

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

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* GERD BAUER, KARL OSTERRIED, CHRISTOPH SCHMIDT,  
REINER VOGT, HELGE-BETTINA KNIESS, MICHAEL UHLIG,  
NORBERT SCHUL and GUNTHER BRENNER

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Appeal No. 1997-3169  
Application 08/211,791

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ON BRIEF

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

*ON REQUEST FOR REHEARING*

Appellants request a rehearing from our decision mailed on October 12, 2000 wherein we affirmed the rejection of claims 29, 31-38, 45-54, 60, 61, 64, 65 and 67-69 under 35 U.S.C. § 103 over the combination of Clark, Saegusa, Persello, Itoh, Noguchi, Clough, and appellants' admitted prior art.

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Appellants argue that their statement that no reference of record provides a teaching of a process for coating particles obtained by fragmentation from a solidified liquid precursor on a substrate with a metal oxide, or the product produced thereby, addressed the combined teachings of the references as a whole (request, page 1). Stating that no single reference provides such a teaching, however, does not address the combined teachings of the references.

Appellants argue that we misapprehended the significance of the metal oxide layer being coated on the particles after they are separated in fragments from a solidified layer on the substrate (request, page 1). Itoh, appellants argue, is silent as to the timing of the coating with metal oxide (request, page 2). The teaching by Itoh, however, that the coating improves the resistance against chalking and discoloring of the pigment, would have fairly suggested, to one of ordinary skill in the art, coating a pigment after fragmentation so that the entire surface of the pigment is provided with such resistance. The inquiry under 35 U.S.C. § 103 is not merely what references expressly teach, but what inferences one of ordinary skill in the art reasonably would draw from them. See *In re Lamberti*, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976); *In re Preda*, 401

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F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

Appellants argue that in the Brückner declaration a temperature of 600°C was applied to the comparative pigments to test them for heat resistance, and that this temperature was not the temperature used in preparing the pigments (request, page 2). The comparative pigments prepared according to Clarke's method, appellants argue, exhibit inferior heat resistance compared to appellants' pigments. See *id.* Clarke teaches that good results generally may be obtained by heating the pigment to 450°C, or a higher temperature if desired, when dehydrating it during its preparation, and that the pigment so prepared has good heat resistance (col. 7, lines 51-55). The Brückner declaration shows (figure 1) that the comparative pigment made according to Clarke's method lost luster and delaminated when it was heated to 600°C, whereas appellants' pigment, when heated to 850°C (figures 2 and 3), had an excellent luster and did not delaminate.

Even if the declaration shows a significant difference between the heat resistances of the tested pigments, the declaration is not sufficient for overcoming the *prima facie* case of obviousness because, first, as stated in our decision (page 6), the thicknesses of the layers are not disclosed and,

therefore, the significance of any differences shown between the properties of the pigments is questionable. Second, as explained in our decision (pages 7-8), the teaching by Itoh that coating  $TiO_2$  with the disclosed materials improves resistance against chalking and discoloring and, therefore, reasonably appears to improve gloss, indicates that the improved luster of appellants' pigment would have been expected by one of ordinary skill in the art. Third, as explained in our decision (pages 8-9), the evidence in the declaration is not commensurate in scope with the claims. Appellants argue (request, page 2) that Itoh does not suggest applying a metal oxide coating after fragmenting the pigment. As discussed above, however, one of ordinary skill in the art would have been led by Itoh to coat a pigment after it has been fragmented so that the entire surface of each pigment particle is provided with the disclosed resistance to chalking and discoloring.

Appellants argue that the board improperly overlooked the reply brief because its nonentry is not an option for the examiner (request, page 2). The propriety of the nonentry of a reply brief is a petitionable matter rather than an appealable matter. *See Manual of Patent Examining Procedure* § 1002.02(c)(8) (7th ed., rev. 1, Feb. 2000). Because the reply brief was not

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entered into the record prior to our consideration of the appeal,  
our refusal to consider the reply brief was proper.

We have considered appellants' rehearing request but, for  
the above reasons, decline to make any change to our decision.

*DENIED*

EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
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	)	
	)	
BRADLEY R. GARRIS	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
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	)	
TERRY J. OWENS	)	
Administrative Patent Judge	)	

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Millen, White, and Zelano  
Arlington Courthouse Plaza 1,  
Suite 1201  
2200 Clarendon Boulevard  
Arlington, VA 22201