The opinion in support of the decision being entered today
was written for publication

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL T. SHELTON

Appeal 2006-2999
Application 10/378,489[1]
Technology Center 1700

Oral Argument: None
Decided: January 10, 2007

Before: FLEMING, *Chief Administrative Patent Judge*, HARKCOM, *Vice-Chief Administrative Patent Judge*, McKELVEY, *Senior Administrative Patent Judge*, and DELMENDO and LANE, *Administrative Patent Judges*.

McKELVEY, *Senior Administrative Patent Judge*.

DECISION ON APPEAL UNDER 35 U.S.C. § 134

A. Introduction

The appeal is from a decision of the Primary Examiner rejecting claims 1-20, all the claims in the application on appeal.

[1] Application for patent filed 3 March 2003. The real party in interest is Z-Man Fishing Products, Inc.

We affirm. Since we rely on evidence and rationale not relied upon by the examiner, applicant is authorized to treat our affirmance as a new ground of rejection. 37 CFR § 41.50 (2006).

B. Facts

The record supports the following facts by a preponderance of the evidence.

The invention

The invention relates to a fishing lure made from synthetic rubber having a non-tacky surface. Specification, page 1, lines 3-4.

Prior to applicant's invention, many commercially available fishing lures were made from "plastisol." Specification, page 1, lines 6-7.

A plastisol is a dispersion or emulsion of polyvinyl chloride (PVC) resin in a plasticizer. Specification, page 1, lines 7-8.

Lures made of various plastisols are said to have been widely accepted. Specification, page 1, lines 8-9.

The plastisol lures are capable of being molded into various shapes, easily colored, relatively inexpensive and "appear lifelike." Specification, page 1, lines 9-11.

A plastisol lure, however, is said to be deficient in that it (1) is not very flexible, (2) is susceptible to tearing, (3) is relatively hard, (4) is perceived as environmentally unsafe and (5) while appearing to be lifelike, it does not feel lifelike. Specification, page 1, lines 11-15.

As a result, it has been proposed that lures be made of a synthetic rubber as opposed to plastisols. Specification, page 1, lines 16-17.

The synthetic rubbers are thermoplastic elastomers, in particular styrene block copolymers. Specification, page 2, lines 3-4.

The lures made from synthetic rubbers are said to be "a significant improvement" over plastisol lures. Specification, page 2, lines 4-5.

We are told that the synthetic rubber lures (1) can be colored and shaped, (2) are softer and elastic and (3) not only look lifelike but feel lifelike. Specification, page 2, lines 5-8.

The synthetic rubber lures will stretch and will not break like the plastisol lures. Specification, page 2, lines 22-23.

Nevertheless, according to applicant the synthetic rubber lures "are extremely tacky." Specification, page 2, line 9.

The tackiness causes synthetic rubber lures to stick to one another or the tackle box, which applicant informs us "is unappreciated by the fisherman." Specification, page 2, lines 14-16.

Against this background it is said that there was a need to lessen surface tack of lures made from synthetic rubbers. Specification, page 3, lines 1-2.

Various patents mentioned in the specification are said to describe reduction of surface tackiness through the incorporation of a stearic acid compound into the synthetic rubber. Specification, page 3, lines 3-9.

The use of stearic acid compounds is said to be appropriate in some cases, but in other cases is inappropriate because stearic compounds are said to negatively impact the dyes used to color the lures. Specification, page 3, lines 9-12.

Alternatively, a synthetic rubber lure surface may be "detackified" through use of a coating having a silicone oil. Specification, page 3, lines 12-14.

Applicant states:

> But, as the lure is used repeatedly in water, the oil is washed from the surface of the lure and it [the surface] reverts to its tacky nature.

Specification, page 3, lines 14-16.

Accordingly, we are told that coating with silicon oil does not provide a "permanent" solution to the surface tack problem. Specification, page 3, lines 16-18.

Rather, according to applicant "there is a need for a *permanently* detackified fishing lure made of a synthetic rubber." Specification, page 3, lines 19-20.

The specification defines "permanent" as:

> Permanent, as used herein, refers to the detackifying coating's ability to maintain its functionality in spite of repeated usage or handling or in spite of washings associated with usage.

Specification, page 6, lines 20-23.

Applicant sets out to solve what he perceived to be a tackiness problem by coating the synthetic rubber lure with "a permanent detackifier." Specification, page 5, line 20.

