

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte A. STEVEN PATTERSON

Appeal No. 1998-2001
Application No. 08/408,688

ON BRIEF

Before ABRAMS, STAAB, and MCQUADE, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 31-49,¹ which constitute all of the

¹An amendment to claim 48 was entered after the final rejection, as a result of which the examiner withdrew rejections of claims 48 and 49 under 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 102(b).

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claims remaining of record in the application, claims 1-30
having been canceled.

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The appellant's invention is directed to a magnetic fluid treatment apparatus (claims 31-47) and to a method for treating a fluid with magnetism (claims 48 and 49). The claims on appeal have been reproduced in an appendix to the Brief.

THE REFERENCE

The references relied upon by the examiner to support the final rejection are:

Zimmerman 5, 1981	4,265,755	May
Ambrose 1991	5,030,344	Jul. 9,
Ito 1991	5,055,189	Oct. 8,
Curtis 1993	5,238,558	Aug. 24,

THE REJECTIONS²

The following rejections stand under 35 U.S.C. § 103:

(1) Claims 31-35, 41 and 45-49 on the basis of Curtis.

²In the Answer, the examiner states that claims 31-49 are rejected under 35 U.S.C. § 103, and that "[t]his rejection" is set forth in Paper No. 18. This is in error. In fact, there are several rejections that apply to various groupings of the claims, and these are set forth in the final rejection, which is Paper No. 15.

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(2) Claims 36, 37 and 40 on the basis of Curtis in view of
Zimmerman.

(3) Claim 42 on the basis of Curtis in view of Zimmerman.

(4) Claims 38 and 39 on the basis of Curtis in view of
Ambrose.

(5) Claims 43 and 44 on the basis of Curtis in view of Ito.

Rather than attempt to reiterate the examiner's full
commentary with regard to the above-noted rejections and the
conflicting viewpoints advanced by the examiner and the
appellant regarding them, we make reference to the Examiner's
Answer (Paper No. 25) and the final rejection (Paper No. 15),
and to the Appellants' Briefs (Papers No. 24 and 26).

OPINION

All of the rejections before us are under 35 U.S.C. §
103. The test for obviousness under Section 103 is what the
combined teachings of the prior art would have suggested to
one of ordinary skill in the art. See, for example, In re
Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In
establishing a prima facie case of obviousness, it is
incumbent upon the examiner to provide a reason why one of
ordinary skill in the art would have been led to modify a

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prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. V. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1052 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988).

The appellant's invention relates to fluid treatment by means of magnetic devices, for the purpose of suppressing undesirable effects of scale and hard water. All of the independent claims recite first, second and third magnets of particular configurations and having specific relationships to one another, to a base member upon which they are mounted and to a spacer positioned on the base member. It is the examiner's position that the subject matter recited in these claims would have been obvious to one of ordinary skill in the art in view of the patent to Curtis.

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Curtis also is directed to treating water by magnetic means. Like the appellant, Curtis uses a plurality of magnets arranged in a particular relationship with one another, with a spacer, and with a mounting platform. Of critical importance to the issue of the patentability of the appellant's claims, however, is the requirement in the Curtis system that the magnet unit "comprises at least four magnets" (Abstract; column 2, line 63). Although it may contain more than four magnets (column 6, lines 49-50), it is clear that it cannot contain fewer than four.

In the statement of the invention in the appellant's apparatus claims 31 and 35 and method claim 48 the magnetic treatment apparatus is recited as "consisting of" an arrangement of three magnets in turn "consisting of" first, second and third

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magnets, and in the final three lines of method claim 48 that the method "does not include any further step of providing additional magnets to said magnetic fluid treatment apparatus." It is axiomatic that whereas the transitional term "comprising" is open-ended and does not exclude additional subject matter, the transitional term "consisting of" does exclude any element, step, or ingredient not specified in the claim, and thus closes the claim to the inclusion of additional subject matter. See Manual of Patent Examining Procedure § 2111.03. This being the case, Curtis, on its face, does not meet the terms of the appellant's claims, a factor which the examiner apparently recognizes.

It is the examiner's view, however, that it would have been obvious to one of ordinary skill in the art to omit one of the Curtis magnets "in order to reduce the cost and complexity of the device in cases where a magnetic field having a smaller area of coverage was required" (Paper No. 15, page 3). We do not agree. From our perspective, one of ordinary skill in the art would have been taught by Curtis that omission of a magnet is not an option because the patent states unequivocally that the invention must

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have at least four magnets, and to omit one magnet gives rise to the presumption that the Curtis system then would be inoperative for the purpose intended, absent evidence that such would not be the case. This, in our opinion, would have been a disincentive to the artisan of such magnitude as to negate motivation to make the modification offered by the examiner.

It therefore is our conclusion that the teachings of Curtis fail to establish a prima facie case of obviousness with regard to the subject matter recited in independent claims 31, 35 and 48. The rejection of these claims thus is not sustained, along with the rejection of claims 32-34, 41, 45-47 and 49.

Zimmerman, which was added to Curtis in the rejection of dependent claims 36, 37, 40 and 42, Ambrose, added with regard to dependent claims 38 and 39, and Ito, added with regard to claims 43 and 44, fail to provide teachings that would overcome the shortcoming of Curtis. Thus, the rejections of the these claims also are not sustained.

In view of our agreement with the appellant that the teachings of the references do not support a prima facie case

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of obviousness, it is unnecessary to consider the evidence regarding unexpected results.

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SUMMARY

None of the five rejections is sustained.

The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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JOHN P. MCQUADE)	
Administrative Patent Judge)	

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REVERSED

Prepared: March 2, 2001