

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES P. BALTZ,
GENE P. ALTENBURGER,
BRIAN E. GORRELL,
VARCE E. HOWE,
and
RICHARD P. BOLGER

Appeal No. 2000-2267
Application No. 08/764,576

ON BRIEF

Before JERRY SMITH, RUGGIERO, and LEVY, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-10, which are all of the claims pending in the present application.

The claimed invention relates to a remote power source for an electrostatic paint applicator used in hazardous locations, the remote power source including an electric generator and low

Appeal No. 2000-2267
Application No. 08/764,576

voltage power regulating and control circuitry mounted in a sealed explosion proof housing. An air driven turbine is mounted on the exterior of the housing and drives the generator through a connection to the generator shaft which extends through and projects from the housing.

Claim 1 is illustrative of the invention and reads as follows:

1. A remote power source for an electrostatic paint applicator comprising a generator, a sealed explosion proof housing enclosing said generator, said generator having a drive shaft with an end projecting through an opening in said housing, said shaft and said housing opening having a diametrical clearance of no greater than 0.008 inch, an air turbine located exterior to said housing and connected to rotate said generator shaft to cause said generator to generate electrical power, and a circuit enclosed within said housing adapted to establish a predetermined low voltage output in response to electrical power from said generator when said air turbine drives said generator.

The Examiner's Answer cites the following prior art:

Gardner	508,380	Nov. 07, 1893
Eckert	2,465,436	Mar. 29, 1949
Cowan	3,791,579	Feb. 12, 1974
Mohan et al. (Mohan)	4,242,628	Dec. 30, 1980
Mommsen	4,462,061	Jul. 24, 1984
D'Amato	4,469,956	Sep. 04, 1984
Reeves	4,491,276	Jan. 01, 1985
Gschwender et al. (Gschwender)	5,073,736	Dec. 17, 1991
Lunzer	5,080,289	Jan. 14, 1992
Seewaldt	5,487,782	Jan. 30, 1996
Horn et al. (Horn)	5,491,602	Feb. 13, 1996

Appeal No. 2000-2267
Application No. 08/764,576

Claims 1-10 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on an inadequate disclosure.¹ Claims 1-5 and 7-10 also stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the Examiner offers the combination of Eckert, Seewaldt, Lunzer, Gschwender, and Horn with respect to claims 1, 2, 8, and 9. Gardner is added to the basic combination with respect to claims 3, 4, 7, and 10, and Cowan is added to Gardner and the basic combination with respect to claim 5.²

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief (Paper No. 16) and Answer (Paper No. 17) for the respective details thereof.

OPINION

Initially we note that Appellants have provided arguments as to the sufficiency of the drawings. However, the issue of the sufficiency of the drawings relates to a petitionable matter and not to an appealable matter. See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201 (8th Ed., Aug. 2001).

¹ At page 8 of the Answer, the Examiner objects to the specification as containing new matter relative to Appellants' amendment specifying that the air source for air turbine 17 is compressed air. Since the issue of the particular air source for the air turbine does not directly or indirectly affect the appealed claims, such issue is not reviewable on appeal.

² The Mohan, Mommsen, D'Amato, and Reeves references, which are not applied in any prior art rejections, are cited as evidentiary documents to support the Examiner's position as to the sufficiency of Appellants' disclosure.

Appeal No. 2000-2267
Application No. 08/764,576

Accordingly, we will not review the issue raised by Appellants on pages 5 and 6 of the Brief.

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, the arguments in support of the rejections, and the evidence of obviousness relied upon by the Examiner as support for the obviousness rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Brief along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that Appellants' specification in this application describes the claimed invention in a manner which complies with the requirements of 35 U.S.C. § 112. We are also of the conclusion that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-5 and 7-10. Accordingly, we reverse.

We consider first the rejection of claims 1-10 under the first paragraph of 35 U.S.C. § 112, noting that the Examiner relies on both the written description and enabling clauses of the statute. Initially, we would point out that the function of

Appeal No. 2000-2267
Application No. 08/764,576

the description requirement of the first paragraph of 35 U.S.C. § 112 is to ensure that the inventor has possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him. In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976).

According to the Examiner (Answer, page 9), the specification lacks a description of how the air turbine 17 will drive the output shaft 31 and the generator shaft 27 since the air turbine is mounted to the generator housing. We agree with Appellants (Brief, page 6), however, that the Examiner's position is based on the incorrect assumption that since the turbine, housing, and turbine shaft are integral, the turbine shaft cannot rotate the generator shaft. We have reviewed the Mohan, Mommsen, D'Amato, and Reeves references cited by the Examiner to support the assertion of lack of written description. We find nothing in these references, however, which would overcome Appellants' compelling arguments that the skilled artisan, on reading Appellants' description of the structure and operation of the turbine 17, generator 27, and associated coupling interconnections at pages 3-5 of the specification, would recognize that air turbines routinely include a rotatable turbine shaft mounted in a housing which does not rotate with the shaft.

Appeal No. 2000-2267
Application No. 08/764,576

As such, we are convinced that a skilled artisan would recognize and appreciate that such a structural interconnection would not prevent the shaft from turning if the turbine housing is mounted to another housing such as a generator housing. "It is not necessary that the application describe the claim limitations exactly, . . . but only so clearly that persons of ordinary skill in the art will recognize from the disclosure that appellants invented processes including those limitations." Wertheim, 541 F.2d at 262, 191 USPQ at 96 citing In re Smythe, 480 F.2d 1376, 1382, 178 USPQ 279, 284 (CCPA 1973).

