

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASATOSHI HIKOSAKA
and HIROYUKI MUTOU

Appeal No. 96-0852
Application 08/116,581¹

ON BRIEF

Before CALVERT, COHEN 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 9, 14 and 16, and from the refusal of the examiner to allow claims 1, 7, 8, 12 and 15 as amended subsequent to the final

¹ Application for patent filed September 7, 1993. According to appellants, this application is a continuation of Application 07/832,915, filed February 10, 1992, now abandoned.

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rejection in papers filed on October 7, 1994 (Paper No. 18) and June 1, 1995 (Paper No. 25). Claims 2 through 6, 10, 11 and 13 have been canceled.

Appellants' invention relates to a process gas chromatographic system. Independent claims 1 and 9 are representative of the subject matter on appeal and a substantially correct copy of those claims may be found in the Appendix to appellants' brief. Claim 1, as seen in the Appendix, was amended by Paper No. 25, filed June 1, 1995, to change "inlet" (second occurrence) in line 62 thereof to -- vent --.

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

Claudy	3,069,894	Dec. 25, 1962
Tinklepaugh et al. (Tinklepaugh)	3,910,765	Oct. 7, 1975
Lamazou et al. (Lamazou) (Swiss Patent Application)	430,278	Feb. 15, 1967

In addition to the foregoing references, the examiner has also relied upon Admitted Prior Art

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set forth on pages 2 and 3 of appellants' specification.

Claims 1, 7 through 9, 12 and 14 through 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lamazou in view of Tinklepaugh, Claudy and the Admitted Prior Art².

The rejection of claims 1, 7 and 8 under 35 U.S.C. § 112, second paragraph made by the examiner as a new ground of rejection in the answer (Paper No. 24, page 6) has now been withdrawn in light of the amendment filed by appellants on June 1, 1995 (see, supplemental answer, page 2) .

Rather than reiterate the examiner's full statement of the above-noted § 103 rejection and the conflicting viewpoints advanced by the examiner and appellants regarding the rejection, we make reference to the examiner's answer (Paper No. 24, mailed April 4, 1995) and supplemental answer (Paper No. 27, mailed September 20, 1995) for the examiner's reasoning in support of the rejection, and to appellants' brief (Paper No. 23, filed January 18, 1995) and reply brief (Paper No. 26, filed June 1, 1995) for appellants' arguments thereagainst.

² hereinafter APA

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determination that we will not sustain the examiner's rejection of claims 1, 7 through 9, 12 and 14 through 16 on appeal. Our reasons follow.

In determining the propriety of a rejection under 35 U.S.C. § 103, it is well settled that the obviousness of an invention cannot be established by combining the teachings of the prior art absent some teaching, suggestion or incentive supporting the combination. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins and Refractories, Inc., 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). The law followed by our court of review, and thus by this Board, is that "[a] prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). See also In re Lalu, 747

F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984) ("In determining whether a case of prima facie obviousness exists, it is necessary to ascertain whether the prior art teachings would appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modification.")

In this case, Lamazou discloses a chromatography installation that addresses similar problems to those addressed by appellants, i.e., 1) heat losses in the sample tubing connecting elements of the installation and 2) the large size and complexity of prior art installations (translation, page 3). As seen best in Figure 1, the installation of Lamazou includes a fixed block (13) that is made of a homogeneous metallic material and which includes recesses and channels that constitute, at least in part, the means for fluid introduction, the calibration means, the means for introduction of the vector or carrier fluid, the detector, and the means for the actuation of at least one column (translation, pages 3-4). The installation further includes chromatographic columns (7, 8) and a toric oven (3) which encloses the chromatographic columns and encircles the block (13).

While the examiner recognizes (answer, page 4) that Lamazou fails to teach or suggest a) a heater in the valve (i.e., in block 13), b) the arrangement of the chromatographic columns in a nested manner, and c) the electronic circuitry and indicator means as set forth in the claims on appeal, we note

that there are several other recited elements of the claims on appeal which are also not found in Lamazou. Most notably, Lamazou fails to teach or suggest 1) an analyzer case having an opening in the lower surface thereof as in the claims on appeal; 2) a manifold formed so as to be fixedly fitted or inserted into said opening, e.g., wherein said manifold provides the means for fixedly coupling the constant temperature oven of the gas chromatographic system with a sample conditioner unit through said opening in the analyzer case as in claim 1 on appeal; and 3) a cylindrical circuit housing protruding horizontally from the analyzer case, with said circuit housing being joined to the analyzer case through “a neck portion, having a predetermined diameter for preventing an influence due to heat conduction from said constant temperature oven” as in the claims on appeal.

The examiner turns to Tinklepaugh for a chromatographic system wherein a heater (44) is located in a heater block (42) that carries the system detector (Figs. 3 and 6), and wherein the electronic control unit for the system is remotely located, with the wires from the components in the heater block being routed through a support pipe (40) to the remote electronic control unit located outside of the oven (Figs. 1 and 6). Claudy is relied upon for a teaching of nesting of the columns in a compact chromatograph, i.e., preheater column (26b) and separation column (24a) as seen in Claudy’s Figure 1.

After carefully reviewing the applied prior art and the examiner's rejection, we share appellants' view that the numerous modifications of Lamazou proposed by the examiner on pages 4 and 5 of the answer are based on impermissible hindsight derived from reliance upon appellants' own teachings. In contrast with the examiner's determinations, we do not consider that the mere existence of the concepts of a heater and a remotely located electronic control unit as in Tinklepaugh, and nested columns as in Claudy, when considered with the APA pointed to by the examiner, are sufficient to have led one of ordinary skill in the art to modifications of Lamazou which would have resulted in a chromatographic system or analyzer as specifically defined by appellants in independent claims 1 and 9 on appeal.

In this regard, we note that a rejection based on § 103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the examiner has the initial duty of supplying the factual basis for the rejection he advances. He may not, because he doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). As our Court of review indicated in In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992), it is impermissible, as the examiner has done here, to use the claimed invention as an instruction manual or "template" to piece together isolated disclosures and teachings of the prior art so that the claimed

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invention may be rendered obvious.

Since we perceive no factual basis in the prior art relied upon which supports the examiner's proposed combinations thereof, and have determined that the examiner's conclusion of obviousness is based on hindsight reconstruction of the claimed invention from isolated, disparate teachings in the prior art and reliance upon appellants' own disclosure, we will not sustain the examiner's rejection of the claims on appeal under 35 U.S.C. § 103.

The decision of the examiner rejecting appealed claims 1, 7 through 9, 12 and 14 through 16 under 35 U.S.C. § 103, accordingly, is reversed.

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

REVERSED

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Administrative Patent Judge)	
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)	BOARD OF PATENT
IRWIN CHARLES COHEN)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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