

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(2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEITH A. WATTS and
ROBERT W. HOSTETLER

Appeal No. 97-2715
Application 08/306,797¹

ON BRIEF

Before ABRAMS, NASE, and CRAWFORD, Administrative Patent
Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

¹Application for patent filed September 15, 1994.

Appeal No. 97-2715
Application No. 08/306,797

This is an appeal from the decision of the examiner finally rejecting claims 1-7, which constitute all of the claims of record in the application.

The appellants' invention is directed to a method and apparatus for treating a shirred food casing, and to the shirred food casing. The subject matter before us on appeal is illustrated by reference to claim 1, which reads as follows:

1. A method for treating a shirred food casing strand, having a diameter, a circumference, a longitudinal axis, a length, an external surface and a hollow bore along at least a portion of said longitudinal axis, which comprises providing an opening space between at least three parallel rollers which space is large enough to insert the strand, closing the space so that all three rollers contact the strand and smoothing said exterior surface by rolling said strand between the at least three rollers, all of which simultaneously contact said external surface at different lines of contact along the entire length of the strand.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Kostner <i>et al.</i> (Kostner)	3,798,302	Mar.
19, 1974		
Moret de Rocheprise	5,207,960	May
4, 1993		

Appeal No. 97-2715
Application No. 08/306,797

(de Rocheprise)

THE REJECTION

Claims 1-7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kostner in view of de Rocheprise.²

The statement of the rejection can be found in Paper No. 12 (the final rejection), with further explanation being provided in the Examiner's Answer.

The opposing viewpoints of the appellants are set forth in the Brief and the Reply Brief.

OPINION

The Examiner's Rejections

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness (*In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993)), which is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill

²This is expressed in two separate rejections in the Examiner's Answer, one directed to claims 1-6 and the other to claim 7.

Appeal No. 97-2715
Application No. 08/306,797

in the art (*In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)). If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned (*In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)).

The appellants' invention is concerned with acting upon the surface of a shirred food casing strand in order to smooth the exterior surface and to provide uniformity to the strand so that the strand is not curved. According to the method described in claim 1, this is accomplished by the steps of (1) providing an opening space between at least three parallel rollers large enough to insert the strand, (2) closing the space so that all three rollers contact the strand, and (3) smoothing the exterior surface of the strand by simultaneously contacting the strand with the three rollers at different lines of contact along its entire length.

This claim stands rejected on the basis of the combined teachings of Kostner and de Rocheprise. Kostner discloses a machine for improving the shape of a shirred food casing strand. It has essentially the same objectives as the

appellants' invention (column 1, line 66 *et seq.*). Kostner discloses two embodiments of the invention, both of which show the strand mounted on a mandrel. The first comprises a block having a round passage (5), through which the strand is pushed (column 2, lines 41-48; Figure 1). The second utilizes "one or more rolls" (column 2, lines 27 and 28; Figure 2), with two rolls (14 and 15) being shown and described. Kostner is silent as to how the strand is placed between the opposed rollers. It is our view, based upon the absence of any mention of moving the rollers apart, that one of ordinary skill would have been taught by Kostner to fixedly mount the two rollers with respect to one another with an appropriately sized gap therebetween, and to push the mounted strand through the gap either longitudinally (as in the first embodiment) or laterally.

Kostner fails to explicitly disclose or teach contacting the strand with three rollers, and providing an opening space between the rollers to receive the strand and then closing the space to smooth the strand along three different lines of contact.

Appeal No. 97-2715
Application No. 08/306,797

The secondary reference is directed to the manufacture of thin tubes of resin which are constructed by wrapping a ribbon around a mandrel and heating the assembly to fuse the ribbon into a thin-walled tube. In order to facilitate the removal of the tube from the mandrel, it is rolled under pressure by three wheels, which causes the tube wall to be thinned, the length to increase, and the interior diameter to expand (column 1, line 66 *et seq.*). The axes of the wheels are inclined, which causes the tube to be rotated as well as moved axially (column 2, lines 16-18; Figure 2). There is no explicit teaching in this reference of providing an opening space between the wheels and then closing it about the tube and its mandrel, and such would seem not to be inherent in its operation.

