

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRIAN T. BYRNE

Appeal No. 2001-1680
Application 08/890,471

ON BRIEF

Before WILLIAM SMITH, LIEBERMAN, and POTEATE, Administrative Patent Judges.

POTEATE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 14-21 and 28.¹

¹ Claims 1-5, 8-13 and 22-25 are pending but have been withdrawn from consideration as directed to a non-elected invention. Final Rejection, Paper No. 13, mailed January 5, 2000, page 2. Claims 6 and 7 were cancelled (Paper No. 12, received October 19, 1999). Claims 26, 27 and 29 were cancelled in an amendment after final (Paper No. 18, received November 9, 2000), filed with the appeal brief (Paper No. 17, page 2, paragraph (4)). See Examiner's Answer, Paper No. 19, mailed January 11, 2001, page 2, paragraph (4).

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Claim 14 is representative of the subject matter on appeal and is reproduced below:

14. Method for recovering fumes from a container of roofing material comprising:
rotating a fan to draw air from the inside of the container of roofing material for passing through a conduit in fluid communication with the container of roofing material; and providing a flame within the conduit, with the fumes passing through the conduit with the air drawn from inside of the container of roofing material being burned or consumed by the flame.

The references relied on by the examiner are:²

Hart et al. (Hart)	3,880,143	Apr. 29, 1975
Locke	4,991,532	Feb. 12, 1991
Vross et al. (Vross)	5,873,919	Feb. 23, 1999

²The examiner also appears to rely on the following references:

Blazejewski,	5,833,938	Nov. 10, 1998
Driscoll et al. (Driscoll)	5,620,668	April 15, 1997

See Examiner's Answer, page 3. However, the examiner has failed to incorporate these references into the statements of the rejections. "Where a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of the rejection." In re Hoch, 428 F.2d 1341, 1342, 166 USPQ 406, 407 (CCPA 1970). Accordingly, in reaching our decision, we have not considered either Blazejewski or Driscoll.

Appellant has also misapprehended the nature of this appeal proceeding. Specifically, we note that appellant has attempted to introduce new evidence as part of his appeal brief. See Appeal Brief, page 4, last paragraph-page 5, first paragraph. 37 CFR 1.195 strictly prohibits the introduction of new evidence absent a showing as to why such evidence was not timely submitted. However, we note that even if such showing had been made, appellant's proffered evidence would be entitled to little weight given the fact that it was not presented in the form of a declaration. In any event, having concluded that the examiner failed to establish a prima facie case of obviousness (see supra, Discussion), we need not consider appellant's evidence of nonobviousness.

Grounds of Rejection³

1. Claims 14-19 and 21 stand rejected under 35 U.S.C. § 103 as unpatentable over Schrader in view Hart;

2. Claim 20 stands rejected under 35 U.S.C. § 103 as unpatentable over Schrader in view of Hart and further in view of Vross; and

3. Claim 28 stands rejected under 35 U.S.C. § 103 as unpatentable over Schrader in view of Hart and further in view of Locke.

We reverse as to all three grounds of rejection.

Background

The invention relates to an apparatus for recovering fumes from a roofing kettle. Appeal Brief, page 2, paragraph (5). Materials used for roofing applications are typically heated in a kettle or a tanker. Specification, page 1, lines 9-11. To avoid pressure build up, the kettle is vented to the

³ The following rejections were rendered moot by appellant's amendment after final (see supra, note 1):

1. Claims 26 and 27 under 35 U.S.C. § 102 as anticipated by Vross.
2. Claim 29 under 35 U.S.C. § 103 as unpatentable over Vross in view of Schrader.
3. Claim 26 under 35 U.S.C. § 112, second paragraph.

atmosphere. Id. at lines 12-14. The venting operation has the undesirable drawback of releasing fumes into the atmosphere. Id. at lines 15-17.

Various prior art attempts have been made to eliminate or reduce release of such fumes. See id., pages 1-2. In one prior art method, a vertical chimney, extending from the roofing kettle lid or cover, is equipped with a burner. Id., page 2, lines 4-9. Heat from the burner causes air to rise in the chimney and fumes passing through the chimney are burned to eliminate visible smoke and odor. Id. at lines 9-13. According to appellant, fire and explosion are of concern in this type of arrangement because the burner is positioned in close proximity to the material in the roofing kettle and there is no provision for stopping gas flow to the burner if the burner flame does not start or is extinguished. Id. at lines 13-19. Further, appellant notes that because air flow is dependent solely on the chimney effect, fumes tend to escape from the kettle around the lid cover and at other locations. Id. at lines 19-22. Appellant states that Schrader utilizes a type of device which is similar in operation to the above-described device. Appeal Brief, page 4, second paragraph.

