

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DAVID R. ELVIDGE and MALCOLM K. SMITH

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Appeal No. 1998-2641  
Application No. 08/700,020

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ON BRIEF

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Before KIMLIN, GARRIS, and WARREN, Administrative Patent Judges.

Garris, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 5, 9, 13, 14 and 21 which are all of the claims remaining in the application.

The subject matter on appeal relates to a method of applying a coating to a surface comprising metering the amount of coating applied to the surface at a metering nip via a

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metering means and continually vibrating the metering means in the nip to reduce the amount of coating passing the metering means with the surface. This appealed subject matter is adequately illustrated by independent claim 21, the sole independent claim on appeal, which reads as follows:

21. Method of applying a coating to a surface comprising delivering said coating to a coating chamber opening toward said surface, moving said surface relative to said chamber, metering in a metering nip formed between said surface and a metering means the amount of said coating carried from said chamber with said surface as said surface moves from said chamber, continually vibrating said metering means in said nip to reduce the amount of coating passing said metering means with said surface as said surface leaves said chamber.

The prior art set forth below is relied upon by the examiner as evidence of obviousness:

Dahlgren et al. (Dahlgren)      4,088,074      May 9, 1978

The admitted prior art on page 1 of the specification.

All of the appeal claims stand rejected under 35 U.S.C. § 103 as being unpatentable over the admitted prior art in view of Dahlgren.

OPINION

We cannot sustain this rejection.

As correctly indicated by the appellants in the brief, Dahlgren discloses an apparatus for inking printing plates

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which includes vibrating rollers, but these vibrating rollers (1) do not correspond to the here claimed metering means, (2) are not located at a metering nip as required by the independent claim on appeal and (3) do not perform the here claimed function of reducing the amount of coating passing the metering means with the surface as the surface leaves the coating chamber (e.g., see Figure 18 and the disclosure in columns 15 through 17 relating thereto). These factual circumstances militate against the examiner's conclusion that "it would have been obvious . . . to vibrate the metering means of the admitted prior art as suggested by Dahlgren . . . since Dahlgren teaches this to be known in the art to eliminate ghosting and to provide a quality coating" (answer, page 3). Indeed, for the reasons expressed above, Dahlgren plainly contains no teaching or suggestion of vibrating a metering means as required by appealed independent claim 21.

In light of the foregoing, it is our determination that the rejection before us is based upon impermissible hindsight derived from the appellants' own disclosure rather than some teaching, suggestion or incentive derived from the applied prior art. W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983), cert.

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denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's section 103 rejection of the appealed claims as being unpatentable over the admitted prior art in view of Dahlgren.

The decision of the examiner is reversed.

REVERSED

	Edward C. Kimlin	)	
	Administrative Patent Judge	)	
		)	
		)	
		)	
	Bradley R. Garris	)	BOARD OF
PATENT		)	
	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
		)	
	Charles F. Warren	)	
	Administrative Patent Judge	)	

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