

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* DENNIS R. FREEMAN,  
NEIL P. REDDEN, and STEVEN A. VAN SLYKE,  
APPELLANTS

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Appeal 2007-1170  
Application 10/971,698<sup>1</sup>  
Technology Center 1700

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Decided: May 14, 2008

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Before ADRIENE LEPIANE HANLON, ROMULO H. DELMENDO, and  
MARK NAGUMO, *Administrative Patent Judges*.

NAGUMO, *Administrative Patent Judge*.

DECISION ON REHEARING

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<sup>1</sup> Application filed 25 October 2004. The real party in interest is identified as Eastman Kodak Co. (Br. at 2.)

Freeman timely requests rehearing<sup>2</sup> under 37 C.F.R. § 41.50(b)(2) of our Decision<sup>3</sup>, in which we affirmed the Examiner’s rejection of claims 1-18 under 35 U.S.C. § 103(a) over the combined teachings of Freeman 013, Spahn, Hanson, and Shen. The affirmance was entered as a new ground of rejection. Freeman has elected to present arguments based solely on the record on appeal. “The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board.” 37 C.F.R. § 41.52(a)(1).

Freeman argues first that we erred in finding that the difference between the volume ratios obtained by modifying dimensions of the prior art sample heating chamber and the volume ratio recited by the claims (a factor of about 1.3—a difference Freeman prefers to say is about 30% higher) is “minor.” (Req. 2-3.) More particularly, Freeman argues that “[a] difference of 4 mm in the height of a 12.5 mm high container (or 7.5 mm in the height of a 25 mm high container) can hardly be considered to be minor. Applied to a more everyday scenario, this would mean that the difference in height between Shaquille O’Neal (7’1”) and the average American female (5’4”) is ‘minor.’” (Req. 3.)

We are not persuaded that our characterization was in error. Whether a difference is major or minor depends on context. In the context of containers used in a “tabletop” laboratory setting, we have no difficulty concluding that a difference of 30% in the volumes of containers used for

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<sup>2</sup> Request for Rehearing under 37 C.F.R. § 41.50(b)(2), filed 15 August 2007 (“Req.”).

<sup>3</sup> Decision on Appeal, mailed 20 June 2007 (“Decision”).

evaporating substances is “minor,” just as we have no difficulty concluding that the differences in stature between healthy adult human beings are “minor” both biologically and bio-mechanically. In the laboratory or the workshop or the marketplace, common sense and the record indicate that adjustments to accommodate such differences in size are generally expected and generally within the skill of the average worker.

Freeman argues further that we misapprehended or overlooked that the claimed invention does not use the prior art element—the baffle—according to its “established function.” (Req. 3.) The established function of the baffle, according to Freeman, is to provide line-of-sight coverage of the substrate from the evaporating sample “to prevent particulate organic material from passing through the apertures.” (*Id.*.. 5, quoting Freeman 013, ¶ 15 and citing Spahn, abstract.) Freeman argues that the function of the baffle in the presently claimed invention—to achieve a specified volume ratio that “produces a more uniform flow into the region above the baffle” (Spec. ¶ 79)—is neither taught nor obvious over the prior art, and that KSR is therefore not on point. (*Id.* 3-5.)

These arguments are not persuasive because the function of the baffle, as taught by Freeman 013 and Spahn, remains the same in the suggested modifications, i.e., to block line-of-sight splatter from the vaporizing sample to the substrate. Thus, KSR remains on point: “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 1739 (2007). The Court added, “If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 1740. On the record before us, this is the case here.

The occurrence of a new function that leads to new results would of course be evidence of unexpected results that should be weighed against the evidence favoring obviousness. However, as we found (Decision at 8-10, Findings of Fact (FF) 27-33) the prior art already taught even deposition of evaporated material on a substrate. In particular, we found that the even deposition shown in the prior art was not distinguishable from the even deposition shown in Figures 16 and 17 of the specification supporting the claimed subject matter. (Decision 8, FF 28.) Thus, we find no credible evidence of unexpected results. Whether the analysis is cast in terms of obviousness, as we have done, or in terms of anticipation based on the potential scope of the limitation of the volume ratio being “at least approximately” the recited values (as Freeman suggests may be possible; Req. 1-2) makes little difference in the ultimate holding of unpatentability. The absence of a difference in results indicates that the differences between the prior art and the claimed subject matter remain obvious.

Freeman has not demonstrated error in our findings of fact or in our reasoning that it would have been obvious for one of ordinary skill in the art to enlarge the sample heating chamber to ease, as suggested, manipulation of the contents and elements of the chamber. On the present record, such larger chambers would continue to function in the same way and would not achieve any marked improvement of evenness of deposition on substrates. Absent unexpected results, the claimed subject matter is not patentable under § 103(a).

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**E. Summary**

In view of the record and the foregoing considerations, it is:

ORDERED that the Freeman's Request for Rehearing is GRANTED to the extent that its arguments have been considered;

FURTHER ORDERED that all requests for relief are DENIED; and

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

**DENIED**

rvb

EASTMAN KODAK COMPANY  
Patent Legal Staff  
343 State Street  
Rochester, N.Y. 14650-2201