The "permanent detackifier" is a "particulate" having an average particle size of 2 nanometers to 10 micros and a surface area of less than 1,000 square meters per gram. Specification, page 5, line 20 through page 6, line 1.

The detackifier may be selected from "the group consisting of" (1) silica gels, (2) natural silicas, (3) fumed silicas, (4) minerals, (5) zeolites (natural or synthetic), (6) organic materials, (7) decorative or ornamental

compounds, (8) pigments and (9) combinations thereof. Specification, page 6, lines 3-6.

According to applicant, "[t]he preferred detackifier is a fumed silica." Specification, page 6, lines 16-17.

Fumed silicas are commercially available, *inter alia*, under the registered trademark CAB-O-SIL®. Specification, page 6, lines 17-18.

As will become apparent later in the opinion, CAB-O-SIL® is a well-known material which those having ordinary skill in the art would have known is a "detackifier."

The "detackifier" is placed on a lure made of synthetic rubber in the form of a "detackifying coating." Specification, page 7, lines 1 and 20-21.

The detackifying coating may "further comprise a coating oil, preferably a silicone." Specification, page 7, lines 1-2.

We are not told explicitly why "silicone" oil is preferred as the coating oil.

Perhaps silicone oil is preferred because when molded, the synthetic rubber lures are said to have a chalky appearance, but when the silicone is applied the chalky appearance is said to disappear. Specification, page 7, line 20 through page 8, line 2.

The rejections

The examiner made three rejections.

Rejection 1: Claims 1-20 were rejected for failure to comply with the enablement requirement of 35 U.S.C. § 112. The examiner was concerned that the specification did not enable a means for providing a coating that is "permanent."

Rejection 2: Claims 2, 17 and 19 were rejected as being indefinite and therefore unpatentable under the second paragraph of 35 U.S.C. § 112.

Rejection 3: Claims 1-20 were rejected as being unpatentable under 35 U.S.C. § 103 over the prior art.

The Claims

Independent claim 1 reads (indentation added):

> A fishing lure comprises [sic—comprising]
>
> a shaped mixture of a synthetic rubber polymer and oil, and
>
> a coating of a permanent detackifier thereon,
>
> wherein said detackifier comprises a particulate having a diameter in a range of 2 nanometers to 10 microns.

Independent claim 17 reads (indentation added):

> A fishing lure comprises [sic—comprising]
>
> a shaped mixture of a synthetic rubber polymer and oil,
>
> said synthetic rubber polymer being one or more styrenic block copolymers,
>
> said oil being in excess by weight of said synthetic rubber polymer, and
>
> a coating of a detackifier thereon, wherein said detackifier is selected from the group consisting of: silica gels, natural silicas, fumed silicas, minerals, zeolites (natural or synthetic), organic materials, decorative or ornamental compounds, pigments and combinations thereof,

said detackifier being a particulate having a diameter in the approximate range of 2 nanometers to 10 micros and a surface area less than 1000 square meters per gram.

Independent claim 19 reads (indentation added):

A fishing lure comprises [sic—comprising]:

a shaped mixture of a synthetic rubber polymer and oil, said synthetic rubber polymer being one or more styrenic block copolymers,

said oil being in excess by weight of said synthetic rubber polymer, and

a coating of a detackifier thereon, where said detackifier is selected from the group consisting of: silica gels, natural silicas, fumed silicas, minerals, zeolites (natural or synthetic), organic materials, decorative or ornamental compounds, pigments and combinations thereof,

said coating further comprises a particulate having a surface area of less than 1000 square meters per gram and a coating oil, wherein a weight ratio of the shaped mixture to said coating oil being 8000:25 ± 20.

Prior Art

The examiner relied on two U.S. Patents to support the rejection under § 103.

(1)

Hastings, U.S. Patent 4,589,223 issued in 1986

Hastings is prior art under 35 U.S.C. § 102(b).

Hastings describes much, but not all, of the prior art described in applicant's specification.

Specifically, Hastings has as one of its objects a lure capable of attracting fish. Col. 1, lines 43-45.

The fish attracting composition of Hastings has (1) about 10% to about 50% of an effective styrene-butadiene copolymer, (2) about 40% to about 80% by weight of fish oil, preferably cod liver oil and (3) an effective amount (at least 10%) of an effective agricultural oil, such as palm oil or soybean oil. Col. 1, lines 54-63.

One styrene-butadiene copolymer described by Hastings is Stereon 840. Col. 4, line 17.

