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Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN F. MURPHY

Appeal No. 2003-0413
Application 09/148,262

ON BRIEF

Before OWENS, WALTZ, and POTEATE, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1-15,
and 19-27. Claims 28-35, which are all of the other claims
remaining in the application, stand withdrawn from consideration
by the examiner as being directed toward a nonelected invention.

THE INVENTION

The appellant claims a plastic article which has been formed in a specified molding apparatus. Claim 1 is illustrative:

1. An article of manufacture comprising a finished configuration having an enhanced surface and made of plastic formulated to eliminate or reduce the need to include a release agent and formed by molding the plastic in a mold having at least one metal base, a mold cavity at least partially defining the plastic configuration, and at least one self-lubricating surface layer having a substantially uniform thickness for further defining the plastic configuration within the mold cavity, the at least one self-lubricating surface layer including a porous metallic skin including a plurality of substantially uniformly-shaped projections integrally connected to and extending from an interior surface of the at least one metal base and lubricating particles disposed on the skin and in pores of the skin, wherein the lubricating particles are bonded together to form a sealed surface of the at least one self-lubricating surface layer whereby the finish of the molded plastic configuration is further defined to provide the enhanced surface.

THE REFERENCES

Niederst et al. (Niederst)	5,300,334	Apr. 5, 1994
Baumgartner et al. (Baumgartner)	5,535,980	Jul. 16, 1996

THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 102(b) as follows: claims 1-15, 19 and 21-27 over Niederst, and claims 1-14 and 19-27 over Baumgartner.

OPINION

We reverse the rejection over Niederst and affirm the rejection over Baumgartner. A rejection of claim 15 over Baumgartner is entered under 37 CFR § 1.196(b).

The appellant indicates that the claims stand or fall in three groups: 1) claims 1-15 and 19-25; 2) claim 26 and 3) claim 27 (brief, page 3). We therefore limit our discussion to claims 26, 27 and one claim in the first group, i.e., claim 1, which is the sole independent claim in that group. See *In re Ochiai*, 71 F.3d 1565, 1566 n.2, 37 USPQ2d 1127, 1129 n.2 (Fed. Cir. 1995); 37 CFR § 1.192(c) (7) (1997).

Claim interpretation

It is proper to use the specification to interpret what the appellant means by a word or phrase in a claim. See *In re Morris*, 127 F.3d 1048, 1053-56, 44 USPQ2d 1023, 1027-30 (Fed. Cir. 1997).

The appellant's claim 1 recites that the article is "made of plastic formulated to eliminate or reduce the need to include a release agent". The appellant's specification indicates that the term "plastic" includes plastics generally (page 6, lines 6-8), and does not indicate that the invention involves formulating the plastic itself in any nonconventional way. Thus, the

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specification indicates that by "formulated to eliminate or reduce the need to include a release agent", the appellant means that a release agent is not needed to obtain the recited enhanced surface, but the plastic can include part or all of the conventional amount of release agent.

Claims 26 and 27 require "reduced levels of release agent". The appellant's specification indicates that the amount of release agent is reduced compared to the amount conventionally used to reduce sticking (page 1, lines 21-22). The specification does not indicate that "reduced amount" requires any particular degree of reduction.

Rejection over Niederst

Niederst discloses a blow molded plastic article having thereon a protective layer of polyurethane to reduce stress cracking on the external surface of the article (col. 1, line 47 - col. 2, line 2; col. 2, lines 57-60).

The examiner's explanation of the rejection over Niederst is the following (answer, pages 3-4):

Niederst et al. teaches blow molded rigid containers for containing carbonated beverages formed from first injection-molding intermediate tubular-shaped articles (preforms) comprising layers of polypropylene, polyester, and/or polyurethane (See Abstract, col. 1, lines 11-17; col. 2, line 38 to col. 3, line 48).

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Claims 10-14 recite the specific method by which the plastic article is made. However, when the prior art of [sic] discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, the burden is on the applicant to present evidence from which the examiner could reasonably conclude that the claimed product differs in kind from those of the prior art.

All of the appellant's claims are product-by-process claims. The examiner has the initial burden of establishing a *prima facie* case of unpatentability by providing evidence or reasoning which indicates that the appellant's product and that of the prior art are identical or substantially identical. See *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985); *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977).

The examiner has not provided the required evidence or reasoning which indicates that the appellant's product and that of the prior art are identical or substantially identical. Specifically, the examiner has not provided evidence or reasoning which shows that Niederst's article has an "enhanced surface" as that term is used by the appellant. The appellant argues that an enhanced surface finish is not a quality taught by Niederst (brief, page 5). The examiner's response is that the enhanced surface "limitation does not add anything materially, or patentably distinguish the surface of the presently claimed

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article over that which is taught by the references" (answer, page 6). The examiner, however, provides no evidence or reasoning in support of this argument.

The examiner argues that "the Examiner cannot precisely determine how the 'enhanced surface finish' of the presently claimed invention is distinct or different over that of the teachings of Niederst et al." See *id.* This argument is not well taken because, as pointed out above, the examiner has the initial burden of providing evidence or reasoning which shows that the articles of the appellant and Niederst reasonably appear to be the same or substantially the same. The examiner's mere statement that the examiner is not able to determine whether the articles of the appellant and Niederst are different does not provide the required evidence or reasoning.