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According to appellant, he has developed a method for recovering fumes from a container of roofing material which overcomes the aforementioned prior art drawbacks. In accordance with the claimed method, air in fluid communication with the fumes of a container of heated material is drawn through a conduit and past a burner assembly in the conduit, the flame of the burner burning or otherwise consuming the fumes. Specification, page 2, line 31-page 3, line 1. The conduit is horizontally arranged and terminates in the hollow interior of a housing such that fresh air can be drawn from the hollow interior along with the air drawn from the conduit. Id., page 3, lines 2-7. According to appellant, this method prevents the tendency of fumes to escape from the source during operation (id. at lines 14-18) and reduces the risk of igniting the fumes or the material source of the fumes (id. at lines 31-34).

Discussion

The initial burden of presenting a prima facie case of obviousness rests on the examiner. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). A proper analysis under 35 U.S.C. § 103 requires, inter alia,

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consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should have made the claimed composition or device, or carried out the claimed process, and (2) whether the prior art would have revealed a reasonable expectation of success in so doing. See In re Dow Chemical Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Both the suggestion and the reasonable expectation of success must be found in the prior art *not in the applicant's disclosure.* Id.

The basis for the examiner's prior art rejections is as follows:

Schrader discloses all of the claimed steps except for a drawing step providing a fan having an inlet in communication with the interior of the housing.

Hart et al disclose a method of reducing asphalt fumes by burning in which a blower fan is placed at the top of the heating chamber (col. 5, lines 48-55, figure 3, reference number 130) in order to draw the burner and air outwardly into the atmosphere (col. 1, lines 56-63). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the fan of Hart et al in the apparatus of Schrader to further promote the outward direction of the gases and burner.

Examiner's Answer, page 3-4. Based on our review of the entire record, we agree with appellant that the examiner's rejection can only be based upon improper hindsight reasoning.

Where the claimed invention combines two or more known

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elements, "the question is whether there is something in the prior art as a whole to suggest the desirability, and thus obviousness, of making the combination." Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984) (citations omitted). As pointed out by appellant, both Schrader and Hart disclose "a total, complete apparatus which is purportedly effective and neither admits to any deficiency which would lead one to refer to another to supply such deficiency." Appeal Brief, page 9. The examiner's contention that it would have been obvious to have used the fan of Hart and the apparatus of Schrader to further promote the desired flow direction of the gases, while plausible, is simply unsupported by the teachings of the prior art. See In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (emphasis added) ("[P]articular findings must be made as to the reasons the skilled artisan *with no knowledge of the claimed invention*, would have selected these components for combination in the manner claimed"). While it is true that the suggestion or motivation to modify a reference may be implicit from the prior art as a whole rather than expressly stated, the examiner must be still provide reasons for finding

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a limitation to be taught or suggested in the reference.

Kotzab, 217 F.3d at 1370, 55 USPQ2d at 1316.

As further pointed out by appellant, Schrader utilizes a forced draft system to cause movement of air. Appeal Brief, page 6. In contrast, movement of air can only be created in Hart's device through the use of an induction type fan which exerts a pulling force to cause the flow of air outwardly into the atmosphere. See Hart, column 1, lines 56-62. While the examiner "holds" that adding a fan to a forced draft system such as that of Schrader would not destroy the system, she has failed to explain why one of ordinary skill in the art would have been motivated, in the first instance, to modify a forced draft system to include features from an induced draft system.

In sum, we conclude that the examiner's motivation for combining Schrader and Hart can only be based upon improper hindsight reasoning.⁴ See W.L. Gore & Associates v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir.

⁴We note that Vross (see supra, Ground of Rejection 2, page 3) is relied on for its disclosure of a mobile system for removing fumes of a roofing product wherein a flexible conduit is in fluid communication between the fume container and the filtering/incinerating housing (see Examiner's Answer, page 6. Locke (see supra, Ground of Rejection 3, page 3) is relied on solely for a teaching of powering a fan by means of a gasoline engine (see Examiner's Answer, pages 6-7). Neither reference remedies the aforementioned deficiencies in the examiner's proposed combination of Schrader and Hart.

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1983), cert. denied, 469 U.S. 851 (1984) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.")

REVERSED

WILLIAM F. SMITH)	
Administrative Patent Judge)	
)	
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)	BOARD OF PATENT
PAUL LIEBERMAN)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
)	
LINDA R. POTEATE)	
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