Too much copolymer makes the lure too rigid. Col. 2, lines 54-58.

Any available fish oil having fish attracting power can be used. Col. 2, lines 63-64.

An optional ingredient is a paraffin-type oil, such as a mineral oil, which is said to serve the purpose of making the composition less tacky. Col. 3, lines 17-19.

Another optional ingredient is an anti-tack modifier such as polyethylene or polypropylene in an amount of 0 to about 20% by weight. Col. 3, lines 26-28.

(2)

Prochnow, U.S. Patent 5,827,551 issued 27 October 1998

Prochnow is prior art under 35 U.S.C. § 102(b).

One of the Prochnow objects is to provide an attractant formulation for use on fishing lures that is easy to apply, withstands repeated exposures

to casting forces and resists removal when a lure coated therewith is fished, *i.e.*, used to try to catch fish. Col. 1, lines 45-48.

The formulation is made up of (1) a stable-water-in-oil emulation of petrolatum mineral jelly or wax, (2) a water soluble delivery agent, (3) a thickening agent and (4) a water soluble fish attractant. Col. 1, line 65 through col. 2, line 1.

Suitable thickening agents include ethylene-acrylic acid copolymers, polyethylene waxes, silica (e.g., CAB-O-Sil^{TM}), naturally occurring silicates, and naturally occurring silicate clays. The most preferred agent is fumed silica. Col. 2, lines 19-22.

The preferred formulations are said to be made of (1) 50-80% petrolatum, (2) 10-30% water soluble delivery agent, (3) 1-10% thickening agent, and 0.01-20% attractant. Col. 3, lines 6-8.

The lure is coated with the formulation by any suitable method depending on the viscosity of the final formulation and the available packaging/dispensing containers available. Col. 3, lines 40-43.

(3)

In addition to the prior art relied upon by the examiner, other prior art is relevant to the issues on appeal. The other prior art shows that one having ordinary skill in the art would have recognized that CAB-O-SIL® fumed silica is a well-known anti-tacking agent in a wide variety of fields.

(4)

Newman, U.S. Patent 3,751,286, issued 7 August 1973

Newman is prior art under 35 U.S.C. § 102(b).

Newman relates generally to thermographic transfer sheets. Col. 1, lines 4-9.

Newman teaches, among other things, that CAB-O-SIL can be used as a filler to "reduce the tackiness" of a binder material. Col. 3, lines 7-8.

CAB-O-SIL is identified as having an average particle size of 0.012 microns. Col. 3, lines 10-11.

CAB-O-SIL is described as the preferred filler, but clay, titania, alumina, calcium carbonate, and talc are also said to be suitable. Col. 3, lines -11-13

(5)

Shultz, U.S. Patent 4,111,853, issued 5 September 1978

Shultz is prior art under 35 U.S.C. § 102(b).

In general Shultz relates to new and useful particulate NaAOS [sodium alpha olefin sulfonate] compositions adapted for use as an intermediate or concentrate in the preparation of particulate synthetic detergent formulations. Col. 2, lines 59-64.

An optional ingredient which can be incorporated in the composition is an anti-tack or crisping agent. Col. 7, lines 60-61 and 67.

One anti-tack agent is pyrogenic silica available commercially under the trademark CAB-O-SIL EH-5. Col. 7, line 68 to col. 8, line 1.

(6)

Mirabella, U.S. Patent 4,503,004, issued 5 March 1985

Mirabella is prior art under 35 U.S.C. § 102(b).

In general Mirabella is directed to a pyrotechnic composition having improved flow properties. Col. 1, lines 14-15.

Mirabella describes making a pyrotechnic which turned out to be a sticky or tacky mass that would not flow to a mold or cavity of a press. Col. 2, lines 44-47.

The stickiness or tackiness is said to have been obviated by blending into the tacky mass about 1 percent of fumed silica sold under the trademark Cab-O-Sil. Col. 2, lines 47-51.

Addition of Cab-O-Sil® is said to have eliminated the tackiness problem and to have greatly increased the efficiency of the process for making pyrotechnics. Col. 2, lines 52-63.

(7)

Habib, U.S. Patent 4,534,767, issued 13 August 1985

Habib relates generally to protective sealing compositions. Col. 1, line 13.

Habib is prior art under 35 U.S.C. § 102(b).

Fused silica, including CAB-O-SIL, is described as having a very high surface area. Col. 3, lines 2-11.

