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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DIETER H. SCHMIDT, MARK T. BEASLEY, and
SCOTT MABS

Appeal 2012-005120
Application 10/156,131
Technology Center 2600

Before BIBHU R. MOHANTY, MICHAEL C. ASTORINO, and
KEVIN W. CHERRY, *Administrative Patent Judges*.

CHERRY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE¹

Dieter H. Schmidt, Mart T. Beasley, and Scott Mabs (Appellants) seek review under 35 U.S.C. § 134 of a final rejection of claims 1-7, 9, 10, and 19², the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

Appellants' claimed invention relates to a method and apparatus for paperless recording of information such as data for critical control points in continuous and batch (discontinuous) product processes (Spec., p. 1).

Claim 1, which is reproduced below, is exemplary.

1. An electronic recorder for paperless recording and retrieving data and other information related to a product process, said electronic recorder being configured to perform multiple functions selected from a group consisting of: functions related to setting up said electronic recorder; and functions related to operating said electronic recorder, said electronic recorder comprising:

a paperless data storage medium; and

a processor with an electronic central processing unit, said processor being configured to receive, store and retrieve data and other information related to the process, further configured to record the data and other information on said paperless data storage medium, and further configured to record an electronic signature on said paperless data storage medium in association with at least a portion of the data and other information, wherein:

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.") filed July 14, 2011, and Reply Brief ("Reply Br.") filed January 3, 2012, and the Examiner's Answer ("Ans.") mailed November 3, 2011, and Final Rejection ("Final Rej.") mailed December 21, 2010.

² Claims 8, 11, 12, and 18 were cancelled, and claims 13-17 and 20-23 are withdrawn from consideration (App. Br. 2, Ans. 3).

said paperless data storage medium comprises a main memory and a replaceable flash memory accessible to said electronic central processing unit for electronically storing information relating to the process, said flash memory being prevented from unauthorized removal from the recorder by a sealing cover; and

said electronic recorder is further configured to provide an access control which identifies a recorder operator with reference to a unique user ID-password combination assigned to said recorder operator and which limits operator access to specific recorder functions selected from said multiple functions depending on said user ID-password combination of said recorder operator, and which recognizes and records operator's access to the electronic recorder.

(App. Br. 8-9, Clms. App'x).

The following rejections are before us on review:

(1) Claims 1-7, 9, and 19 stand rejected as unpatentable under 35 U.S.C. § 103(a) over Silvester (US 2002/0069358 A1, pub. June 6, 2002), Tsuchiya (JP2001-066159 A, pub. Mar. 16, 2001) and Gilpin (US 5,554,822, iss. Sept. 10, 1996); and

(2) Claim 10 stands rejected as unpatentable under 35 U.S.C. § 103(a) over Tsuchiya and Gilpin.

We AFFIRM.

FINDINGS OF FACT

We find the findings of fact in the Analysis section below are supported at least by a preponderance of the evidence.³

³ See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

ANALYSIS

Appellants argue that based on a Declaration they submitted on October 4, 2010 under 37 C.F.R. § 1.131 (“Declaration”) that they have “defeat[ed] the Tsuchiya reference and accordingly the noted two final rejections” (App. Br. 7).⁴ The Declaration is signed by Appellants’ counsel and provides the date of the publication of Tsuchiya (March 16, 2001) and the date of the filing of the provisional patent application to which the current application claims priority (May 30, 2001) (App. Br. Evidence App’x, Declaration Pursuant to 37 C.F.R. § 1.131, dated Oct. 4, 2010 (“Declaration”) ¶ 2-3). The Declaration also notes that certain claims in the provisional application correspond to certain claims in the pending application (*Id.* ¶ 4). Finally, the Declaration provides that:

5) The noted provisional application also includes as an enclosure Appendix A which bears the date of December 13, 1999, and identifies one of the co-inventors, Mr. Mark T. Beasley. The noted Appendix includes drawings and some text which can be found in the noted application. It is accordingly believed that the noted Appendix should support the noted claims.

(*Id.* ¶ 5). In their Appeal Brief, Appellants further clarify that they are not relying on the filing date of the provisional application, but rather on the date of Appendix A, which was submitted with the provisional application (App. Br. 6). Thus, Appellants conclude that this establishes that their invention antedates the March 16, 2001 publication date of Tsuchiya and removes Tsuchiya as prior art (App. Br. 7).

⁴ In the Answer, the Examiner asserted that the Declaration was untimely because it was “presented only after the final rejection” (Ans. 12). However, this is incorrect because it was addressed in the Final Rejection, dated December 21, 2010.

We are not persuaded that the Examiner erred in finding the Declaration insufficient to antedate Tsuchiya. To antedate a reference based on a declaration under 37 C.F.R. § 1.131, the showing of facts shall be such, in character and weight, as to establish (1) reduction to practice prior to the effective date of the reference, or (2) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. 37 C.F.R. § 1.131(b).

Here, Appellants' Declaration is insufficient to meet either of the prongs of 37 C.F.R. § 1.131(b). Appellants' Declaration does not use the words conception, reduction to practice, or diligence, or any explanation resembling them, but merely points to Appendix A of the provisional patent application and states that it "bears a date of December 13, 1999, and identifies one of the co-inventors, Mr. Mark T. Beasley" (Declaration ¶ 5). However, there is no explanation of what the document in Appendix A is; whether it purports to establish conception or actual reduction to practice; what diligence, if any, the inventors can show in reducing the invention to practice; and how it discloses the claimed invention. Instead, the Declaration contains only the most general and vague statements about what the document shows. We further note that the document identified as "Appendix A" is actually entitled "Appendix Documents" and appears to be a conglomeration of several different documents. Thus, it is unclear, without some explanation, how these different documents, one of which bears one of the named inventors' names and the other which bears the December 13, 1999 date are related. As such, the Declaration fails to even provide any facts or evidence needed to establish conception or reduction to

practice and it is not sufficient to antedate Tsuchiya. *See In re Borokowski*, 505 F.2d 713, 718 (CCPA 1974) (“The affidavits for the most part consist of vague and general statements in the broadest terms as to what the exhibits show along with the assertion that the exhibits describe a reduction to practice. This amounts essentially to mere pleading, unsupported by proof or showing of facts.”) (citing *In re Harry*, 333 F.2d 920 (CCPA 1964)).

In their Appeal Brief, Appellants do not contest the Examiner’s findings that the alleged limitations found in the preamble of claim 1 are satisfied by Paragraphs [0001] and [0028] of Silvester (*see* App. Br. 6-7). For the first time in this appeal, Appellants argue in their Reply Brief that these findings are erroneous (Reply Br. 2). However, Appellants fail to explain why this new argument was not presented in their Appeal Brief.

Under regulations governing appeals to the Board, any new argument (or evidence) not timely presented in the Appeal Brief will not be considered when filed in a Reply Brief, absent a showing of good cause explaining why the argument (or evidence) could not have been presented in the Appeal Brief. *See* 37 C.F.R. § 41.37 and § 41.41; *see also Ex parte Borden*, 93 USPQ2d 1473, 1474-77 (BPAI 2010) (informative). Appellants have provided this record with no such showing. Accordingly, we will not consider this new argument first raised in the Reply Brief.

Accordingly, we sustain the Examiner’s rejection of claims 1-7, 9, 10, and 19.

Appeal 2012-005120
Application 10/156,131

CONCLUSIONS OF LAW

The rejection of claims 1-7, 9, and 19 under 35 U.S.C. § 103(a) as unpatentable over Silvester, Tsuchiya, and Gilpin is not in error.

The rejection of claim 10 under 35 U.S.C. § 103(a) as unpatentable over Tsuchiya and Gilpin is not in error.

DECISION

The rejection of claims 1-7, 9, 10, and 19 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2011).

AFFIRMED

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