

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHARON R. HEWINS

Appeal No. 1996-2158
Application 08/100,260

ON BRIEF

Before KIMLIN, ELLIS and WALTZ, ***Administrative Patent Judges***.

ELLIS, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 8 through 11. Claims 1 through 6 have been withdrawn from consideration by the examiner pursuant to 37 CFR § 1.142(b). Claim 7 has been canceled. Claim 9 is illustrative of the subject matter on appeal and read as follows:

9. A method of producing a sculptured product, including the steps of:

obtaining a quantity of microwave-treated material composition prepared by the steps of mixing together (a) a quantity of a premixed mixture of ground cellulose-containing material, plaster of paris, and starch preservative, (b) a quantity of a water-based adhesive resin, and (c) a quantity of talcum powder to form a precursor material composition,

treating the precursor material composition with microwave energy, such that a treated material composition is formed that has a greater volume and greater pliability than the precursor material composition,

manually shaping the microwave-treated material composition, and

curing the manually shaped, microwave-treated material composition.

The references relied upon by the examiner are:

Harris	3,468,414	Sept. 23, 1969
Wu	4,472,185	Sept. 18, 1984

The claims stand rejected as follows:

Claims 8 through 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Harris in view of Wu.

We **reverse**.

DISCUSSION

As evidence from claim 9, above, the present invention is directed to a method of producing a product which involves treating a mixture comprising cellulose, plaster of paris, a starch preservative, a water-based adhesive resin and talcum powder in a

microwave oven such that a composition is formed which has a “greater volume and greater pliability” than the precursor material. After the composition expands with the microwave treatment it is then manually shaped and cured.

The examiner has based his conclusion of obviousness on the teachings of Harris, a patent which discloses a composition containing all the claimed components and a method of making paper mache; and Wu, a patent which discloses a method of producing a cellular ceramic body from a selected, synthetic, lithium and/or sodium, water-swelling mica. The examiner points to the teaching of Harris that

Articles formed of this plastic material are then dried, either at room temperature or at an elevated temperature of the order of 150E F., for example, if more rapid drying is desired, to thereby form a solid object which may be further operated upon as desired, or used directly [Harris, col. 4, lines 38-43].

According to the examiner, Harris only fails “to suggest utilizing microwave energy as an alternative source of heat” in the disclosed method. Answer, p. 3. The examiner argues that Wu discloses “the use of microwave energy to cellululate the floc in water soluble paste compositions. The water acts as a cellululating/foaming agent when it is converted to steam inside the paste and causes an expected effect upon the molded composition.” Answer, p. 4. The examiner concludes that it would have been obvious to one of ordinary skill in the art to utilize microwave energy as the heat source in the intermediate step taught by Harris. ***Id.*** We find this position untenable.

It is well established that the examiner has the initial burden under § 103 to establish a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). It is the examiner's responsibility to show that some objective teaching or suggestion in the applied prior art, or knowledge generally available [in the art] would have led one of ordinary skill in the art to combine the references to arrive at the claimed invention. *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 745 F.3d 1568, 1573, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996).

The method disclosed by Harris differs from that which is disclosed in the claims in more ways than that which is acknowledged by the examiner. What the examiner has referred to as an "intermediate" step of heating the composition in Harris is, in fact, an optional final step. Heating forms a solid object which can be "sawed, filed, cut, sanded, machine-ground, waterproofed and painted,"¹ not manually shaped as required by the claimed method. Thus, the step of heating the composition as disclosed by Harris is equivalent to the curing step in the present method. Here, we find that the examiner has failed to provide any reasons based on the applied prior art, or otherwise, as to why it would have been obvious to one of ordinary skill in the art to heat the

¹ Harris, col. 4, lines 45-46.

composition described by Harris (i) prior to molding or shaping in the manner of the conventional wet paper mache or clay,² and (ii) in a manner such that the treated composition expands a greater volume and has increased pliability. Thus, on this record, we are constrained to reverse.

The decision of the examiner is reversed.

REVERSED

Edward C. Kimlin)	
Administrative Patent Judge)	
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Joan Ellis)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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² Harris, col, 4, lines 32-38.

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