

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL M. MAKOWIECKI, JOHN A. KERNS,
CRAIG S. ALFORD and MARK A. MCKERNAN

Appeal No. 1998-2207
Application 08/627,162

ON BRIEF

Before GARRIS, PAK, and WARREN, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-12, 31, and 32. The only other claims remaining in the application, which are claims 13-19, have been indicated by the examiner as being allowable.

Appeal No. 1998-2207
Application No. 08/627,162

The subject matter on appeal relates to a process for coating material composed of particles, fibers, and powders comprising the steps of depositing thereon a layer of adhesion material using a sputter technique and depositing a material on the adhesion material layer. This appealed subject matter is adequately illustrated by independent claim 1¹ which reads as follows:

1. A process for coating material composed of particles, fibers, and powders, comprising:

depositing a layer of adhesion material on the material to be coated using a sputtering technique, and

¹ The record before us reflects that the appellants and the examiner have implicitly interpreted the appealed claim 1 phrase "coating material composed of particles, fibers, and powders" as including (at least essentially) only the specifically recited particles, fibers and powders. Our study of the subject specification reveals that such an interpretation is reasonable and consistent with the specification disclosure. Regarding claim interpretation generally, see In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). Also regarding interpretation of the claim phrase "composed of", specifically, see AFG Industries, Inc. v. Cardinal IG Company, Inc., 239 F.3d 1239, 1248, 57 USPQ2d 1776, 1780-81 (Fed. Cir. 2001). As a consequence, we also will so interpret this claim in our disposition of the appeal.

Appeal No. 1998-2207
Application No. 08/627,162

depositing at least one layer of at least one material on the layer of adhesion material.

The references relied upon by the examiner as evidence of obviousness are:

Cairns et al. (Cairns)	4,046,712	Sep. 06, 1977
Carcia	4,563,482	Aug. 20, 1985
Keem et al. (Keem)	4,619,865	Oct. 28, 1986
Takeshima (Takeshima '523)	4,940,523	Jul. 10, 1990
Geodicke	5,470,388	Nov. 28, 1995
Takeshima et al. (Takeshima '922)	JP 5-271,922	Oct. 19, 1993

All of the appealed claims stand rejected under 35 U.S.C. § 103 as being unpatentable over Keem, in view of Cairns, Carcia, Takeshima '523, Geodicke, and Takeshima '922.

This rejection cannot be sustained.

As previously indicated, appealed independent claim 1 is directed to a process for coating particles, fibers and powders. The only other independent claim on appeal, which is claim 31, is directed to a process for coating particulate

Appeal No. 1998-2207
Application No. 08/627,162

material specifically. According to the appellants, the primary reference to Keem contains no teaching or suggestion of coating such materials. In the paragraph bridging pages 15 and 16 of the answer, the examiner responds to this argument in the following manner:

In response to the argument that Keem et al. nowhere teaches that other types of substrates, other than the illustrated flat type can be used, it is agreed that Keem et al. do not specifically mention coating "particles, fibers, and powders". However, Keem et al. do indicate that "other substrate" materials can be used and that graphite and plastic substrates can be used. (See Keem et al. discussed above)

The examiner's answer does not contain a specific exposition of an obviousness conclusion regarding the here claimed materials much less of the supporting rationale therefore. Nevertheless, it is reasonably clear that the examiner believes the disclosure of the Keem patent would have suggested using patentee's coating process for coating materials of the type here claimed, namely, particles, fibers,

Appeal No. 1998-2207
Application No. 08/627,162

powders and particulate materials.² From our perspective, the Keem disclosure contains no suggestion for coating such materials.

Keem discloses a process for coating surfaces or substrates which are specifically disclosed to be in the form of valve piston rings (see example 1 in column 11), a flat plate (see example 2 in column 11) and the cutting edge of a tool (see claims 43 and 44 in column 14). As alluded to by the examiner in the above quotation, patentee teaches that the low temperature sputtering operation of his process is particularly useful for coating certain materials including graphite, plastics, and other substrate materials which are adversely affected by elevated temperature (see lines 43-52 in column 10). However, we perceive nothing and the examiner

²Based on the record before us, it is also clear that the examiner does not rely upon any of the secondary references for a suggestion of using Keem's process for coating the here claimed materials. Instead, these secondary reference are relied upon by the examiner for a suggestion of providing Keem's process with an agitation step (which relates to a feature recited only in certain dependent claims on appeal); e.g., see the last paragraph on page 13 of the answer.

Appeal No. 1998-2207
Application No. 08/627,162

points to nothing in this portion or any other portion of Keem's disclosure which would have suggested coating materials in the form of particles, fibers, powders, or particulate materials as here claimed. The mere fact that the Keem process could be modified for coating such materials does not make the modification obvious unless the prior art would have suggested the desirability of the modification. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

In short, the examiner has failed to carry his initial burden of establishing a prima facie case of obviousness vis-à-vis the use of Keem's process for coating materials of the type of here claimed. It follows that we cannot

sustain the examiner § 103 rejections of the appealed claims as being unpatentable over Keem in view of Cairns, Carcia, Takeshima '523, Geodicke and Takeshima '922.

Appeal No. 1998-2207
Application No. 08/627,162

The decision of the examiner is reversed.

REVERSED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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CHUNG K. PAK)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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CHARLES F. WARREN)	
Administrative Patent Judge)	

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Appeal No. 1998-2207
Application No. 08/627,162

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