

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 YOSHINARI YASUI and TAKASHI IWASAKI

Appeal No. 1998-3271
Application 08/563,156

ON BRIEF

Before PAK, WARREN and OWENS, **Administrative Patent Judges**.
OWENS, **Administrative Patent Judge**.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 3-30 and 32, which are all of the claims remaining in the application.

THE INVENTION

The appellants claim an apparatus for applying a liquid coating to a surface of a traveling continuous web. Claims 3 and 5 are illustrative and a copy of the claims is appended to this decision.

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THE REFERENCES

Landis et al. (Landis)	4,324,816	Apr. 13, 1982
Kasamatsu	4,708,629	Nov. 24, 1987
Chino et al. (Chino)	5,072,688	Dec. 17, 1991
Watanabe et al. (Watanabe)	5,145,528	Sep. 08, 1992
Columbus et al. (Columbus)	5,334,247	Aug. 02, 1994

(filed Jul. 25, 1991)

THE REJECTIONS

The claims stand rejected as follows: claims 6, 20 and 32 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention;¹ claims 5-30 and 32 under 35 U.S.C. § 112, first paragraph, written description requirement; claim 3 under 35 U.S.C. § 103 as being obvious over Kasamatsu; claim 4 under 35 U.S.C. § 103 as being obvious over Kasamatsu in view of Chino; claims 5-11 and 18-25 under 35 U.S.C. § 102(b) as being anticipated by Watanabe; claims 5-8, 12, 18-20, 26 and 27 under 35 U.S.C.

¹ In the examiner's answer this rejection is set forth as being under the 35 U.S.C. § 112, first paragraph, enablement requirement. However, the rejection is argued as if it were under 35 U.S.C. § 112, second paragraph, using the same language used in the final rejection (mailed September 20, 1996, paper no. 15, page 3) wherein the rejection is stated to be under 35 U.S.C. § 112, second paragraph. Thus, we consider the examiner's statement in the examiner's answer that the rejection is under 35 U.S.C. § 112, first paragraph, to be inadvertent and treat the rejection as if it is under 35 U.S.C. § 112, second paragraph.

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§ 102(e) as being anticipated by Columbus;² claims 5-8, 18-20 and 24 under 35 U.S.C. § 102(b) as being anticipated by Landis; and claims 21, 22, 25 and 28 under 35 U.S.C. § 103 as being obvious over Landis.³

OPINION

We reverse the rejections under 35 U.S.C. § 112 and the rejection under 35 U.S.C. § 102(b) over Landis, and affirm the remaining rejections.

The appellants indicate that the claims stand or fall in three groups: 1) claims 3 and 4, 2) claims 5-28, and 3) claims 29 and 30 (brief, page 5). Claims 29 and 30 are not rejected over prior art. With respect to the prior art rejections, therefore, we limit our discussion to one claim within each of the first two

² The examiner's answer states that this rejection is under 35 U.S.C. § 103(e), which does not exist. The examiner argues the rejection as if it were under 35 U.S.C. § 102(e), and this rejection is set forth in the final rejection (page 6) as being under 35 U.S.C. § 102(e). We therefore consider the examiner's statement of the rejection in the examiner's answer as being under 35 U.S.C. § 103 to be inadvertent and treat the rejection as if it is under 35 U.S.C. § 102(e).

³ In each of the rejections in the examiner's answer except the rejections under 35 U.S.C. § 103 of claims 3 and 4 and the rejection of claims 5-11 and 18-25 under 35 U.S.C. § 102(b) over Watanabe, the examiner omits some claims which were rejected in the final rejection. Also, the examiner omits from the examiner's answer rejections which were made in the final rejection of claims 29 and 30 under 35 U.S.C. § 102(b) over U.S. 5,188,789 to Nishiura, and claim 4 under 35 U.S.C. § 103 over Nishiura in view of U.S. 4,142,010 to Pipkin et al. We consider the rejections of claims which were rejected in the final rejection but not the examiner's answer to be withdrawn by the examiner.

