

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 LOWELL D. EUBANK and ERNEST R. BOLLER

Appeal No. 2003-0210
Application 03/237,574

HEARD: JANUARY 23, 2003

Before OWENS, JEFFREY T. SMITH and TIMM, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1-3, 6-11 and 13-15, which are all of the claims in the application. In the examiner's answer the examiner states that claim 9 is allowed (page 2). Hence, the claims before us are claims 1-3, 6-8, 10, 11 and 13-15.

Appeal No. 2003-0210
Application 03/237,574

THE INVENTION

The appellants claim a uranium article having a specified protective alloy coating. Claim 1 is illustrative:

1. A metallic uranium article having a protective coating of a copper-tin alloy containing from 45 to 50% by weight of copper and from 55 to 50% by weight of tin, said alloy being firmly bonded to the metallic uranium.

THE REFERENCES

| | | |
|------------------------|-----------|-----------------------|
| Corson | 2,059,557 | Nov. 3, 1936 |
| Eubank | 2,847,321 | Aug. 12, 1958 |
| | | (filed Mar. 16, 1945) |
| Boller et al. (Boller) | 2,848,351 | Aug. 19, 1958 |
| | | (filed Sep. 28, 1945) |
| Robinson | 2,849,337 | Aug. 26, 1958 |
| | | (filed Nov. 28, 1945) |
| Gray | 2,928,168 | Mar. 15, 1960 |
| | | (filed Jan. 24, 1945) |
| Creutz | 3,037,924 | Jun. 5, 1962 |
| | | (filed Jul. 30, 1945) |

THE REJECTIONS

The claims stand rejected as follows: claims 1, 7 and 15 under 35 U.S.C. § 102(a) as being clearly anticipated by Robinson; claims 1 and 7 under 35 U.S.C. § 102(a) as being clearly anticipated by Boller; claims 1, 7 and 8 under 35 U.S.C. § 102(a) as being clearly anticipated by Eubank; claims 1-3, 10, 11 and 13-15 under 35 U.S.C. § 103 as being obvious over Gray or

Appeal No. 2003-0210
Application 03/237,574

Creutz, in view of Robinson, Boller or Eubank; and claim 6 under 35 U.S.C. § 103 as being obvious over Robinson, Boller or Eubank, in view of Corson.¹

OPINION

We reverse the aforementioned rejections.

*Rejections under 35 U.S.C. § 102(a) of
claims 1, 7 and 15 over Robinson,
claims 1 and 7 over Boller, and
claims 1, 7 and 8 over Eubank*

In *Carella v. Starlight Archery*, 804 F.2d 135, 139, 231 USPQ 644, 646 (Fed. Cir. 1986), the court stated that "[t]he statutory language 'known or used by others in this country' (35 U.S.C. §102(a)), means knowledge or use which is accessible to the public." However, the court in *In re Borst*, 345 F.2d 851, 854, 145 USPQ 554, 557 (CCPA 1965), *cert. denied*, 382 U.S. 973 (1966), stated:

Section 155 of the Atomic Energy Act of 1954 (42 U.S.C. 2185) provides:

In connection with applications for patents covered by this subchapter [XII - Patents and Inventions], the fact that the invention or discovery was known or used before shall be a bar to the patenting of such invention or discovery even though such

¹ In the examiner's answer the examiner withdraws rejections under 35 U.S.C. § 102(a) of claim 9 over Eubank and claim 15 over Eubank or Boller (answer, page 2).

Appeal No. 2003-0210
Application 03/237,574

prior knowledge or use was under secrecy within the atomic energy program of the United States.

We think the meaning and intent of this provision is so clear as to admit of no dispute: With respect to subject matter covered by the patent provisions of the Atomic Energy Act, prior knowledge or use under section 102(a) *need not* be accessible to the public.

