

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HEINZ BECHTOLD

Appeal No. 1998-0784
Application No. 07/949,567

ON BRIEF

Before KIMLIN, GARRIS, and TIMM, *Administrative Patent Judges*.
TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1, 4-9, 14, 16-18, and 24. Claims 19-23 and 25-39, the only other pending claims, were withdrawn from prosecution pursuant to a restriction requirement.

BACKGROUND

Appellant's invention relates to a base plate for use in the production of concrete products. According to Appellant, during concrete product production, the base plate supports a mold which is filled from above with a mixture of cement and sand (specification, page 1). After densification of the concrete mixture, the mold is lifted off the base plate leaving the molded concrete on the base plate (*Id.*). The molded concrete, supported on the base plate, is conveyed to a drying room (*Id.*). During drying and storage, the loaded based plate rests on only two border areas on stacking rails or stacking feet (specification, page 2). Appellant indicates that if the base plate is not entirely flat, hair cracks will develop during hardening of the concrete-sand mixture rendering the finished concrete product useless (*Id.*). To prevent such cracking, the bending rigidity of the base plate must be high (*Id.*). At the time of invention, those in the art normally used solid wood plates as wood is inexpensive and possesses the necessary bending rigidity (*Id.*).

Instead of wood, Appellant's base plate is produced using recycled plastic waste. Importantly, the base plate includes reinforcing rails at a particular location and of a particular height. Claim 1 is illustrative:

1. A base plate configured for preparation of concrete products comprising:
a planar support body made of a plate material, wherein said plate material includes an extruded or pressed thermoplastic component containing recycled plastic waste; and
reinforcing rails located at longitudinal edges of said planar support body;

First, we agree with Appellant that the Examiner has misinterpreted “longitudinal” as used in the claim (Reply Brief, page 1). In the Brief at page 3, Appellant reproduces a sketch of a prior art base plate with metal profiles on the frontal sides of wood planks as was known in the prior art. The location of the metal profiles is shown on the short or width dimension of the rectangular base plate. In the Answer, the Examiner states that the sketch presented in the Brief accurately depicts reinforcing rails on two of the longitudinal ends (Answer, page 4).

The frontal edges as depicted in the Brief are not longitudinal edges. As pointed out by Appellant, “longitudinal” is defined as “1: placed or running lengthwise 2: of or relating to length or the lengthwise dimension” (Reply Brief, page 1, quoting Merriam Webster’s Collegiate Dictionary, 10th Ed. 1996). In order for the planar support body to have “longitudinal edges”, the body must have a lengthwise dimension and a widthwise dimension. The lengthwise dimension must necessarily be the longer dimension. The rails must be located on the long edge. Location of the rails on the widthwise dimension or short edge as shown in Appellant’s sketch of the prior art does result in a base plate which is different than that claimed.

We also agree with Appellant that the Examiner has failed to present any basis to believe that base plates having longitudinal rails were known in the prior art (Brief, pages 3-4). As discussed above, the admitted prior art suggests a metal profile on the frontal sides and Appellant has established, without dispute by the Examiner, that such frontal sides were conventionally shorter than the edges running perpendicular to the frontal sides. Neither Matsuo nor the

Recycling Article describes longitudinal rails. There simply is no evidence that one of ordinary skill in the art would have found it obvious to incorporate reinforcing rails on the longitudinal edges of the planar support body.

Even if it would have been obvious to incorporate longitudinal rails in general, we agree with Appellant that there is no evidence that one of ordinary skill in the art would have found it obvious to incorporate such rails having a height smaller than the height of the planar support body (Brief, pages 4-5). The Examiner cites no basis in the prior art for the use of rails of such height. In the Response to Argument section of the Answer, the Examiner seems to imply that Appellant must establish that the height of the rails is critical in view of the fact that the specification, on page 3, states that “[t]he height of the reinforcing rails may be equal to or smaller than the height of the base plate.” The Examiner seems to think that since Appellant discloses that either height can be used, the height is an *art* recognized variable. But Appellant did not disclose that use of either height was prior art to him. There is a basic difference between (a) a showing by an applicant of what was *known in the art* to be equivalents and (b), a showing that the *applicant has found*, as a part of his or her discovery or inventive process, that certain things may be used to achieve the same result. Equivalence taught by an applicant but not known to those of ordinary skill in the art at the time cannot be said to be recognized in the prior art. *In re Ruff*, 256 F.2d 590, 596-597, 118 USPQ 340, 346 (CCPA 1958). A determination of obviousness cannot be based on Appellant’s own invention. There must be some basis in the

references or knowledge known to those of ordinary skill in the art for concluding that the claimed subject matter would have been obvious.

“A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field.” *In re Kotzab*, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). “The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.” *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)(quoting *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985). To establish a *prima facie* case of obviousness, “there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant.”

In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998). In our view, the Examiner used the description of the invention provided in the specification as a blueprint for the rejection. Thus, the record indicates that the Examiner used impermissible hindsight when rejecting the claims. *See W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *In re Rothermel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960). Accordingly, we reverse the examiner’s rejection for the reasons set forth above and as developed in Appellant’s Brief.

As all the other claims on appeal depend from claim 1, we conclude that the Examiner has failed to establish a *prima facie* case of obviousness with respect to the subject matter of claims 1, 4-9, 14, 16-18, and 24.

OTHER ISSUES

The language used on line 9 of claim 1 appears to be inaccurate. It appears that “finished product” is meant to read “finished base plate” as that is the language used in the specification at page 7, line 32 and “product” is used in the preamble of the claim to refer to the concrete article formed and not to the base plate. We trust that the Appellant and Examiner will resolve inconsistency in the claim.

CONCLUSION

To summarize, the decision of the Examiner to reject claims 1, 4-9, 14, 16-18, and 24 under 35 U.S.C. § 103 is reversed.

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
)	
)	
)	
)	
)	BOARD OF PATENT
BRADLEY R. GARRIS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
CATHERINE TIMM)	
Administrative Patent Judge)	

CT/jrg

Appeal No. 1998-0784
Application No. 07/949,567

Page 9

ROBERT J. KOCH
FULBRIGHT AND JAWORSKI
801 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20004