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groups, i.e., claims 3 and 5, and to one claim, i.e., claim 21, from among claims 21, 22, 25 and 28 which are separately rejected.⁴ **See *In re Ochiai***, 71 F.3d 1565, 1566 n.2, 37 USPQ2d 1127, 1129 n.2 (Fed. Cir. 1995); 37 CFR § 1.192(c)(7) (1997).

***Rejection of claims 6, 20 and 32 under
35 U.S.C. § 112, second paragraph***

The relevant inquiry under 35 U.S.C. § 112, second paragraph, is whether the claim language, as it would have been interpreted by one of ordinary skill in the art in light of the appellants' specification and the prior art, sets out and circumscribes a particular area with a reasonable degree of precision and particularity. **See *In re Moore***, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

The examiner argues that "[c]laims 6, 20 and 32 are confusing since it is unclear how the feed block can be inboard of the tip portion when applicant has recited the tip portion exterior surface is part of the feed block" (answer, page 4). The examiner, however, has not explained why the claim language, as it would have been interpreted by one of ordinary skill in the

⁴ Claim 4 is separately rejected under 35 U.S.C. § 103 over Kasamatsu in view of Chino. The appellants, however, provide no separate argument with respect to this rejection but, rather, state that claim 4 stands or falls with claim 3. We therefore do not separately address the rejection of claim 4 but, rather, consider it to stand or fall with claim 3.

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art in light of the appellants' specification and the prior art, fails to set out and circumscribe a particular area with a reasonable degree of precision and particularity. Particularly, the examiner has not explained why the appellants' figures would not have indicated to one of ordinary skill in the art that claims 6, 20 and 32 merely require that the feed block is on the side of the tip surface opposite the web. Accordingly, we reverse the rejection under 35 U.S.C. § 112, second paragraph.

***Rejection of claims 5-30 and 32
under 35 U.S.C. § 112, first paragraph***

The examiner argues that "[t]he specification fails to disclose the coating apparatus is comprised of a feed block having a base portion and a taper portion including a tip portion and it is unclear how these elements relate to the back block and doctor block set forth by appellant in the specification" (answer, page 4).

"To comply with the description requirement it is not necessary that the application describe the claimed invention in *ipsis verbis*, ***In re Lukach***, 58 CCPA 1233, 442 F.2d 967, 169 USPQ 795 (1971); all that is required is that it reasonably convey to

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persons skilled in the art that, as of the filing date thereof, the inventor had possession of the subject matter later claimed by him." ***In re Edwards***, 568 F.2d 1349, 1351-52, 196 USPQ 465, 467 (CCPA 1978). If "the specification contains a description of the claimed invention, albeit not *in ipsius verbis* (in the identical words), then the examiner or Board, in order to meet the burden of proof [of lack of adequate written description], must provide reasons why one of ordinary skill in the art would not consider the description sufficient." ***In re Alton***, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996).

The appellants' specification describes the coating apparatus in terms of a back block (20) and a doctor block (21), each having a base portion and a tip portion, and illustrates this apparatus (figures 1-8). The specification differs from the present claims by using the terms "back block" and "doctor block" instead of "feed block". The examiner has not provided the required reasoning in support of the argument that the disclosure of "back block" and "doctor block" would not have reasonably conveyed to one of ordinary skill in the art that the appellants had possession of a coating apparatus having a feed block as

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presently claimed. Consequently, we reverse the examiner's rejection under 35 U.S.C. § 112, first paragraph.

Rejections of claim 3 under 35 U.S.C. § 103 over Kasamatsu and claim 4 over Kasamatsu in view of Chino

Kasamatsu discloses an apparatus for applying a liquid coating (10) to a surface of a traveling continuous web (15), including a die (1) (i.e., a nozzle) extending across the width of the web transversely to a direction of the web (figure 5), the die including a plurality of spaced apart discharge openings (4) arranged at predetermined distances in a row along the longitudinal direction of the die (figure 4), a flat surface (71) at a tip of the die facing the web (figure 5), the flat surface being downstream of the discharge openings respecting the direction of travel of the web (figure 3A), for governing thickness uniformity of the coating applied to the traveling web from the die (col. 3, lines 24-28; figure 5). Thus, Kasamatsu anticipates the apparatus recited in the appellants' claim 3.

