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for publication and is not binding precedent of the Board.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. 38

# UNITED STATES PATENT AND TRADEMARK OFFICE

## BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte HELMUTH SOKOLEAN

Appeal No. 2004-1312
Application No. 08/710,554

ON BRIEF

Before ABRAMS, McQUADE, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

## DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 57 to 60 and 62 to 70. Claims 1 to 56 have been canceled.[1] Dependent claim 61 is pending but not on appeal.[2]

We REVERSE.

[1] While the examiner has approved entry of the amendment after final rejection canceling claims 23 to 29 and 31 to 56 (Paper No. 27, filed September 20, 2002), we note that this amendment has not been clerically entered.

[2] In the Advisory Action dated November 21, 2002 (Paper No. 31), the examiner refused to enter the amendment after final canceling claim 61.

## BACKGROUND

The appellant's invention relates to a contact element for providing heat transfer from a heat transfer medium to a ceiling. A copy of the dependent claims under appeal is set forth in the appendix to the appellant's brief. Claim 57, the only independent claim on appeal, reads as follows:

> A contact element for providing heat transfer from a heat transfer medium to a ceiling, said contact element comprising:
> at least one guide for holding in heat-conducting contact a conduit through which a heat transfer medium flows; and
> a contact panel in heat-conducting connection with the at least one guide and having at least one contact surface, wherein the contact surface has a width to define lateral edges and includes at least one flat adhesive depression containing an adhesive means to provide an adhesive surface substantially flush with the contact surface, wherein the adhesive surface is spaced away from the lateral edges of the contact surface.

The rejections under appeal are as follows:

1. Claims 57 to 60, 62 and 64 to 69 under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over JP 56-160597 to Maeda.

2. Claims 57 to 60, 62 and 64 to 69 under 35 U.S.C. § 103 as being unpatentable over US 2,625,378 to Nason in view of JP 5-138654 to Doi et al. (Doi).

3. Claim 63 under 35 U.S.C. § 103 as being unpatentable over Nason in view of Doi and GB 2 036 840 A to Yeomans.

4. Claim 70 under 35 U.S.C. § 103 as being unpatentable over Nason in view of Doi and NL 291742 to Inland [illegible] Products Company.

5. Claims 57 to 60, 62 to 65 and 70 under 35 U.S.C. § 103 as being unpatentable over NL 291742 to Inland [illegible] Products Company in view of Doi and US 5,042,570 to Schmitt-Raiser et al. (Schmitt-Raiser).

6. Claims 66 to 69 under 35 U.S.C. § 103 as being unpatentable over Inland [illegible] Products Company in view of Doi, Schmitt-Raiser and US 5,743,330 to Bilotta et al. (Bilotta).

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 22, mailed February 26, 2002) and the answer (Paper No. 33, mailed June 3, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 32, filed November 25, 2002) and reply brief (Paper No. 34, filed August 4, 2003) for the appellant's arguments thereagainst.

## OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the

respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

**Rejection 1**

We will not sustain the rejection of claims 57 to 60, 62 and 64 to 69 under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Maeda.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987).

Claim 57 is not anticipated by Maeda since Maeda does not disclose a contact panel in heat-conducting connection with the at least one guide and having at least one contact surface, wherein the contact surface of the contact panel includes at least one flat adhesive depression containing an adhesive means to provide an adhesive surface substantially flush with the contact surface. Clearly, Maeda's plate 6 as shown in Figures 3-6 includes no depression let alone a flat adhesive depression containing an adhesive means to provide an adhesive surface substantially flush with the contact

surface. While Maeda does provide a space or gap 9 between the plate 6 and the pipe 7 for lumps 10 of adhesive, the space or gap 9 does not constitute a depression in the plate 6 for the reasons set forth by the appellant in the brief (pp. 6-7) and reply brief (pp. 2-5).

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the teachings of the applied prior art would appear to be sufficient for one of ordinary skill in the relevant art having the applied prior art before him to arrive at the claimed invention. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

In this rejection, the examiner has not set forth any rationale as to why it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified Maeda's plate 6 to include a flat adhesive depression containing an adhesive means to provide an adhesive surface substantially flush with the contact surface. As such, the examiner has not presented a prima facie case of obviousness.

For the reasons set forth above, the decision of the examiner to reject claim 57, and claims 58 to 60, 62 and 64 to 69 dependent thereon, under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Maeda is reversed.

