

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.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 JOHN E. JACKSON
and MARIANNE O. PRICE

Appeal No. 95-2315
Application 07/917,670¹

ON BRIEF

Before KIMLIN, GARRIS and WARREN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 1, 3 through 5 and 9.² Claims 10 through 19 are also of record and have been withdrawn from consideration by the examiner.

We will not sustain either of the examiner's grounds of rejection of the appealed claims under 35 U.S.C. § 103 over appellants' admissions in their specification, Routsis, Wolfla et al. and McComas

¹ Application for patent filed July 21, 1992. According to appellants, this application is a continuation of application 07/729,154, filed July 12, 1991, now abandoned.

et al.³ (answer, pages 5-9) because we agree with appellants that any combination of the admitted state of the art and the applied references would have failed to reasonably suggest the claimed invention as a whole to one of ordinary skill in this art. *See, e.g., In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). We observe that appellants have admitted that face contact seals having first (“hard material”) and second (“carbonaceous material”) members wherein the first member was coated with “[c]onventional type coatings of 20[80Ni20Cr] + 80 [Cr. Carbide]” for “mating against carbon [second member]” were known at the time the claimed invention was made (specification, pages 1 and 9; principal brief, page 5).⁴ We are of the view that there are two differences between the claimed face seals and the admittedly old face seals: (1) the first member of the claimed face seals has a chromium carbide-age *hardened* nickel base alloy coating,⁵ while the first member of the admittedly known face seals has a coating of 20[80Ni20Cr] + 80 [Cr. Carbide]; and (2), the appealed claims require the heat treatment of a chromium carbide-age *hardenable* nickel base alloy coating in order to obtain the chromium carbide-age *hardened* nickel base alloy coating and there is no evidence of record that the 20[80Ni20Cr] + 80 [Cr. Carbide] coating is heat treated.

We fail to find any reasonable suggestion and reasonable expectation of success in the references applied by the examiner, either separately or combined, to substitute the age *hardenable* nickel base alloy binder, such as Inconel 718 (appealed claim 4), for the 80Ni20Cr alloy binder in a face seal coating to obtain a chromium carbide-age *hardenable* nickel base alloy coating and then to heat treat this coating to obtain chromium carbide-age *hardened* nickel base alloy coating. *In re Vaeck*, 947 F.2d 488, 493-95, 20 USPQ2d 1438, 1442-44 (Fed. Cir. 1991); *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed. Cir. 1988). While Wolfla et al. (e.g., page 778)

² See, e.g., appealed claim 1 in the amendment of March 26, 1993 (Paper No. 11).

³ The references relied on by the examiner with respect to the grounds of rejection are listed at page 4 of the answer. We refer to these references in our opinion by the name associated therewith by the examiner.

⁴ We note that an example of the latter coating on an Inconel 718 substrate is disclosed in Routsis (col. 3, lines 6-14).

⁵ The term “age hardened nickel base alloy” is defined in appellants’ specification (page 5, lines 7-11; principal brief, page 5). *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

discloses that age *hardenable* nickel base alloys can be used as a binder in place of the 80Ni20Cr alloy in chromium carbide-metal alloy coatings, this reference is directed to “rubbing surfaces” of “liquid-Na fast breeder reactors” and, thus, is non-analogous art because it is not directed to the same field of endeavor, face contact fluid seals,⁶ or reasonably pertinent to the same problem, “local ‘hot spots’,” addressed by appellants (see specification, page 9; principal brief, pages 5 and 8; reply brief, page 2). *In re Clay*, 966 F.2d 656, 658-59, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). Even assuming that Wolfla et al. did provide the requisite suggestion and reasonable expectation of success to interchange the alloy binders, as recognized by the examiner, this reference does not suggest heat treating the resulting coating. However, the examiner’s reliance on McComas et al. to generally demonstrate heat treatment of carbide-alloy coatings, such as the coatings disclosed by Wolfla et al., is misplaced as this combination would not have reasonably suggested the heat treatment of the coating of Wolfla et al. to one of ordinary skill in this art. *Keller, supra*. Indeed, the coatings disclosed by McComas et al. contain different amounts of different carbides (e.g., col. 3, lines 8-10 and 27-30, col. 4, lines 62-63, and col. 5, lines 35-55), the alloy is not an “age hardenable nickel based alloy” and the heat treatment mechanism suggested by this reference does not result in a “hardened alloy” (e.g., col. 4, lines 38-44, and col. 5, lines 35-41). Furthermore, based on these teachings of McComas et al., even if one of ordinary skill in this art did substitute the alloy of this reference for the 80Ni20Cr alloy of the admittedly old coatings, as alternatively suggested by the examiner (answer, page 9), the combination would not have resulted in appellants’ claimed invention. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-54, 5 USPQ2d 1434, 1438-41 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

⁶ As a matter of claim construction, the phrase “face contact fluid seal” in appealed claim 1 when considered in the context of the claimed invention as a whole, including consideration thereof in light of the specification, must be given weight as a claim limitation which characterizes the product of the claimed article of manufacture in order to give meaning to the claims and properly define the invention. *See generally In re Fritch*, 972 F.2d 1260, 1262, 23 USPQ2d 1780, 1781 (Fed. Cir. 1992) (citing *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 896, 221 USPQ 669, 675 (Fed. Cir.), *cert. denied*, 469 U.S. 857 [225 USPQ 792] (1984), *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989), *In re Stencel*, 828 F.2d 751, 754-55, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987).

Accordingly, it is manifest that the only direction to appellants' claimed invention as a whole on the record before us is supplied by appellants' own specification. *See Vaeck, supra; Uniroyal, supra; Dow Chemical, supra; In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968).

The examiner's decision is reversed.

Reversed

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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BRADLEY R. GARRIS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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CHARLES F. WARREN)	
Administrative Patent Judge)	

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PRAXIS, INC.,
Law Department
MI-557
39 Old Ridgebury Road
Danbury, CT 06810-5113