The appellants argue that "the flat surface recited in claim 3 as being at the tip of the nozzle facing the web is not anticipated by surface 70 in Kasamatsu as contended by the

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examiner" (brief, page 11). Because Kasamatsu's disclosure does not include a surface 70, we assume that the appellants are referring to surface 71 relied upon by the examiner (answer, page 8). The appellants provide no supporting explanation for their argument, and none is apparent. Surface 71 is at the tip of the nozzle as shown in Kasamatsu's figure 5, and it provides thickness uniformity across the total width of the substrate (col. 3, lines 28-28).

Because anticipation is the epitome of obviousness, **see In re Skoner**, 517 F.2d 947, 950, 186 USPQ 80, 83 (CCPA 1975); **In re Pearson**, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974), we affirm the rejection of claim 3 under 35 U.S.C. § 103, and affirm the rejection of claim 4 which stands or falls therewith.

***Rejection of claims 5-11 and 18-25
under 35 U.S.C. § 102(b) over Watanabe***

Watanabe discloses an apparatus for applying coating material under pressure (col. 4, lines 59-61) to a surface of a traveling continuous web (1), comprising a longitudinally elongated feed block (7, 8; figure 2) transversely disposed with respect to the direction of the web travel (figure 2), the feed

block having a base portion remote from the web and a taper portion more proximate the web (figure 2), the feed block having a coating supply reservoir (13) within the base portion and extending longitudinally substantially the length thereof (figures 2 and 3), the taper portion tapering from the base portion towards the web and terminating in a tip portion proximate the web (figure 2), the tip portion including an exterior surface (10) which extends longitudinally the length of the tip portion and parallel with and facing the web (figure 2), the feed block having a plurality of coating feed passageways (14) terminating in apertures (11) formed in the tip portion exterior surface, the apertures communicating with the reservoir via respective associated coating feed passageways serially disposed with a longitudinally elongated passageway in the feed block (figure 3). Hence, Watanabe anticipates the apparatus recited in the appellants' claim 5.

The appellants argue that Watanabe's figure 5 shows that each of the apertures is connected to a common groove rather than to a plurality of feed passageways as required by the appellants' claim 5 (brief, pages 10-11). This argument is not persuasive

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even if it is correct, because Watanabe's figure 5 pertains to a second embodiment (col. 6, lines 9 and 38), and the apparatus recited in the appellants' claim 5 is anticipated by Watanabe's first embodiment (col. 4, line 45 - col. 6, line 8), which is the embodiment discussed above.

Accordingly, we affirm the rejection of claims 5-11 and 18-25 over Watanabe.

***Rejection of claims 5-8, 12, 18-20, 26 and 27
under 35 U.S.C. § 102(e) over Columbus***

Columbus discloses an apparatus for applying a coating material under pressure to a surface of a traveling continuous web (abstract; col. 3, lines 32-38; figure 12), comprising a longitudinally elongated feed block (120A) transversely disposed with respect to the direction of web travel (figures 12 and 13), the feed block having a base portion remote from the web and a taper portion more proximate the web (figure 12), the feed block having a coating supply reservoir within the base portion and extending longitudinally substantially the length thereof (figures 12 and 13), the taper portion tapering from the base portion towards the web and terminating in a tip portion

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proximate the web (figures 7 and 12), the tip portion including an exterior surface which extends longitudinally the length of the tip portion and parallel with and facing the web (figures 6, 12 and 13), the feed block having a plurality of coating feed passageways terminating in apertures formed in the tip portion exterior surface (figure 11), the apertures communicating with the reservoir via respective associated coating feed passageways serially disposed with a longitudinally elongated passageway in the feed block (figures 6 and 11). Thus, the appellants' claim 5 is anticipated by Columbus.

