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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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

JAN 26 1996

Ex parte GUNTER SCHMITTCHEN
and
KARL E. VON ECKARDSTEIN

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

Appeal No. 95-4900
Application 08/013,199¹

ON BRIEF

Before MEISTER, ABRAMS and FRANKFORT, Administrative Patent Judges.

MEISTER, Administrative Patent Judge.

DECISION ON APPEAL

Gunter Schmittchen and Karl E. Von Eckardstein (the appellants) appeal from the final rejection of claims 1-11, the only claims present in the application.

¹ Application for patent filed January 29, 1993. According to applicants, the application is a continuation of Application 07/639,975, filed January 11, 1991.

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The appellants' invention pertains to a system for spraying concrete which includes a pump for pumping concrete to a mixing jet, means for supplying compressed air to the mixing jet and a means for controlling the amount of compressed air supplied to the mixing jet in response to the amount of concrete which is pumped by the concrete pump. Independent claim 1 is further illustrative of the appealed subject matter and a copy thereof, as it appears in the appendix to the appellants' brief, is appended to this opinion.

The references of record relied on by the Examiner are:

Weisbrod	4,298,288	Nov. 3, 1981
Green et al. (Green)	4,614,100	Sep. 30, 1986

Claims 1-11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Weisbrod in view of Green. According to the examiner it would have been obvious to provide the concrete spraying device of Weisbrod with means for monitoring the amount of concrete being pumped and thereafter regulating the amount of compressed air being supplied to the mixing jet in response to the amount of concrete monitored in view of the teachings of Green.

Rather than reiterate the arguments of the appellants and the examiner in support of their respective positions, reference is made to the brief, reply brief and answer for the full exposition thereof.

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OPINION

We have carefully reviewed the appellants' invention as described in the specification, the appealed claims, the prior art applied by the examiner and the respective positions advanced by the appellants in the brief and reply brief, and by the examiner in the answer. As a consequence of this review, we will not sustain the above-noted rejection. However, pursuant to our authority under the provisions of 37 CFR § 1.196(b), we will enter new rejections of claims 1-11 under 35 U.S.C. § 112, first and second paragraphs. Our reasons for these determinations follow.

We consider first the rejection of claims 1-11 under 35 U.S.C. § 103. For reasons stated *infra* in our new rejection under the provisions of 37 CFR § 1.196(b), we are of the opinion that claims 1-11 fail to satisfy the requirements of 35 U.S.C. § 112, second paragraph. Normally a claim which fails to comply with the second paragraph of Section 112 will not be analyzed as to whether it is patentable over the prior art since to do so would of necessity require speculation with regard to the metes and bounds of the claimed subject matter. See *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962) and *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). Nevertheless, in this instance, we are of the opinion that the examiner's rejection of claims 1-11 cannot be sustained based on those portions of the claimed

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subject matter that are understandable, namely, the provision of a concrete spraying device with means for (1) monitoring or measuring the amount of concrete being pumped to a mixing jet and (2) regulating the amount of compressed air being supplied to the mixing jet in response to the amount of concrete monitored or measured.

It is the examiner's position that

[t]o regulate the flow of one material in response to the flow conditions of another material is old and well known in the art, as taught by Green. While Weisbrod desires a selectively varied final concrete composition, there is disclosed only means to manually adjust the flow rates of the elements which make up the final concrete composition. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Weisbrod with the monitoring and regulating means of Green, to provide automatic adjustment of the compressed air delivered to the mixing nozzle as a result of the amount of concrete being pumped. Thus, ensuring a desired final composition without manual adjustment of any elements. (see answer, pages 4 and 5)

We will not support this position. The mere fact that (1) Green, as a broad proposition, teaches the regulation of the flow of one material in response to the flow conditions of another material and (2) a "desired final composition" would be achieved in the device of Weisbrod "without manual adjustment of any elements" if the references were combined in the manner proposed by the examiner, does not provide a proper motivation

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for combining the teachings of Weisbrod and Green. Instead, it is the teachings of the prior art taken as a whole which must suggest the desirability of making the modification which the examiner proposes. See *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) and *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Here, the evidentiary record before us is totally devoid of any suggestion or motivation that would have led one of ordinary skill to modify the concrete spraying device of Weisbrod in view of the teachings of Green as the examiner has proposed. As the examiner recognizes, Weisbrod shows a concrete spraying device including a mixing jet, a concrete pump for supplying concrete to the mixing jet and means for supplying a variable amount of compressed air to the mixing jet, but lacks a means to monitor or measure the amount of concrete supplied to the mixing jet and a means to control the amount of compressed air supplied to the mixing jet in response to the amount of concrete monitored or measured. In an attempt to overcome this deficiency the examiner has relied on the teachings of Green, but Green is directed to a completely different type of apparatus from that of Weisbrod. Green is directed to a shot peening apparatus for compressively stressing the outer surface of a work piece. While Green does broadly disclose the measurement of the amount of peening media present in a composite stream of air and peening media being supplied to a blasting nozzle and regulates

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the supply of compressed air in response to this measurement, we are at a complete loss as to why one of ordinary skill in the art would have been motivated to modify the device of Weisbrod in light of Green's disparate teaching as the examiner has proposed. It is well settled that an examiner cannot establish obviousness by locating references which describe various aspects of an applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the applicant has done. See *Ex parte Levengood*, 28 USPQ2d 1300, (BPAI 1993). Since we find no persuasive evidence of such a motivating force, we will not sustain the examiner's rejection of claims 1-11 under 35 U.S.C. § 103.

Under the provisions of 37 CFR § 1.196(b), we make the following new rejections.

