals to an evaluating device connected to the camera; and

    (e) determining, by the evaluating device, a distribution of useful fibers per area unit in the fiber web from the signals.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Shofner et al. (Shofner)	5,544,090	Aug. 6, 1996
Leifeld	5,692,267	Dec. 2, 1997

THE REJECTIONS

Claims 1 through 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Leifeld.

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Shofner.

Attention is directed to the main and reply briefs (Paper Nos. 13 and 16) and to the answer (Paper No. 15) for the respective positions of the appellant and the examiner regarding the merits of these rejections.[1]

DISCUSSION

I. Preliminary matter

The appellant raises as a issue in the appeal the decision of the examiner to make the Office action appealed from "final" (see pages 10 and 11 in the main brief). As this issue is not directly connected with the merits of any rejection of claims, it is

[1] In the final rejection (Paper No. 10), the statement of the rejection of claims 13 and 14 refers to Leifeld and U.S. Patent No. 5,014,395 to Staheli et al. (Staheli). The examiner has since indicated (see page 16 in the answer) that the citation of Staheli was accidental and that Staheli is not in fact relied on to support the rejection.

reviewable by petition to the Director rather than by appeal to this Board (see In re Hengehold, 440 F.2d 1395, 1403-1404, 169 USPQ 473, 479 (CCPA 1971)), and hence will not be further addressed in this decision.

II. The 35 U.S.C. § 103(a) rejection of claims 1 through 14 as being unpatentable over Leifeld

Leifeld discloses "an apparatus associated with a carding machine, for recognizing foreign bodies, particularly trash particles, neps, seed coat fragments and the like in a textile material such as cotton or chemical fibers" (column 1, lines 14 through 17). The apparatus comprises a video camera 18 for viewing the web 16 and an on-line measuring system, which includes a computer 30, in communication with the camera for recognizing and evaluating trash, seed coat fragments and neps according to their number, type and size (see column 4, line 39, through column 5, line 50).

The examiner (see pages 4 and 8 in the answer) concedes that the Leifeld apparatus and the manner in which it operates do not meet the limitation in independent claim 1 requiring an evaluating means for determining a distribution of useful fibers per area unit in the fiber web or the corresponding limitation in independent claim 2 requiring the step of determining by the evaluating device a distribution of useful fibers per area unit in the fiber web. The rationale advanced by the examiner to cure these shortcomings (see pages 4 through 10 in the answer) stems from an impermissible hindsight reconstruction of the claimed invention having no

factual support in the fair teachings of Leifeld. Indeed, the examiner's threshold finding that Leifeld meets the limitations in claims 1 and 2 relating to the detection of useful fibers and empty locations in the web and the generation of signals representative thereof also lacks evidentiary support. Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id. In the present case, the examiner's position is rife with speculation and unfounded assumptions as to both the teachings of Leifeld and the suggestions that one of ordinary skill in the art would have derived therefrom.

Thus, Leifeld does not provide the evidentiary basis necessary to conclude that the differences between the subject matter recited in claims 1 and 2 and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of independent claims 1 and 2, and dependent claims 3 through 14, as being unpatentable over Leifeld.

III. The 35 U.S.C. § 103(a) rejection of claim 1 as being unpatentable over Shofner

Shofner discloses a web evaluation apparatus and method which are similar in many respects to those disclosed by Leifeld. In Shofner's words:

> an apparatus is provided for monitoring and processing a web of textile materials, such as cotton being processed in a textile mill. The web includes a plurality of entities such as cotton fibers, neps, leaf trash, seed coat fragments, and other foreign matter. The web is monitored by an optical imaging unit, such as a video camera, and a monitor signal is produced containing information corresponding to the content of the web, including the location of entities in the web. A computer receives the monitor signal and determines the position of the entities based on the location information and generates control signals based on the determined positions. Web processing means receives the control signals and processes the web in response thereto for reducing the amount of entities contained in the web [column 2, lines 8 through 20].

As was the case with Leifeld, the examiner (see page 7 in the answer) concedes that the Shofner apparatus does not meet the limitation in independent claim 1 requiring an evaluating means for determining a distribution of useful fibers per area unit in the fiber web. The rationale offered by the examiner to cure this shortcoming (see page 7 in the answer) is identical to that presented with respect to Leifeld and suffers the same flaws, starting with an unsupported finding that Shofner meets the limitation in claim 1 relating to the detection of useful fibers and empty locations in the web and the generation of signals representative thereof.

Consequently, we also shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 1 as being unpatentable over Shofner.

SUMMARY

The decision of the examiner to reject claims 1 through 14 is reversed.

REVERSED

Lawrence J. Staab Administrative Patent Judge	))))) BOARD OF PATENT
John P. McQuade Administrative Patent Judge	)) APPEALS AND)) INTERFERENCES
Jeffrey V. Nase Administrative Patent Judge	))))

JPM/jlb

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