The appellants argue (brief, page 11): "Claim 5 recites that the feed block has 'a coating supply reservoir within said base portion and extending longitudinally substantially the length thereof'. Accordingly, Columbus does not anticipate claim 5 under 35 U.S.C. §102(e)." The appellants do not define "substantially" in their specification. The common meanings of this term include "[b]eing of considerable importance, value, degree, amount, or extent".⁵ Columbus' figure 13 shows the coating supply reservoir extending well over half way along the

⁵ *Webster's II New Riverside University Dictionary* 1155 (Riverside 1984).

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length of the base portion, which is a considerable extent. Consequently, we are not persuaded by the appellants' argument. Accordingly, we affirm the rejection of claims 5-8, 12, 18-20, 26 and 27 over Columbus.

***Rejection of claims 5-8, 18-20 and 24
under 35 U.S.C. § 102(b) over Landis***

In order for a claimed invention to be anticipated under 35 U.S.C. § 102(b), all of the elements of the claim must be found in one reference. ***See Scripps Clinic & Research Found. v. Genentech Inc.***, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

Landis discloses an apparatus for applying a coating material under pressure to a surface of a continuous web (figure 1), comprising a feed block (24), the feed block having a base portion remote from the web and a taper portion more proximate the web (figure 1), the feed block having a coating supply reservoir within the base portion (figures 2 and 4), the taper portion tapering from the base portion towards the web and terminating in a tip portion proximate to and facing the web (figure 1), the feed block having a plurality of coating feed

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passageways (41, 42) terminating in apertures formed in the tip portion exterior surface (figures 2 and 4), the apertures communicating with the reservoir via respective associated coating feed passageways in the feed block (figures 2 and 4).

The examiner argues that Landis discloses a "longitudinally elongated passageway 40 in the feed block" (answer, page 6). Landis, however, shows hopper 6 as being generally cylindrical (col. 3, lines 54-56). Thus, it reasonably appears that die 40 within hopper 6 is cylindrical rather than elongated as argued by the examiner.

The examiner argues that Landis' hopper 6 is elongated versus its width (answer, page 10). The appellants' claim 5, however, requires that the coating feed passageways are "serially disposed with a longitudinally elongated passageway in said feed block." If the longitudinal direction is considered to be the vertical direction in Landis' figures, as argued by the examiner, then the coating feed passageways are not serially disposed with this passageway. Instead, they are serially disposed in a direction perpendicular to the longitudinally elongated passageway.

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We find that, for the above reasons, the examiner has not set forth a factual basis which is sufficient for establishing a *prima facie* case of anticipation of the apparatus recited in the appellants' claim 5 and claims 6-8, 18-20 and 24 which depend therefrom. Consequently, we reverse the rejection under 35 U.S.C. § 102(b) over Landis.

***Rejection of claims 21, 22, 25 and 28
under 35 U.S.C. § 103 over Landis***

The appellants' claim 5, from which claim 21 indirectly depends, requires a longitudinally elongated feed block which is transversely disposed with respect to the direction of web travel and which has coating feed passageways which are serially disposed with a longitudinally elongated passageway therein. Landis discloses what appears to be a cylindrical die (40) having two bores (41 and 42) therein (figures 2 and 4). Landis prefers that the two bores are positioned such that the plane defined by the bores and the line connecting them are perpendicular to the direction of web travel so that the maximum coating stripe width/thickness ratio is obtained (col. 4, lines 20-26). Landis also teaches that instead of two bores, a higher number of bores, such as six, can be used to form wider coating stripes (col. 5,

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lines 27-30). This teaching of use of a larger number of bores in the direction perpendicular to the direction of web, together with the teaching by Landis that the hopper can have various configurations other than the generally cylindrical configuration exemplified for two bores (col. 3, lines 54-56), would have fairly suggested, to one of ordinary skill in the art, forming an elongated hopper (6) and die (40) in the direction of a row of a higher number of bores used to form a wider stripe, in order to accommodate the higher number of bores. Such a person would not have been led by Landis to enlarge the hopper and die also in the direction perpendicular to the row of bores, such as by using a larger cylindrical hopper and die to accommodate a longer row of bores, because such an enlargement would provide no operational benefit and would waste hopper and nozzle material.

