

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GARRY GWOZDZ, MARK MITCHNICK
and DAVID FAIRHURST

Appeal No. 2006-1421
Application No. 10/434,397

HEARD: July 12, 2006

Before GARRIS, KRATZ, and TIMM, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 1-4, 6, 7, and 15. The record for this application reflects that claims 5 and 16 have been cancelled (see page 5 of both the original Brief filed June 20, 2005 and the replacement Brief filed October 14, 2005) and that claims 8-14 and 17-21 are now

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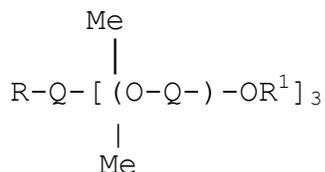
objected to as being dependent upon a rejected base claim but otherwise allowable (see page 2 on both the original Answer mailed September 8, 2005 and the replacement Answer mailed November 9, 2005).

We AFFIRM.

The subject matter on appeal relates to a free-flowing metallurgical powder comprising particles of metal and/or metal oxide having a coating thereon of an at least partially hydrolysed compound. Further details of this appealed subject matter are set forth in claims 1 and 4, the sole claims on appeal, which read as follows:

1. A free-flowing metallurgical powder comprising particles of metal and/or metal oxide having unagglomerated number average particle diameters of between 0.01 μm and 5 mm and a coating on the particles consisting essentially of an at least partially hydrolysed hydrolysable compound, the coating comprising from 0.005% to 10% by weight of the particles.

4. A free-flowing metallurgical powder comprising particles of metal and/or metal oxide having unagglomerated number average particle diameters of between 0.01 μm and 5 mm and a coating on the particles of an at least partially hydrolysed hydrolysable Si compound, the coating comprising from 0.005% to 10% by weight of the particles, wherein the hydrolysable compound comprises a material having the structural formula of



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wherein Me is a methyl group, R is an organic group, R¹ is an alkyl or aryl group, and Q is Si.

The references set forth below are relied upon by the examiner in the 35 U.S.C. § 102 and § 103 rejections before us.

Lefebvre et al. (Lefebvre)	5,798,439	Aug. 25, 1998
Mitchnick et al. (Mitchnick)	6,045,650	Apr. 4, 2000

Claims 1-3, 6, 7, and 15 are rejected under 35 U.S.C. § 102(b) as being anticipated by Lefebvre.¹

Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Lefebvre in view of Mitchnick.

We refer to the original and replacement Briefs as well as to the original and replacement Answers, for a complete exposition of the opposing viewpoints expressed by the appellants and by the examiner concerning the above-noted rejections.

OPINION

For the reasons set forth in the Answer and below, we will sustain each of the rejections before us on this appeal.

¹ By inadvertent oversight, the examiner has failed to include dependent claim 15 in this rejection as presented in his original and replacement Answers. However, this oversight is harmless since the appellants fully appreciate that claim 15 is included in this rejection as reflected by both the original and replacement Briefs.

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The § 102 Rejection

It is the examiner's position that Sample B (i.e., metal powder with a sol-gel coating of titanium alkoxide stabilized with diethanolamine) in Comparative Example 1 of Lefebvre anticipatorily satisfies each of the limitations recited in the here rejected claims.

According to the appellants, Sample B of Lefebvre is a comparative nonfunctioning example and therefore cannot anticipate the claims under review. We agree with the examiner, however, that Sample B would not be rendered non-anticipatory even if it were nonfunctioning in the manner argued by the appellants and that, more importantly, Sample B is expressly taught by patentee as being a useful, functional embodiment (e.g., see lines 42-47 in column 7).

The appellants further argue that the diethanolamine stabilizing agent of Sample B is excluded by the claim 1 language "consisting essentially of." This language renders the here rejected claims open to unlisted ingredients that do not materially affect the basic and novel properties of the invention. PPG Industries Inc. v. Guardian Industries, Corp., 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-54 (Fed. Cir. 1998). In this regard, we find nothing, and the appellants certainly

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point to nothing, in the subject specification which defines the scope of this language by making clear what is regarded as a material change in the basic and novel characteristics of the appellants' invention. Id., 156 F.3d at 1355, 48 USPQ2d at 1355.

