

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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERHARD WISSING

Appeal No. 2000-0996
Application 08/836,940

ON BRIEF

Before WARREN, TIMM and JEFFREY T. SMITH, *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 views of the examiner, in the answer, and appellant, in the brief, and based on our review, find that we cannot sustain any of the grounds of rejection of record: appealed claims 21 through 23 and 25 through 32, under 35 U.S.C. § 103(a) as being unpatentable over Tornero in view of Kohama et al.¹ (Kohama) and optionally in view of Knaus et al. (Knaus); appealed claim 24 under 35 U.S.C. § 103(a) as being unpatentable over Tornero in view of Kohama and optionally in view of Knaus, and further in view of Andrews et al. (Andrews); appealed claim 33 under 35 U.S.C. § 103(a) as being unpatentable over Tornero in view of Kohama and optionally

¹ Kohama is a published United Kingdom Patent Application.

in view of Knaus, and further in view of Todd et al. (Todd); and appealed claim 34 and 36 through 42² under 35 U.S.C. § 103(a) as being unpatentable over Tornero in view of Kohama and optionally in view of Knaus, and further in view of Thevenet et al. (Thevenet).³

As appellant points out (brief, e.g., pages 10-11), the plain language of appealed claim 21, on which all of the appealed claims depend, requires “said panel and backing web are flat before said thermoforming and have surfaces that lay together flat before said thermoforming,” and “feeding compressed air into a closed cavity over said panel,” none of which is taught by Tornero. Thus, the issue is whether one of ordinary skill in this art would have combined Tornero with the teachings of Kohama and Knaus, on the basis the combination would have suggested the modification of the vacuum molding process of Tornero by laying and holding the panel and backing web together flat in the mold and not “naturally loose” such that gaps may exist between these sheets as taught by Tornero (e.g., col. 4, lines 47-51, and col. 5, lines 21-28 and 57-67) and by applying compressed air by covering the uncovered female mold required by the process of Tornero (e.g., col. 3, lines 4 and 44).

We have very carefully considered the examiner’s position in the answer and appellant’s position in the brief. We have no doubt that one of ordinary skill in this art can modify the vacuum molding process of Tornero as proposed by the examiner. However, that one of ordinary skill in the art may be capable of doing so does not alone provide the basis for combining the applied prior art as there must also be some teaching, suggestion or motivation in the combined prior art to make the modification. *See e.g., In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (“The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.”) Here, we find no specific teaching or inference that one of ordinary skill in the art would have been expected to reasonably draw from the combined

² Appealed claims 21 through 34 and 36 through 42 are all of the claims now in the application. Appellant amended appealed claims 21, 22, 27, 30 through 32 and 36 through 38, and canceled claims 35, 43 and 44 in the amendment April 2, 1999 (Paper No. 10). Because appealed claim 42 remains dependent on canceled claim 35, the examiner should enter a ground of rejection of appealed claim 42 as being indefinite under 35 U.S.C. § 112, second paragraph, upon further prosecution of the appealed claims after disposition of this appeal.

³ Answer, pages 2-13.

teachings of the applied references which support the examiner's position.⁴ On this record, we are of the opinion that the differences in the arrangement of the panel and backing web and the construction of the female mold between Tornero and the layers and molds of Kohama and Knaus clearly indicates that the modification of these aspects of the vacuum molding process of Tornero as proposed by the examiner would indeed render the vacuum molding process of Tornero incapable of operating in the manner taught in that reference. *See Fritch, supra; In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Therefore, we must conclude that the examiner has failed to make out a *prima facie* case of obviousness with respect to all of the grounds of rejection on appeal,⁵ and accordingly, we reverse.

Other Issues

We recommend that upon further prosecution of the appealed claims after disposition of this appeal, the examiner conduct a further search for the claimed invention in Class 264. A cursory electronic search of that art area resulted in the United States Patent to Conner and the Japanese Patents to Honda and to Yoshida et al. (Yoshida).⁶

We decline to exercise our authority under 37 CFR § 1.196(b) (2003) and enter on the record a new ground of rejection of at least appealed claim 21 under 35 U.S.C. § 102(b) and/or § 103(a) over any of Kohama, Conner, Honda and Yoshida, leaving it to the examiner to make factual findings from the teachings of these references and consider whether these references or any other prior art applies under either or both statutory provisions.

The examiner's decision is reversed.

⁴ It is well settled that a reference stands for all of the specific teachings thereof as well as the inferences one of ordinary skill in this art would have reasonably been expected to draw therefrom, see *In re Fritch*, 972 F.2d at 1264-65, 23 USPQ2d at 1782-83; *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968), presuming skill on the part of this person. *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

⁵ A discussion of *Andrews, Todd and Thevenet* is not necessary for our decision.

⁶ A copy of these references and a PTO Form 892 listing the same are appended to this decision.

Reversed

CHARLES F. WARREN)	
Administrative Patent Judge)	
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CATHERINE TIMM)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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