

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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICK A. RICHARDSON
and DANIEL A. BROCKMAN

Appeal No. 2002-1489
Application 09/173,456

ON BRIEF

Before WARREN, OWENS and TIMM, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellants, in the brief, and based on our review, find that we cannot sustain the rejections under 35 U.S.C. § 103(a) of appealed claims 1 through 5, 24 through 29, 31 through 33, 35 through 37, 40 through 43, 45 and 48 as being unpatentable over Gamblin in view of Ratzker et al. (Ratzker) and of appealed claims 1 through 7, 24 through 29, 31 through 33, 35 through 37, 40 through 43, 45 and 48 as being unpatentable over Myers et al. (Myers) in view of Ratzker.^{1,2}

¹ These are all of the claims in the application. See the specification, pages 28 and 31-33 and the amendment of January 19, 2001 (Paper No. 13)

As an initial matter, we find that, when considered in light of the written description in the specification as interpreted by one of ordinary skill in this art, *see, e.g., In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000); *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997), *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985), the plain language of all of the appealed claims, as represented by appealed claim 1, specifies that the “amorphous non-laminar” phosphorous containing alloy is characterized in product-by-process format with the limitations that the product is “produced by electrodeposition . . . while maintaining the cathode efficiency at a range of between about 4 and 10 mg/amp. min.,” and is further “characterized by the absence of a plurality of thick, parallel lines or regions in cross-sectional photomicrographs of the alloy after electrodeposition.”

It is well settled that in order to establish a *prima facie* case of obviousness of the appealed product-by-process claims, the examiner must show that the phosphorous containing alloy prepared from the materials of each of Gamblin and Myers by the method of Ratzker would reasonably appear to be identical or substantially identical to the phosphorous containing alloys having the characteristics, including preparation by electrodeposition at the required cathode efficiency, specified in these appealed claims. *See generally, Thorpe, supra; In re Best*, 562 F.2d 1252, 1254-56, 195 USPQ 430, 432-34 (CCPA 1977); *see also In re Skoner*, 517 F.2d 947, 950, 186 USPQ 80, 82 (CCPA 1975) (“Appellants have chosen to describe their invention in terms of certain physical characteristics Merely choosing to describe their invention in this manner does not render patentable their method which is clearly obvious in view of [the reference]. [Citation omitted.]”); *cf. In re Spada*, 911 F.2d 705, 708-09, 15 USPQ2d 1655, 1657-58 (Fed. Cir. 1990) (“The Board held that the compositions claimed by Spada ‘appear to be identical’ to those described by Smith. While Spada criticizes the usage of the word ‘appear’, we think that it was reasonable for the PTO to infer that the polymerization by both Smith and Spada of identical monomers, employing the same or similar polymerization techniques, would produce polymers having the identical composition.”).

Here, the examiner has merely alleged that the result of using the method of Ratzker to

² Answer, pages 3-7. The examine withdrew the ground of rejection of appealed claims 1, 6, 7, 42 and 43 under 35 U.S.C. § 112, second paragraph (*id.*, page 2).

prepare the phosphorous containing alloys of Gamblin and Myers would reasonably be “amorphous non-laminar” phosphorous containing alloys as specified by the appealed claims. Indeed, Ratzker does disclose that “[w]hen deposition was performed on a rotating disc electrode at rotation speeds, no layers were observed” in what is described as “homogeneous material” (page 81), which disclosure is relied on by the examiner to establish that the reference “defines specific conditions upon how one will obtain a non-laminar structure when producing amorphous . . . alloys by electrodeposition” (answer, pages 4-5).

However, appellants submit that Ratzker fails to “address detailed ways to control the deposition of the alloy to produce the desired [claimed] structure,” and point to the claimed “structural limitations made possible by maintaining the electrodeposition cathode efficiency within a narrowly defined range” (brief, 7). We also fail to find in Ratzker any disclosure with respect to control of cathode efficiency.

In response, the examiner takes the position that all non-laminar products are the same (answer, page 6) and that the burden thus shifts to appellants to point out “any feature of the claimed product not known or obvious from the prior art products as discussed supra,” finding “no distinction . . . between any product-by-process aspects of the claimed invention and the disclosures of the applied prior art” (*id.*, page 7). We fail to find any evidence in the record establishing that *all* non-laminar phosphorous alloys are indeed the same regardless of the method of preparation.

Thus, we find that the examiner has failed to account for the cathode efficiency limitation which characterizes in part the claimed alloy, and we fail to find any evidence on this record which establishes that this claim limitation can be ignored. It is well settled that the examiner must consider *all* claim limitations in determining whether the claimed invention as defined by *all* of the claim limitations of the claim complies with any and all applicable statutory provisions. *See, e.g., In re Geerdes*, 491 F.2d 1260, 1262-63, 180 USPQ 789, 791-92 (CCPA 1974) (“[E]very limitation in the claim must be given effect rather than considering one in isolation from the others.”); *see also* appellants’ analysis (brief, page 7). Thus, there is no evidence of record establishing that, *prima facie*, it reasonably appears that the alloys of the combined teachings of Gamblin and of Myers each with Ratzker are identical or substantially identical to

the claimed alloys as encompassed by the appealed claims. *Cf. In re Spada*, 911 F.2d 705, 708-09, 15 USPQ2d 1655, 1657-58 (Fed. Cir. 1990) (“The Board held that the compositions claimed by Spada ‘appear to be identical’ to those described by Smith. While Spada criticizes the usage of the word ‘appear’, we think that it was reasonable for the PTO to infer that the polymerization by both Smith and Spada of identical monomers, employing the same or similar polymerization techniques, would produce polymers having the identical composition.”).

Accordingly, since the examiner has failed to establish a *prima facie* case of obviousness under § 103(a), we reverse the ground of rejection.

The examiner’s decision is reversed.

Reversed

CHARLES F. WARREN)	
Administrative Patent Judge)	
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)	
TERRY J. OWENS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
CATHERINE TIMM)	
Administrative Patent Judge)	

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