

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(2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTHONY M. DICCIANNI and ERIC A. DICCIANNI

Appeal No. 1996-2644
Application 08/232,565

ON BRIEF

Before WINTERS, WILLIAM F. SMITH, and ROBINSON, Administrative Patent Judges.

ROBINSON, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-5, 8-12, 14-20, and 22-24, which are all of the claims pending in this application.

Independent claim 1 is illustrative of the subject matter on appeal and reads as follows:

1. A sealed system for handling, manipulating and formulating materials in an isolated environment, the system comprising:

a portable isolation system for performing at least a portion of the handling, manipulating, and formulating, the isolation system having an interior at least partially defined by a plurality of walls, an inlet port for allowing air to flow into the interior, an outlet port for allowing air to flow out of the interior, and a transfer port positioned on one of the walls for transferring items into and out of the isolation system;

an autoclave fixedly mounted to a building wall and selectively coupled to the transfer port of the isolation system and having an interior for receiving the items, the interior being accessible through an opening, the building wall having an opening in registry with the opening of the autoclave;

a substantially outwardly extending trough of predetermined configuration surrounding one of the transfer port of the isolation system and the opening of the autoclave, the trough having a sealing substance disposed therein; and

a substantially outwardly extending blade of predetermined configuration surrounding the other of the transfer port of the isolation system and the opening of the autoclave, the configuration of the blade corresponding to the configuration of the trough, the blade being aligned with and placed within the trough such that the blade sealingly engages the sealing substance within the trough to prevent external matter from passing into the interior of the isolation system and the interior of the autoclave through the transfer port and the opening, the interior of the coupled autoclave being accessible from the interior of the isolation system through the transfer port of the isolation system and the opening of the autoclave.

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The references relied upon by the examiner are:

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| Schwanke et al. (Schwanke) | 4,971,774 | Nov. 20, 1990 |
| Diccianni et al. (Diccianni) | 5,257,957 | Nov. 02, 1993 |
| Saint Martin (European Patent) | 0,095,971 | Jul. 12, 1983 |

Grounds of Rejection

Claims 1-5, 8-12, 14-20, and 22-24 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies on Diccianni, Saint Martin and Schwanke.

We reverse.

Background

At page 3 of the specification, the applicants describe the invention as relating to a sealed system for handling, manipulating and formulating materials in an isolated environment. The applicants state that the system is portable and includes an interior at least partially defined by a plurality of walls and a transfer port positioned on one of the walls for transferring items into and out of the isolation system which may be selectively coupled to an autoclave in a manner to prevent external matter from passing into the interior of the isolation system and the interior of the autoclave through the transfer port and the opening.

Discussion

The rejection under 35 U.S.C. § 103

It is the initial burden of the patent examiner to establish that claims presented in an application for patent are unpatentable. In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). We have carefully considered the evidence and discussion in support of the rejection presented by the examiner. However, a fair evaluation of the references, applicants' specification and consideration of the claimed subject matter as a whole, dictates a conclusion that arriving at the claimed system from the prior art teachings is not suggested by the record before us. To the extent that the prior art relied upon by the examiner establishes that the individual components of the claimed sealed system of claim 1 are old, we find no reason, suggestion, or direction, in the prior art, to combine the references in a manner to arrive at the claimed invention. To establish a prima facie case of obviousness, there must be more than the demonstrated existence of all of the components. There must be some reason or suggestion found in the prior art whereby a person of ordinary skill in the field of the invention would be led to combine the teachings of the prior art to arrive at the claimed invention. That knowledge cannot come from the applicants' invention itself. Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678-79,

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7 USPQ2d 1315, 1318 (Fed. Cir. 1988); In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). The extent to which such suggestion must be explicit in or may be fairly inferred from, the references, is decided on the facts of each case, in light of the prior art and its relationship to the invention. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention using applicants' specification as a template and selecting elements from references to fill the gaps. In re Gorman, 933 F.2d 982, 986-987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

As pointed out by appellants (Brief, page 16):

the examiner has not pointed to any objective teaching or disclosure that would suggest that the isolation structure disclosed in either the Diccianni or Saint Martin references could or should be modified to be sealingly mated to an autoclave fixedly mounted to a building wall such that the interior of the autoclave is accessible from the interior of the isolation structure, that the Schwanke sealing arrangement or any other sealing devices should be employed to seal the interconnection, or that a releasable securing device . . . should be employed to maintain the blade within the trough.

We conclude that the rejection before us is predicated on impermissible hindsight and that the examiner has failed to establish that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of the individual references to arrive at a sealed system for handling, manipulating, and formulating materials in an isolated environment which is selectively coupled to an

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autoclave fixedly mounted to a building wall as presently claimed. The rejection under 35 U.S.C. § 103 is reversed.

Summary

We reverse the rejection of claims 1-5, 8-12, 14-20, and 22-24 under 35 U.S.C. § 103.

REVERSED

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| SHERMAN D. WINTERS |) | |
| Administrative Patent Judge |) | |
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| WILLIAM F. SMITH |) | BOARD OF PATENT |
| Administrative Patent Judge |) | APPEALS AND |
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| DOUGLAS W. ROBINSON |) | |
| Administrative Patent Judge |) | |

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