For the above reasons we find that the examiner has not carried the burden of establishing a *prima facie* case of anticipation of the appellant's claimed invention over Niederst. Consequently, we reverse the rejection over this reference.

Rejection over Baumgartner

Baumgartner discloses a plastic article which may be made by injection molding using a mold having a hard skin layer that can be made of metal, ceramics, glass, quartz, plastics and plastic

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composites (col. 3, lines 21-36; col. 5, lines 11-27; col. 12, lines 41-50). The hard skin layer provides the desired surface quality to the article (col. 5, lines 33-34). The article surfaces are relatively smooth, having an average surface roughness of less than about 0.1-0.2 μm (col. 10, lines 48-56; col. 11, lines 12-47; col. 12, lines 51-53). Baumgartner does not disclose that the plastic contains a release agent.

Because Baumgartner's article, like that of the appellant, is made in a mold having a skin layer which imparts a desired surface finish to the molded article, the disclosed surface finish being a relatively smooth surface, it reasonably appears that Baumgartner's article has an enhanced surface as that term is used by the appellant.

When the appellant's product and that of the prior art appear to be identical or substantially identical, the burden shifts to the appellant to provide evidence that the prior art product does not necessarily or inherently possess the relied-upon characteristics of the appellant's claimed product. See *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980); *Best*, 562 F.2d at 1255, 195 USPQ at 433-34. The appellant has not provided such evidence.

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The appellant points out that Baumgartner does not mention a release agent and argues, in reliance upon *In re Robinson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999), that there is no clear evidence that a release agent is absent from Baumgartner's article (brief, page 4). The evidence is Baumgartner's lack of a disclosure of a release agent. The reference provides no reason to believe that the article contains a release agent.¹

Accordingly, we find that a *prima facie* case of anticipation of the appellant's claimed invention over Baumgartner has been established and has not been effectively rebutted by the appellant. We therefore affirm the rejection over Baumgartner.

New ground of rejection

Claim 15 is rejected under 35 U.S.C. § 103 as being unpatentable over Baumgartner.

¹ The appellant points out (brief, page 4) that it is disclosed in 21 *Kirk-Othmer Encyclopedia of Chemical Technology* 213 (John Wiley & Sons, 4th 3d. 1997) that "[r]elease agents are widely used in the rubber and plastic industry to achieve release of polymers and release from polymers." Regardless of whether release agents were widely used in the plastic industry, Baumgartner's lack of a teaching that a release agent is present in the plastic indicates that the relatively smooth surface of Baumgartner's article is obtained without a release agent being present in the plastic.

Claim 15 requires that the plastic in the article of claim 1 is a polyurethane. Baumgartner does not disclose polyurethane. Baumgartner's teaching, however, that various thermoplastics can be used (col. 11, line 60 - col. 12, line 18) would have fairly suggested, to one of ordinary skill in the art, the use of thermoplastics generally, including linear thermoplastic polyurethanes.² Consequently, the use of a linear thermoplastic polyurethane as Baumgartner's plastic would have been *prima facie* obvious to one of ordinary skill in the art.

OTHER ISSUES

The appellant's specification states that the appellant's self-lubricating mold surface layer is commonly referred to as an Endura® Series 203 coating (page 12, lines 22-24). The examiner and the appellant should address on the record whether such a coating, and the disclosures on the Endura Coatings website that the coating resists wetting by most liquids and that few materials will permanently adhere to the nonstick surface, were known in art at the time of the appellant's invention.³ If so,

² See 23 *Kirk-Othmer Encyclopedia of Chemical Technology* 576 (John Wiley & Sons, 3rd ed. 1983), a copy of which is provided to the appellant with this decision.

³ A copy of the relevant pages of the Endura Coatings website is provided to the appellant with this decision.

the examiner and the appellant should address on the record whether, because the coating resists wetting by most liquids and few materials will permanently adhere to the nonstick surface, it would have been obvious to one of ordinary skill in the art to use a reduced amount of release agent in the article being molded.⁴

Also, the appellant discloses that it was known in the art to reduce the problem of sticking of resin to a mold surface not only by including a release agent in the plastic, but also by spraying a release agent onto the mold surface (specification, page 1, lines 17-22). The examiner and the appellant should address on the record whether an article made using such a mold surface having a coating of release agent meets the requirements of the appellant's independent claims, i.e., 1) an eliminated or reduced need for a release agent in the plastic (claim 1) or a reduced level of release agent in the plastic (claims 26 and 27), and 2) an enhanced surface.

In addition, the appellant's claim 1 merely requires elimination or reduction of the need to include a release agent

⁴ The appellant's specification does not indicate that "reduce" requires any particular degree of reduction. Thus, the appellant's claims encompass an infinitesimal reduction in the conventional amount of release agent.

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in the plastic, but does not actually require a reduced amount of release agent in the plastic. The examiner and the appellant, therefore, should address on the record whether a molded plastic article containing a conventional amount of a release agent has an enhanced surface as that term is used by the appellant and, therefore, meets the requirements of the appellant's claim 1.

DECISION

The rejection of claims 1-15, 19 and 21-27 under 35 U.S.C. § 102(b) over Niederst is reversed, and the rejection of claims 1-14 and 19-27 under 35 U.S.C. § 102(b) over Baumgartner is affirmed. A new rejection of claim 15 has been entered under 37 CFR § 1.196(b).

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

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37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART, 37 CFR § 1.196(b)

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Administrative Patent Judge)	
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