Since both references are devoid of any suggestion to open a space between the rollers to receive the article to be treated and thereafter close it to begin operation, as is required by claim 1, it is our conclusion that the teachings of these references fail to establish a *prima facie* case of obviousness with regard to the claim on this basis and we will

Appeal No. 97-2715
Application No. 08/306,797

not sustain the rejection. It follows that the rejection of dependent claim 2 also will not be sustained.

Another reason for not sustaining this rejection is grounded in our view that one of ordinary skill in the art would not have been motivated to combine the teachings of the references in the manner proposed by the examiner. The peripheral surfaces of the wheels of the de Rocheprise apparatus are not flat, and their purpose is not to smooth and straighten the surface of the tube, but to alter its structure in such a manner as to cause the inside diameter to increase as they concurrently cause the tube to move longitudinally. Therefore, even conceding, *arguendo*, de Rocheprise to be analogous art, we are of the opinion that there would have been no suggestion derived from this reference to modify Kostner so that it had three rollers instead of two. We are not persuaded by the examiner's argument that the mere mention by Kostner of "one or more rolls" is sufficient. From our perspective, the only suggestion to combine the references is

Appeal No. 97-2715
Application No. 08/306,797

found via the luxury of hindsight, which is not a proper basis. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

The reasoning set forth above for not sustaining the rejection of method claim 1 also applies to claim 3, which is directed to an apparatus for practicing the method of claim 1, and which requires at least three rollers arranged so as to contact the surface of the strand and "means for separating the rollers to permit placement of the strand between them and for causing said contact after said placement." The rejection of claims 3-6 will not be sustained.

Claim 7 is drawn to a shirred food casing strand "rolled at three simultaneous lines of contact extending along the entire length of the casing." While this is a product-by-process claim, the examiner's reasoning in rejecting it is the same as that which we found fatally defective above. The same holds true here, and therefore the rejection of claim 7 also will not be sustained.

New Rejection Under 37 CFR 1.196(b)

Appeal No. 97-2715
Application No. 08/306,797

Pursuant to our authority under Rule 1.196(b), we make the following new rejection:

Claim 7 is rejected under 35 U.S.C. § 103 as being unpatentable over Kostner.

Claim 7 is a product-by-process claim. The guidance that has been provided to us by our reviewing court on this matter is

[i]f 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.³

Applying this direction, the process limitations in claim 7 fall by the wayside, which leaves for our consideration only "[a] shirred food casing strand having a length and an external surface."

Both the appellants and Kostner have directed their inventive efforts to solving the same problems present in shirred food casing strands, and they have done so by methods which include contacting the outer surface with a plurality of rollers. While the methods differ, as we have pointed out

³*In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985).

Appeal No. 97-2715
Application No. 08/306,797

above, it would appear from the descriptions of the strands provided in the specifications of the pending application and the reference that the shirred food casing strands which result therefrom are indistinguishable from one another. No evidence has been provided from which the conclusion can be established that the shirred food casing strand of claim 7 patentably differs from the shirred food casing strand disclosed in Kostner.

This being the case, the product recited in claim 7 would, in our view, have been *prima facie* obvious in view of the teachings of Kostner.

SUMMARY

The examiner's rejection of claims 1-7 as being unpatentable over Kostner in view of de Rocheprise is not sustained.

Pursuant to 37 CFR 1.196(b) claim 7 is rejected under 35 U.S.C. § 103 as being unpatentable over Kostner.

The decision of the examiner is reversed.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final

Appeal No. 97-2715
Application No. 08/306,797

rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203
Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR

§ 1.196(b) provides that, "A new rejection shall not be
considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants,
WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise
one of

the following two options with respect to the new ground of
rejection to avoid termination of proceedings (§ 1.197(c)) as
to the rejected claims:

(1) Submit an appropriate amendment of the
claims so rejected or a showing of facts relating to
the claims so rejected, or both, and have the matter
reconsidered by the examiner, in which event the
application will be remanded to the examiner. . . .

(2) Request that the application be reheard
under § 1.197(b) by the Board of Patent Appeals and
Interferences upon the same record. . . .

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

REVERSED; 1.196(b)

Appeal No. 97-2715
Application No. 08/306,797

	Neal E. Abrams)	
	Administrative Patent Judge)	
)	
)	
)	
	Jeffrey V. Nase)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
	Murriel E. Crawford)	
	Administrative Patent Judge)	

Appeal No. 97-2715
Application No. 08/306,797

Dunn & Associates
P.O. Box 96
Newfane, NY 14108