

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES G. MACKU and JOHN A. TRYGG

Appeal No. 1999-0313
Application No. 08/918,089¹

ON BRIEF

Before NASE, CRAWFORD, and GONZALES, Administrative Patent Judges.

NASE, Administrative Patent Judge.

¹ Application for patent filed August 25, 1997. According to the appellants, the application is a continuation of Application No. 08/567,431, filed December 5, 1995, now abandoned.

Appeal No. 1999-0313
Application No. 08/918,089

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 29 through 68, which are all of the claims pending in this application.²

We AFFIRM-IN-PART.

² Claims 54 and 63 were amended subsequent to the final rejection.

BACKGROUND

The appellants' invention relates to an asphalt paver with remixing conveyor system. An understanding of the invention can be derived from a reading of exemplary claim 54, 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:

Brown et al. (Brown) 1991	5,002,426	Mar. 26,
Miller 1993	5,240,321	Aug. 31,
Reed 10, 1996	5,553,969	Sep.
		(filed Feb. 13, 1995)
Hoffman ³ 1971	1,584,435 (Germany)	Sep. 9,
Pietro	1,011,358 (Canada)	May 31, 1977
Gerard ⁴	2,648,168 (France)	Dec. 14, 1990

³ In determining the teachings of Hoffman, we will rely on the translation provided by the PTO. A copy of the translation is attached for the appellants' convenience.

⁴ In determining the teachings of Gerard, we will rely on the translation provided by the PTO. A copy of the translation is attached for the appellants' convenience.

The rejections before us on appeal as set forth in the examiner's answer (Paper No. 22, mailed Oct. 26, 1998) are:

- (1) Claims 29 to 35, 37, 38 and 49 to 52 under 35 U.S.C. § 103 as being unpatentable over Brown in view of Reed;
- (2) Claim 36 under 35 U.S.C. § 103 as being unpatentable over Brown in view of Reed and Hoffman;
- (3) Claims 39 to 43 under 35 U.S.C. § 103 as being unpatentable over Brown in view of Reed and Pietro;
- (4) Claims 44 and 53 under 35 U.S.C. § 103 as being unpatentable over Brown in view of Reed and Miller;
- (5) Claims 45 to 48 under 35 U.S.C. § 103 as being unpatentable over Brown in view of Reed and Gerard;
- (6) Claims 54 to 58, 60 and 61 under 35 U.S.C. § 103 as being unpatentable over Brown in view of Gerard and Reed;
- (7) Claim 59 under 35 U.S.C. § 103 as being unpatentable over Brown in view of Gerard, Reed and Hoffman; and
- (8) Claim 62 under 35 U.S.C. § 103 as being unpatentable over Brown in view of Gerard, Reed and Miller.⁵

⁵ The following rejections were withdrawn by the examiner in the answer (pp. 2, 4, 5, 7 & 15): (1) claim 66 under 35 U.S.C.

(continued...)

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 21, filed September 4, 1997) 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.

In the brief (p. 4), the appellants stated that

Claims 29-43 and 45-48 stand or fall together. Claim 44 stands alone. Claims 49-53 stand or fall together.

⁵(...continued)
§ 112, ¶1; (2) claim 63 under 35 U.S.C. § 112, ¶2; and (3) claims 63 to 68 under 35 U.S.C. § 103. The status (e.g., allowed) of claims 63 to 68 (which are not subjected to any rejection) was not set forth by the examiner in the answer.

Claims 54-61 stand or fall together. Claim 62 stands alone.

In addition, on pages 5 to 9 of the brief, the appellants have provided separate arguments as to the patentability of claims 29, 44, 49, 54 and 62. In accordance with the appellants grouping of claims and arguments provided, we need to review only the rejections of claims 29, 44, 49, 54 and 62 to decide the appeal on the rejections under 35 U.S.C. § 103 set forth above.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Claim 29

We sustain the rejection of claim 29 under 35 U.S.C. § 103.

The appellants have not contested the examiner's determination that it would have been obvious to provide Brown with a pug mill as suggested and taught by Reed's pug mill 122. The appellants only argue that such combination fails to arrive at the claimed combination. Specifically, the appellants argue (brief, pp. 5-6) that nothing in either Brown or Reed "even remotely suggests that a single structural component may be arranged to convey the material as well as mix the material as the material is being conveyed."

The examiner responded to this argument (answer, p. 12) by stating that Reed's pug mill 122 "receives paving components received from conveyor 80, mixes them, and conveys them to spreader box 136."

In our view, Reed's pug mill 122 clearly is a single structural component which conveys the material as well as

mixes the material as the material is being conveyed. In that regard, Reed teaches (column 4, lines 19-22) that

[c]onveyor 80 then passes mixed components into pug mill 122 which thoroughly distributes the components before passing the same into chute 132 and spreader box 136 for use on surface 142.

Reed also teaches (column 3, lines 55-58) that as shown in Figures 3, 7, and 8

[p]ug mill 122 comprises a pair of counter rotating augers 124 and 126 which are driven by hydraulic motor 128 through gear drive 130.

