

The opinion in support of the decision being entered today was *not* written for publication and 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 MELVIN L. ROWE
and ARTHUR M. KIRBY

Appeal No. 1998-1073
Application 08/488,521

ON BRIEF

Before WARREN, KRATZ and DELMENDO, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing view of the examiner, in the answer, and appellants, in the brief, and based on our review, find that we cannot sustain the rejection of appealed claims 1 through 8,¹ all of the claims in the application, under 35 U.S.C. § 103(a) as being unpatentable over Sakakibara et al.²

It is well settled that a *prima facie* case of obviousness is established by showing that some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge

¹ See specification, pages 7-8.

² Answer, pages 3-7.

generally available to one of ordinary skill in the art would have led that person to the claimed invention as a whole, including each and every limitation of the claims, without recourse to the teachings in appellants' disclosure. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Oetiker*, 977 F.2d 1443, 1447-48, 24 USPQ2d 1443, 1446-47 (Fed. Cir. 1992) (Nies, J., concurring); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) ("The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that [the claimed process] should be carried out and would have a reasonable likelihood of success viewed in light of the prior art. [Citations omitted] Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure."). This same criteria for *prima facie* obviousness also applies where a single reference is applied. *See generally, B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996) ("When obviousness is based on a particular prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. [Citation omitted.] This suggestion or motivation need not be expressly stated. [Citation omitted.]"); *In re Lamberti*, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976) ("The fact that neither of the references expressly discloses asymmetrical dialkyl moieties is not controlling; the question under 35 USC 103 is not merely what the references expressly teach, but what they would have suggested to one of ordinary skill in the art at the time the claimed invention was made.")

We have difficulty in finding that one of ordinary skill in this art would have found in Sakakibara et al. alone or in combination with knowledge generally available to one of ordinary skill in the art, all of the elements of the claimed method encompassed by appealed claim 1. The most troubling is the matter of whether one of ordinary skill in this art would have modified the apparatus discussed in the patent specification of and shown in the figures of Sakakibara et al. to include means for "applying a negative pressure" at the outlet of the fluidized bed "contained zone" as required by this claim, as the reference does not disclose applying negative pressure to the fluidized bed, and FIGs. 1 and 5 provide no disclosure as to the structure of the upper end of the fluidized bed in the apparatus shown therein (e.g.,

cols. 5-7). The examiner advances the *unsupported* position that the application of negative pressure in the apparatus shown in the referenced would have been a modification within the ordinary skill in this art because the use of negative pressure was “conventional in the art forming a fluidized bed” and one of ordinary skill would have expected that such modification would provide “similar results” (answer, pages 5-6; see also pages 9-10). Appellants contend that it is “not conventional to employ both negative and positive pressures when working with such fine particles” (brief, page 6).

It may well be that, as the examiner alleges, the application of a negative pressure to a fluidized bed was an optional, conventional modification in the art, but the examiner has not adduced any evidence or scientific reason establishing why one of ordinary skill in this art, armed with this unidentified knowledge, would have found in Sakakibara et al. and/or this unidentified knowledge a suggestion or motivation to modify the apparatus used in the reference to include means to apply negative pressure to the fluidized bed of particles in which the core of the mold to be surface treated is repeatedly moved (e.g., col. 5, lines 44-63). In this respect, the examiner has not responded to appellants’ contention that negative pressure is not conventionally employed along with positive pressure when fine particles are used in a fluidized bed. *See Rouffet, supra* (the specific understanding or principal within the knowledge of one of ordinary skill in the art leading to the modification of the prior art in order to arrive at appellants’ claimed invention must be explained). That one of ordinary skill in the art could have so modified the apparatus of Sakakibara et al. is insufficient suggestion or motivation for the modification. *See, e.g., In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

Therefore, we determine from this record that the examiner has resorted to hindsight gained from appellants’ specification and claims in order to reach the conclusion that the claimed invention was *prima facie* obviousness over Sakakibara et al., which is an inappropriate standard of obviousness under 35 U.S.C. § 103(a). *See generally, W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983) (“To imbue one of ordinary skill in the art with knowledge of the invention . . . when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to . . . hindsight . . . wherein that which only the inventor taught is used against its teacher.”).

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