

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 MICHAEL BINDER

Appeal 2007-0142
Application 10/636,964
Technology Center, 1700

Decided: February 23, 2007

Before PETER F. KRATZ, JEFFREY T. SMITH, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Applicants appeal from a final rejection of claims 7 to 25 under 35 U.S.C. § 134 (2002).¹ We have jurisdiction under 35 U.S.C. § 6(b) (2002).

¹ An oral hearing was held on January 11, 2007.

We AFFIRM

Appellant's invention relates to a paraffin ring adapted to be fitted onto a spindle-like pin holder of a textile spinning machine. The paraffin is applied to a length of yarn as it is conveyed by the spinning machine during the manufacturing process. According to Appellant, the improvement in the paraffin ring resides in the wear indicator or a taphole that extends into the cylindrical paraffin member from a first end and is substantially parallel to the insertion bore. (Specification, page 2, lines, 6-10). Claims 7 and 16, as presented in the Brief, appear below:

7. A paraffin ring for paraffining yarn, said paraffin ring comprising:

- a) a paraffin cylindrical member, said cylindrical member having a first end and a second end, said second end adapted to engage a yarn to be paraffined;
- b) an insertion bore for receiving said cylindrical member on a holder when paraffining yarn, said insertion bore extends concentrically through said cylindrical member and along a central longitudinal axis thereof; and
- c) at least one taphole, said at least one taphole extends into said cylindrical member at said first end and substantially parallel to said insertion bore but not to said second end so that when said cylindrical body member second end is caused to engage a yarn to paraffin the same, said second end is worn away and said at least one taphole is caused to extend to the worn second end and provide a visual signal.

16. A paraffin ring for paraffining yarn, said paraffin ring comprising:

- a) a paraffin cylindrical member, said cylindrical member having a first end and a second end, said second end adapted to engage a yarn to be paraffined;
- b) an insertion bore for receiving said cylindrical member on a holder when paraffining yarn, said insertion bore extends concentrically through said cylindrical member and along a central longitudinal axis thereof; and
- c) at least one wear indicator, said at least one wear indicator extends into said cylindrical member at said first end and substantially parallel to said insertion bore but not to said second end so that when said cylindrical body member second end is caused to engage a yarn to paraffin the same, said second end is worn away and said at least one wear indicator is exposed at the worn second end.

The Examiner relies on the following reference in rejecting the appealed subject matter:

Stahlecker US 5,879,455 Mar. 9, 1999

The Examiner has entered the following grounds of rejection:

Claims 7, 8, 10-12, 14-18, 20-22, 24, and 25 stand rejected under 35 U.S.C. § 102 (b) as anticipated by Stahlecker. Claims 9, 13, 19, and 23 stand rejected under 35 U.S.C. § 103(a) as obvious over Stahlecker.

ISSUE

I.

The Examiner contends that Stahlecker describes a paraffin cylindrical member that comprises first and second tips (from a paraffining machine) extending into the cylindrical member at the first end and substantially parallel to the insertion bore. The Examiner contends that the

tips inserted into the paraffin cylindrical member create bores that are equivalent to the claimed wear indicator and taphole (Answer 3-4).

The Appellant contends that Stahlecker does not explicitly or inherently disclose all the elements of the claimed invention. Specifically Appellant contends that the region that surrounds the tips (spikes) of Stahlecker are not tapholes because tapholes do not contain metal spikes (Br. 8).

The first issue before us is whether Applicant has shown that the Examiner erred in rejecting the claims 7, 8, 10-12, 14-18, 20-22, 24, and 25 under 35 U.S.C. § 102 (b). The issue turns on whether the Examiner has established a reasonable belief that the property or characteristic recited in the claims would have been inherent to the product of Stahlecker, and whether the Appellant has adequately rebutted the Examiner's position by showing that the characteristic or property is not possessed in the cited reference. Specifically, the issue is: Does the paraffin described in the prior art contains voids that serve to provide a visual signal that the second end of the paraffin has been reached? We answer this question in the affirmative.

II.

Appellant contends that Stahlecker does not suggest or provide the motivation for producing a paraffin ring containing wear indicators/tapholes that have different depths (Br. 11-12).

The Examiner contends that Stahlecker describes "that the size and location of the tapholes are used for taking-along connection with the paraffin ring (column 4, lines 2 – 5), and therefore discloses that the length of the tapholes are selected depending on the desired depth of the connection." (Answer 5).

The second issue is whether the Examiner erred in rejecting claims 9, 13, 19, and 23 under 35 U.S.C. § 103(a). The issue turns on whether there is some teaching, suggestion or motivation to modify the invention of Stahlecker to meet the claimed invention. Specifically, the issue is: Has the Examiner identified a justifiable basis for varying the lengths of the projection tips that are inserted into the paraffin ring? We answer this question in the negative.

