

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 RYAN C. SHIRK,
STEPHEN M. SANOCKI, JOSEPH C. PEISERT,
ROGER L. LANGER, LOYD R. HORNBACK III and
IAN R. HARDING

Appeal No. 2006-0583
Application No. 10/322,008

ON BRIEF

Before GARRIS, PAK and FRANKLIN, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 24-28, 30-34 and 46.

The subject matter on appeal relates to a method of making a pollution control device which comprises providing a flexible and self-supporting insulating end cone of insulating material and disposing the insulating end cone between inner and outer end cone housings of the pollution control device. Further details regarding this subject matter are set forth in representative independent claim 24, which reads as follows:

24. A method of making a pollution control device, said method comprising:

providing a flexible and self-supporting insulating end cone comprising resilient and compressible non-intumescent or intumescent insulating material, the insulating end cone having a three dimensional cone shape; and

disposing the insulating end cone between inner and outer end cone housings of the pollution control device,

wherein the insulating end cone maintains its three dimensional cone shape under the force of gravity, when placed on a level surface prior to said disposing.

The prior art set forth below is relied upon by the examiner as evidence of obviousness:

Mocker et al. (Mocker)	3,058,160	Oct. 16, 1962
Farr	3,598,157	Aug. 10, 1971

Admitted prior art as set forth on pages 1-2 of the instant specification

Claims 24-28, 30, 31, and 46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the admitted prior art in view of Farr, and claims 32-34 are correspondingly rejected over the aforementioned prior art and further in view of Mocker.

We refer to the brief and to the answer for a complete discussion of the opposing viewpoints expressed by the appellants and by the examiner concerning the above noted rejections.

OPINION

For the reasons which follow, we will sustain each of these rejections.

As an initial matter, the appellants argue that the examiner has improperly designated and relied upon certain aspects of the specification disclosure as admitted prior art and in particular as “some admission regarding the need to improve the method of making a pollution control device.” (Brief, page 12). However, as revealed by the answer generally and pages 2,

3 and 6 thereof specifically, the examiner has designated as admitted prior art only the Background section on pages 1-2 of the specification (and not the Summary of the Invention section on specification page 4 as indicated by the appellants on page 10 of their brief), and at no point in the answer has the examiner contended that the admitted prior art includes “some admission regarding the need to improve the method of making a pollution control device” as urged by the appellants on page 12 of their specification.

The appellants further argue that the Farr reference is nonanalogous art because “the teaching of Farr has nothing to do with pollution control devices, and especially the particular problems with which the present Appellant was concerned, namely, methods of making a pollution control device” (brief, page 11). We perceive no convincing merit in this argument.

It is well settled that prior art is analogous: (1) if the reference is from the inventor’s field of endeavor regardless of the problem addressed, and (2) if the reference is reasonably pertinent to the particular problem with which the inventor was involved regardless of the field of endeavor. See In re Clay, 966 F.2d 656, 658, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). Here, the Farr reference is reasonably pertinent to the appellants’ problem relating to the use of non-preformed insulation (e.g., see lines 1-6 on specification page 4 in comparison with lines 6-26 in column 1 of Farr). The appellants’ contrary view is based on a confused conflation of the field of an inventor’s endeavor and the problem with which the inventor was involved. That is, the latter is not confined to the environment of the former as the appellants seem to believe since otherwise the legal standard for analogous art would not be a two-pronged test.

Finally, it is the appellants' position that no reason exists for combining the admitted prior art with Farr in the manner proposed by the examiner. We cannot agree. An artisan would have so-combined these prior art teachings in order to provide the admitted prior art with the advantages taught by Farr to attend use of preformed insulation (e.g., see lines 15-22 in column 1 of Farr). We also disagree with the appellants' related contention that patentee's disclosure of an airspace (see lines 14-18 in column 2) would have "motivated away from seeking the teaching of Farr" (brief, page 13). The mere possibility of airspace in Farr has no apparent relevance to the admitted prior art. In this regard, we remind the appellants that the test for obviousness is what the combined teachings of the prior art would have suggested to those of ordinary skill and that one cannot show nonobviousness by attacking references individually where rejections are based on combinations of references. In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881-82 (CCPA 1981).

Under the circumstances recounted above, it is our determination that the prior art applied by the examiner establishes a prima facie case of obviousness which the appellants have failed to successfully rebut with argument or evidence of nonobviousness. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). We hereby sustain, therefore, the § 103 rejection based on the admitted prior art and the Farr reference of argued independent claim 24 and of non-argued dependent claims 25-28, 30, 31, and 46.

For analogous reasons, we also hereby sustain the § 103 rejection based on the admitted prior art, Farr and Mocker of claims 32-34. Contrary to the appellants' argument, Mocker is analogous prior art because it is reasonably pertinent to the appellants' problem relating to the manufacture of performed insulation. See In re Clay, 966 F.2d at 658, 23 USPQ2d at 1060. Furthermore, again contrary to the appellants' argument, an artisan

would have been motivated to combine the applied prior art in the manner proposed by the examiner in order to obtain the preformed insulation disclosed by Farr via a manufacture technique evinced by Mocker to be known in the prior art as effective.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a) (Sept. 13, 2004).

AFFIRMED

Bradley R. Garris)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
Chung K. Pak)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
)	
Beverly A. Franklin)	
Administrative Patent Judge)	

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