

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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ANTON PLOMER

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Appeal No. 1998-2275  
Application No. 08/428,253

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ON BRIEF

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Before CALVERT, ABRAMS, 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 14-18, 20-27, 29 and 30, which are all of the claims pending in this application.<sup>1</sup>

We REVERSE.

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<sup>1</sup> Claims 14, 16 and 29 were amended subsequent to the final rejection.

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BACKGROUND

The appellant's invention relates to a method and system for coating a traveling material web (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

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

Hartog et al. 1984 (Hartog)	4,448,818	May 15,
Elvidge et al. 27, 1994 (Elvidge)	5,376,177	Dec.
Korhonen 1995	5,397,601	Mar. 14,
Alheid et al. (Alheid)	GB 2, 103,115	Feb. 16, 1983

Claims 14-18, 24 and 26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hartog.

Claim 25 stands rejected under 35 U.S.C. § 103 as being unpatentable over Hartog.

Claims 20-23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hartog in view of either Korhonen or Elvidge.

Claims 27, 29 and 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hartog in view of Alheid.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer<sup>2</sup> (Paper No. 18, mailed July 17, 1997) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 14, filed June 13, 1997) and reply brief (Paper No. 19, filed September 19, 1997) for the appellant's arguments thereagainst.

OPINION

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<sup>2</sup> The answer does not appear to have been signed by a primary examiner as required by 37 CFR § 1.193 and Manual of Patent Examining Procedure (MPEP) § 1208.

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

**The anticipation rejection**

We will not sustain the rejection of claims 14-18, 24 and 26 under 35 U.S.C. § 102(b).

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

It is well-settled that under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). As the court stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)(quoting Hansgirg v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. [Citations omitted.] If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

In this case, we agree with the appellant's argument that the examiner's determination that the primary trough 6 of Hartog includes "a positive pressure therein" as recited in each of the independent claims on appeal (i.e., claims 14 and

15) is simply speculative. It is our opinion that the examiner has not provided any evidence or scientific reasoning to establish the reasonableness of his belief that the above-noted limitation is an inherent characteristic of Hartog. In addition, we find that it more likely than not that primary trough 6 of Hartog is subject to "a negative pressure therein" due to the action of fan 9.

For the reasons set forth above, Hartog does not meet the above-noted limitation of claims 14 and 15 and therefore does not anticipate claims 14 and 15. In light of the foregoing, the decision of the examiner to reject claims 14 and 15, as well as claims 16-18, 24 and 26 dependent thereon, under 35 U.S.C.

§ 102(b) is reversed.

**The obviousness rejections**

We will not sustain the rejection of dependent claims 20-23, 25, 27, 29 and 30 under 35 U.S.C. § 103.

We have also reviewed the Korhonen, Elvidge and Alheid references additionally applied in the rejection of the above-noted claims under 35 U.S.C. § 103 but find nothing therein which makes up for the deficiencies of Hartog discussed above. Accordingly, we cannot sustain the examiner's rejection of appealed claims 20-23, 25, 27, 29 and 30 under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner to reject claims 14-18, 24 and 26 under 35 U.S.C. § 102(b) is reversed

and the decision of the examiner to reject claims 20-23, 25,  
27, 29 and 30 under 35 U.S.C. § 103 is reversed.

REVERSED

IAN A. CALVERT	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
NEAL E. ABRAMS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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TODD T. TAYLOR  
TAYLOR & AUST, P.C.  
142 S. MAIN, P.C. DRIVE  
P.O. BOX 560  
AVILLA, IN 46710

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