

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

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(2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GIAN L. RIGOSI,
ROBERTO MARZOLA, GIAN P. GUIDETTI,
DINO BACCI, and GEORGES ASPERTI

Appeal No. 96-1501
Application 08/172,517¹

HEARD: Sep. 18, 1997

Before STONER, Chief Administrative Patent Judge, and
LYDDANE and CRAWFORD, Administrative Patent Judges.

LYDDANE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's refusal
to allow claims 1 through 6, which are all of the claims pending
in the application.

¹ Application for patent filed December 21, 1993.

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The subject matter on appeal is directed to a process for coating the inner surface of metal containers. Claim 1 is exemplary of the invention and reads as follows:

1. A process for coating the inner surface of metal containers having an inside volume ranging from 20 to 250 liters, comprising:

1) electrostatically depositing on the inside surface of bottoms, lids and bodies of containers, a polyolefin composition selected from the group consisting of:

a) a polyethylene selected from the group consisting of HDPE, LDPE and LLDPE, said polyethylene having a melt index E ranging from 1 to 70 dl/g; and

b) a polypropylene composition having melt index L ranging from 15 to 150 g/10 minutes and comprising at least one of the following components (i) to (iii):

(i) a crystalline homopolymer of propylene;

(ii) a propylene/ethylene crystalline random copolymer; and

(iii) a propylene/ethylene/C₄₋₁₀ "-olefin crystalline random copolymer; and optionally, one of the following components (iv) to (vi):

(iv) an elastomeric copolymer selected from the group consisting of ethylene/propylene elastomeric copolymer and ethylene/1-butene elastomeric copolymer;

(v) a polypropylene modified with polar groups; and

(vi) a mixture of (iv) and (v); wherein said polyolefin composition is in powder form with the diameter of the particles not exceeding 600 micrometers and having a particle size

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distribution wherein no more than 25% of the powder has a particle diameter ranging from 300 to 450 micrometers, and no more than 10% have a particle diameter greater than 450 micrometers;

2) pre-melting the polyolefin composition deposited in step (1); and

3) assembling the bottoms, lids and bodies of the containers, and subsequently melting the polyolefin composition.²

The prior art of record relied upon by the examiner in rejections of the claims under 35 U.S.C. § 103 are:

Walker	1,921,247	Aug. 8, 1933
Matsumoto et al. (Matsumoto)	4,198,327	Apr. 15, 1980
Marzola et al. (Marzola)	4,350,797	Sep. 21, 1982

Appellants⁰ admitted prior art as described on pages 2 through 4 of the specification.

Claims 1 through 3, 5 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Appellants' admitted prior art in view of Walker.

Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Appellants' admitted prior art in view of Walker and Marzola.

² We understand the last paragraph of this claim to mean "assembling the bottoms, lids and bodies into containers, and subsequently melting the polyolefin composition."

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Claims 1 through 3, 5 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Matsumoto in view of Walker and Appellants' admitted prior art.

Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Matsumoto in view of Walker, Appellants' admitted prior art and Marzola.

Rather than reiterate the examiner's statement of the above rejections and the conflicting viewpoints advanced by the examiner and the appellants, we refer to pages 4 through 12 of the examiner's answer, to the supplemental answer, to pages 6 through 12 of the appellants' brief, to the reply brief, and to the supplemental reply brief for the full exposition thereof.

OPINION

In arriving at our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art, and to the respective positions advanced by the appellants and by the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to all claims on appeal. Our reasoning for this determination follows.

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In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). A prima facie case of obviousness is established by presenting evidence indicating that the prior art teachings would appear to be sufficient for one of ordinary skill in the relevant art having those teachings before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the prior art to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988), In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986) and ACS Hosp. Sys., Inc. v.

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Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Additionally, rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner has the initial duty of supplying the factual basis for the rejection. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellants' disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings in the prior art. See, e.g., Grain Processing Corp. v. American Maize-Prods. Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

With this as background, we first consider the examiner's rejection of claims 1 through 3, 5 and 6 under 35 U.S.C. § 103 as being unpatentable over Appellants' admitted prior art in view of Walker. We agree with the examiner's position that Appellants' admitted prior art discloses that it is well known to coat the inside of metal containers to be used for food products (page 2

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of appellants' specification) and that the admitted prior art also evidences that it is well known to utilize an electrostatic deposition technique for coating a powder of a polyolefin composition onto a surface to be coated (page 4 of appellants' specification). We also agree in substance with the examiner's position that the patent to Walker discloses a method of producing a container wherein components of the container are coated by tinning, jointed to one another, and then subjected to heat, thus causing the components coated by tinning to be sweated together.

