

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(2) is not binding precedent of the Board.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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TETSUYA HIGUCHI, SHUNICHI NOMURA,
SHIGERU ICHIBA, HIROSHI YAMAGUCHI, MASAOMI GOROMARU,
AKIRA WATANABE, KAZUHIRO TAKEDA, MIKIO MORITA,
KAZUHISA FUJITA and YASUYUKI MORIYAMA

Appeal No. 95-3313
Application 08/134,851¹

ON BRIEF

Before JOHN D. SMITH, GRON, and HANLON, Administrative Patent Judges.

¹ Application for patent filed October 12, 1993.
According
to applicants, this application is a continuation of
Application 07/882,259, filed May 8, 1992, abandoned; which is
a continuation
of Application 07/729,311, filed July 12, 1991, abandoned;
which
is a continuation-in-part of Application 07/492,016, filed
March 12, 1990, abandoned.

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GRON, Administrative Patent Judge.

DECISION ON APPEAL UNDER 35 U.S.C. § 134

This is an appeal under 35 U.S.C. § 134 of an examiner's rejection of Claims 9 and 11-15, all claims pending in this application.

Introduction

Claims 9 and 11-15 were finally rejected under 35 U.S.C. § 103 as being unpatentable in view of the combined teachings of Whitlock, U.S. 3,046,263, patented July 24, 1962, and Malhotra, U.S. 4,123,606, patented October 31, 1978. On appeal before this Board, the examiner "dropped [Malhotra] from the rejection" in response to appellants' Appeal Brief (Examiner's Answer (Ans.), p. 2). Accordingly, Claims 9 and 11-15 stand rejected under 35 U.S.C. § 103 as being unpatentable in view of Whitlock's teaching alone. Appellants ask us to independently review the merits of the examiner's section 103 rejection of Claims 9 and 12 over Whitlock's teaching. Otherwise, Claims 11 and 13-15 are said to stand or fall with Claim 9 (Appeal Brief (Br.), p. 3). Claims 9, 12 and 14 are reproduced below.

9. A continuous process for preparing polytetrafluoroethylene wet powder which comprises

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continuously supplying an aqueous dispersion containing fine particles of polytetrafluoroethylene prepared by emulsion polymerization to a high shear machine having a rotating element to continuously form a slurry containing flocculated polytetrafluoroethylene, continuously passing the slurry containing flocculated polytetrafluoroethylene to a lower portion of a vertical agitator having a granulation zone in its lower half and a shaping zone in its upper half, continuously applying a shearing force to the flocculated polytetrafluoroethylene in the granulation zone, continuously applying a shearing force to the granulated polytetrafluoroethylene particles in the shaping zone, and wherein the shearing force in the granulation zone is greater than the shearing force in the shaping zone, wherein the shearing force in the granulation zone is greater than the shearing force in the shaping zone, and continuously taking off polytetrafluoroethylene wet powder from an upper portion of the vertical agitator.^[2]

12. A process according to claim 9, wherein the path of the granules in the shaping zone is guided by means of a spiral flow guide in the shaping zone.

14. The polytetrafluoroethylene wet powder prepared by the process of claim 9, having a water content of 40

² We note that the underlined portion of Claim 9, which was entered by amendment filed December 17, 1993 (Paper No. 20), and is herein reproduced, does not appear in the corresponding Claim 9 reproduced in the Appendix to appellants' Appeal Brief. The underlined clause is repeated in tandem in Claim 9. We consider the repetition of the clause to be a readily correctable, typographical error.

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to 80% by weight; and in its dry state, a particle size within a range of 400 to 1200 μm , and an apparent density of 0.25 to 0.70 g/cc.

Discussion

The examiner has the initial burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness under 35 U.S.C.

§ 103. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The examiner's arguments in this case that Whitlock's process and device could be modified to produce the claimed process do not justify a rejection for obviousness where Whitlock does not reasonably suggest the modification's desirability. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Various elements of the process appellants claim and the apparatus employed to carry out the claimed process, given a rash interpretation which discounts the specification's teaching, might be broadly interpreted to encompass elements of the process Whitlock discloses. However, claim language is to be given the broadest reasonable interpretation which is consistent with the description of the invention in appellants' specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). The examiner

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has in this case erroneously interpreted the claim language in a vacuum.

Moreover, a reference must be read for all it would have fairly taught a person having ordinary skill in the art. In re Lamberti, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976). A fair reading of Whitlock's disclosure would not have led a person having ordinary skill in the art to the process appellants claim. To the contrary, we find in Whitlock's disclosure, including all its examples, no description of or reasonable suggestion to use a vertical agitator having both a lower granulation zone and an upper shaping zone which together continuously apply shearing forces greater in the granulation zone than in the shaping zone. It is not enough for the examiner to allege that (1) appellants' modifications in process and apparatus design are known in the art, (2) Whitlock's teaching is not constrained by the physical arrangement he describes, and (3) other configurations fall within the auspices of the invention (Ans., p. 3). There must be a suggestion or motivation in the prior art to do what appellants have done. In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990).

The examiner's finding that "Whitlock achieves the same

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ends as the secondary mixer of the claimed invention by agitating and then holding product in the tail end of the agitation zone until sufficient product is present to overflow the weir" (Ans., p. 4, l. 1-4), does not support the examiner's rejection. A finding that "an invention is an 'improvement' is not a prerequisite to patentability." Custom Accessories, Inc. v. Jeffrey-Allan Industries, Inc., 807 F.2d 955, 960 n. 12, 1 USPQ2d 1196, 1199 n. 12 (Fed. Cir. 1986). We reverse the examiner's rejection. However, we do not rest.

Other Issues

The examiner has not considered product-by-process Claim 14 separately from process Claims 9, 11-13, and 15. Rather, the examiner has adopted the position that the product of Claim 14, made by the process of Claim 9, is unpatentable only if Claim 9 is unpatentable. Accordingly, we are constrained to reverse the examiner's rejection of Claim 14 under 35 U.S.C. § 103 in view of Whitlock's teaching because we reverse the examiner's rejection of Claims 9, 11-13, and 15 under 35 U.S.C. § 103 in view of Whitlock's teaching.

However, because the examiner has not considered the patentability of product-by-process Claim 14 independently of

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process Claim 9, the patentability of the product of Claim 14 cannot have been adequately considered. The PTO's examination of the subject matter appellants claim is incomplete until the examiner has considered whether polytetrafluoroethylene wet powder of Claim 14 on appeal is the same or substantially the same as the polytetrafluoroethylene wet powder prepared by Whitlock's process or other patentably distinct prior art processes. See In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985):

[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972)

The patentability of a product does not depend on its method of production. *In re Pilkington*, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969). If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Marosi*, 710 F.2d 799, 803, 218 USPQ 289, 292-93 (Fed. Cir. 1983)

. . . The burden of presenting a *prima facie* case of unpatentability resides with the PTO, as discussed in *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

When the record indicates that the PTO has correctly

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adduced a *prima facie* case, the burden shifts to the applicant "to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980);

In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)." *In re Thorpe*, 777 F.2d at 698, 227 USPQ at 966.

In response to the examiner's rejection here, appellants submitted a Declaration by Tetsuya Higuchi, filed December 17, 1993 (Paper No. 20), seemingly to show that products made by the process of Claim 9 are patentably distinct from products made by the processes described by Whitlock. Thus, it appears from this record that the examiner not only failed to adduce the applicable precedent, i.e., *In re Thorpe*, supra, with regard to the evidence upon which an examiner may rely on to establish the *prima facie* unpatentability of product-by-process claims and shift the

burden of proof, but also to understand the significance of Higuchi's Declaration. Accordingly, we remand this case to the examiner to determine whether Claim 14 is *prima facie* unpatentable under 35 U.S.C. § 102 and/or 103 over Whitlock,

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consistent with instructions in In re Thorpe, supra, and In re Best, supra, and, if the examiner holds that a *prima facie* case of unpatentability exists, to thoroughly consider all the evidence of record favoring patentability.

Conclusion

We reverse the examiner's rejection of Claims 9 and 11-15 under 35 U.S.C. § 103 in view of Whitlock's teaching.

We remand the case to the examiner for consideration of issues of patentability under 35 U.S.C. § 102 and/or 103 in light of precedent cited herein.

This application, by virtue of its "special" status, requires an immediate action. Manual of Patent Examining

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Procedures § 708.01(d)(7th ed., rev. 3, July 1998). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REVERSED; REMANDED

	John D. Smith)	
	Administrative Patent Judge)	
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	Teddy S. Gron)	BOARD OF
PATENT)	
	Administrative Patent Judge)	APPEALS AND
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