Various tack tests are reported by Habib. See Table A and Table B, where dry tack is reported as a function of the amount of fumed silica in the composition. Depending on the amount of fumed silica used, dry tack is lower or higher. Col. 7, line 38 through col. 8, line 17.

(8)

Mazer, U.S. Patent 6,251,432 B1, issued 26 June 2001

Mazer is prior art under 35 U.S.C. § 102(b).

In general, Mazer relates to a coating system for sustained release of an agent from a dosage form, and particularly to a dosage form unit having a latex coating for sustained release of what is characterized as a beneficial agent. Col. 1, lines 6-9.

Apart from the principal ingredients of the dosage form, Mazer indicates (col. 10, lines 35-40) (emphasis added):

> Additional tableting aids also may be used to enhance fabrication and construction of the core. For example, and as embodied herein, a standard flow agent, such as talc, colloidal silica, or kaolin, is included to prevent *tackiness*, wherein fumed silica commonly available under the trademark CAB-O-SIL from Cabot Corporation is preferred.

(9)

Sue, U.S. Patent 6,667,059 B2, issued 23 December 2003

Sue is prior art under 35 U.S.C. § 102(e), Sue's filing date being 30 May 2001.

Sue teaches that CAB-O-SIL is anti-tacking agent. Col. 13, Table 3.

Sue also teaches that talc, one of applicant's other detackifiers, is also known as an anti-taking agent. Col. 13, Table 3.

Based on the new prior art references, we find that those skilled in a wide variety of arts would have known that CAB-O-SIL® could be used to obviate tackiness.

Other findings, as necessary, appear in the Discussion portion of this opinion.

C. Discussion

For two independent reasons, the invention sought to be patented would have been obvious within the meaning of 35 U.S.C. § 103.

(1)

At the outset, we note with respect to the obviousness issue, applicant elected to discuss only independent claims 1, 17 and 19. Hence, the appeal is decided on the basis of those claims. 37 CFR § 41.37(c)(1)(vii) (2005).

(2)

In claim 1, but not claims 17 and 19, applicant mentions a "permanent detackifier." While the applicant and the examiner have a difference of opinion about the meaning of "permanent detackifier", for the purpose of this appeal we believe the meaning of "permanent" is made reasonably clear on page 6, lines 20-23 of the specification.

"Permanent," according to applicant, "refers to the detackifying coating's ability to maintain its functionality in spite of repeated usage or handling or in spite of washings associated with usage." Consistent with the definition of "permanent" in the specification, in the Reply Brief filed 16 May 2006, applicant does "not deny that the coating would wear off over time …." So, permanent does not mean for all time. It means that as long as the lure does not become tacky during use, any coating may continue to be considered "permanent."

Having resolved the meaning of "permanent", we nevertheless find that it is hard to distinguish applicant's "permanent" from applicant's

characterization of the supposed "non-permanency" of prior art lures: "as the [prior art] lure is used repeatedly in water, the oil is washed from the surface of the lure and it reverts to its tacky nature." Specification, page 3, lines 14-16. The coating of the prior art lures, as well as applicant's lures, at some point revert to a tacky state. "Permanent" does not tell one skilled in the art in any practical sense how the return to tackiness of applicant's lures is to be distinguished from the return to tackiness of the prior art lure.

(3)

A review of the prior art discussed in the specification reveals that a point of novelty of applicant's claimed invention is the use of a detackifier which (1) has a particulate size of 2 nanometers to 10 microns (claim 1 and 17), (2) has a surface area of less than 1,000 square meters per gram (claims 17 and 19) and/or (3) is combined with a coating oil in a particular ratio, *viz.*, 8000:25 ± 20 (claim 19).

Styrene block copolymers have been used to make lures. The STEREON 840 copolymer described by Hastings (col. 2, lines 43-46) is a styrene butadiene block copolymer. *See*, *e.g.*, U.S. Patent 4,582,876 issued to Weemes on 15 April 1986 and filed (10 September 1984) shortly after Hastings (25 July 1984). At col. 6, lines 39-42 Weemes says: "Stereon 840 is a graded diblock copolymer of about 57% by weight butadiene and 43% by weight styrene and is sold by Firestone Synthetic Rubber & Latex Co." Thus, Hastings describes, consistent with applicant's description of the prior art, the use of styrene block copolymers to make lures.

Likewise, described by Hastings is the use of oil in combination with the styrene block copolymers and like applicant generally more oil is present than styrene block copolymer.

