

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. 42

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN E. BENNETT,
GERALD R. POHTO,
and
THOMAS A. MITCHELL

Appeal No. 1997-2667
Application No. 07/632,907

HEARD: OCTOBER 24, 2000

Before PAK, KRATZ, and TIERNEY, **Administrative Patent Judges**.

PAK, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's refusal to allow claims 26, 28, 30 through 38, 43 and 44 which are all of the claims pending in the application.

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Claim 26 is representative of the subject matter on appeal and reads as follows:

26. A greatly expanded titanium metal mesh of enhanced void fraction, said greatly expanded mesh being selected from the group consisting of titanium metal, titanium metal alloys, and intermetallic mixtures containing titanium metal, said titanium mesh having a pattern of substantially diamond-shaped voids having LWD and SWD dimensions for units of the pattern, the pattern of voids being defined by a continuum of metal strands interconnected at nodes, wherein the mesh is a flexible and stretchable titanium mesh with strands of thickness less than 0.125 cm and having a void fraction of at least 90%, said flexible and stretchable mesh being coilable and uncoilable about an axis along the LWD dimension of the pattern units and being stretchable along the SWD dimension of the pattern units and further being bendable in the general plane of the mesh about a bending radius in the range from 5 to 25 times the width of the mesh, with the mesh nodes being of double strand thickness.

In support of his rejections, the examiner relies on the following prior art:

Watkins 896,912 May 23, 1962
(Published British Patent Application)

"Niles Expanded Metals," page 12, 1973 (hereinafter referred to as "Niles").

Claims 26, 28, 30 through 38, 43 and 44 stand rejected under 35 U.S.C. § 102(b) as anticipated by the disclosure of Niles. Claims 26, 28, 30 through 38, 43 and 44 stand rejected under 35 U.S.C. § 103 as unpatentable over the

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combined disclosures of Watkins and Niles.

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This is the second appeal of the same subject matter previously considered by the merits panel. In the previous appeal, the merits panel reversed the rejections proposed by the examiner and made new grounds of rejection. However, these new grounds of rejection were made by the merits panel without the benefit of the new arguments and evidence advanced by appellants in the present appeal. Accordingly, we will reevaluate the propriety of these rejections repeated by the examiner in his Answer in view of the new arguments and evidence¹ presented by appellants in the present appeal.

The examiner has rejected claims 26, 28, 30 through 38, 43 and 44 under 35 U.S.C. § 102(b) as anticipated by the disclosure of Niles. Anticipation under Section 102 is established only if Niles discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. ***See In re Spada***, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); ***RCA Corp. v. Applied Digital Data Sys., Inc.***, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). However, the examiner has not disputed

¹The Bennett 1994 declaration contains additional evidence which was not presented in the Bennett 1992 declaration.

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appellants' assertion that Nile does not describe a flexible and stretchable titanium mesh with "strands of thickness less than 0.125 cm and having a void fraction of at least 90%." Compare Brief, page 7, with Answer in its entirety. Nor has the examiner challenged the propriety and sufficiency of appellants' assertion and evidence (a declaration executed by John E. Bennett on October 26, 1994 under 37 CFR § 1.132) directed to show that the claimed thickness and void fraction of a titanium mesh are not inherently present in the largest Niles titanium mesh, the number 9 mesh, relied upon by the examiner. Compare Brief, page 7, with Answer in its entirety. Under these circumstances, we are constrained to reverse the examiner's decision rejecting all of the appealed claims under 35 U.S.C. § 102(b).

The examiner has also rejected claims 26, 28, 30 through 38, 43 and 44 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Watkins and Niles. In order to establish a **prima facie** case of obviousness under Section 103, the prior art teachings as a whole must be sufficient to suggest to one of ordinary skill in the art making the modification needed to

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arrive at the claimed invention. ***See, e.g., In re Lalu***, 747
F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984).

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In the present case, the examiner does not appear to dispute appellants' assertion that neither Watkins nor Niles describe the claimed thickness and void fraction of a titanium mesh. Compare Brief, pages 7-9, with Answer, pages 3-5. Rather, the examiner appears to take the position that the need to optimize the physical characteristics of a titanium mesh for a given electrode would have led one of ordinary skill in the art to a titanium mesh having the claimed thickness and void fraction. See Answer, page 3-4. However, as correctly observed by appellants (Brief, page 9):

The reference combination follows the conventional wisdom, which suggests that: larger void fraction goes hand-in-hand with larger strand size. Appellants' unique mesh goes completely contrary to this conventional wisdom. As void fraction increases from 49% for the 188 mesh of the British '912 reference, to 72% for the Niles No. 9 mesh, strand dimension increases from 0.16 cm. to 0.366 cm. This reference combination thus guides completely away from arriving at the characteristics of Appellants' mesh.

Indeed, this observation is supported by the examiner's own evidence, Niles. Thus, we determine that a person having ordinary skill in the art, upon reviewing the prior art teachings as a whole, "would [have been] led in a direction divergent from the path that was taken by the applicant[s]."

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See In re Gurley, 27 F.3d 551, 553, 31 USPQ2d 1130, 1331 (Fed.
Cir. 1994).

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In other words, the applied prior art as whole would have taught away from the claimed subject matter. Since the examiner has not established obviousness regarding the claimed subject matter as indicated *supra*, we reverse the examiner's decision rejecting all of the appealed claims under 35 U.S.C. § 103 as well.

In view of the foregoing, the decision of the examiner is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED

CHUNG K. PAK)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
PETER F. KRATZ)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
MICHAEL P. TIERNEY)	
Administrative Patent Judge)	

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CKP:hh

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