

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM K. LEONARD

Appeal No. 2005-0638
Application No. 10/087,301

ON BRIEF

Before KIMLIN, WALTZ, and KRATZ, Administrative Patent Judges.
WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's final rejection of claims 30 through 48 (Brief, page 5). Claims 1-29 and 51-57 stand withdrawn from further consideration by the examiner as directed to a non-elected invention (final Office action dated Dec. 23, 2003; Brief, page 5). The remaining claims pending in this application are claims 49 and 50, which stand allowed by the examiner (Brief, page 5; Answer, page 2; Reply

Brief, page 3).¹ We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellant, the invention is directed to a device for forming a very thin, uniform coating on a filamentous article comprising a coating station to apply a coating liquid to produce a "substantially uneven" coating on a strand or filament, followed by an improvement station comprising at least two rolls that periodically contact and re-contact the wet coating at different positions along the length of the filamentous article to improve the uniformity of the coating (Brief, pages 7-9). A copy of representative independent claim 30 is reproduced below:

30. A device comprising a coating station that directly or indirectly applies a substantially uneven coating to at least some of the exposed portion of a filamentous article and an improvement station comprising two or more rotating rolls that periodically contact and re-contact the wet coating at different positions along the length of the filamentous article, wherein the number or periods of the rolls improve the uniformity of the coating.

¹We note that claims 49 and 50 depend upon previously rejected independent claim 30. The examiner has stated that claims 49 and 50 "are allowed" (Answer, page 2) but has not objected to these claims as depending upon a rejected claim. See *MPEP*, § 608.01(n)(V), 8th ed., p. 600-81, Rev. 2, May 2004. This lack of an objection by the examiner is moot in view of our decision *infra*.

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The examiner has relied upon the following references as evidence of unpatentability:

Von Kohorn	2,570,173	Oct. 02, 1951
Severini	2,867,108	Jan. 06, 1959
Guillermin et al. (Guillermin)	4,059,068	Nov. 22, 1977
Guertin	5,034,250	Jul. 23, 1991
Leonard et al. (Leonard) (filed Jan. 10, 2001)	6,737,113 B2	May 18, 2004

The following rejections are pending in this appeal:

(1) claims 30, 33, 34, and 36-38 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 63-65, 67 and 68 of Application No. 09/757,955 (now U.S. Patent No. 6,737,113 B2 to Leonard)(final Office action dated Dec. 23, 2003, page 2);²

(2) claims 30, 32, 33, 35, 42-45, and 48 stand rejected under 35 U.S.C. § 102(b) as anticipated by Von Kohorn (Answer, page 3);

(3) claims 30-33, 36-45 and 48 stand rejected under § 102(b) as anticipated by Severini (Answer, page 4);

²This obviousness-type double patenting rejection was not repeated in the Answer (see the Answer in its entirety). However, we consider this rejection to still be pending in this appeal since the examiner responded to appellant's arguments from the Brief with no indication that this rejection has been withdrawn (Answer, pages 7-8). Furthermore, appellant presented arguments traversing this rejection in the Reply Brief, with no indication that the rejection has been withdrawn (Reply Brief, page 4). This omission by the examiner of the statement of the rejection in the Answer is moot in view of our disposition of this rejection *infra*.

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(4) claims 30-34, 36, 38, 39, 42-46 and 48 stand rejected under § 102(b) as anticipated by Guertin (Answer, page 5);

(5) claim 31 stands rejected under § 102(b) as anticipated by or, in the alternative, under § 103(a) as unpatentable over Von Kohorn (Answer, page 6);

(6) claim 31 stands rejected under § 102(b) as anticipated by or, in the alternative, under § 103(a) as unpatentable over Guertin (Answer, page 7); and

(7) claim 47 stands rejected under § 103(a) as unpatentable over Guertin in view of Guillermin (Answer, page 7).

Based on the totality of the record, we reverse all of the rejections on appeal essentially for the reasons stated in the Brief, Reply Brief, and those reasons set forth below.