Hastings also recognizes, as did applicant, that lures made from styrene block copolymers and oil are "tacky." Col. 3, lines 17-19 and 26-28.

The difference between applicant's claimed subject matter and that of Hastings is that Hastings does not explicitly describe the use of detackifiers having a diameter in the range of 2 nanometers to 10 microns and a surface area less than 1000 square meters per gram. Applicant cannot deny that CAB-O-SIL® fused silica is a known detackifying agent having the diameter and surface areas called for by the claims given that it is applicant's preferred detackifying agent. *See* (1) Hawley's Condensed Chemical Dictionary, page 194 (12th ed. 1992), which states that CAB-O-SIL has the surface area in the range of 50 to 400 m^2/g, and (2) Newman which identifies the average particle size of CAB-O-SIL as being 0.012 microns (col. 3, lines 10-11).

A person having ordinary skill in the art faced with applicant's tackiness problem would have turned to the art which teaches eliminating or minimizing tackiness. *Cf.* (1) *Dann v. Johnston*, 425 U.S. 219, 96 S. Ct. 1393, 189 USPQ 257 (1976) (techniques used in other industries relevant to solving problem in data processing in banking industry); (2) *Graham v. John Deere Co.*, 383 U.S. 1, 86 S. Ct. 684, 148 USPQ 459 (1966) (problem facing insecticide container industry was not an insecticide problem; it was a mechanical closure problem so art dealing with closure techniques relevant); (3) *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U.S. 84, 62 S. Ct. 37, 51 USPQ 272 (1941) (automobile cigarette light problem was not a lighter problem; it was a circuit breaker problem so art dealing with circuit breakers was relevant) and (4) *Mast, Foos & Co. v. Stover Mfg. Co.*, 177 U.S. 485, 20 S. Ct. 708 (1900) (techniques used in other mechanical apparatus relevant to solving a similar mechanical problem in windmills).

In this case, it is appropriate to consider what one skilled in the art would have known about compounds which can be used as detackifiers. In using the known detackifier CAB-O-SIL® fumed silica in place of the also known paraffin oil or polyethylene or polypropylene detackifiers described by Hastings, applicant has done nothing more than use a known detackifier for its known purpose to achieve an expected result. *Cf. Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 90 S. Ct. 305, 163 USPQ 673 (1969) (use of a radiant-heat burner for its known use in combination with a spreader and tamper/screed held to be obvious).

Based on arguments in the Reply Brief, applicant in response to our rationale no doubt would contend that there is no specific teaching, and therefore no "motivation," to use CAB-O-SIL® fumed silica on lures in place of the detackifiers explicitly described by Hastings. *Graham v. John Deere Co.*, 383 U.S. 1, 86 S. Ct. 684, 148 USPQ 459 (1966), and other pre- and post-1952 Supreme Court precedent, however, does not require an explicit teaching of "motivation." Nor does binding precedent of our immediate reviewing court.

Does there have to be a suggestion in the prior art to do what an applicant claims? Yes. *In re Fridolph*, 134 F.2d 414, 416, 57 USPQ 122, 124 (CCPA 1943) ("does … [the prior] art suggest doing the thing which the appellant has done?"); *In re Goepfrich*, 136 F.2d 918, 920, 58 USPQ 324, 326 (CCPA 1943) ("the question is, could one skilled in the art with the references before him make the combination of elements here claimed without exercise of the inventive faculty ….").

Does the suggestion have to be explicit? No. *In re Rosselet*, 347 F.2d 847, 851, 146 USPQ 183, 186 (CCPA 1965) ("it is our view that the test of obviousness is not express suggestion of the claimed invention in any or all

of the references but rather what the references taken collectively would suggest to those of ordinary skill in the art presumed to be familiar with them.").

Statements in recent Federal Circuit precedent are consistent with *Fridolph* and *Rosselet*. For example, in *In re Kahn*, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), the Federal Circuit notes that the reason to justify a combination of prior art teachings may be implicit from the prior art as a whole, rather than expressly stated in a prior art reference. In *Dystar Textilfarben GmbH v. C.H. Patrick Co.*, 464 F.3d 1356, 1366, 80 USPQ2d 1641, 1649 (Fed. Cir. 2006), the Federal Circuit again notes that the reason to combine prior art teachings may be found in the knowledge of one of ordinary skill in the art, or in some cases, from the nature of the problem to be solved. The Federal Circuit also notes that if the prior art does not have an express suggestion to combine teachings in prior art references, then the level of ordinary skill will often predetermine whether an implicit suggestion exists. 464 F.3d at 1370, 80 USPQ2d at 1653.