Additionally, as shown in Figure 1, the conveyor 80 drops the mixed components into the left side of the pug mill 122 which passes the components into chute 132 at the right side of pug mill 122. Accordingly, it is our determination that Reed's pug mill 122 clearly conveys the mixed components from the left side of the pug mill where the components are deposited from conveyor 80 to the right side of the pug mill 122 for deposit in chute 132. Thus, Reed's pug mill 122 clearly is a single structural component which conveys the components as well as mixes the components as the components are being conveyed.

For the reasons stated above, the decision of the examiner to reject claim 29 under 35 U.S.C. § 103 is affirmed.

Claim 44

We will not sustain the rejection of claim 44 under 35 U.S.C. § 103.

We agree with the appellants' argument (brief, pp. 6-7) that the applied prior art does not suggest the claimed subject matter of claim 44.

Claim 44 requires the feed augers to have "a tapered peripheral diameter." However, this limitation is not suggested by the applied prior art. In that regard, while Miller does teach screw mixers each having a tapered peripheral diameter, it is our view that Miller does not teach or suggest modifying the augers in the pug mill of Reed to each include a tapered peripheral diameter.

In our view, the only suggestion for modifying the applied prior art in the manner proposed by the examiner to meet the above-noted limitation stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C.

§ 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that the decision of the examiner to reject claim 44 under 35 U.S.C. § 103 is reversed.

Claim 49

We sustain the rejection of claim 49 under 35 U.S.C. § 103.

Once again, the appellants have not contested the examiner's determination that it would have been obvious to provide Brown with a pug mill as suggested and taught by Reed's pug mill 122. The appellants only argue (brief, p. 7) that such combination fails to suggest a kit in which an

existing conventional slat conveyor is replaced with a pair of feed augers arranged to convey the hot asphalt material and to remix the hot asphalt material as the material is being conveyed.

This argument is unpersuasive for the following reasons. First, it is not commensurate in scope with the subject matter claimed. In that regard, we note that claim 49 is drawn to a "kit" comprised of the recited elements (i.e., feed augers, securing devices, and motors) not the method of replacing an existing conventional slat conveyor with a pair of feed augers. Accordingly, the fact that the applied prior art may not have rendered it obvious to have replaced an existing conventional slat conveyor with a pair of feed augers does not equate to a conclusion that the "kit" recited by claim 49 is patentable over the applied prior art. Second, as set forth above in our discussion of claim 29, Reed's pug mill 122 clearly is a single structural component which conveys the components as well as mixes the components as the components are being conveyed.

For the reasons stated above, the decision of the examiner to reject claim 49 under 35 U.S.C. § 103 is affirmed.

Claims 30 to 43, 45 to 48 and 50 to 53

As set forth previously, the appellants have grouped claims 29 to 43 and 45 to 48 as standing or falling together and has grouped claims 49 to 53 as standing or falling together. Thereby, in view of the affirmance of the rejection of claims 29 and 49 above, claims 30 to 43, 45 to 48 and 50 to 53 fall with claims 29 and 49. Thus, it follows that the decision of the examiner to reject claims 30 to 43, 45 to 48 and 50 to 53 under 35 U.S.C. § 103 is also affirmed.

Claim 54

We will not sustain the rejection of claim 54 under 35 U.S.C. § 103.

We agree with the appellants' argument (brief, pp. 8-9) that the applied prior art does not suggest the claimed subject matter of claim 54 (i.e., the auger clause of claim 54).

Claim 54 requires the feed augers to be "disposed within said hopper" and to define "a remixing zone therebetween wherein the material is desegregated laterally relative to the path as the material is conveyed by said augers." However, these limitations are not suggested by the applied prior art. In that regard, while Reed does teach feed augers having the recited mixing zone, the augers are not disposed within the hopper. Similarly, while Gerard does teach feed augers disposed within the hopper, the augers do not have the recited mixing zone. It is our view that while Gerard may have suggested replacing Brown's slat conveyors with auger conveyors as taught by Gerard, the applied prior art would not have further suggested modifying those augers to define "a remixing zone therebetween wherein the material is desegregated laterally relative to the path as the material is conveyed by said augers." In our view, the only suggestion for modifying the applied prior art in the manner proposed by the examiner to meet the above-noted limitations stems from the use of impermissible hindsight. It follows that the decision of the examiner to reject claim 54 under 35 U.S.C. § 103 is reversed.

Claims 55 to 62

Claims 55 to 62 depend from independent claim 54 and are patentable over the applied prior art for the reason set forth above with respect to claim 54.⁶ Thus, it follows that the decision of the examiner to reject claims 55 to 62 under 35 U.S.C. § 103 is also reversed.

⁶ We have reviewed the references additionally applied in the rejection of claims 59 and 62 (i.e., Hoffman and Miller) but find nothing therein which makes up for the deficiencies of Brown, Gerard and Reed discussed above with respect to claim 54.

CONCLUSION

To summarize, the decision of the examiner to reject claims 29 to 43 and 45 to 53 under 35 U.S.C. § 103 is affirmed and the decision of the examiner to reject claims 44 and 54 to 62 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

JEFFREY V. NASE)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
MURRIEL E. CRAWFORD)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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APPEAL NO. 1999-0313 - JUDGE NASE
APPLICATION NO. 08/918,089

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DECISION: **AFFIRMED-IN-PART**

Prepared By: Gloria Henderson

DRAFT TYPED: 15 Jun 99

FINAL TYPED: