

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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM T. SAUNDERS et al.

Appeal No. 2000-0874
Application No. 08/695,554

ON BRIEF¹

Before ABRAMS, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 26 to 30, added subsequent to the final rejection. These claims constitute all of the claims pending in this application.

We REVERSE.

¹ On January 31, 2001, the appellants waived the oral hearing (see Paper No. 22) scheduled for March 8, 2001.

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BACKGROUND

The appellants' invention relates to methods and apparatus for fabricating sidewall elongated one-piece can bodies from flat-rolled sheet metal (specification, p. 2). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

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

Maeder et al. (Maeder)	4,289,014	Sep. 15, 1981
Saunders	4,584,859	Apr. 29, 1986
Clowes	4,685,322	Aug. 11, 1987

Claims 26 to 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Clowes in view of Saunders and Maeder.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 15, mailed December 18, 1998) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper

No. 14, filed October 22, 1998) and reply brief (Paper No. 19, filed April 22, 1999) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 26 to 30 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of

obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

As the Supreme Court observed in Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966):

While the ultimate question of patent validity is one of law, . . . the § 103 condition [that is, nonobviousness] . . . lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unresolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.

Thus, initially, the scope and content of the prior art are to be determined.² In the rejection before us in this appeal (answer, pp. 4-5), the examiner has briefly set forth the teachings of the applied prior art.

Secondly, the differences between the applied prior art (i.e., Clowes) and the claims at issue are to be ascertained. This the examiner has not done. Then, the examiner must determine if the ascertained differences between the subject matter sought to be patented and the combined teachings of the applied prior art (i.e., Clowes, Saunders and Maeder) 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. The examiner has not determined that the actual differences between the subject matter sought to be patented and the combined teachings of Clowes, Saunders and Maeder are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

² As set forth in Manual of Patent Examining Procedure (MPEP) § 2141, Office policy is to follow the four factual inquires enunciated in Graham v. John Deere Co. in determining obviousness under 35 U.S.C. § 103.

having ordinary skill in the art. Since the examiner has not made the above-noted determinations necessary to support a rejection under 35 U.S.C.

§ 103, the examiner has not established a prima facie case of obviousness and accordingly the decision of the examiner to reject claims 26 to 30 under 35 U.S.C. § 103 is reversed.

With regard to claim 26, an independent claim directed to a process for fabricating a one-piece sheet metal can body, based on our analysis and review of Clowes, it is our opinion that Clowes clearly lacks all the limitations recited in paragraphs A, B and C of claim 26. One such limitation is the step of providing a planar blank of "flat-rolled sheet metal" (paragraph A) which is subsequently draw formed into a drawn cup (paragraphs B and C). Since Clowes does not teach forming his drawn cup (see Figure 2) from a planar blank of "flat-rolled sheet metal" and the examiner has not made any determination in the rejection before us in this appeal that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have formed Clowes' drawn cup from a planar blank of "flat-rolled sheet

metal," the decision of the examiner to reject claim 26, and claims 27 to 29 dependent therein, under 35 U.S.C. § 103 is reversed.

With regard to claim 30, a claim directed to a flat-rolled sheet metal can body fabricated in accordance with the process of claim 26 or 27, based on our analysis and review of Clowes, it is our opinion that Clowes' metal can body clearly lacks the claimed height (about five inches) and the claimed diameter (about two and eleven sixteenths inches). In the rejection before us in this appeal, the examiner has not made any determination, or provided any evidence, that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have modified Clowes' metal can body to have a height of about five inches and a diameter of about two and eleven sixteenths inches. Accordingly, the decision of the examiner to reject claim 30 under 35 U.S.C. § 103 is reversed.³

³ In reversing the decision of the examiner to reject claims 26 to 30 under 35 U.S.C. § 103, we are aware of Saunders teaching (column 8, lines 16-23) of a making a can
(continued...)

³(...continued)

body having a height in the range of about one to about five inches and a diameter of in the range of about two to about four and one-quarter inches from flat-rolled steel or flat-rolled aluminum. However, in the rejection before us, the examiner has not relied upon this teaching as evidence as to why the it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the can body of Clowes to arrive at the subject matter of claim 30.

CONCLUSION

To summarize, the decision of the examiner to reject claims 26 to 30 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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