For example, lines 8 and 9 on the sixth page of the specification (i.e., in the second full paragraph after the heading "DETAILED DESCRIPTION OF THE INVENTION;" note: the specification pages do not appear to be numbered) teach that, "[i]n the practice of the present invention, it is desirable to minimize additives and to attempt to exclude most additives except for the hydrolysable compound(s)." Thus, while it is clear that some though not necessarily all additives are desirably excluded, no guidance is provided as to which additives are excluded versus included by the claim language "consisting essentially of" vis-à-vis materially affecting the basic and novel properties of the invention.

Particularly under these circumstances, it is the appellants' burden to show that the diethanolamine of Lefebvre's Sample B is excluded by the claim 1 language under consideration. PPG Industries., 156 F.3d at 1355-56, 48 USPQ2d at 1355-56. See also In re Herz, 537 F.2d 549, 551-52, 190 USPQ

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461, 463 (CCPA 1976) and In re De Lajarte, 337 F.2d 870, 873-74, 143 USPQ 256, 258 (CCPA 1964). This burden has not been carried on the record before us.

The only dependent claim subject matter separately argued by the appellants involves the claim 2 requirement that the hydrolysable compound of parent independent claim 1 be a silicon compound. Specifically, the appellants point out that the hydrolysable compound of Lefebvre's Sample B is a titanate and argue that "[i]t is not within the teachings of Lefebvre to replace the titanium in a non-functional example . . . with a silicon compound" (replacement Brief, page 16). As correctly explained by the examiner and not contested by the appellants, Lefebvre expressly teaches the use of silicon as well as titanium based compounds for coating metal particles (e.g., see the last paragraph in column 3 and the first full paragraph in column 5). For this reason and especially because the appellants have mischaracterized Lefebvre's Sample B as a nonfunctional embodiment, we perceive no merit or even technical accuracy in this argument.

In light of the circumstances recounted above, it is our determination that the examiner has established a prima facie case of anticipation which the appellants have failed to

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successfully rebut with argument or evidence to the contrary.²

See In re Oetiker, 977 F.2d 1443, 1444, 24 USPQ2d 1443, 1444

(Fed. Cir. 1992). We hereby sustain, therefore, the examiner's § 102 rejection of claims 1-3, 6, 7, and 15 as being anticipated by Lefebvre.

The § 103 Rejection

It is undisputed that Mitchnick discloses the use of a silicon-based compound as defined by the here rejected claim for coating particles, such as magnetic particles of the type taught by Lefebvre (e.g., see lines 6-19 in column 1, lines 28-44 in column 4, lines 40-59 in column 7, and lines 10-34 in column 8 of Mitchnick; also see lines 6-11 in column 1 and lines 36-67 in column 3 of Lefebvre). The examiner concludes that:

[I]t would have been obvious to one of ordinary skill in the art to employ the organometallic [silicon based coating material of Mitchnick] to coat the iron-base magnetic particles taught by Lefebvre . . . because using this coating material the coating thickness and

² We recognize that the appellants have discussed a "Declaration of Gary Gwozdz" on pages 14 and 15 of the replacement Brief and that the examiner has explained why this Declaration does not establish patentability in the paragraph bridging pages 5 and 6 of the replacement Answer. However, the evidence appendix of the replacement Brief expressly states that "[t]here is no extrinsic or declaration evidence at issue in this Appeal." Consistent with this statement is the fact that no copy of the aforementioned Declaration is associated with the replacement Brief (or the original Brief). In these respects, see the requirements of the pertinent regulation 37 CFR § 41.37(c)(1)(ix) (2004). For these reasons, we will not consider this Declaration vis-à-vis patentability of the appealed claims.

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continuity of the coating can be readily controlled as desired by Lefebvre . . . , col. 5, lines 31-40 and taught by Mitchnick [replacement Answer, page 4].

In support of their nonobviousness position, the appellants argue that "[o]ne of ordinary skill in the art would not use the materials taught by Mitchnick . . . in the non-functional comparative sample environment of Lefebvre [i.e., Sample B]" (replacement Brief, page 17). This argument is unconvincing. Contrary to the premise of the appellants' argument, it is inappropriate to characterize Sample B of Lefebvre as "non-functional." Furthermore, as expressed in the examiner's afore-quoted obviousness conclusion, an artisan would have been motivated to use the silicon-based coating material of Mitchnick because the "thickness and continuity of the [Mitchnick] coating can be readily controlled as desired by Lefebvre . . . and taught by Mitchnick" (replacement Answer, page 4).

In light of the foregoing, we again determine that the examiner has established a prima facie case of unpatentability which the appellants have failed to successfully rebut with argument or evidence of patentability.³ See Oetiker, 977 F.2d at

³ As a matter of interest, we observe that the earlier mentioned Declaration, which the appellants discussed with respect to the § 102 rejection and which we declined to consider in footnote 2, has not been discussed at all with respect to the § 103 rejection under review.

