

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(2) is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DENNIS L. LOTT

Appeal No. 1997-3355
Application No. 08/375,456

ON BRIEF

Before PAK, WALTZ and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-16.

Details of the appeal subject matter are set forth in illustrative independent claims 1 and 14 that read as follows:

1. A process for providing a wax coating to particles which contain or are coated with sugar, comprising:
 - (a) applying to the particles an emulsion coating having a wax-containing internal phase and an aqueous external phase, and which is substantially free of sugars;
 - (b) without drying the particles, applying a powdered wax coating to the emulsion-coated particles;
 - (c) tumbling the particles to polish the wax coating; and
 - (d) drying the polished particles.

14. A process for providing a polished wax coating to particles, comprising:
 - (a) placing the particles in an inclined rotating pan;
 - (b) applying a sugar coating to the particles by spraying thereon a sugar syrup, as the pan rotates;
 - (c) without removing the particles from the pan, applying as the pan rotates an aqueous-continuous emulsion having wax in the internal phase, the emulsion being substantially free of sugars;
 - (d) without drying the particles, and without removing the particles from the pan, applying a powdered wax coating to the emulsion-coated particles;
 - (e) without removing the particles from the pan, rotating the pan to cause tumbling of the powder-coated particles to polish the wax; and
 - (f) drying the polished particles.

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

Biddle	3,438,797	Apr. 15, 1969
Jordan	5,389,129	Feb. 14, 1995

Appellants state in their brief (page 3) that the claims are grouped as claims 1-13 and claims 14-16, and that claims 14-16 require a process step not included in claim 13. (Brief, page 3). Hence, we decide this appeal based upon independent claims 1 and 14. 37 CFR § 1.192 (c) (7) (1995).

Grounds of Rejection

The examiner has rejected claims 1, 3-7, 9-12, and 14-16 under 35 U.S.C. § 103 as being obvious over Biddle.

The examiner has also rejected claims 2, 8, and 13 under 35 U.S.C. § 103 as being obvious over Biddle as applied to claims 1, 3-7, 9-12, 14-16, and further in view of Jordan.

We **REVERSE**.

Discussion

In reaching our decision in this appeal, we have given careful consideration to the specification and claims, and to the respective positions as set forth by appellant in his brief (Paper No. 11), and by the examiner in the examiner's answer (Paper No. 12).

Appellant's claim 1 is directed to a process of providing a wax coating to particles, comprising (a) applying an emulsion coating which is substantially free

of sugars, (b) without drying the particles, applying a powdered wax coating to the emulsion-coated particles, (c) tumbling the particles to polish the wax coating, and (d) drying the polished particles.

The Biddle process includes (a) applying an emulsion, (b) drying the applied emulsion, (c) imprinting indicia, (d) drying the indicia, (e) applying a protective transparent outer coating of a suitable material, and (f) polishing the protective transparent outer coating. See column 2, lines 29-38 of Biddle.

The examiner asserts that steps (b), (c), and (d) of Biddle are extra steps, not specifically included in appellant's claim 1 (Answer, page 4). The examiner also asserts, however, that the omission of a method step of a known process with the corresponding omission of that step's function is not patentable and cites In re Brown and Kernan, 228, F.2d 247, 249, 108 USPQ 232, 234 (CCPA 1955), and concludes that appellant's claims 1 and 14 would have been obvious in view of Biddle.

The function of the process steps in Biddle of (b) drying the applied emulsion, (c) imprinting indicia, and (d) drying the indicia, are to obtain clearly visible identifying markings, without the use of hazardous materials, in a simpler and less time consuming way (column 2, lines 9-28). Also, the wax emulsion can serve as a final color coat. Without these steps, the objects of Biddle's invention would not be obtained. Accordingly, these steps are critical aspects of Biddle's process, and there exists no reasonable basis for omitting them from Biddle's process, and the examiner has not pointed out such a basis. Hence, it would not have been obvious to one of ordinary skill in the art to omit the critical steps of Biddle. Ex parte Robert K. Schultz [complete cite].

Moreover, assuming, *arguendo*, that Biddle's process could have been altered as suggested by the examiner, Biddle does not teach or suggest the use of a dry, powdered wax coating as required by appellants' claim 1, as pointed

out by appellant on page 4 of the Brief. The examiner asserts that the form of the wax would have been a matter of design choice (Answer, page 5), however, the examiner fails to point out any suggestions found in the prior art that would lead one skilled in the art to have chosen a dry, powdered wax coating in the process of Biddle. In a proper obviousness determination, "[w]hether the changes from the prior art are 'minor', . . . the changes must be evaluated in terms of the whole invention, including whether the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes that would produce the [claimed subject matter]" In re Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 935, 15 USPQ2d 1321, 1324 (Fed. Cir. 1990), cert. denied, 498 U.S. 920 (1990). This includes what could be characterized as simple changes, as stated in In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) "[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification."

Here, there is no teaching or suggestion in the prior art that would lead one of ordinary skill in the art to modify the Biddle process by utilizing a dry, powdered wax coating. Moreover, appellant's ability to complete the process in a single piece of equipment without intermediate drying operations, and an ability to imprint the final coated, polished particles counters the examiner's assertion that use of a dry, powdered wax coating is merely a "design choice." See In re Gal, 980 F.2d 717, 719, 25 USPQ2d 1076, 1078 (Fed. Cir. 1992) (finding of "obvious design choice" precluded where the claimed structure and the function it performs are different from the prior art).

The above analysis also applies to appellant's claim 14, as claim 14 includes the same aspects of claim 1 which the applied art fails to teach or suggest.

Appellant has presented separate arguments with regard to claims 2, 8, and 13. Since the examiner has not established a *prima facie* case of obviousness with respect to claim 1, which is broader than claims 2, 8, and 13, and upon which these claims depend, the merits of these arguments need not be discussed. Moreover, the reference of Jordan, studied in detail, does not cure the deficiencies of Biddle, discussed above.

In view of the above, we reverse the examiner's rejections of claims 1-16 under 35 U.S.C. § 103.

REVERSED

CHUNG K. PAK)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
THOMAS A. WALTZ)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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