OPINION

A. The Rejection for Obviousness-type Double Patenting

The examiner provisionally rejects claims 30, 33, 34 and 36-38 under the judicially created doctrine of obviousness-type double patenting over claims 63-65, 67 and 68 of co-pending Application No. 09/757,955 (final Office action dated Dec. 23, 2003, page 2). The examiner finds that the "conflicting claims are not identical" but they are not "patentably distinct" from each other because both applications claim a device with three or more rotating rolls that can periodically contact and re-contact the coating at different positions on a substrate, as well as a coating station that initially applies a discontinuous or uneven

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coating (*id.*). The examiner recognizes that Application No. 09/757,955 has now become U.S. Patent No. 6,737,113 (Leonard)(Answer, page 7). However, the examiner has not changed the "provisional" rejection status (see footnote 2 above).

Appellant is unsure whether appellate jurisdiction applies to a "provisional" rejection (Brief, page 13). It is well settled that "provisional" rejections may be made by the examiner during *ex parte* prosecution, with resulting appellate jurisdiction residing with this Board. See *Ex parte Karol*, 8 USPQ2d 1771, 1773 (Bd. Pat. App. & Int. 1988).

As correctly argued by appellant (Brief, page 14; Reply Brief, page 4), claims 63-65, 67 and 68 are no longer pending in Application No. 09/757,955, now U. S. Patent No. 6,737,113 (see Leonard, where claims 1-62 are directed to a method for improving the uniformity of a wet coating on a substrate). Furthermore, in a proper rejection for obviousness-type double patenting, the examiner must rely on the claims of the conflicting application as the basis for the obviousness conclusion, resorting to the disclosure only for an explanation or meaning of terminology. See *Eli Lilly & Co. v. Barr Laboratories Inc.*, 251 F.3d 955, 968, 58 USPQ2d 1869, 1878 (Fed. Cir. 2001)(en banc); *In re Goodman*, 11 F.3d 1046, 1052, 29 USPQ2d 2010, 2015 (Fed. Cir. 1993). From the

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examiner's response on page 7 of the Answer, it appears that the examiner is relying on the disclosure of Leonard as evidence of obviousness. Finally, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a section 103(a) obviousness determination. See *In re Longi*, 759 F.2d 887, 892-93, 225 USPQ 645, 648 (Fed. Cir. 1985). In the analysis presented by the examiner (final Office action dated Dec. 23, 2003, page 2), the examiner has not presented in detail any differences between the conflicting claims, with reasons or evidence as to why these differences would have been obvious to one of ordinary skill in this art at the time of appellant's invention.

For the foregoing reasons, we cannot sustain the examiner's rejection of claims 30, 33, 34 and 36-38 for obviousness-type double patenting over any claims of Leonard. Upon the return of this application to the jurisdiction of the examiner, the examiner should review the status and claims of Application No. 10/821,588 (Reply Brief, page 4) and properly determine whether the claims on appeal should be rejected for obviousness-type double patenting over any claims of this application.

B. The Rejections under § 102(b)

The same issues arise with regard to each of the examiner's rejections under section 102(b) over Von Kohorn, Severini and Guertin (Answer, pages 3-6; Brief, pages 15-31; Reply Brief, pages 5-8 and 13-18). Accordingly, we consider these rejections together, with consideration limited to independent claim 30.

To anticipate a claim under section 102(b), every limitation of the claim must be disclosed, either expressly or under the principles of inherency, by a prior art reference. See *In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). Implicit in any analysis of the examiner's rejection is that the claim must first have been correctly construed to define the scope and meaning of any contested limitation. See *Gechter v. Davidson*, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997).

The examiner clearly construes the contested claim language "a coating station that directly or indirectly applies a substantially uneven coating to at least some...of a filamentous article" (see claim 30) to mean any coating station that is capable of applying a "substantially uneven" coating to the filamentous article (e.g., Answer, page 8). Appellant construes this same claim language as "both a structural and a functional

limitation" (e.g., Reply Brief, page 5). Although it appears that appellant's claim construction does not differ substantially from the examiner's claim construction, we determine that the claimed "coating station" merely defines an area where a coating device is *capable* of applying an initial "substantially uneven" coating, as defined in appellant's specification (page 4, ¶[0023]). See *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995) (During examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification).

However, on this record, the examiner has failed to establish that the spray nozzles of Von Kohorn or Guertin or the pipe of Severini are *capable* of applying a "substantially uneven" initial coating as defined by appellant (specification, page 4, ¶[0023]). See *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Additionally, the examiner has not presented any evidence on this record to support the allegation that "[o]ne of ordinary skill in the art would know there must be at least an on/off valve to stop the flow of coating between runs. This would provide a means of coating unevenly the filamentous article." Answer, page 8 (see also pages 11 and 12). The examiner has failed to point to any

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disclosure or suggestion in any part of Von Kohorn, Severini, or Guertin relating to on/off valves, or any structure that would produce intermittent coating.

