

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MICHAEL DI GIOIA and JOSE RODRIGUES

Appeal No. 2003-1463
Application No. 09/536,341

ON BRIEF

Before COHEN, NASE and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-7, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a system for spraying a powder coating product and, more particularly, to an improvement seeking to eliminate lumps of powder that can form and be entrained in the flow of air-powder mixture (specification, page 1). In particular, appellants' improvement is the provision of a flow chicane 62, formed by an annular rib 63 and an annular groove 64 on facing faces of the cup 52 and deflector 54, in the narrow flow space 56 formed between the cup and deflector. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

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

Babka	1,620,625	Mar. 15, 1927
Ficker	3,061,200	Oct. 20, 1962
Schneider	4,838,487	Jun. 13, 1989
Chabert	5,353,995	Oct. 11, 1994

The following rejections are before us for review.

Claims 5-7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Babka.

Claims 1-3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Babka in view of Schneider.

Claims 1-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chabert in view of Ficker.

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. 17) for the examiner's complete reasoning in support of the rejections and to the brief and reply brief (Paper Nos. 15 and 19) 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.

The anticipation rejection

Babka discloses an oil atomizer comprising a pipe 15 through which oil is delivered to a burner nozzle 1, the pipe 15 being provided with a goose neck extension 16 on the downstream end thereof. The burner nozzle is formed by a rear cup 5 and a front cup 6, each comprising a series of projecting rings or annular flanges 8-10 and 11-14, respectively, forming a series of interconnected annular spaces between the two cups through which the oil flows. As oil is delivered through the pipe 15 it is discharged into the inner surface of an inner ring 7 on the rear cup 5 where it has imparted to it a rotational velocity which causes it to spread to a film and from which it escapes through slots 17 and strikes flange 11. The oil spreads in a film and flows toward and over the curved surface of the flange 11 until it is discharged off the edge onto the next flange 8. The direction of flow of the oil is then reversed and the oil flows over the surface of the flange 8 toward the front until it is discharged onto the next flange 12 and so on.

According to Babka, the impact of the oil striking each flange may cause some atomization but, at any rate, the film formed on each succeeding flange is thinner because of the increased rotational velocity imparted to the oil and because of the increased area of each succeeding flange (page 2, lines 28-34). Babka further explains (page 2, lines 42-48) that

[i]n order to enable a very small quantity of oil to be handled with uniformity the end of the goose neck 16 is preferably adjusted quite close to the inner ring 7 so that the rotating surface will pull the oil evenly out of the opening and prevent the formation of drops.

Appellants argue on pages 9 and 10 of their brief that Babka is not directed to a powder coating system and that the examiner has failed to specify how the goose neck extension 16 can accommodate an air-powder mixture, pointing out that the goose neck extension, which is “directed almost immediately into a circumferential wall,” along with the slot structure 17 of Babka would quickly cause the chamber to clog up with powder if used as a powder coating system.

In response, the examiner references Babka’s disclosure in column 1, lines 14-18, that the rotary atomizer can be used for other purposes and urges that, since Babka’s device has all the claimed limitations, there is nothing that would preclude it from being used “for spraying a powder coating product” and that, since Babka’s cavity does in fact accommodate a feed pipe, it is capable of performing the function of accommodating an air-powder mixture feed pipe as recited (answer, page 6).

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984). Under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

In this instance, Babka discloses a device for use as an oil atomizer only; there is no disclosure that the atomizer is capable of use for spraying a powder coating product. Babka's disclosure of the oil atomizer for "other purposes" referenced by the examiner relates to use of the atomizer to deliver oil either to an oil engine or for other purposes, that is, for delivery to devices or locations other than an oil engine. The examiner's

position appears to be that Babka's oil atomizer is inherently capable of accommodating an air-powder mixture feed pipe for spraying a powder coating product. It is well settled that the language "[a] person shall be entitled to a patent unless" in 35 U.S.C. § 102 places a burden of proof on the examiner to produce the factual basis for its rejection of an application under sections 102 and 103. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). It follows that, when relying on the theory of inherency, the examiner has the initial burden of providing a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic reasonably flows from the teachings of the applied prior art. See In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986). In our opinion, the examiner has not discharged that initial burden. The examiner has offered no evidence or technical reasoning to support the determination that Babka's atomizer is reasonably capable of use in a system for spraying a powder coating product and, in particular, has not responded to appellants' argument that powder would clog up the chamber between the exit of the goose neck extension and first annular flange 11. Moreover, as evidenced by European Patent Application publication EP 870,546 (page 2, col. 2, lines 37-45), it was recognized in the art at the time of appellants' invention that powder, unlike liquids, can tend to accumulate causing various adverse effects. Thus, one skilled in the art of air-powder mixture spraying would not necessarily consider an oil atomizer capable of use as a spray head in a system for spraying a powder coating product and, as mentioned above, the examiner has offered

no explanation or technical reasoning to support the determination that Babka's atomizer is capable of such use.

For the foregoing reason, we cannot sustain the rejection of claim 5 as being anticipated by Babka. It follows that we also cannot sustain the rejection of claims 6 and 7 depending from claim 5 as being anticipated by Babka.

The obviousness rejections

We turn next to the rejection of claims 1-3 as being unpatentable over Babka in view of Schneider. Schneider, like Babka, is directed to a device for atomizing liquid and, in any event, provides no cure for the deficiency of Babka discussed supra. Moreover, we find no suggestion in the combined teachings of Babka and Schneider to modify Babka to eliminate the goose neck extension 16 as proposed by the examiner. Babka's goose neck extension is intentionally provided to direct the oil radially outwardly onto the inner surface of the ring 7 where it will have imparted to it a rotational velocity and the examiner's proposed modification would seemingly destroy this arrangement and thus would not have been obvious.¹ We therefore shall also not sustain this rejection.

Turning finally to the rejection of claims 1-7 as being unpatentable over Chabert in view of Ficker, there appears to be no dispute that Chabert discloses the subject matter of independent claims 1 and 5 with the exception of the flow chicane in the flow

¹ Where the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, the proposed modification would not have been obvious. See Tec Air Inc. v. Denso Mfg. Michigan Inc., 192 F.3d 1353, 1360, 52 USPQ2d 1294, 1298 (Fed. Cir. 1999); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

space. We agree with appellants that Ficker, directed to a centrifugal spray device for applying a liquid coating composition comprising a spray head provided with a labyrinth passage with a series of successive conical faces against which the liquid impinges to disperse the liquid into fine particles, affords no suggestion to provide a labyrinth flow passage on Chabert's spray head for applying an air-powder mixture. First, the purpose for which the labyrinth flow passage is provided in Ficker's liquid application device, namely, dispersion of the liquid into fine particles, is not relevant to Chabert's air-powder mixture spray head. Second, as evidenced by EP 870,546, as discussed above, differences between the behavior of liquids being sprayed and powders being sprayed were recognized in the art at the time of appellants' invention and, in light of the recognized issues with accumulation of powders in flow passages discussed in EP 870,546, one skilled in the art of air-powder mixture sprayers at the time of appellants' invention would not necessarily have viewed the teachings of Ficker as being applicable to Chabert's device. For the foregoing reasons, we shall not sustain the rejection of claims 1-7 as being unpatentable over Chabert in view of Ficker.

CONCLUSION

To summarize, none of the examiner's rejections is sustained. The decision of the examiner to reject claims 1-7 is reversed.

REVERSED

IRWIN CHARLES COHEN
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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