

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. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROLF VAN HAAG

Appeal No. 2001-1088
Application No. 08/879,140

HEARD: January 10, 2002

Before FRANKFORT, STAAB, 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 1 to 32, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a roll that includes a roll tube provided with an outer elastic coating. The sealed interior space may include a vaporizable liquid and a heat exchanger for cooling heat generated in the roll during use (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:

Wolfgang (Wolfgang '615)	DT 24 00 615 A1	July 17, 1975
Teruhisa	JP 58061318 A	Apr. 12, 1983
Matsuda	JP 58034999	Aug. 1983
Wolfgang (Wolfgang '875)	EP 0 567 875 A1	Nov. 3, 1993 ¹

Claims 1 to 6, 10 to 15, 17, 18 and 20 to 32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wolfgang '875 in view of Matsuda.

¹ In determining the teachings of these four references we will rely on the translations of record in the application file.

Claims 7, 8, 9 and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wolfgang '875 in view of Matsuda Wolfgang '615.

Claim 16 stands rejected under 35 U.S.C. § 103 as being unpatentable over Wolfgang '875 in view of Matsuda and Teruhisa.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 21, mailed May 17, 2000) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 20, filed March 7, 2000) and reply brief (Paper No. 23, filed July 17, 2000) for the appellant's arguments thereagainst.

OPINION

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. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 32 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The appellant argues that the applied prior art does not suggest the claimed subject matter. We agree.

All the claims under appeal require a roll having an elastic coating and either (1) a vaporizable liquid and a heat exchanger therein (claims 1 to 21 and 32) or (2) a vaporizable liquid therein which is vaporized and condensed therein (claims 22 to 31). However, these limitations are not suggested by the applied prior art. In that regard, while Wolfgang '875 does teach a roll having a vaporizable liquid and a heat exchanger therein (see for example the roll shown in either Figure 1 or 2, Wolfgang '875 does not teach providing the roll having a vaporizable liquid and a heat exchanger therein with an elastic coating. In addition, while Wolfgang '875 teaches rollers having rubber jackets (translation, page 1) and Matsuda teaches a roll with rubber 8 wound on the outer surface of a cylindrical iron core 7, there is no teaching, suggestion or incentive in the applied prior art references for a person of ordinary skill in the art at the time the invention was made to have provided the cooling roll of Wolfgang '875 having a vaporizable liquid and a heat exchanger therein with an elastic coating. In that regard, we find ourselves in agreement with the appellant that the addition of an elastic coating to the cooling roll of Wolfgang

'875 is contrary to the use of the roll of Wolfgang '875 (i.e., to conduct heat through the roller jacket 4 to the vaporous liquid 7 so that the roll may be used as a cooling roller in a paper machine).

Instead, it appears to us that the examiner relied on hindsight in reaching his obviousness determination. However, our reviewing court has said, "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W. L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It is essential that "the decisionmaker forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the invention was made . . . to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." Id. Since the claimed subject matter is

not taught or suggested by the applied prior art, we will not sustain the 35 U.S.C. § 103 rejection of claims 1 to 32.²

² We have also reviewed the references to Wolfgang '615 and Teruhisa additionally applied in the rejection of some of the dependent claims but find nothing therein which makes up for the deficiencies of Wolfgang '875 and Matsuda discussed above.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 32 under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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