**Rejection 2**

We will not sustain the rejection of claims 57 to 60, 62 and 64 to 69 under 35 U.S.C. § 103 as being unpatentable over Nason in view of Doi.

When it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the appellant. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the appellant's structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the appellant's combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (citations omitted).

After reviewing the teachings of Nason and Doi, we find no suggestion, teaching or motivation therein for a person of ordinary skill in the art at the time the invention was made to have modified Nason to arrive at the claimed subject matter. Specifically, it is our opinion that Doi would not have made it obvious to the skilled artisan to have modified Nason's sheet 20 to include a flat adhesive depression containing an adhesive means to provide an adhesive surface substantially flush with the contact surface. As such, the examiner has not presented a prima facie case of obviousness.

For the reasons set forth above, the decision of the examiner to reject claims 57 to 60, 62 and 64 to 69 under 35 U.S.C. § 103 as being unpatentable over Nason in view of Doi is reversed.

**Rejections 3 and 4**

We will not sustain the rejection of claim 63 under 35 U.S.C. § 103 as being unpatentable over Nason in view of Doi and Yeomans or the rejection of claim 70 under 35 U.S.C. § 103 as being unpatentable over Nason in view of Doi and Inland [illegible] Products Company. We have reviewed the references to Yeomans and Inland [illegible] Products Company but find nothing therein which makes up for the deficiency of Nason and Doi discussed in rejection 2 above.

**Rejection 5**

We will not sustain the rejection of claims 57 to 60, 62 to 65 and 70 under 35 U.S.C. § 103 as being unpatentable over Inland [illegible] Products Company in view of Doi and Schmitt-Raiser.

After reviewing the teachings of Inland [illegible] Products Company, Doi and Schmitt-Raiser, we find no suggestion, teaching or motivation therein for a person of ordinary skill in the art at the time the invention was made to have modified Inland [illegible] Products Company to arrive at the claimed subject matter. Specifically, it is our opinion that Doi and Schmitt-Raiser would not have made it obvious to the skilled artisan to have modified the flange 10 of Inland [illegible] Products Company to include a flat adhesive depression containing an adhesive means to provide an adhesive surface substantially flush with the contact surface. As such, the examiner has not presented a prima facie case of obviousness.

For the reasons set forth above, the decision of the examiner to reject claims 57 to 60, 62 to 65 and 70 under 35 U.S.C. § 103 as being unpatentable over Inland [illegible] Products Company in view of Doi and Schmitt-Raiser is reversed.

**Rejection 6**

We will not sustain the rejection of claims 66 to 69 under 35 U.S.C. § 103 as being unpatentable over Inland [illegible] Products Company in view of Doi, Schmitt-Raiser and Bilotta. We have reviewed the reference to Bilotta but find nothing therein which makes up for the deficiency of Inland [illegible] Products Company, Doi and Schmitt-Raiser discussed in rejection 5 above.

CONCLUSION

To summarize, the decision of the examiner to reject claims 57 to 60, 62 and 64 to 69 under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Maeda is reversed; the decision of the examiner to reject claims 57 to 60, 62 and 64 to 69 under 35 U.S.C. § 103 as being unpatentable over Nason in view of Doi is reversed; the decision of the examiner to reject claim 63 under 35 U.S.C. § 103 as being unpatentable over Nason in view of Doi and Yeomans is reversed; the decision of the examiner to reject claim 70 under 35 U.S.C. § 103 as being unpatentable over Nason in view of Doi and Inland [illegible] Products Company is reversed; the decision of the examiner to reject claims 57 to 60, 62 to 65 and 70 under 35 U.S.C. § 103 as being unpatentable over Inland [illegible] Products Company in view of Doi and Schmitt-Raiser is reversed; and the decision of the examiner to reject claims 66 to

69 under 35 U.S.C. § 103 as being unpatentable over Inland [illegible] Products Company in view of Doi, Schmitt-Raiser and Bilotta is reversed.

REVERSED

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| NEAL E. ABRAMS<br>Administrative Patent Judge | ) | |
| JOHN P. McQUADE<br>Administrative Patent Judge | ) | BOARD OF PATENT APPEALS AND INTERFERENCES |
| JEFFREY V. NASE<br>Administrative Patent Judge | ) | |

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