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1444, 24 USPQ2d at 1444. It follows that we hereby sustain the examiner's § 103 rejection of claim 4 as being unpatentable over Lefebvre in view of Mitchnick.

Other Issues

In the rejections advanced on this appeal, the examiner has focused on Lefebvre's disclosure of Sample B in Comparative Example 1 wherein a metallic powder is coated with a single coating of a titanium alkoxide sol-gel. However, Lefebvre's invention concerns metal powders sequentially (or simultaneously) coated with a gellable sol and a polymer resin (e.g., see the last paragraph in column 3 and Sample D in Example 2 at columns 7 and 8). This embodiment of a metal powder sequentially coated with a sol-gel coating (e.g., titanium alkoxide) followed by a resin coating appears to be encompassed by independent claim 1. That is, the recitation in this claim of "a coating on the particles consisting essentially of an at least partially hydrolysed hydrolysable compound" does not appear to exclude an additional coating of polymer resin in accordance with Lefebvre's invention.

Upon receipt of this decision, the examiner (and the appellants) should consider whether appealed claim 1 indeed encompasses Lefebvre's sequential coatings of sol-gel and

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polymer resin. If so, the examiner should consider applying this aspect of Lefebvre's disclosure against independent claim 1 as well as other claims including possibly the claims which are "objected to" but otherwise allowable (i.e., claims 8-14 and 17-21). In this regard, the examiner has not provided the record with an explanation as to why he considers these last mentioned claims to be allowable. However, it may be that these reasons are applicable to Lefebvre's Comparative Sample B embodiment but are not applicable to Lefebvre's inventive embodiments wherein metal powder is sequentially coated as discussed above. Regardless, the examiner should respond to this decision by providing the written record with his reasons for regarding any non-rejected claims, which at present are claims 8-14 and 17-21, as patentable over the teachings of Lefebvre including patentee's teachings of sequential coatings.

CONCLUSION

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

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§ 1.136(a)(1)(iv) (effective Sep. 13, 2004; 69 Fed. Reg. 49960
(Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

AFFIRMED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
)	
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)	
CATHERINE TIMM)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES

BRG:clm

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Kratz, Administrative Patent Judge, concurring:

I concur with the majority that the examiner's rejections are sustainable for the reasons set forth in the answer and agree with the reasoning and analyses provided in the majority opinion with the exception of the majority's decision respecting a "Declaration" of Gary Gwozdz, one of the named inventors of this application. The majority does not consider this "Declaration" in their opinion in support of the Decision. Unlike the majority, I would consider the Gwozdz "Declaration" in fashioning a final Decision, on the record before us.

The Gwozdz "Declaration" was received by the Patent and Trademark Office (PTO) on April 21, 2005 (the same date the Notice of Appeal was filed), as shown in the image file wrapper (IFW) record of this application. In an advisory action mailed on May 09, 2005, the examiner approved entry of the Gwozdz "Declaration" into the record. Appellants and the examiner discuss the Gwozdz "Declaration" in the replacement brief and the replacement answer, respectively, as acknowledged in footnote 2 at page 7 of the majority opinion. In addition, appellants relied on the Gwozdz "Declaration" in arguments presented in the brief (pages 15 and 16) filed June 20, 2005.

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However, there is an apparent inconsistency in the replacement brief in that appellants stated "[t]here is no extrinsic or declaration evidence at issue in this Appeal" under an "Evidence Appendix" section heading while appellants continue to rely on the entered Gwozdz "Declaration" in the Argument section of the replacement brief. The "Evidence Appendix" submission was filed as a part of or, in the alternative, to be a part of the replacement brief.⁴

The majority resolves this matter by relying on the statement submitted under the "Evidence appendix" caption and noting the absence of a copy of the Gwozdz "Declaration" submitted with the brief, in support thereof.⁵ In so doing, the

⁴ There were several submissions respecting the replacement brief. The IFW record is not entirely clear in recording the makeup of the individual submissions. For example, one copy of the replacement recorded in the IFW file record of this application as an October 14, 2005 submission includes portions from a facsimile transmission of October 14, 2005 and portions from a facsimile transmission of October 13, 2005. The other copy of the replacement brief recorded in the IFW file record as an October 14, 2005 submission includes a copy of a first class mail submitted replacement brief that does not include an Evidence Appendix. Review of the IFW file record to determine if the IFW file accurately reflects the actual submissions made by appellants should be undertaken prior to final disposition of this application. Corrections to the record should be made, if necessary, to accurately reflect the filings submitted by appellants.

