

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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LAURENCE BURST SPERRY, ANTHONY ORKIN DAVLIN,
KERRY MICHAEL MCKINLEY and GEORGE TEOPFIUS BERTRAM

Appeal No. 2000-1267
Application No. 08/843,274

HEARD: February 22, 2001

Before ABRAMS, STAAB, and BAHR, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-15. Claims 27-37 were withdrawn by the examiner as being directed to a non-elected invention, and claims 16-26 were canceled by the appellants.

We REVERSE.

BACKGROUND

The appellants' invention relates to a method of enhancing the mixing of foam precursors in foamed-in-place precursor systems. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the amendment filed on May 3, 1999 (Paper No. 8).¹

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

Fitts	3,419,134	Dec. 31, 1968
Inoue et al. (Inoue)	3,722,833	Mar. 27, 1973

Claims 1-15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fitts in view of Inoue.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the Answer (Paper No. 13) and the final rejection (Paper No. 9) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 12) for the appellants' arguments thereagainst.

¹The Brief failed to include an appendix containing a clean copy of the claims being appealed, as is required by 37 CFR § 1.192(c)(9), a deficiency which was noted by the examiner but did not cause him to challenge the Brief on the grounds that it was defective. Therefore, one must look to Paper No. 8 for claims 1-3, 5, 6, 10 and 12, and to the application as originally filed for claims 4, 7-9, 11 and 13-15.

OPINION

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

The rejection is under 35 U.S.C. § 103. The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

Independent claims 1 and 10 both are directed to a method of enhancing the mixing of foam precursors and include, inter alia, the step of warming the bag into which foam precursors have been placed in separate portions to a temperature above ambient

temperature sufficient to provide the energy required for good foam quality with repeatable yield, prior to the step of mixing the previously separated precursors. The examiner has taken the position that all of the steps in these two claims except for the heating step are taught by Fitts, but that it would have been obvious to add the heating step to the Fitts method in view of the teachings of Inoue. We find ourselves in agreement with the appellants that the combined teachings of the two applied references would not have suggested the claimed method to one of ordinary skill in the art. Our reasons for arriving at this conclusion follow.

Fitts discloses a foam-making system in which precursors are kept in separate bags until the foam is to be formed, whereupon the bags are breached to allow the precursors to combine and form a foam within a container. There is no mention in Fitts of warming the bags and/or the enclosed foam precursors at any point in the method, much less doing so after they are placed in the bags and prior to being mixed.

Inoue is directed to a method of mixing packaged dental filling material. The ingredients to be combined are in part liquid and in part powder, and are packaged in separate bags. Immediately prior to the mixing step, the bags are broken to allow the materials to be combined. The patent explains that the mixing of the ingredients causes an exothermic reaction, that is, it generates heat, and it may be advantageous to control the environmental temperature in order to hold this reaction to a moderate rate (column 7,

line 3 et seq.). In furtherance of this goal, Inoue teaches that mixing should be done in a housing wherein the temperature is controlled by a “coolant or temperature-controlled fluid” (column 3, lines 29-35; see also column 8, lines 19-26). It is the examiner’s view that this would have suggested to one of ordinary skill in the art that heating or cooling can be applied to the precursors, and thus it would have been obvious to supplement the Fitts method by adding the step of heating the precursors prior to mixing.

It is our opinion that there are two shortcomings in the examiner’s position. First, the particular ingredients utilized in Inoue’s method of mixing dental filling generate heat upon being mixed. Therefore, even though Inoue describes the temperature controlled housing as being provided with “coolant or temperature-controlled fluid” (column 3, line 32, emphasis added), it is our view that the artisan would have appreciated that this would not include a temperature-controlled fluid that would add heat to the process, which already is generating heat, for this would exacerbate the situation. Second, even if one were to accept, arguendo, the examiner’s view that Inoue should be interpreted as suggesting that heating as well as cooling could be added to the process, the point in the process at which Inoue controls the temperature differs from that which is recited in the claim. As we understand the process disclosed in Inoue, the temperature control is applied during the mixing step (see column 6, line 65 to column 7, line 13 and column 7, line 55 to column 8, line 50). However, claims 1 and 10 require that the heat be applied prior to the mixing

step, and there is nothing in Inoue to suggest that the temperature regulation be applied at that point. In fact, the reference actually teaches away from the appellants' method in that it is only during the mixing step, and at no other point in the method, that Inoue considers temperature regulation to be necessary.

It is our conclusion that the combined teachings of Fitts and Inoue fail to establish a prima facie case of obviousness with regard to the subject matter recited in independent claims 1 and 10. We therefore will not sustain the rejection of these claims or, it follows, of claims 2-9 and 11-15, which depend therefrom.

SUMMARY

The rejection is not sustained.

The decision of the examiner is REVERSED.

NEAL E. ABRAMS
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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