

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

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH M. HARRIS and KENNETH ENG JR.

Appeal No. 1997-2429
Application No. 08/323,215

ON BRIEF

Before ABRAMS, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-21, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a process for preparing rigid feedblocks of animal feed supplements (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Theuninck et al. 1989 (Theuninck)	4,851,244	July 25,
Chu et al. 1992 (Chu)	5,140,949	Aug. 25,
Laroche et al. 23, 1993 (Laroche)	5,264,227	Nov.

Claims 1-8 and 10-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Theuninck in view of Laroche.

Claims 9, 10 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Theuninck in view of Laroche as applied above, and further in view of Chu.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (Paper No. 6, mailed June 26, 1996) and the answer (Paper No. 11, mailed January 7, 1997) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 10, filed November 25, 1996) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1-21 under 35 U.S.C.

§ 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

In the final rejection (pp. 2-3), the examiner (1) set forth the teachings of Theuninck and Laroche; (2) ascertained that Theuninck does not use compression; and (3) determined that it would have been obvious to one having ordinary skill in the art to compress the block of Theuninck to achieve the benefits discussed by Laroche.

The appellants argue (brief, pp. 2-5) that the applied prior art does not suggest the claimed subject matter. Specifically, the appellants' argue that the suggested

combination of the liquid-based Theuninck process and the compression step of the Laroche process would not result in the "cohesive, non-pumpable, non-flowable mixture" that is further compressed to remove entrained air as set forth in all the claims under appeal. We agree.

In our view the examiner did not ascertain the differences between the prior art and the claims at issue correctly.¹ Based on our analysis and review of Theuninck and the independent claims on appeal (i.e., claims 1 and 21), it is our opinion that more than the one difference identified by the examiner exists. In that regard, Theuninck does not teach or suggest the mixing step recited in paragraph (b) of claims 1 and 21 since Theuninck mixing step forms a thick, flowable liquid which can be pumped (see column 6, lines 21-22), not the "cohesive, non-pumpable, non-flowable mixture" recited by the claims under appeal. Thus, even if the examiner were correct that it would have been obvious to one having ordinary

¹ After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

skill in the art to compress the block of Theuninck to achieve the benefits discussed by Laroche, such a modification of Theuninck would not have arrived at the claimed invention. It follows that we cannot sustain the examiner's rejections of claims 1-21.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-21 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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JOHN F. BOOTH
CRUTSINGER & BOOTH
1601 ELM STREET
SUITE 1950
DALLAS, TX 75201-4744

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