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THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

**MAILED**

**AUG 9 - 1996**

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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

*Ex parte* EDWIN G. DAUBER, CHRISTIAN E. BAILEY  
and ROBERT L. SASSA

Appeal No. 94-3133  
Application 07/864,700<sup>1</sup>

ON BRIEF

Before ABRAMS, GARRIS and FRANKFORT, *Administrative Patent Judges.*

FRANKFORT, *Administrative Patent Judge.*

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 1 through 10, 14 and 15. Claims 11 through 13

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<sup>1</sup> Application for patent filed April 7, 1992. According to appellants, this application is a continuation-in-part of Application 07/666,435 filed March 11, 1991, now abandoned; and a continuation-in-part of Application 07/496,484 filed March 20, 1990, now abandoned.

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and 16 through 20, the only other claims in the application, stand allowed.

Appellants' invention is directed to a thin, compact adsorbent assembly useful for removing gaseous contaminants from within an enclosure for sensitive equipment, such as, for example, an enclosure for a computer hard disk drive. The subject matter before us on appeal is illustrated by reference to independent claim 1, which reads as follows:

1. An adsorbent assembly having a low profile container for removing unfiltered gaseous contaminants generated within an enclosure consisting of three layers including a layer of an adhesive; a flattened adsorbent layer; and a layer of filtering media of expanded porous polytetrafluoroethylene membrane wherein the adsorbent layer is placed between the adhesive layer and the filtering layer.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Graham	3,505,783	Apr. 14, 1970
Nelson	4,208,194	June 17, 1980
Sassa et al. (Sassa)	4,830,643	May 16, 1989
Osendorf	4,863,499	Sept. 5, 1989
Hayes	4,889,542	Dec. 26, 1989

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Claims 1 through 7, 9 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Osendorf in view of Hayes and Sassa.

Claim 8 stands rejected under 35 U.S.C. § 103 as being unpatentable over Osendorf in view of Hayes and Sassa as applied to claim 1 above, and further in view of Nelson.

Claims 14 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Osendorf in view of Hayes and Sassa as applied to claim 1 above, and further in view of Graham.

Reference is made to the examiner's answer (Paper No. 14, mailed February 22, 1994) for the examiner's complete reasoning in support of the above noted § 103 rejections. Appellants' arguments thereagainst are found in the brief (Paper No. 13, filed December 20, 1993).

#### OPINION

After consideration of appellants' specification and claims, the applied prior art references, and the positions set forth by

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both the examiner and appellants, we have concluded that the combined teachings of the prior art relied upon by the examiner fail to establish a *prima facie* case of obviousness with respect to the claimed subject matter defined in appellants' claims 1 through 10, 14 and 15. This being the case, we will not sustain the examiner's rejections of the appealed claims under 35 U.S.C. § 103. Our reasoning for this determination follows.

We begin by observing that the initial burden of establishing a basis for denying patentability to a claimed invention under 35 U.S.C. § 103 rests upon the examiner. *See In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). We further note that in establishing a *prima facie* case of obviousness under 35 U.S.C. § 103, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference to arrive at the claimed invention. *See Ex parte Clapp*, 227 USPQ 972, 973 (BPAI 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from appellants' own

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disclosure. See, for example, *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir. 1988). If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. See *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

Looking first at the examiner's rejection of claims 1 through 7, 9 and 10 under § 103, we note that the patent to Osendorf discloses an anti-diffusion chemical breather assembly (10) for insertion in an opening of a disk drive housing (Figure 1). Of concern to the patentee is the possible entry of moisture into the disk drive housing and, more particularly, of the need for an apparatus which during shut down periods of the disk drive inhibits or extends the rate of time for moisture entering the drive to reach the internal components thereof (column 1, lines 26-62). As seen best in Figures 2 and 5, the breather assembly comprises a body portion (20), a cover portion (40) and a filter media (50) having two layers (51) and (52). At column 4, lines 27-33, it is noted that the filter media (50) is a high efficiency particulate media (HEPA), wherein the layer (51) is impregnated with activated charcoal granules (53) that facilitate removal of harmful gases from air entering the disk drive

housing. The filter media (50) is received in a recess (46) on the inner side of cover (40) and is sealed thereto by ultrasonically welding filter media layer (52) to the surface (41). An adhesive vinyl ring (48), seen best in Figure 2, is then used to secure any raw edges of the filter media between the ring and the cover (40). See column 4, lines 18-26 of Osendorf.

