

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JOSEF TRENDELKAMP and JURGEN VELTEL

Appeal No. 1996-4167
Application No. 08/324,369

ON BRIEF¹

Before STAAB, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 6, 9, 11 and 12, which are all of the claims pending in this application.²

We REVERSE.

¹ On September 5, 2002, the appellants waived the oral hearing (see Paper No. 38) scheduled for October 10, 2002.

² Claims 11 and 12 were amended subsequent to the final rejection.

BACKGROUND

The appellants' invention relates to a filter-replacement cassette for an extruder (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art of record relied upon by the examiner in rejecting the appealed claims is:

Shirato et al. (Shirato)	4,167,384	Sep. 11, 1979
Konno et al. (Konno)	4,416,605	Nov. 22, 1983
Gaul, Jr. (Gaul)	4,507,072	Mar. 26, 1985
Lin	DE-GM 90 11 605.4	Nov. 22, 1990 ³

In addition, the examiner also relied upon the appellants' admission of prior art (specification, page 1, lines 16 to 20) relating to a filter-replacement cassette (Admitted Prior Art).

Claims 6, 9, 11 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over anyone of Shirato, Lin and the Admitted Prior Art in view of either Konno or Gaul.

³ In determining the teachings of Lin, we will rely on the translation provided by the USPTO. A copy of the translation is attached for the appellants' convenience.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the final rejection (Paper No. 24, mailed July 28, 1995), the answer (Paper No. 33, mailed March 19, 1996) and the supplemental answer (Paper No. 35, mailed July 9, 1996) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 31, filed January 29, 1996) and reply brief (Paper No. 34, filed April 22, 1996) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art, and to the respective positions articulated by the appellants and 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 the claims under appeal.⁴ Accordingly, we will not sustain the examiner's rejection of claims 6, 9, 11 and 12 under 35 U.S.C. § 103. Our reasoning for this determination follows.

⁴ Thus, there is no need in this case for us to weigh the declaration under 37 CFR § 1.132 filed on November 5, 1995 and argued in the reply brief.

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). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The appellants argue that the applied prior art does not suggest the claimed subject matter. We agree.

All the claims under appeal recite a filter-replacement device for an extruder comprising, inter alia, a housing having an inlet and an outlet for flowing plastic extrudate; first and second flow passages for the extrudate extending between the inlet and the outlet; a start-up outlet bore communicating with the first flow passage; first and second linear bores that extend through the first and second passages; first and second cartridges, respectively accommodating replaceable first and second filters and adapted to move back and forth inside a respective one of the first and second bores; the first cartridge having a tap for diverting extrudate from the inlet to the outlet bore and being movable between (1) a start-up position in which, extrudate flow to the first filter is

blocked and in which the tap communicates with the inlet via the first flow passage to receive the extrudate and direct the extrudate to the outlet bore, (2) a running position in which the extrudate can pass from the inlet to the outlet via the first flow passage and through the first filter and (3) a blocking position in which extrudate flow to both the tap and the first filter is blocked and flow through the first flow passage is blocked; and the second cartridge being movable between (1) a running position in which extrudate can pass from the inlet to the outlet via the second flow passage and through the second filter and (2) a blocking position in which extrudate flow to the second filter is blocked and flow through the second flow passage is blocked. However, these limitations are not suggested by the combined teachings of the applied prior art for the following reasons.

Shirato, Lin and the Admitted Prior Art teach or suggest a filter-replacement device for an extruder having a housing having an inlet and an outlet for flowing plastic extrudate; first and second flow passages for the extrudate extending between the inlet and the outlet; first and second linear bores that extend through the first and second passages; and first and second cartridges, respectively accommodating replaceable first and second filters and adapted to move back and forth inside a respective one of the first and second bores from a running position in which the extrudate can pass from the inlet to the outlet via the first flow passage and through the respective filter and a

blocking position in which extrudate flow to the respective filter is blocked and flow through the respective flow passage is blocked. Shirato, Lin and the Admitted Prior Art do not teach or suggest a filter-replacement device having a start-up outlet bore communicating with the first flow passage, the first cartridge having a tap for diverting extrudate from the inlet to the outlet bore. Thus, neither Shirato, Lin or the Admitted Prior Art has a start-up position for the first cartridge in which, extrudate flow to the first filter is blocked and in which the tap communicates with the inlet to receive the extrudate and direct the extrudate to the outlet bore.

To supply these omissions in the teachings of Shirato, Lin and the Admitted Prior Art, the examiner relied on the teachings of either Konno or Gaul. Konno and Gaul both teach the use a filter-replacement device for an extruder having a housing having an inlet and an outlet for flowing plastic extrudate; a single flow passages for the extrudate extending between the inlet and the outlet; a start-up outlet bore communicating with the single flow passage; a single linear bore that extends through the single flow passage; and a single cartridge adapted to move back and forth inside the single bore. The single cartridge has both a replaceable filter and a tap for diverting extrudate from the inlet to the outlet bore. The tap can be replaced with a filter. The single cartridge is movable between two positions. A first/start-up position in which, extrudate flow to the filter is blocked and in which the tap communicates with the inlet to

receive the extrudate and direct the extrudate to the outlet bore. A second/running position in which the extrudate can pass from the inlet to the outlet via the filter. In the first/start-up position the filter which is not in the flow of extrudate can be replaced. In the second/running position the tap which is not in the flow of extrudate can be replaced with another filter.

In our view, the combined teachings of the applied prior art would have made it obvious at the time the invention was made to a person of ordinary skill in the art to have only modified the filter-replacement device of either Shirato, Lin or the Admitted Prior Art by modifying the blocking position of the first and second cartridges to be a replaceable tap as taught by either Konno or Gaul. However, such a modification to the filter-replacement device of either Shirato, Lin or the Admitted Prior Art does not result in the claimed invention since the modified first and second cartridges would still only be moveable to two positions. Thus, the modified filter-replacement devices of Shirato, Lin or the Admitted Prior Art lack the claimed first cartridge being movable between (1) a start-up position in which, extrudate flow to the first filter is blocked and in which the tap communicates with the inlet via the first flow passage to receive the extrudate and direct the extrudate to the outlet bore, (2) a running position in which the extrudate can pass from the inlet to the outlet via the first flow passage and through the first filter

and (3) a blocking position in which extrudate flow to both the tap and the first filter is blocked and flow through the first flow passage is blocked.

Accordingly, we reach the conclusion that the only suggestion for modifying either Shirato, Lin or the Admitted Prior Art to arrive at the claimed invention stems from hindsight knowledge derived from the appellants' own disclosure, not from the teachings and suggestions set forth in the applied prior art. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claims 6, 9, 11 and 12 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 6, 9, 11 and 12 under 35 U.S.C. § 103 is reversed.

REVERSED

LAWRENCE J. STAAB
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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