Claims 1-11 are rejected under 35 U.S.C. § 112, first paragraph, as being based on a non-enabling disclosure. We initially observe that the test regarding enablement is whether the disclosure, as filed, is sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. See *In re Moore*, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971), *In re Scarbrough*, 500 F.2d 560, 182 USPQ 298 (CCPA 1974) and *In re Wands*, 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir. 1988). The experimentation required, in

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addition to not being undue, must not require ingenuity beyond that expected of one of ordinary skill in the art. See *In re Angstadt*, 537 F.2d 498, 190 USPQ 214 (CCPA 1976). Moreover, the specification must teach those of skill in the art how to make and use the invention as broadly as it is claimed. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

Here, independent claims 1 and 9 each expressly require a means for regulating the amount of compressed air mixed with the concrete stream is that "which produces the **smallest** dust yield when the concrete is supplied" (emphasis ours). While the appellants' disclosure **broadly** teaches that (1) the amount of concrete being supplied to the mixing jet should be monitored or measured and (2) the amount of compressed air being supplied to mixing jet should be controlled in response to this monitored or measured amount in order to achieve a reduction of dust yield, there is absolutely nothing in the appellants' which would teach one of ordinary skill in the art how the **smallest** dust yield is achieved. Page 8 of the appellants' original specification stated that the

desired value of the amount of compressed air is prescribed in such a way as to correspond to the achievable minimal value of fine dust at the jet, which is identical to the smallest quantity of compressed air that is required technically for the concrete. From here one can assume that the relationship of the quantity of compressed air is m^3 per

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minute to the concrete in m³ per hour is about 1 to 1; this rule of thumb **can be improved still more through more exact measurements.** (emphasis ours)

Page 13 of the appellants' original disclosure also stated that

the relationship of the amount of compressed air mixed in per unit of time to the concrete pumped per unit of time is adjusted correspondingly to **a desired value** that corresponds to the smallest fine dust accrual when applying concrete to the surface (6); this is accomplished by the regulating section (21), in which the volume of the concrete pump forms the standard volume for the quantity regulation of the compressed air flowing to the mixing jet (3). (emphasis ours).

There is, however, neither a disclosure of any structure for achieving this "desired value" nor is there any guidance as to how this value is attained. From our perspective, the appellants' disclosure merely suggests that it is possible to adjust the compressed air in such a manner that the "smallest" dust yield is obtained without ever showing how such a result might be achieved. Such a disclosure is merely an invitation to experiment rather than an explanation to the skilled artisan how to make and use the claimed invention and the specification does not contain sufficient information to enable the broad scope of the claims. In this regard, we also observe that when

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appellants choose to rely upon general knowledge in the art to render their disclosure enabling, then the burden rests upon them to establish that those of ordinary skill in the art can be expected to possess or know where to obtain this knowledge. See *In re Howarth*, 654 F.2d 103, 210 USPQ 689 (CCPA 1981).

Claims 1-11 are rejected under 35 U.S.C. § 112, second paragraph. Initially, we note that in order to satisfy the requirements of the second paragraph of Section 112, a claim must accurately define the invention in the technical sense. See *In re Knowlton*, 481 F.2d 1357, 178 USPQ 486 (CCPA 1973). We also observe that language in the preamble of a claim cannot be ignored when determining whether a claim satisfies the requirements of the second paragraph of Section 112. See *Ex parte Kristensen*, 10 USPQ2d 1701 (BPAI 1989). With respect to claims 1-11, we do not believe that these claims accurately define the invention in the technical sense, since the scope of the preambles of independent claims 1 and 9 is inconsistent with the scope of the bodies of these claims. The preambles of independent claims 1 and 9 set forth "[a] concrete pump" *per se* (i.e., the element 1) while the bodies of set forth numerous other elements in addition to the concrete pump, such as a first means for monitoring the amount of concrete pumped by the concrete pump to the mixing jet and a second means for

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controlling the amount compressed air being supplied. It is thus readily apparent that these claims define much more than the "concrete pump" set forth in the preamble and, accordingly, do not accurately define the invention in the technical sense.

In summary:

The examiner's rejection of claims 1-11 under 35 U.S.C. § 103 is reversed.

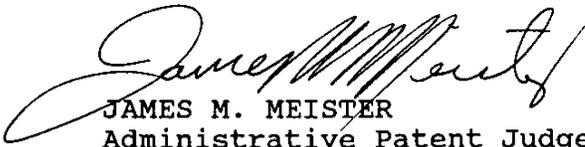
New rejections of claims 1-11 are made under 35 U.S.C. § 112, first and second paragraphs.

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date of the decision (37 CFR § 1.197). Should the appellants elect to have further prosecution before the examiner in response to the new rejections under 37 CFR § 1.196(b) by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision.

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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).

REVERSED
37 CFR § 1.196(b)


JAMES M. MEISTER)
Administrative Patent Judge)

NEAL E. ABRAMS)
Administrative Patent Judge)

CHARLES E. FRANKFORT)
Administrative Patent Judge)

) BOARD OF PATENT
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APPENDIX

1. A concrete pump for the wet spraying process, in which concrete is pumped to a mixing jet and is applied to a surface through the mixing jet with compressed air whereby a concrete dust yield is produced, the improvement comprising a regulator having:

first means for monitoring an amount of concrete pumped; and

second means responsive to said first means for regulating an amount of compressed air flowing to said mixing jet in such a way that a resulting relationship of said amount of compressed air to said amount of concrete pumped corresponds to a desired value which produces the smallest dust yield when the concrete is applied.