To further address the above noted moisture problem, the breather assembly in the Osendorf patent includes a tortuous passage (15) in the body portion between an inlet (22) and an outlet (34), so that air entering the disk drive housing from the external environment must traverse the tortuous passage prior to reaching the desiccant layer (51) of the filter media and entering into the disk drive housing. It is noted (column 4, lines 12-18) that the tortuous passage (15) maximizes the distance for inertial separation of contaminants and moisture entering inlet (22) and thereby extends the useful life of the breather filter since moisture and harmful gases dissipated over the length of the passage (15) will not reach the filter element (50).

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The examiner recognizes that Osendorf differs from the subject matter set forth in appellants' claim 1 on appeal in that this patent does not address or disclose an adsorbent assembly consisting of three layers, including a layer of an adhesive, an adsorbent layer, and a layer of filtering media of expanded porous polytetrafluoroethylene membrane wherein the adsorbent layer is placed between the adhesive layer and the filtering media layer as claimed. To account for the several differences, the examiner turns to the teachings of Hayes and Sassa, urging that Hayes (e.g., Figures 1-3) teaches use of a double-sided adhesive (24, 26) on one side of a filter member (10) for securing the filter member to a disk drive housing (12), and that Sassa teaches use of a filtering media (10) made of a porous polytetrafluoroethylene membrane filled with an adsorbent material (12). Relying on these teachings, the examiner reaches the conclusion that

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to provide Osendorf with an adhesive seal at the lower part "51", in view of the showing of Hayes, so that the filter can be attached to the housing, and to structure the filter to be of porous polytetrafluoroethylene filled with the adsorbent, in view of the showing of such structure by Sassa et al (answer, page 3).

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While it is apparent the examiner has shown in the prior art relied upon that certain individual features of the claimed subject matter are known, such a showing alone cannot support a rejection under 35 U.S.C. § 103. Knowledge of separate features is not the appropriate test for obviousness under § 103. Rather, the proper test for obviousness is whether the claimed subject matter taken as a whole, in light of all of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. See *Connell v. Sears Roebuck Co.*, 722 F.2d 1542, 1549, 220 USPQ 193, 199 (Fed. Cir. 1983). Moreover, we observe that the mere fact that the applied references could be combined in a manner which might result in the claimed subject matter does not make the proposed modification obvious unless the references fairly suggest the desirability of the modification. See *In re Gordon*, 733 F.2d 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

In the present case, the dissimilar objectives of the applied references, coupled with the lack of any incentive in the references themselves for making the several modifications proposed by the examiner, leads us to the conclusion that the rejection is not well founded. Like appellants, when we consider

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the teachings of the applied references together, forgetting about what appellants have taught us in the present application, it becomes clear that without appellants' teachings the references themselves would not have fairly motivated the person of ordinary skill in the art to make the various modifications proposed by the examiner in the device of Osendorf so as to arrive at the particular adsorbent assembly defined in appellants' independent claim 1.

The examiner's proposal to eliminate the housing for the filter media (50) of Osendorf (answer, page 5), in our opinion, is unwarranted and contrary to the clear teachings of this patent. As for the proposal to provide adhesive strips at the lower part of layer (51) in Osendorf following the teachings in Hayes, we find such a selective combination of the references to also be unwarranted. If anything, it appears to us that the collective teachings of these patents would have led one of ordinary skill in the art to replace the ultrasonic weld between layer (52) and surface (41) of Osendorf with adhesive mounting tape strips like those of Hayes. Considering the references in their entireties, there is simply nothing in the teachings of

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Osendorf, Hayes and Sassa which fairly suggests an adsorbent assembly "consisting of" three layers including an adhesive layer, an adsorbent layer and a filtering media layer wherein "the adsorbent layer is placed between the adhesive layer and the filtering layer," as claimed by appellants.

Since we have determined that the examiner's conclusion of obviousness is based on a hindsight reconstruction using appellants' own disclosure as a blueprint to arrive at the claimed subject matter from disparate teachings in the prior art, it follows that we will not sustain the rejection of appealed claims 1 through 7, 9 and 10 under 35 U.S.C. § 103.

In addition to the foregoing, we have reviewed the teachings of Nelson and Graham, applied by the examiner in the separate rejections of dependent claims 8, 14 and 15. However, we find nothing in these references which provide for and overcome the deficiencies already noted with regard to Osendorf, Hayes and Sassa. Accordingly, we also will not sustain the examiner's rejection of these claims under 35 U.S.C. § 103.



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