⁵ The majority refers to the requirements of 37 CFR ' 41.37 (c) (1) (ix) (2004). However, it is noted that the record does not reflect that appellants were afforded an appropriate notification with a time period to comply that satisfies the requirements of 37 CFR ' 41.37(d) regarding a lack of a copy of the ADeclaration@ in an Evidence Appendix or any other perceived defect in the brief in terms of satisfying the requirements of 37 CFR ' 41.37 (c). Indeed, at the oral hearing, counsel presented arguments consistent with appellants= continued reliance on the Gwozdz ADeclaration@ in this appeal.

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majority disregards appellants' continued reliance on the Gwozdz "Declaration" in the Argument section of the briefs. Also, the majority does not fairly weigh the examiner's consideration of the "Declaration" as part of the argued appeal record.

It is my opinion that any final decision rendered should take into account the Gwozdz "Declaration" to afford appellants a fair hearing absent further clarification of the record via a Remand or Order. This is so because the "Declaration" is entered into the record and discussed in the briefs and answers, and such discussion should be given primacy over an inconsistent statement submitted under an Appendix heading. The appendix was apparently filed in response to one or more telephone calls. Moreover, the detailed content of any telephone conversations or calls respecting this matter are not memorialized in the record. Thus, I would afford the arguments made in the briefs coupled with the references to the Gwozdz "Declaration" that is of record more weight than does the majority in resolving this inconsistency short of further clarification sought via a Remand or Order.

However, in so considering the Gwozdz ADeclaration@ in light of the arguments made in the brief, I agree with the examiner=s

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criticisms of this ADeclaration@ as set forth in the answer. Concerning the examiner=s anticipation rejection over Lefebvre, appellants seemingly rely on the Gwozdz "Declaration" to support their assertion of an alleged compositional difference in the claimed coated particles and the asserted non-functional Sample B of Lefebvre.⁶ In this regard, appellants have not fairly established that the Transverse Rupture Strength comparison set forth in the Gwozdz "Declaration" is persuasive of a compositional or structural difference between the claimed product and that of Sample B of Lefebvre. Concerning this matter, the examiner has correctly noted that the Gwozdz "Declaration" discusses tests of a polymeric coated powder according to Lefebvre, not the applied sol-gel coated powder of Sample B of Lefebvre. The test results related in the Gwozdz "Declaration" have not been established to be commensurate in

⁶ To the extent appellants are also arguing an unexpected result for the claimed subject matter, we note that evidence of unexpected results, even if presented, is irrelevant in overcoming a rejection under 35 U.S.C. § 102. In re Malagari, 499 F.2d 1297, 1302, 182 USPQ 549, 553 (CCPA 1974) (holding that an anticipation rejection "cannot be overcome by evidence of unexpected results or teachings away in the art."). While appellants refer to the arguments made against the anticipation rejection ("reasons provided above," replacement brief, page 17) in arguing the obviousness rejection, appellants do not separately argue how the Gwozdz "Declaration" would be relevant in overcoming the obviousness rejection.

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scope with the claimed subject matter or fairly representative of the disclosure of Lefebvre for reasons indicated by the examiner at page 6 of the answer.

In addition, the Gwozdz "Declaration" is not in proper form for a declaration under 37 CFR ' 1.132, the Federal Regulation which the "Declaration" is most clearly associated with. See MPEP ' 716 and ' 716.02(g). Also, the reported "Declaration" data is presented as having been generated by an unnamed third party company without furnishing a first hand account in declaratory form as to the specific details of all of the tests conducted, including the particle sizes and source of the iron metal particles, the particular silane compound employed, the substrate employed, specific molding conditions used, etc. Thus, the informally presented information furnished in the Gwozdz "Declaration" has not been fairly established by appellants as being particularly persuasive in overcoming the examiner=s rejections.

While I consider an appeal record that includes the Gwozdz "Declaration," I reach the same conclusion as does the majority as to the propriety of the examiner=s rejections. Accordingly,

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I concur with the majority's decision to affirm the decision of
the examiner.

PETER F. KRATZ) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES

PRK:clm

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Mark A. Litman & Associates, P.A.
York Business Center, Suite 205
3209 West 76th Street
Edina, MN 55435