

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DANIEL J. BOSCH, HAL W. COUSINS, ED L. HENDRICKS,  
DONALD R. JOHNSON and THOMAS F. MITCHELL

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Appeal No. 2000-1298  
Application 08/938,779

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ON BRIEF

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Before ABRAMS, FRANKFORT, and BAHR, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 10 through 13. Claims 18 and 19, the only other claims pending in the application, have been withdrawn from further consideration as being directed to a non-elected invention. Claims 1 through 9 and 14 through 17 have been canceled.

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Appellants' invention is directed to a baffle preform for use in the manufacture of a heat exchanger with a baffled, tubular header. Independent claim 10 is representative of the subject matter on appeal and a copy of that claim may be found in the Appendix to appellants' brief.

The prior art references relied upon by the examiner in rejecting the appealed claims are:

Knocke	3,269,582	Aug. 30,
1966		
Gire	5,450,667	Sept. 19,
1995		

Claims 10 through 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of Knocke and Gire.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejection and the conflicting viewpoints advanced by the examiner and appellants regarding the rejection, we make reference to the examiner's

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answer (Paper No. 12, mailed September 2, 1999) for the reasoning in support of the rejection, and to appellants' brief (Paper No. 10, filed August 20, 1999) and reply brief (Paper No. 13, filed October 29, 1999) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

On page 3 of the answer, the examiner directs us to Figure 8 of the Knocke patent urging that the closure plug (601) seen therein reads directly on the structure recited in appellants' claims, with the exception that the closure plug described in Knocke is not disclosed as being formed of aluminum as required in the claims on appeal and lacks the

recited braze clad of appellants' claimed subject matter. To account for these differences, the examiner points out that aluminum and its alloys are notoriously well known metals for fabricating diverse parts and that the Gire patent teaches a closure plug "somewhat like Knocke's" in which the plug is deformed into gripping contact with a header wall to hold it in place and wherein, to ensure a good seal with the wall, the plug can optionally be soldered in place. From these teachings, the examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of appellants' invention "to form the closure plug of Knocke out of a well known material such as aluminum, and in view of Gire, to provide a solder clad layer on the aluminum plug in the well known manner to provide a reliable seal with the wall in which the plug is installed" (answer, page 4).

After discussing the closure plug of Knocke and deformable partition (2) of Gire, appellants assert (brief, page 7) that the concepts involved in these two patents are mutually incompatible and that there is no reason to combine

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them other than through the use of hindsight. In appellants' view, the examiner has combined the applied references only after reading and studying appellants' own disclosure which has served as the road map for the combination. We agree with appellants' assessment of the examiner's rejection.

Assuming for argument sake that Knocke is analogous prior art, we nonetheless share appellants' view that there is no motivation, teaching or suggestion in the applied references, whether considered individually or collectively, for the examiner's proposed combination thereof in such a manner as to result in appellants' claimed baffle preform. In this regard, we agree with appellants that the examiner has used impermissible hindsight derived from appellants' own teachings in seeking to combine the applied prior art references in a manner so as to result in a baffle preform that has the specific configuration set forth in appellants' claims on appeal, is made of aluminum and includes a braze clad on at least one side thereof. In our opinion, even if one of ordinary skill in the art had selected some form of aluminum

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as the resiliently deformable material for making the closure plug in Knocke, such artisan would not then have found any teaching/suggestion in the applied references for also providing the resiliently deformable closure plug of Knocke with a braze clad on at least one side thereof. As urged by appellants, the concepts involved in the resiliently deformable plug of Knocke and the plastically deformable partition of Gire are so fundamentally different as to be mutually incompatible and to thus strongly militate against their combination.

With respect to the examiner's rejection, we note that, as our court of review indicated in In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992), it is impermissible to use the claimed invention as an instruction manual or "template" to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered obvious. That same Court has also cautioned against focussing on the obviousness of the differences between the claimed invention and the prior art rather than on

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the invention as a whole as 35 U.S.C. § 103 requires, as we believe the examiner has done in the present case. See, e.g., Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987).

Since we have determined that the teachings and suggestions found in Knocke considered with those of Gire would not have made the subject matter as a whole of claims 10 through 13 on appeal obvious to one of ordinary skill in the art at the time of appellants' invention, we must refuse to sustain the examiner's rejection of those claims under 35 U.S.C. § 103.

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In light of the foregoing, the decision of the examiner to reject claims 10 through 13 of the present application under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

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