A reason to combine teachings the prior art helps avoid an *improper* "hindsight" analysis. However, all have to recognize that post-filing date obviousness analysis is necessarily based on hindsight—one has to read the specification and analyze the claims and perform an "after-the-fact" analysis. But as long as the analysis takes into account only knowledge available in the prior art and the skill in the art, there can be no *improper* "hindsight" reconstruction of an applicant's claimed invention. *In re McLaughlin*, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). To the extent that applicant requires more of the PTO than is required collectively by the cited cases, we respectfully disagree.

The three *Graham* obviousness factors are squarely based on the statutory language of § 103: (1) scope and content of the prior art being based on the language "prior art", (2) differences between the subject matter sought to be patented and the prior art being based on the language "differences", and (3) level of ordinary skill being based on the language "a person having ordinary skill in the art." Unlike the statutory criteria on which the Supreme Court counsels fact-finding, nowhere does the word "motivation" appear in § 103. What drives the obviousness determination is what one of ordinary skill in the art would have known and would normally have done prior to an applicant's invention. And, a person of ordinary skill in the art is necessarily "motivated" to use known elements for their intended purpose without any further suggestion to do so. Section 103 is designed to prevent issuance of patents to inventions which preclude a person having ordinary skill in the art from using known elements for their intended purpose absent some significant reason to the contrary, *e.g.*, an unexpected result. Thus, as *Graham* points out in discussing writings of Thomas Jefferson, 383 U.S. at 10: "A man has a right to use a saw, an axe, a plane separately; may he not combine their uses on the same piece of wood?" *See also Dunbar v. Myers*, 94 U.S. 187, 195 (1876) (ordinary mechanics know how to use bolts, rivets and screws and it is obvious that any one knowing how to use such devices would know how to arrange a deflecting plate at one side of a circular saw which had such a device properly arranged on the other side).

In the case before us, a person having ordinary skill in the art seeking to solve a tackiness problem (1) would have known about CAB-O-SIL®, (2) would have known it was a detackifier, (3) would have known to use it where detackifying is necessary and (4) would therefore have used it to

detackify, *inter alia*, a tacky styrene block fish lure. Applicant's use of CAB-O-SIL® in place of other known detackifiers was well within the skill of a person having ordinary skill in the art. *Cf. Hotchkiss v. Greenwood*, 11 How. (52 U.S.) 248 (1850) (substitution of clay knob for metal and wood knobs held to lack that degree of skill and ingenuity which constitute essential elements of every [unobvious] invention;[2] in other words, the improvement is the work of the skillful mechanic, not that of an "inventor."

We recognize that applicant believes that he has discovered a different and new function through the use of CAB-O-SIL® fused silica, *viz*, a "permanent" coating. However, as discussed above, we are unable on this record to tell how applicant's coating is any more permanent that the silicone oil coatings used in the prior art. There is no objective evidence, such as credible scientific data, to compare the "permanency" of prior art coatings vis-à-vis applicant's "permanency." *Cf. Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45, 43 S. Ct. 322 (1923) (improved Fourdrinier machines which reached speeds of 600-700 feet per minute when the prior art at best had only reached 500 feet per minute); *Webster Loom Co. v. Higgins*, 105 U.S. 580 (1881) (improved loom which produced 50 yards per day when the prior art had been able to do only 40 yards per day). Moreover, an inventor must show with conclusive evidence that the results the inventor says the inventor gets with his invention are actually obtained with the invention. *See McClain v. Ortmayer*, 141 U.S. 419, 429, 12 S. Ct.

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[2] Today we would say "unobvious invention." *See In re Jacoby*, 309 F.2d 513, 516 n.3, 135 USPQ 317, 318-19 n.3 (CCPA 1962), where Judge Rich writing for the CCPA states: "To add to the statement it must be unobvious, as required by 35 U.S.C. § 103, the further statement that it must 'involve invention' is merely to state the same legal proposition in two different ways. It would seem to suffice to state it once, and that, preferably, in the words of the statute."

76, 79; *In re Klosak*, 455 F.2d 1077, 1080, 173 USPQ 14, 16 (CCPA 1972). Apart from some unclear subjective assertions concerning "permanency," applicant has failed to offer conclusive evidence to credibly establish what "permanency" results are actually obtained and whether those results would or would not be unexpected.