However, Walker is directed to a metal can 1 formed by welding breast 2 and body 3 to a ring 7 (Figure 1 and page 2, lines 1-3), tinning the connected parts inside and out (page 2, lines 12-13), and forming a base 13, 15 which is also tinned over the entire exposed surfaces and then cooled (page 2, lines 20-34). The base and the body are then assembled, all the parts are then subjected to heating to cause the tinned surfaces to melt and to flow, thus causing the parts to be sweated together (page 2, lines 34-40).

It is clear that the process for coating the inner surface of metal containers of appealed claim 1 requires, inter alia, electrostatically depositing on the inside surface of bottoms,

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lids and bodies of containers, a polyolefin composition, premelting the polyolefin composition, assembling the bottoms, lids and bodies into containers and subsequently melting the polyolefin composition. It is our opinion that nothing in the Appellants' admitted prior art or in Walker teaches or suggests utilizing electrodeposited polyolefin to coat the individual elements of a container, much less premelting the polyolefin composition, assembling the elements into a container, and melting the polyolefin composition, all as required by the process of appealed claim 1. Moreover, even assuming arguendo that appellants' admissions would have suggested coating the inside of a container with polyolefin by electrodeposition, like the appellants, we fail to see how the process of forming the metal can of Walker would have taught one of ordinary skill in the art to utilize these admissions to premelt the polyolefin composition, then assemble the elements, and then melt the polyolefin composition again to arrive at the process recited in appealed claim 1. In our view, any relevance which the process of Walker may have with respect to appellants' claimed process only becomes apparent, if at all, from a reading of appellants' disclosure, and not from anything in the applied prior art.

As stated in W.L. Gore & Assocs., Inc. v. Garlock, Inc.,

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721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984),

[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

It is our conclusion that the only reason to combine the teachings of the applied prior art in the manner proposed by the examiner results from a review of appellants' disclosure and the application of impermissible hindsight. Thus, we cannot sustain the examiner's rejections of appealed claims 1 through 3, 5 and 6 under 35 U.S.C. § 103 as being unpatentable over Appellants' admitted prior art in view of Walker. We have also considered the additional teachings of the patent to Marzola applied in the rejection of appealed claim 4 under § 103, but we find nothing therein to cure the deficiencies noted above. Consequently, we also cannot sustain the examiner's rejection of appealed claim 4 under 35 U.S.C. § 103 as being unpatentable over Appellants' admitted prior art in view of Walker and Marzola.

We next consider the examiner's rejection of claims 1 through 3, 5 and 6 under 35 U.S.C. § 103 as being unpatentable over Matsumoto in view of Walker and Appellants' admitted prior

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art. From our review of the patent to Matsumoto, we find that Matsumoto discloses that polyolefin coatings may be applied to containers "useful as packaging materials for foods, liquids, and medicines" (column 4, lines 21-22) as has the examiner, but also that it discloses that a method of applying a polyolefin coating can include "adhering the polyolefin composition to the polar material by electrostaticity and then melting the polyolefin composition to laminate it on the polar material" (column 3, lines 58-61), and that a primer may be used prior to such coating (column 4, lines 5-7).

However, as with our discussion above with respect to the rejection of claims 1 through 3, 5 and 6 under § 103 as being unpatentable over Appellants' admitted prior art in view of Walker, we fail to see how the process of forming the metal can of Walker would have taught one of ordinary skill in the art to utilize these teachings to coat the inside surface of elements of containers, then premelt the polyolefin composition, then assemble the elements, and then melt the polyolefin composition again to arrive at the process recited in appealed claim 1. We again conclude that the only reason to combine the teachings of the applied prior art in the manner proposed by the examiner in this rejection of claims 1 through 3, 5 and 6 under 35 U.S.C.

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§ 103 results from a review of appellants' disclosure and the application of impermissible hindsight. Thus, we also cannot sustain the examiner's rejection of appealed claims 1 through 3, 5 and 6 under 35 U.S.C. § 103 as being unpatentable over Matsumoto in view of Walker and Appellants' admitted prior art. We have also considered the additional teachings of the patent to Marzola applied in the further rejection of appealed claim 4 under § 103, but we again find nothing therein to cure the deficiencies noted above. Consequently, we also cannot sustain the examiner's rejection of appealed claim 4 under 35 U.S.C. § 103 as being unpatentable over Matsumoto in view of Walker, Appellants' admitted prior art and Marzola.

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Accordingly, the decision of the examiner rejecting claims 1 through 6 under 35 U.S.C. § 103 is reversed.

REVERSED

Bruce H. Stoner Jr., Chief)	
Administrative Patent Judge)	
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William E. Lyddane)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
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