

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NEVILLE S. BATLIWALLA and
JAMES C. THOMPSON

Appeal No. 1997-0236
Application No. 08/211,829¹

ON BRIEF

Before URYNOWICZ, BARRETT, and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-20. An amendment after final rejection which

¹ Application for patent filed November 6, 1992. According to appellants, this application is a 371 of PCT/US91/03123, filed May 7, 1991.

Appeal No. 1997-0236
Application No. 08/211,829

anceled claim 17 was filed January 10, 1996 and was entered by the Examiner. Accordingly, claims 1-16 and 18-20 are the appealed claims remaining in the application.

The disclosed invention relates to an elongate heater having a resistive heating element core surrounded by first and second insulating jackets. Appellants assert at page 2 of the specification that the additional insulating jacket provides reduced flammability relative to conventional elongate heaters having a single insulating jacket.

Claim 1 is illustrative of the invention and reads as follows:

1. An elongate heater which passes the VW-1 flame test and which comprises
 - (1) a core which comprises a resistive heater element which comprises a conductive polymer composition which exhibits PTC behavior;
 - (2) a first insulating jacket which
 - (a) surrounds the core, and
 - (b) is composed of a first insulating material comprising an organic polymer; and
 - (3) a second insulating jacket which surrounds and contacts the first insulating jacket;

Appeal No. 1997-0236
Application No. 08/211,829

the components of the heater being such that a heater which is substantially identical, except that it does not contain the second insulating jacket, fails the VW-1 flame test, and (b) a heater which is substantially identical, except that it does not contain the first insulating jacket, fails the VW-1 flame test.

The Examiner relies on the following prior art:

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|---------------------------------------------|-----------|---------------|
| Bruns | 3,576,388 | Apr. 27, 1971 |
| Smith-Johannsen et al. (Smith-Johannsen) | 3,861,029 | Jan. 21, 1975 |
| Betts et al. (Betts) | 4,151,366 | Apr. 24, 1979 |
| Shulver | 4,677,418 | Jun. 30, 1987 |

Claims 1-16 and 18-20 stand rejected under 35 U.S.C. § 103 as unpatentable over Smith-Johannsen in view of Shulver or Betts and further in view of Bruns.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief and Answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner, and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants'

Appeal No. 1997-0236
Application No. 08/211,829

arguments set forth in the Brief along with the Examiner's rationale in support of the rejection and arguments in rebuttal

set forth in the Examiner's Answer. It is our view, after consideration of the record before us, that the collective evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-16 and 18-20. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to

Appeal No. 1997-0236
Application No. 08/211,829

modify the prior art or to combine prior art references to arrive

at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole

or knowledge generally available to one having ordinary skill in

the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825

(1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.,

776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed.

Cir. 1984). These showings by the Examiner are an essential part

of complying with the burden of presenting a prima facie case of

Appeal No. 1997-0236
Application No. 08/211,829

obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24
USPQ2d
1443, 1444 (Fed. Cir. 1992).

The Examiner has grouped all of the appealed claims together in the 35 U.S.C. § 103 rejection and, as the basis for the obviousness rejection, proposes to modify the elongate heater insulating structure of Smith-Johannsen by relying on Shulver or Betts to supply the missing teaching of utilizing a preformed tape as a secondary insulating jacket. Bruns is additionally added to the combination as providing a teaching of covering a cable with a braided metallic sheath. In the Examiner's view (Answer, page 4), the skilled artisan would find it obvious to include a preformed tape insulating layer and a metallic sheath in the elongate heater of Smith-Johannsen for increased flame resistance and moisture and abrasion protection in view of the combined teachings of Shulver, Betts, and Bruns.

In response, Appellants assert that the Examiner has failed to set forth a prima facie case of obviousness since proper motivation for one of ordinary skill to make the

Appeal No. 1997-0236
Application No. 08/211,829

Examiner's proposed combination has not been established. Upon careful review of the applied prior art, we are in agreement with Appellants' stated position in the Brief. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F. 2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). It is our view that, while a showing of proper motivation does not require that a combination of prior art teachings be made for the same reason as Appellants to achieve the claimed invention, we can find no motivation for the skilled artisan to apply the preformed tape insulating jackets of either Shulver or Betts to the elongate heater structure of Smith-Johannsen. There is nothing in the disclosure of Smith-Johannsen to indicate that moisture penetration or lack of strength, the problems addressed by Shulver, were ever a concern. Similarly, the desire for flame protection, the problem addressed by Betts, is never discussed by Smith-Johannsen. It is our opinion that the only basis for applying the teachings of either Shulver or Betts to the

Appeal No. 1997-0236
Application No. 08/211,829

heater structure of Smith-Johannsen comes from an improper attempt to reconstruct Appellants' invention in hindsight.

With regard to the Bruns reference, it is apparent that this reference was applied by the Examiner solely for providing a teaching of wrapping an insulating cable with a metallic sheath, a feature present in some of the dependent claims but not in any of the independent claims on appeal. Our review of Bruns reveals no disclosure that would overcome the innate deficiencies of Smith-Johannsen alone or in combination with Shulver or Betts. Further, as with Shulver, we can find no motivation for combining Bruns' teachings with Smith-Johannsen since the problem of abrasion protection, addressed by Bruns with the addition of a metallic sheath, is not disclosed to be a problem in Smith-Johannsen.

Finally, although the Examiner's proposed combination of references is apparently intended to apply to all of the rejected claims, we note that independent claim 1 contains no recitation of a preformed tape or metallic sheath insulating layer. Claim recitations directed to these layers are ostensibly the reason the Examiner has applied the secondary

Appeal No. 1997-0236
Application No. 08/211,829

references of Shulver, Betts, and Bruns. In the responsive arguments portion at page 7 of the Answer, the Examiner suggests that Smith-Johannsen meets the requirements of claim 1 by the fact that dual insulating jackets of the same material are used. After reviewing the claim language of claim 1 in light of the arguments of record, it is our view that the Examiner has not addressed the specifics of the language in the last paragraph of claim 1. To establish prima facie obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Since the disclosure of Smith-Johannsen is totally silent as to any concern for flame protection, we fail to see how such disclosure would meet claim limitations directed to a flame test, let alone under the specific conditions set forth in the last paragraph of claim 1. If the Examiner intends to suggest that the materials used in the insulating jackets of Smith-

Appeal No. 1997-0236
Application No. 08/211,829

Johannsen would inherently pass a flame test, no support for such position is forthcoming from the Examiner other than the bald assertions mentioned above.

For all of the reasons discussed above, we are of the view that the Examiner has not established a prima facie case of obviousness and, therefore, do not sustain the 35 U.S.C. § 103 rejection of any of the claims on appeal. Accordingly, the Examiner's decision rejecting claims 1-16 and 18-20 is reversed.

REVERSED

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| STANLEY M. URYNOWICZ JR. |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| LEE E. BARRETT |) | APPEALS |
| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
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Leticia

Appeal No. 97-0236
Application No. 08/211,829

APJ RUGGIERO

APJ URYNOWICZ

APJ BARRETT

DECISION: REVERSED
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s):

Prepared: October 12, 2000

Draft Final

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OB/HD GAU

PALM/ACTS 2/BOOK
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