

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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN W. EASON et al.

Appeal No. 1998-1258
Application No. 08/442,676

Heard: November 16, 2000

Before ABRAMS, McQUADE, and LAZARUS, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 17-29, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a method for loading a plurality of doses of particulate material into apertures in a plate. An understanding of the invention can be derived from a reading of exemplary claim 17, which appears in the appendix to the appellants' Brief.

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

Schaefer	3,208,192	Sep. 28, 1965
Ulveling <u>et al.</u> (Ulveling)	4,702,288	Oct. 27, 1987
Cocozza <u>et al.</u> (Cocozza)	5,207,217	May 4, 1993
Boyhan	5,271,209	Dec. 21, 1993

Claims 17-19, 21, 22, 24 and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Boyhan in view of Ulveling.

Claim 23 stands rejected under 35 U.S.C. § 103 as being unpatentable over Boyhan in view of Ulveling and Cocozza.

Claims 20 and 26-29 stand rejected under 35 U.S.C. § 103 as being unpatentable over Boyhan in view of Ulveling and Schaefer.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the Answer (Paper No. 14) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 13) and Reply Brief (Paper No. 16) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Independent claim 17 is directed to a method of loading a plurality of doses of a predetermined amount of particulate material into the apertures of a plate. The method comprises the steps of supporting the plate on a porous bed in such a position that the apertures communicate with a reservoir of an excess amount of particulate material, exerting sufficient gaseous pressure on the material to cause it to fill the apertures, with the porous bed allowing gas to escape while preventing the particulate material from being expelled, and separating the filled apertures from the reservoir. The examiner is of the view that the subject matter of this claim is unpatentable on the basis of the combined teachings of Boyhan and Ulveling. In particular, it is his position that Boyhan teaches all of the features of the claim except for the packaging of particulate material and the use of pressurized gas to force it into the apertures, but that it would have been obvious to utilize the Boyhan bottom plate "with reduced components and a middle plate with correspondingly reduced holes to pass a supply of powdered material from a supply into said compartments in order to evenly distribute the powder into individual compartments

with a minimum of waste,” and to “use the method of forcing powder out of a source by means of pressurized nitrogen as taught by ULVELING ET AL . . . in order to push the powdered material into the compartments of BOYHAN in a rapid and controllable manner” (Answer, page 5). The appellants take issue with this theory, primarily on the basis that neither reference teaches the use of a porous member in conjunction with the disclosed methods and, even if such were the case, no suggestion exists to combine the teachings of the references in the manner proposed by the examiner.

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, 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 or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 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 the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

Boyhan is directed to an apparatus and method for packaging discrete articles such as pieces of candy into an apertured container. As explained with regard to Figures 1-I through 1-IV, this is accomplished by placing first pieces to be packaged into first cavities (14) in a first plate member (10) and second pieces to be packaged in second cavities (20) in a second plate (16). The first and second cavities are not aligned with one another, but the first cavities are aligned with openings (22) in the second plate which are interposed between the second cavities. In order to load the package, the second plate is oriented over the first plate and the package is placed upside down over the second plate, as shown in Figure 1-III, whereupon all three components are inverted, causing the second pieces to fall directly into cavities in the package and the first pieces to fall through the apertures in the second plate member into others of the cavities in the package. Thus, the motivating force for loading the articles is the influence of gravity. Boyhan is not concerned with loading apertures with particulate material, but with discrete articles, so the problems to which the appellants' method is concerned are not recognized. In addition, from our perspective, Boyhan fails to disclose or teach using a porous member that will allow the passage of gas but prevent the passage of the material being loaded, as well as loading the material by means of gas pressure.

Ulveling is concerned with injecting powdered coal into a furnace. This is accomplished by alternately loading a pair of intermediate silos (24A and 24B) by

powdered coal and then charging them with gas at a pressure sufficiently high to force the coal into the furnace against the pressure existing therein. We specifically take note of the fact that this reference does not utilize a porous bed in communication with the reservoir of powdered coal.

It is axiomatic that the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In the present case, we fail to perceive any teaching, suggestion or incentive in either reference which would have led one of ordinary skill in the art to modify Boyhan in the manner set forth by the examiner. To do so would require: (1) that the Boyhan invention be converted from loading discrete articles to loading particulate material;

(2) that a porous bed that permits the passage of gas but prohibits the passage of the particulate material be provided beneath the plate in which the apertures are located; and

(3) that the gravity-operated loading mechanism disclosed by Boyhan be discarded in favor of a gas-operated system. Such a wholesale reconstruction essentially destroys the Boyhan invention, which would act as a disincentive to one of ordinary skill in the art to do so. In our opinion, the only suggestion for making the changes set forth by the examiner is found in the hindsight afforded one who first viewed the appellants' disclosure. This, of

course, is not a proper basis for a rejection under 35 U.S.C. § 103. See In re Fritch, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

The shortcomings we have found in the combination of Boyhan and Ulveling are not alleviated by considering Cocozza, which further was cited with regard to dependent claim 23, or Schaefer, which was added with regard to dependent claims 20 and 26-29.

We therefore will not sustain the rejection of independent claim 17 or, it follows, of dependent claims 18-29.

SUMMARY

None of the rejections are sustained.

The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	
Administrative Patent Judge)	APPEALS AND
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APPEAL NO. 1998-1258 - JUDGE ABRAMS
APPLICATION NO. 08/442,676

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Three judge conference

DECISION: REVERSED

Prepared By:

DRAFT TYPED: 03 Jul 01

FINAL TYPED: