

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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* LUDWIG WIERES

---

Appeal No. 2000-1269  
Application 08/756,349

---

ON BRIEF

---

Before OWENS, LIEBERMAN and KRATZ, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

*DECISION ON APPEAL*

This appeal is from the final rejection of claims 1-13, which are all of the claims in the application.

*THE INVENTION*

The claimed invention is directed toward a honeycomb catalyst support body having alternating substantially smooth and structured sheet metal layers. Claim 1 is illustrative:

1. A honeycomb body of a catalytic reactor, comprising:



Maus discloses a honeycomb body of a catalytic reactor, and teaches that when there are alternating layers of smooth and corrugated sheet-metal layers, "it is suitable to reinforce some of the smooth sheet-metal layers. Smooth sheet-metal layers deform less under tensile strain than corrugated ones and can therefore transmit the resultant forces better than corrugated sheet-metal layers" (col. 2, lines 54-59).

The admitted prior art relied upon by the examiner (answer, page 3) is the discussion of Maus in the appellant's specification, wherein the appellant states that "preparing individual, different-thickness sheet-metal layers in the stack entails increased production cost" (page 2, lines 1-2) and that "[i]t is also fundamentally advantageous, for the sake of reducing the mass and expense of the honeycomb body, to make the sheet-metal layers as thin as possible. However, that objective contradicts the objective of high strength of the honeycomb body and long-term resistance to corrosion" (page 2, lines 6-11).

The appellant refers to these excerpts as the appellant's teachings (brief, pages 6-7), and the examiner has not

Appeal No. 2000-1269  
Application 08/756,349

established that these excerpts are admitted prior art rather than being teachings by the appellant. Regardless, even if the subject matter of these excerpts was known in the art, the examiner's rationale is not persuasive.

The examiner argues that it would have been obvious to one of ordinary skill in the art to make all, rather than some, of Maus' smooth layers thicker than the corrugated layers if the catalyst support body required greater strength (brief, pages 4-5). Maus, however, indicates that reinforcing only some of the smooth layers provides adequate strength (col. 2, lines 54-59), and the examiner has provided no evidence that there are catalytic support bodies which require greater strength. The examiner has merely provided speculation to that effect, and such speculation is not a sufficient basis for a *prima facie* case of obviousness. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968); *In re Sporck*, 301 F.2d 686, 690, 133 USPQ 360, 364 (CCPA 1962).

The examiner argues that the appellant's statement that "preparing individual, different-thickness sheet-metal layers

in the stack entails increased production costs” (specification, page 2, lines 1-2) indicates that it would have been obvious to one of ordinary skill in the art to make all of Maus’ smooth layers thicker than the corrugated layers to reduce production costs (answer, page 4). The examiner argues that one of ordinary skill in the art would not have made both the smooth and structured layers the same thickness to minimize production cost because Maus teaches (col. 2, lines 55-59) that reinforcing some of the smooth layers strengthens the catalyst support body (answer, page 4). Thus, the examiner argues, one of ordinary skill in the art would have reached a balance between strength and production cost through optimization, and in doing so would have made all smooth layers the same thickness and all corrugated layers the same thickness to reduce production cost, and would have made all smooth layers thicker than the corrugated layers to increase the strength of the catalyst support body (answer, page 5).

In order for a *prima facie* case of obviousness to be established, the teachings from the prior art itself must

Appeal No. 2000-1269  
Application 08/756,349

appear to have suggested the claimed subject matter to one of ordinary skill in the art. See *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). The mere fact that the prior art could be modified as proposed by the examiner is not sufficient to establish a *prima facie* case of obviousness. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

The examiner has provided no evidence that one of ordinary skill in the art, given only the applied prior art, would have reached an appropriate balance between production cost and catalyst support body strength by making all of the smooth layers one thickness and all of the corrugated layers a smaller thickness rather than doing what Maus discloses, i.e., reinforcing just some of the smooth layers and making all of the other layers, both smooth and corrugated, the same thickness, thereby minimizing the production cost of all of the other layers while providing the required catalyst support body strength. The record indicates that the motivation for modifying Maus as proposed by the examiner comes from the appellant's disclosure of his invention rather than coming

Appeal No. 2000-1269  
Application 08/756,349

from the applied prior art and that, therefore, the examiner used impermissible hindsight when rejecting the claims. See *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *In re Rothermel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960).

For the above reasons we conclude that the examiner has not carried the burden of establishing a *prima facie* case of obviousness of the invention recited in any of the appellant's claims. Accordingly, we reverse the examiner's rejection.

Appeal No. 2000-1269  
Application 08/756,349

*DECISION*

The rejection of claims 1-13 under 35 U.S.C. § 103 over the appellant's admitted prior art in view of Maus is reversed.

*REVERSED*

	)	
TERRY J. OWENS	)	)
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
PAUL LIEBERMAN	)	)
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
PETER F. KRATZ	)	)
Administrative Patent Judge	)	

Appeal No. 2000-1269  
Application 08/756,349

LERNER AND GREENBERG  
POST OFFICE BOX 2480  
HOLLYWOOD, FL 33022-2480

TJO:caw