(4)

Claim 19 (but not claims 1 and 17) calls for use of a coating comprising (1) particulate matter (*e.g.*, CAB-O-SIL® fumed silica) and (2) coating oil. Silicone oil was used in the prior art to achieve detackifying. Specification, page 3, lines 12-14. One skilled in the art would have recognized that CAB-O-SIL® fumed silica could also be used to achieve detackifying. What the prior art reveals is that both silicon oil and CAB-O-SIL® fumed silica are individually known as detackifiers. Well-established in the binding precedent of our reviewing court, is the proposition that it is generally *prima facie* obvious to combine two compositions each of which is taught in the prior art to be useful for the same purpose in order to form a third composition which also used for that purpose. *See*, *e.g.*, *In re Kerkoven*, 626 F.2d 846, 850, 205, USPQ 1069, 1072 (CCPA 1980), *In re Pinten*, 459 F.2d 1053, 1055, 173 USPQ 801, 803 (CCPA 1972), *In re Dial*, 326 F.2d 430, 432, 140 USPQ 244, 245 (CCPA 1964) and *In re Crockett*, 279 F.2d 274, 276, 126 USPQ 186, 188 (CCPA 1960). Consistent with respectful adherence to *stare decisis*, in this case there is no apparent cogent basis for departing from a long-standing general rule established by the cited precedent.

(5)

Claim 19 (but not claims 1 and 17) calls for the use of a particular ratio of silicone oil to CAB-O-SIL® fumed silica. We have held that it would have been obvious to use a mixture of silicone oil and CAB-O-SIL® fumed silica. Manifestly, a person having ordinary skill in the art using a mixture knows that some ratio of one to the other has to be used.

There is nothing in the specification to indicate that the ratio is in any way critical or that any unexpected result is obtained using the claimed ratio. Nor can we imagine that one skilled in the art using a mixture of silicone oil and CAB-O-SIL® fumed silica would be unable to determine an appropriate ratio of one to the other. In fact, as shown by Habib, one skilled in the art would know that some experimentation is appropriate to determine suitable amounts of fumed silica to use to obtain a given amount of reduced tack. *See* Habib, col. 7-8, Table A and B. On this record, the ratio limitation does not render the claimed subject matter, as a whole, non-obvious.

(6)

The examiner's obviousness rationale is different from the rationale discussed to this point in this opinion. Nevertheless, it too supports a holding of obviousness albeit on a different obviousness theory.

From the examiner's point of view, it would have been obvious to use the attractant coating of Prochnow on the fishing lure of Hastings. It is true that Hastings makes lures from a composition designed to attract fish. On this record, we do not know how well the Hastings attraction compositions worked. What we do know, however, is that Prochnow's subsequent development in the fish attracting field is a coating which preferably contains, *inter alia*, CAB-O-SIL® fumed silica. Those skilled in the art

would know that fumed silica is an anti-tacking agent. That aside, Prochnow teaches that his composition (1) attracts fish, (2) is easy to put on lures (col. 1, line 46), (3) *withstands repeated exposures to casting forces* (col. 1, line 47), and (4) resists removal when used for fishing (col. 1, lines 47-48). In terms of applicant's "permanent" coating one skilled in the art cannot help but see a parallel.

Why would one skilled in the art use the Prochnow composition on the already fish attracting lure of Hastings? One skilled in the art uses known compositions for their intended purpose and there is no reason apparent to us why one skilled in the art would not use the Prochnow composition on the Hastings lure despite Hastings' claim of fish attracting properties of its lures. As in the case of the use of a mixture of two known detackifiers, one skilled in the art would recognize that both the Prochnow fish attractant and the Hastings fish attractant could be used in combination to make a fish attracting lure.

It is true that the examiner's reason for combining the teachings of Prochnow with those of Hastings is different than the reason applicant uses CAB-O-SIL® fumed silica to achieve detackifying. However, the reason one skilled in the art would combine prior art teachings does not have to be the same as the reason an applicant does so. *In re Kemps*, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1311 (Fed. Cir. 1996), citing *In re Dillon*, 892 F.2d 1554, 13 USPQ2d 1337 (Fed. Cir. 1989) (*en banc*). The examiner combines Prochnow with Hastings to achieve fish attractant properties. Since a preferred thickening agent described by Prochnow is CAB-O-SIL® fumed silica, one can find on this record that the use of the Prochnow composition on the Hastings lure will result in less tacky lures given the known anti-

tackiness properties of CAB-O-SIL® fumed silica. The bottom line is that the combination of Prochnow and Hastings would have rendered the subject matter of at least claims 1 and 17 obvious.

