

The opinion in support of the decision being entered today  
is *not* binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* VICTOR ROSYNISKY,  
KENNETH W. BLAMBLE, BRENT C. BIBBEE,  
JERRY D. CORNELIUS, RALPH A. QUIGLEY,  
GARY A. GRAMICCIIONI, MASAKI FUNABIKI,  
TUNEHISA KAWAUCHI, and TOMOYA TAKAHASHI

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Appeal 2007-2233  
Application 10/228,754  
Technology Center 1700

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Decided: August 30, 2007

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Before CHARLES F. WARREN, PETER F. KRATZ, and  
CATHERINE Q. TIMM, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicants appeal to the Board from the decision of the Primary Examiner finally rejecting claims 1 through 6 and 17 through 23 in the Office Action mailed October 18, 2005. 35 U.S.C. §§ 6 and 134(a) (2002); 37 C.F.R. § 41.31(a) (2005).

We reverse the decision of the Primary Examiner.

Claim 17 illustrates Appellants' invention of a method for applying a catalyst composition to an interior of a hollow substrate, and is representative of the claims on appeal.

17. A method for applying a catalyst composition to the interior of a hollow substrate comprising:

coating the interior of a hollow substrate with a catalytic composition by partially immersing an end the substrate into a vessel containing a bath of coating slurry and applying a vacuum to the partially immersed substrate at an intensity and time sufficient to draw the coating slurry upwardly from the bath into the interior of the hollow substrate;

removing the substrate from the bath;

rotating the substrate 180°; and

then applying a blast of air to the end of the substrate which had been immersed into the slurry to distribute the catalytic composition therewithin.

The Examiner relies on the evidence in these references:

Hoyer	US 4,038,939	Apr. 2, 1977
Watanabe	US 5,182,140	Jan. 26, 1993
Rosinsky	WO 97/48500 A1	Dec. 24, 1997

The Examiner applies Rosinsky in view of Watanabe to claim 17, one of two independent claims, and other claims under 35 U.S.C. § 103(a), and these references further combined with Hoyer with respect to other claims under 35 U.S.C. § 103(a), the two grounds of rejection submitted for review on appeal by Appellants (Answer 3-7; Br. 5). We decide this appeal on independent claim 17. 37 C.F.R. § 41.37(c)(1)(vii) (2005).

The claimed method comprises at least the steps of, among other things, coating the interior of a substrate by partially immersing an end thereof into a vessel containing the composition and applying a vacuum to the substrate to draw the composition upward into the interior of the

substrate, removing the substrate from the bath; rotating the catalyst composition containing substrate 180°; and “then applying a blast of air to the end of the substrate which has been immersed into the slurry to distribute the catalyst composition therewithin.”

The Examiner finds Rosinsky teaches the method steps of partially immersing an end of a hollow substrate into a bath containing a catalyst composition, applying a vacuum to a substrate which draws the composition into the interior of the substrate, removing the substrate from the bath, and drying the substrate prior to curing (Answer 3). The Examiner finds Rosinsky further teaches that “[t]he typical coating operation requires the immersion of one end of the substrate into the slurry followed by drying and then the insertion of the opposed end of the substrate into the slurry followed by drying and curing” (*id.* 3-4, citing Rosinsky 11:10-15 and 22-27). The Examiner takes the position “[s]ince the substrate has opposed ends, . . . the substrate must, necessarily, be rotated 180° in order to coat both opposing ends” (*id.* 4).

The Examiner determines Rosinsky does not apply a blast of pressurized air to the substrate to form a uniform coating therein (Answer 4). The Examiner finds Watanabe teaches the method steps of applying a catalyst composition to the interior of a hollow substrate “like Rosinsky,” and after coating with the composition, “pressurized air is supplied from the top of the substrate to discharge liquid which remains in the inner cells of the substrate thereby causing the coating liquid to adhere speedily and uniformly” (*id.*, citing Watanabe col. 3, ll. 40-63). The Examiner determines since both references teach applying a catalyst composition and both teach a

uniform coating is desirable, one of ordinary skill in the art would have modified Rosinsky's method by applying a blast of pressurized air to distribute the coating composition as suggested by Watanabe in the expectation of removing excess coating composition and distributing the remaining slurry in the substrate (*id.* 4-5).

The Examiner contends that when the combination of the references is applied to Rosinsky's method, the first end of the substrate is immersed in the composition; the substrate is removed from the composition; the thus coated substrate dried; the substrate is rotated 180°; the uncoated second end of the substrate is immersed; the substrate removed from the slurry; and then the pressurized air blast of Watanabe is applied (Answer 9).

Appellants contend that in considering the steps specified in claim 17, "the term 'then' precedes the step of applying the blast of pressurized air, which is recited immediately after the step of rotating the substrate 180°," requiring that after the coating has been applied to the substrate and the substrate rotated 180°, the blast of air is then applied to the end of the substrate immersed in the coating (Br. 7).

The issue in this appeal is whether the Examiner has carried the burden of establishing a *prima facie* case of obviousness in applying the combined teachings of Rosinsky and Watanabe to the claimed method encompassed by claim 17. This is the basic combination of references applied to all of the appealed claims and thus, a discussion of Hoyer is not necessary to our decision.

We agree with Appellants that when claim 17 is interpreted in light of the written description in the Specification, the claimed method encompasses

the successive steps of coating the interior of a substrate through a partially immersed end thereof, rotating the substrate 180°, and then applying a blast of air to the end of the substrate that had been submerged. *See, e.g., In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004); *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000); *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). We point out that while the transitional term “comprising” opens the claim to encompass methods which contain other steps and ingredients in addition to those specified in the claim as interpreted in light of the written description in the Specification, it does not modify specifically required steps and ingredients. *See, e.g., Vehicular Technologies Corp. v. Titan Wheel Int'l Inc.*, 212 F.3d 1377, 1383, 54 USPQ2d 1841, 1845 (Fed. Cir. 2000); *Genentech Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 802 (CCPA 1981).

We agree with the Examiner’s finding of fact from Rosinsky and Watanabe and determination of a method reasonably suggested to one of ordinary skill in the art by this combination of references. However, the Examiner has not established a *prima facie* case of obviousness because the

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suggested method does not have the three successive steps required by claim 17. *See Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-54, 5 USPQ2d 1434, 1438-41 (Fed. Cir. 1988).

Accordingly, in the absence of a prima facie case of obviousness, we reverse the grounds of rejection under 35 U.S.C. § 103(a).

The Primary Examiner's decision is reversed.

REVERSED

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