FINDINGS OF FACT

Appellant invented a paraffin ring for paraffining yarn. The paraffin ring is adapted to fit on a spindle-like pin holder of a textile spinning machine. The holder, or insertion bore, runs concentric to a central longitudinal axis of the paraffin ring. (Specification 1, ll. 14-17). The paraffin is applied to a length of yarn as it is conveyed by the spinning machine during the manufacturing process. (Specification 1, ll. 25-28).

The improvement in the paraffin ring resides in the wear indicator or a taphole that extends into the cylindrical paraffin member from a first end and is substantially parallel to the insertion bore. (Specification 2, ll. 6-10).

In operation of the spinning machine, the length of the paraffin ring wears away to visibly expose the taphole/wear indicator indicating that the paraffin ring will soon need to be changed. (Specification 2, ll. 13-20).

Stahlecker describes a cylindrical paraffin body (4) for paraffin waxing yarn. (Col. 3, ll. 42-44; Fig. 3).

Stahlecker discloses the paraffin body(4) is placed on a carrier (28) that comprises projection tips (28A) that are inserted into the paraffin body (4). The projection tips (28A) extend into the cylindrical paraffin body (4)

from a first end and are substantially parallel to the sliding section (25) on which the paraffin body (4) is arranged. (Col. 3, l. 55 – Col. 4, l. 7; Fig. 3).

Stahlecker discloses the waxing of yarn is performed by placing the yarn (12) against the front surface of the paraffin body (5). (Col. 3, ll. 47-48; Fig. 2).

PRINCIPLES OF LAW

A claimed invention is anticipated under 35 U.S.C. § 102 when all of the elements of the claimed invention are found in one reference. *See Scripps Clinic & Research Found. V. Genentech Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). The prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. *In re Schreiber*, 44 USPQ2d 1429, 1433 (Fed. Cir. 1997).

Under 35 U.S.C. § 103, a prima facie case of obviousness can be established based upon some teaching, suggestion, and/or motivation in the applied prior art reference(s) and/or knowledge generally available to a person having ordinary skill in the art to arrive at the claimed subject matter.

Pro-Mold & Tool Co. v. Great lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

The Examiner must explain why the prior art would have suggested to one of ordinary skill in the art the desirability of the modification. *See In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

The Examiner must provide evidence to support allegations of obviousness. *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002)

ANALYSIS

I.

Stahlecker describes a paraffin body that comprises projection tips (28A) that are inserted into the paraffin body. The projection tips (28A) extend into the soft cylindrical paraffin body displacing the paraffin from these areas to create a connection between the carrier (28) and the paraffin body. In the spinning machine of Stahlecker, the waxing of yarn is performed by placing the yarn against the front surface of the paraffin body (5). The paraffin body is worn down towards the projection tips (28A). As such, it is apparent that the displaced paraffin voids created by the projection tips (28A) would be reached before the second end of the paraffin and the carrier (28) and provide a visual indicator that the end of the paraffin is near. The structure of the paraffin containing the projection tips is the same as the claimed paraffin having a wear indicator/taphole. The projection tips of Stahlecker are not part of the paraffin body. However, these projection tips create voids in the paraffin body, which are the same as the claimed invention. Thus we uphold the Examiner's anticipation rejection.

II.

The mere fact that the prior art could be modified as proposed by the Examiner is not sufficient to establish a *prima facie* case of obviousness. See *In re Fritch*, 972 F.2d at 1266, 23 USPQ2d at 1783-84. The Examiner must explain why the prior art would have suggested to one of ordinary skill in the art the desirability of the modification. The Examiner has not

provided such an explanation. The Examiner takes the additional position that one of ordinary skill in the art would modify the length of the projection tips (28A) to adjust the connection between the carrier (28) and the paraffin ring. The Examiner has not provided any information as to why it would be desirable to have projection tips of varying lengths. The Examiner has not directed us to evidence on this record that suggests varying the lengths of the projection tips would improve or diminish the connection between the paraffin ring and the carrier. As such, the Examiner has not directed us to evidentiary support on this record for modifying the projection tips of Stahlecker to create voids in the paraffin ring that would meet the claimed invention. *See In re Lee.* Thus we reverse the Examiner's obviousness rejection.

CONCLUSION OF LAW

I.

The Examiner's rejection is supported by a legally sufficient basis for holding that the subject matter of claims 7, 8, 10-12, 14-18, 20-22, 24, and 25 would have been anticipated within the meaning of § 102 (b).

II.

On the record before us, the Examiner has not met the require burden in this case to establish that the claimed subject matter would have been obvious over the cited prior art. Thus, the Examiner's rejection is not supported by a legally sufficient basis for holding that the claimed subject matter of claims 9, 13, 19, and 23 would have been obvious within the meaning of § 103(a).

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DECISION.

The Examiner's rejection of claims 7, 8, 10-12, 14-18, 20-22, 24, and 25 is affirmed. The rejection of claims 9, 13, 19, and 23, is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED IN PART

tf/clj

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