Hence, Robinson, Boller and Eubank are available as of their respective filing dates of November 28, 1945, September 28, 1945 and March 16, 1945 as evidence of what was known by others under 35 U.S.C. § 102(a). These filing dates are prior to the appellants' earliest effective filing date of February 4, 1946.

Robinson and Boller disclose metallic uranium rods which have been coated in baths containing 67 wt% copper and 33 wt% tin (Robinson, col. 2, lines 7-9; Boller, col, 2, line 71 - col. 3, line 4).

Eubank discloses metallic uranium rods which have been coated in baths containing 1) 67 wt% copper and 33 wt% tin, 2) about 46.5 wt% copper, 52.5 wt% tin and 1 wt% nickel, and 3) 47 wt% copper and 53 wt% tin (col. 3, lines 43-47 and 68-75; col. 4, lines 43-50).

In the declaration under 37 CFR § 1.131 by John T. Lucas (filed February 12, 2001, paper no. 38), invention disclosure documents are provided which show that as of November 1944 the

Appeal No. 2003-0210
Application 03/237,574

appellants had invented a coated metallic uranium article made by dipping metallic uranium a bath comprising from 75% copper and 25% tin to 20% copper and 80% tin.

This declaration is effective for overcoming Robinson as to claims 1, 7 and 15, Boller as to claims 1 and 7, and Eubank as to claims 1, 7 and 8 because it at least would have rendered obvious so much of the appellants' claimed invention as each of these references shows. See *In re Clarke*, 356 F.2d 987, 992, 148 USPQ 665, 670 (CCPA 1966).²

Accordingly, we find that the examiner has not established a *prima facie* case of anticipation of the appellants' claimed invention by Robinson, Boller or Eubank.

² The examiner argues, in reliance upon Manual of Patent Examining Procedure (MPEP) § 2138.06, that the Rule 131 declaration is insufficient to overcome the references because there is no showing of diligence during the 15 months between the dates in the invention disclosure documents and the filing date of the parent application (answer, pages 5-6). The section of the MPEP relied upon by the examiner pertains to the consideration of diligence set forth in 35 U.S.C. § 102(g) with respect to determinations of priority in interferences and, therefore, is not relevant to the present case.

Appeal No. 2003-0210
Application 03/237,574

*Rejection of claims 1-3, 10, 11 and 13-15
under 35 U.S.C. § 103 over Gray or Creutz,
in view of Robinson, Boller or Eubank*

The Rule 131 declaration of Lucas has overcome Robinson, Boller and Eubank as to claims 1-3, 10, 11 and 13-15, by at least rendering obvious so much of the claimed invention as the references show. The remaining issue is whether the invention claimed in these claims would have been obvious to one of ordinary skill in the art over Gray or Creutz.

The examiner argues that Gray and Creutz "each show a uranium article coated with bronze, and Al-Si layer and covered with an aluminum sheath (e.g. see col. 10, lines 17+ of Creutz and cols. 2-4 of Gray", but do not disclose the composition of the appellants' bronze alloy, ternary bronze alloy or ternary aluminum silicon alloy (answer, page 8). "Clearly," the examiner argues, "the use of any conventionally known bronze alloy (as well as any conventionally known aluminum silicon alloy) in either primary reference would have been prima facie obvious as an obvious choice among conventionally known alternatives" (answer, page 9).

The examiner argues that his assertion that the appellants' alloys were conventionally known is sufficient to establish a *prima facie* case of obviousness because the appellants have not challenged that assertion (answer, pages 8-9). The appellants, however, state that "the particular art here is the coating of uranium. During the Manhattan Project, appellant questions whether the art had been around long enough for much to have already become conventional" (brief, page 11). Thus, the appellants have challenged the examiner's assertion. The examiner, therefore, to establish a *prima facie* case of obviousness, must provide prior art and explain how the teachings from the prior art itself would have suggested the claimed subject matter to one of ordinary skill in the art, see *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976), and the examiner has not done so.