Applicant argues that Hastings teaches away from using "petroleum oils" because they are said to be exuded and are not attractive to fish. Col. 3, lines 19-21. For this reason, Hastings prefers to use "mineral oil." Applicant notes that Prochnow uses "petrolatum" as one of his ingredients. A careful reading of Prochnow reveals that Prochnow describes the use of "a stable water-in-oil emulsion of petrolatum *mineral* jelly or wax" (emphasis added). In making his argument, applicant does not distinguish between "petrolatum", "mineral oil", and "petrolatum mineral jelly or wax." In any event, one skilled in the art reading Prochnow and Hastings would conclude that what apparently was so in 1984 when Hastings filed his application, appears to have been subsequently overcome by 1996 when Prochnow filed his application.

(7)

One of applicant's principal arguments seems to be that hindsight is being used to reject his claims. We disagree. Only prior art knowledge is being used in connection with our rationale, as well as that of the examiner. We believe that applicant fails to come to grips with the fact that one skilled in the art uses known elements described in the prior art, indeed, we would say is necessarily "motivated" to use those elements as needed. Why would the hypothetical person skilled in the art close its eyes to the known properties of CAB-O-SIL® fumed silica? What applicant seeks to do is secure a patent on the use of CAB-O-SIL® fumed silica so that those skilled in the fish lure art would be prevented from using a known material for its known purpose to solve a known problem (minimize tackiness). Issuing a patent to applicant on the claimed invention would "remove existent knowledge from the public domain and restrict free access to materials already available." The Supreme Court tells us that what applicant wants to do is not permitted. *Graham v. John Deere Co.*, 383 U.S. at 6, 86 S. Ct. at 688, 148 USPQ at 462; *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146, 109 S. Ct. 971, 975, 9 USPQ2d 1847, 1850 (1989).

It is the duty of the Commissioner of Patents (now Director) and of the courts in the administration of the patent system to give effect to the constitutional standard by appropriate application, in each case, of the statutory scheme of the Congress and the primary responsibility for sifting out unpatentable material lies in the Patent Office. *Graham v. John Deere Co.*, 383 U.S. at 6 and 18, 86 S. Ct. at 688 and 694, 148 USPQ at 462 and 467. For all the reasons given above, we think the examiner's decision to reject the claims properly "sifted out" applicant's unpatentable invention.

D. Order

Upon consideration of the record, and for the reasons given, it is

ORDERED that the decision of the examiner rejecting claims 1-20 under 35 U.S.C. § 103 is affirmed.

FURTHER ORDERED that applicant is authorized to treat the affirmance as a new ground of rejection, in which case applicant may exercise the one of the two options set out in 37 CFR § 41.50(b) (2006): (1) reopen prosecution before the examiner with new evidence or amendments to the claims or both or (2) request rehearing.

FURTHER ORDERED that if applicant elects to treat our affirmance as a new ground of rejection the time for taking action under 37 CFR § 41.50(b) is set to expire **two months** from the date of this opinion.

FURTHER ORDERED that if applicant elects to treat our affirmance as not being a new ground of rejection, the time for seeking judicial review is **two months** from the date of this opinion. 37 CFR § 1.304 (2006).

FURTHER ORDERED that in view of the affirmance of the rejection under § 103 it is unnecessary to consider the remaining rejections under § 112.

FURTHER ORDERED that the provisions of 37 CFR § 1.136(a) are not applicable to time periods for taking subsequent action.

AFFIRMED

/ss/ Michael R. Fleming MICHAEL R. FLEMING *Chief Administrative Patent Judge*	
/ss/ Gary V. Harkcom GARY V. HARKCOM *Vice-Chief Administrative Patent Judge*	
/ss/ Fred E. McKelvey FRED E. McKELVEY *Administrative Patent Judge*	BOARD OF PATENT APPEALS AND INTERFERENCES
/ss/ Romulo H. Delmendo ROMULO H. DELMENDO *Administrative Patent Judge*	
/ss/ Sally Gardner Lane SALLY GARDNER LANE *Administrative Patent Judge*	

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