Claim 18, from which claim 21 depends, requires that the apertures are longitudinally evenly spaced. Landis' teaching that the coating stripe is to have a uniform thickness across its width (col. 4, lines 55-59) would have fairly suggested, to one of ordinary skill in the art, making the bores evenly spaced in order to obtain this uniform thickness.

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Claim 21 requires that the aperture shape is rectangular. Landis teaches that it is preferred but not essential that the bores are cylindrical because a column extruded from a non-cylindrical bore usually impinges on the moving web before assuming a fully cylindrical configuration (col. 5, lines 18-24). This teaching that a cylindrical bore is not essential would have fairly suggested, to one of ordinary skill in the art, using a common non-cylindrical shape such as rectangular. Hence, we affirm the rejection of claims 21, 22, 25 and 28 under 35 U.S.C. § 103 over Landis.

REMAND

The application is remanded to the examiner to consider rejecting claim 5 and the claims which depend directly or indirectly therefrom, other than already-rejected claims 21, 22, 25 and 28, under 35 U.S.C. § 103 over Landis.⁶

DECISION

The rejections of claims 6, 20 and 32 under 35 U.S.C. § 112, second paragraph, claims 5-30 and 32 under 35 U.S.C. § 112, first paragraph, written description requirement, and claims 5-8, 18-20

⁶ The examiner particularly should consider claim 23 which requires that the apertures are longitudinally aligned. This claim, which presently is not rejected over Landis, depends from a claim which is rejected over that reference.

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and 24 under 35 U.S.C. § 102(b) over Landis are reversed. The rejections of claim 3 under 35 U.S.C. § 103 over Kasamatsu, claim 4 under 35 U.S.C. § 103 over Kasamatsu in view of Chino, claims 5-11 and 18-25 under 35 U.S.C. § 102(b) over Watanabe, claims 5-8, 12, 18-20, 26 and 27 under 35 U.S.C. § 102(e) over Columbus, and claims 21, 22, 25 and 28 under 35 U.S.C. § 103 over Landis, are affirmed.

AFFIRMED-IN-PART and REMANDED

CHUNG K. PAK)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES F. WARREN)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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TERRY J. OWENS)	
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Appendix
Claims 3 and 5

3. Apparatus for applying a liquid coating to a surface of a traveling continuous web, comprising:
- a. a nozzle extending longitudinally across the width of the web transversely to direction of web travel, said nozzle including a plurality of spaced apart discharge openings arranged at predetermined distances in a row along the longitudinal direction of said nozzle;
 - b. a flat surface at a tip of said nozzle facing said web, said flat surface being downstream of said discharge openings respecting the direction of travel of said web, for governing thickness uniformity of said coating applied to said traveling web from said nozzle.
5. Apparatus for applying coating under pressure to a surface of a traveling continuous web comprising:
- a. a longitudinally elongated feed block transversely disposed with respect to direction of web travel;
 - b. said feed block having a base portion remote from said web and a taper portion more proximate said web;
 - c. said feed block having a coating supply reservoir within said base portion and extending longitudinally substantially the length thereof;
 - d. said taper portion tapering from said base portion towards said web and terminating in a tip portion proximate said web;

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- e. said tip portion including an exterior surface which extends longitudinally the length of said tip portion and parallel with and facing said web;
- f. said feed block having a plurality of coating feed passageways terminating in apertures formed in said tip portion exterior surface, said apertures communicating with said reservoir via respective associated coating feed passageways serially disposed with a longitudinally elongated passageway in said feed block.