The examiner argues that the mere existence of a federal designation for an aluminum-silicon alloy containing 0.1% sodium (specification, page 10, lines 27-29) indicates that such an alloy was known in the art (answer, page 9). It is inconceivable, the examiner argues, that such an alloy could be disclosed and not have any known uses. See *id.* This argument is not persuasive even if known uses for the alloy existed, because

Appeal No. 2003-0210
Application 03/237,574

the examiner has not established any such known uses included coating uranium.

The examiner argues that the appellants' specification at page 2, lines 3-6 indicates that addition of 1% aluminum to a copper-tin bath to facilitate coating a uranium article was known prior to the appellants' effective filing date (answer, page 10). This portion of the appellants' specification states: "In the early application of bronze coatings to uranium, it was found that the addition of about 1% of aluminum or 1.2% to 5% of nickel was advantageous for improving the continuity of the resulting coatings." When this statement is read in the context in which it appears, it is clear that it refers to the early application of bronze coatings to uranium by the appellants, not by others before the appellants.

For the above reasons we conclude that the examiner has not established a *prima facie* case of obviousness of the invention claimed in the appellants' claims 1-3, 10, 11 and 13-15.

Appeal No. 2003-0210
Application 03/237,574

*Rejection of claim 6 under 35 U.S.C. § 103 over
Robinson, Boller or Eubank, in view of Corson*

For the reasons given above regarding the rejections under 35 U.S.C. § 102(a), the Rule 131 has removed Robinson and Boller as references as to claim 6.

Eubank discloses in example 6 a uranium rod coated in a bath containing about 46.5 wt% copper, 52.5% tin and 1% nickel (col. 3, lines 68-75). The invention disclosure documents relied upon in the Rule 131 declaration do not show possession of this alloy by the appellants. However, the knowledge requirement of 35 U.S.C. § 102(a) is that the claimed invention must be known by others in this country before the applicant's invention. Because the disclosure in Eubank's example 6 is his own invention and Eubank is one of the inventors in the present application, it is impossible for the knowledge indicated by that example to precede the invention of the subject matter in claim 6 of the present application. Thus, Eubank is not available as a reference under 35 U.S.C. § 102(a) as to the appellants' claim 6.

Moreover, Corson discloses adding to the components of bronze up to 0.3% phosphorous and up to 3% nickel, to form at least some grains of nickel phosphide as a hard constituent (page 1, line 48 - page 2, line 13). The examiner argues that

Appeal No. 2003-0210
Application 03/237,574

Corson "shows it is old and advantageous in the art to add a small amount of nickel to the copper tin-alloy" (answer, page 11). This argument is not sufficient for establishing that the applied references themselves would have fairly suggested, to one of ordinary skill in the art, adding Corson's components to the bronze used by Eubank for coating uranium.

For the above reasons we conclude that the examiner has not carried the burden of establishing a *prima facie* case of obviousness of the article claimed in the appellants' claim 6.

DECISION

The rejections of claims 1, 7 and 15 under 35 U.S.C. § 102(a) over Robinson, claims 1 and 7 under 35 U.S.C. § 102(a) over Boller, claims 1, 7 and 8 under 35 U.S.C. § 102(a) over Eubank, claims 1-3, 10, 11 and 13-15 under 35 U.S.C. § 103 over

Appeal No. 2003-0210
Application 03/237,574

Gray or Creutz, in view of Robinson, Boller or Eubank, and
claim 6 under 35 U.S.C. § 103 over Robinson, Boller or Eubank, in
view of Corson, are reversed.

REVERSED

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|-----------------------------|---|-----------------|
| |) | |
| TERRY J. OWENS |) | |
| Administrative Patent Judge |) | |
| |) | |
| |) | |
| |) | BOARD OF PATENT |
| CATHERINE TIMM |) | |
| Administrative Patent Judge |) | APPEALS AND |
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| |) | |
| JEFFREY T. SMITH |) | |
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Appeal No. 2003-0210
Application 03/237,574

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