Accordingly, we determine that the examiner has no factual support, on this record, for the finding that Von Kohorn discloses "changing the application period by turning the spray nozzles on and off" (Answer, page 3), the findings that Severini discloses a coating station that indirectly "drips by means of a pipe (column 4, lines 43-48) a substantially uneven coating" and changes "the application period by turning the spray nozzles on and off" (Answer, page 4), or the findings that Guertin discloses a coating station that "directly sprays or drips a substantially uneven coating" and changes "the application period by turning the spray nozzles on and off" (Answer, page 5).

For the foregoing reasons and those stated in the Brief and Reply Brief, we determine that the examiner has not established that every claimed limitation has been disclosed or described by Von Kohorn, Severini, or Guertin within the meaning of 35 U.S.C. § 102(b). Therefore we cannot sustain the examiner's rejections under section 102(b) over Von Kohorn, Severini or Guertin.

C. The Rejections under § 102(b)/§ 103(a)

The examiner rejects claim 31 under sections 102(b)/103(a) over either Von Kohorn (Answer, page 6) or Guertin (Answer, page 7). The examiner finds that the spray nozzles of Von Kohorn or Guertin are "considered capable" of dripping an uneven coating (Answer, pages 6-7). In any event, the examiner concludes that it would have been obvious in either Von Kohorn or Guertin "to use dripping means to conserve coating material and prevent excess coating material from being wasted in the coating area by spraying" (*id.*).

A deficiency in the examiner's rejections is that the examiner has not established, on this record, that the spray nozzles of Von Kohorn or Guertin are *capable* of initially applying a "substantially uneven" coating to a filamentous article as claimed (with "substantially uneven" defined as in the specification, page 4, ¶[0023]). With regard to the examiner's obviousness conclusion, again we must note that there is no evidence of record supporting the examiner's reasoning to use dripping means (to conserve coating material and prevent excess coating material from being wasted). Contrary to the examiner's position, Von Kohorn teaches the use of a trough 23 to catch spent treating liquids, where these liquids may be discarded or

replenished and recirculated (col. 4, ll. 16-20). We also note that Severini teaches the use of drain troughs 14 to allow the recovery of spent liquors (col. 4, ll. 51-56). Accordingly, the prior art on this record does not support the examiner's reasoning.

For the foregoing reasons and those stated in the Brief and Reply Brief, we cannot sustain the examiner's rejection of claim 31 under section 102(b)/section 103(a) over either Von Kohorn or Guertin.

D. The Rejection under § 103(a)

The examiner rejects claim 47 under section 103(a) over Guertin in view of Guillermin, applying Guillermin for the teaching of employing grooves in the rolls to reduce friction with the filamentous article (Answer, page 7).³ However, Guillermin does not remedy the deficiencies discussed above with regard to the primary reference to Guertin. Accordingly, we reverse the examiner's rejection of claim 47 under section 103(a) over Guertin in view of Guillermin for reasons stated above.

³See also Severini, col. 4, ll. 7-11.

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E. Summary

The rejection of claims 30, 33, 34 and 36-38 under the judicially created doctrine of obviousness-type double patenting over claims 63-65, 67 and 68 of Application No. 09/757,955 is reversed.

The rejection of claims 30, 32, 33, 35, 42-45 and 48 under 35 U.S.C. § 102(b) over Von Kohorn is reversed. The rejection of claims 30-33, 36-45 and 48 under 35 U.S.C. § 102(b) over Severini is reversed. The rejection of claims 30-34, 36, 38, 39, 42-46 and 48 under 35 U.S.C. § 102(b) over Guertin is reversed.

The rejection of claim 31 under 35 U.S.C. § 102(b)/§ 103(a) over Von Kohorn is reversed. The rejection of claim 31 under 35 U.S.C. § 102(b)/§ 103(a) over Guertin is reversed. The rejection of claim 47 under 35 U.S.C. § 103(a) over Guertin in view of Guillermin is reversed.

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The decision of the examiner is reversed.

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
THOMAS A. WALTZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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PETER F. KRATZ)	
Administrative Patent Judge)	

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