

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 STEVEN G. CORVELEYN

Appeal No. 2005-2679
Application 10/009,353

ON BRIEF

Before GARRIS, WARREN and TIMM, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, and based on our review, find that we cannot sustain the rejection of appealed claims 16, 17 and 19 through 21 under 35 U.S.C. § 103(a) as being unpatentable over Dawes et al. (Dawes) (answer, pages 4-6).¹

We refer to the answer and to the brief for a complete exposition of the positions advanced by the examiner and appellant.

The dispositive issue in this appeal is the interpretation of the term “blended” in the claim language “a fluoroelastomer blended with a mineral oil” of representative appealed claim 16,

¹ Claims 1 through 15 and 23 through 26 are also of record and have been withdrawn from consideration by the examiner under 37 CFR § 1.142(b). Claims 1 through 17 and 19 through 26 are all of the claims in the application. See the appendix to the brief.

when given the broadest reasonable interpretation in its ordinary usage as would be understood by one of ordinary skill in the art in light of the written description in the specification as interpreted by this person, and without reading into the claim any limitation or particular embodiment disclosed in the specification. *See, e.g., In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). We find it readily apparent from the written description in the specification that the term “blended” is employed with its ordinary meaning in context of combined in a mixture, which meaning is consistent with the ordinary, dictionary definition of the term in technical and non-technical dictionaries.² Thus, claim 16 encompasses fluoroelastomer compositions comprising at least a fluoroelastomer blended, that is, mixed, with a mineral oil, as appellant argues (brief, e.g., pages 14-15).

We find as does appellant (brief, e.g., pages 9-10), that the extruded core of fluoroelastomer of Dawes is coated by a low viscosity liquid, which can contain mineral oil, that “displaces the polymeric core material from contact with the die wall,” wherein the reference specifically would have taught that “[t]he low viscosity liquid does not become mixed with the polymeric core material under processing conditions” (e.g., col. 4, ll. 19-22, 26-31 and 65-67, and col. 5, ll. 1-9, 15-16, 28-32 and 42-44). The examiner does not deny the teachings of the reference, contending that “it is immaterial whether fluoroelastomer and mineral [*sic*, oil] are blended or simply brought into contact with each other,” because according to the examiner, the reference “discloses a composition that contains all the (claimed) ingredients” and since “[a] lubricant is known to be admixed with a polymeric matrix,” the reference “would have provided enough incentive to one to arrive at instant invention” (answer, page 5). The examiner disregards the limitation “blended with” as a product-by-process limitation, pointing out that such a claim is directed to products which are “obvious from the product of the prior art even if prior art product was made by a different process” (*id.*).

It is well settled that the examiner has not established a *prima facie* case of obviousness

² *See generally, The American Heritage College Dictionary Third Edition* 148 (Boston, Houghton Mifflin Company, 2000); *McGraw-Hill Dictionary of Scientific and Technical Terms* 239 (5th ed., Sybil P. Parker, ed., New York, McGraw-Hill, Inc. 1994)

when all of the claim limitations have not been considered. *See, e.g., In re Geerdes*, 491 F.2d 1260, 1262-63, 180 USPQ 789, 791-92 (CCPA 1974) (In considering grounds of rejection under 35 U.S.C. §§ 103 and 112, “every limitation in the claim must be given effect rather than considering one in isolation from the others.”). In the present appeal, the limitation “a fluoroelastomer blended with a mineral oil” in claim 16 simply requires a mixture, whether this claim language is considered as plainly requiring a mixture, or as a process-by-product step characterizing the claimed product as a composition formed as a mixture by any manner of process. We agree with appellant that the examiner has disregarded this limitation and, indeed, has not attempted to establish that one of ordinary skill in this art would have found in the disclosure of the reference a teaching or inference that a coating liquid containing a mineral oil is in fact admixed or can be admixed with the core fluoroelastomer in spite of the clear teaching of Dawes that the coating and core do “not become mixed.” *See generally, In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000), citing *B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996), (“Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of the reference.”); *see also In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998) (“hindsight” is inferred when the specific understanding or principal within the knowledge of one of ordinary skill in the art leading to the modification of the prior art in order to arrive at appellant’s claimed invention has not been explained).

Accordingly, the examiner has not established a *prima facie* case of obviousness on this record, and therefore, we reverse the ground of rejection of appealed claims 16, 17 and 19 through 21 under 35 U.S.C. § 103(a).

The examiner’s decision is reversed.

Reversed

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St. Paul, MN 55144-3427