In our opinion, under the factual situation presented in the present case, Appellants have satisfied the statutory written description requirement because they were clearly in possession of the claimed invention at the time of filing of the application. Therefore, the Examiner's rejection of claims 1-10 based on the "written description" requirement of the first paragraph of 35 U.S.C. § 112 is not sustained.

We next consider the Examiner's 35 U.S.C. § 112, first paragraph, rejection of claims 1-10 under the "enablement" requirements of the statute. We note that, while the Examiner has made a separate insufficient disclosure under the "enabling" clause of the statute, the underlying rationale for the rejection

Appeal No. 2000-2267
Application No. 08/764,576

is the same as set forth under the "written description" statutory requirement. The Examiner reiterates (Answer, page 7) the contention that Appellants' disclosure is deficient in describing how the connection of the air turbine housing to the generator housing will permit the turbine output shaft to rotate the generator shaft 27 so as to enable one of ordinary skill to make and use the invention.

For all of the reasons previously discussed, it is our view that Appellants' description at pages 3 and 4 of the description of the structural coupling between the air turbine housing 19 and the generator housing 10 provides a clear indication that such a coupling permits the turbine shaft to rotate the generator shaft regardless of the bracket connection between turbine and generator housings. In our opinion, after reviewing the evidence and arguments of record, including Appellants' description in the specification, that the level of skill relative to air turbine generators at the time of filing of Appellants' disclosure would enable the skilled artisan to implement the claimed turbine generating power source without undue experimentation. Accordingly, we do not sustain the Examiner's rejection of claims 1-10 under the enabling provisions of the first paragraph of 35 U.S.C. § 112.

Appeal No. 2000-2267
Application No. 08/764,576

Lastly, we consider the Examiner's rejection of all of the appealed claims 1-5 and 7-10 under 35 U.S.C. § 103(a). In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073-74, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re

Appeal No. 2000-2267
Application No. 08/764,576

Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to independent claims 1 and 8, Appellants' response to the Examiner's obviousness rejection asserts a failure by the Examiner to set forth a prima facie case since proper motivation for the proposed combination of references has not been established. In particular, Appellants argue (Brief, page 15) that Eckert, relied on by the Examiner as providing a teaching of an exterior air turbine connected to an explosion-proof generator housing, does not in fact disclose a turbine driven generator.

After careful review of the Eckert reference in light of the arguments of record, we are in agreement with Appellants' position as stated in the Brief. Our interpretation of the disclosure of Eckert coincides with that of Appellants, i.e., the fan 8, which the Examiner likens to the claimed air turbine, does not drive the generator shaft as in the appealed claims but, rather, is driven by the pulley driven generator shaft to provide cooling for an engine. Given this deficiency in the disclosure of Eckert, we fail to see how the skilled artisan would be motivated to combine it with any of the other applied prior art

Appeal No. 2000-2267
Application No. 08/764,576

references to provide the remote air turbine driven paint applicator power source set forth in the appealed claims.

Further, even assuming, arguendo, that the fan 8 in Eckert could be construed as an air turbine, we find no basis for the Examiner's proposed combination of references. The Horn reference, despite the Examiner's assertion to the contrary, has no disclosure of a sealed explosion-proof housing and, further, does not disclose an electrostatic paint applicator but, rather, an ionizer for dusting prior to painting. The Seewaldt reference, while disclosing that a generator can be located interiorly or exteriorly to an applicator housing, has no disclosure of being powered by a turbine. As such, these references disclose completely opposite approaches to the problem of providing a power supply to a paint applicator structure and, in our view, any attempt to combine them could only come from Appellants' own disclosure and not from any teaching or suggestion in the references themselves.

We have also reviewed the Lunzer and Gschwender references added to the proposed combination by the Examiner as providing teachings of, respectively, a low voltage circuit for a paint applicator and a machine housing located control circuit. We find nothing in these references which would cure the previously

Appeal No. 2000-2267
Application No. 08/764,576

discussed deficiencies in Eckert, Horn, and Seewaldt. Similarly, we find that the Gardner and Cowan references, applied to address the housing end structure and cable connection features of several of the dependent claims, do not overcome the innate deficiencies of Eckert, Horn, Seewaldt, Lunzer and Gschwender.

For all of the above reasons, because the Examiner has not established a prima facie case of obviousness since all of the limitations of the appealed claims are not taught or suggested by the applied prior art, the Examiner's 35 U.S.C. § 103(a) rejection of independent claims 1 and 8, as well as claims 2-5, 7, 9, and 10 dependent thereon, is not sustained.

Appeal No. 2000-2267
Application No. 08/764,576

In summary, we have not sustained the Examiner's 35 U.S.C. § 112, first paragraph, rejection of claim 1-10, nor the 35 U.S.C. § 103(a) rejection of claim 1-5 and 7-10. Therefore, the decision of the Examiner rejecting claims 1-10 is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
)	
STUART S. LEVY)	
Administrative Patent Judge)	

JFR:hh

Appeal No. 2000-2267
Application No. 08/764,576

MACMILLAN, SOBANSKI & TODD, LLC
ONE MARITIME PLAZA
720 WATER ST.
4TH FLOOR
TOLEDO, OH 43604