

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

This opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGE G. WICKS

Appeal No. 94-1255
Application 07/796,974¹

ON BRIEF

MAILED

DEC 26 1995

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before JOHN D. SMITH, TURNER and WARREN, Administrative Patent Judges.

TURNER, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the Examiner's decision rejecting claims 1-11 which are all of the claims under rejection. Claims 12-23 have been withdrawn from consideration under 37 C.F.R. § 1.142(b). Illustrative claim 1 is reproduced below.

¹ Application for patent filed November 25, 1991. According to the appellant, the Application is a division of Application 07/668,364 filed March 31, 1991, which is a continuation of Application 07/293,846 filed January 5, 1989, now abandoned.

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1. An opaque ceramic composite suitable for curing, bonding to and thereby repairing substrates, said ceramic composite being obtained by:

mixing ethanol and water to form a first pre-mix;

adjusting the pH of said first pre-mix into the acid range:

mixing ethanol and tetraethyl orthosilicate to form a second pre-mix;

adding said first pre-mix to said second pre-mix to form a third mixture and thoroughly mixing same;

aging said third mixture at room temperature; while maintaining sufficient alcohol-water solvent present from said pre-mixes to avoid premature curing of said third mixture;

mixing a fine crystalline particulate with said third mixture to form a slurry.

The references of record relied upon by the Examiner are:

Yoldas	4,278,632	July 14, 1981
Mishima et al. (Mishima)	4,397,666	Aug. 9, 1983
Barringer et al. (Barringer)	4,788,046	Nov. 29, 1988
Van Lierop et al. (Van Lierop)	4,806,328	Feb. 21, 1989

The appealed claims stand rejected under 35 U.S.C. § 112, first paragraph. Similarly, the appealed claims stand rejected under 35 U.S.C. § 103 as unpatentable over Van Lierop, Yoldas or Mishima in view of Barringer.

The subject matter on appeal is directed to an opaque ceramic composite prepared by

1) mixing ethanol and water to form a pre-mix and adjusting to an acid pH;

2) mixing ethanol and tetraethyl orthosilicate to form a second pre-mix;

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3) mixing 1) and 2) together and aging the mixture; and
4) mixing a fine crystalline particulate with the mixture to
form a slurry.

According to the Examiner, the claims stand or fall together
and Appellant appears to have grouped claims 1-11 together as
well.

OPINION

We have carefully reviewed the record before us, including
each of the arguments and comments advanced by Appellant and the
Examiner in support of their respective positions. This review
leads us to conclude that the Examiner's position is not well
founded with respect to the rejections under § 112, first para-
graph and § 103. Accordingly, we will not sustain either of the
rejections. Our reasons follow.

REJECTION OF CLAIMS 1-11 UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

We will not sustain this rejection. It is the Examiner's
view that the specification fails to provide an adequate written
description of the invention since

... there is no antecedent basis in the specification
for an opaque slurry[;]only for formation of a "slight-
ly opaque" film after curing (the basis for "slightly
opaque" in the parent application is tenuous at best).

It is our view that there is an adequate written description
of an opaque slurry. The specification at page 4, line 11 states
that "The opaque ceramic composite of the present invention

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comprises a low temperature sol gel matrix". At page 5, line 8, Appellant begins a discussion of the procedure for preparing the "composite". The procedure involves the addition of particulates to form a slurry-like composition (page 7, lines 12 and 13). This composite can vary in viscosity from that of a slurry to that of a thick paste (page 7, lines 22-24). Thus, we have little doubt as to the adequacy of the written description insofar as an opaque ceramic composite (slurry) is concerned. It is not necessary that the claimed subject matter be described identically, but the disclosure originally filed must convey to those skilled in the art that Appellant had invented the subject matter later claimed. In re Kaslow, 707 F.2d 1366, 217 USPQ 1089, 1096 (Fed. Cir. 1983). Here, it is clear to us that Appellant has done that.

Accordingly, we will not sustain this rejection.

REJECTION OF CLAIMS 1-11 UNDER 35 U.S.C. § 103 OVER VAN LIEROP,
YOLDAS OR MISHIMA IN VIEW OF BARRINGER

We will not sustain this rejection since the Examiner has not, in our view, established a prima facie case of obviousness. The Examiner acknowledges (Answer, page 3, penultimate paragraph) that the difference between the components of the primary references and the instant claims is the addition of a fine crystalline particulate (the Examiner refers to it as a powder material, alumina, for example). The Examiner relies upon Barringer for

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its teaching of the addition of alumina to sol-gel glasses and concludes that it would be obvious to employ the Barringer alumina as a filler in the processes described in the primary references. We disagree. The Examiner has offered no motivation for combining the alumina of Barringer with the components of the primary references. The Barringer alumina is employed, as a suspension, in the production of composite ceramic particles and is mixed with reagent solutions of certain inorganic oxides, followed by the addition of precipitating agents so as to precipitate the oxides onto the alumina to form composite ceramic particles of the alumina.

We do not find that the Examiner has provided adequate motivation to combine the alumina of Barringer with the alcohol, water, acid and silicate components of the primary references. The mere fact that the prior art may be modified to reflect the features of the claimed invention does not make the modification, and here the claimed invention, obvious, unless the desirability of such modification is suggested by the prior art; the claimed invention cannot be used as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). The Barringer ceramic composite is used for integrated circuits while none of the primary reference

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