

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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD L. LONG, JR.
and
DONALD E. BARBER

Appeal No. 1998-2642
Application No. 08/697,339

ON BRIEF

Before WARREN, WALTZ, and JEFFREY T. SMITH, **Administrative Patent Judges**.

WALTZ, **Administrative Patent Judge**.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 12, 14, 15, 17 through 20, 22, 23, 30 and 31 as amended subsequent to the final rejection (see the amendment dated Oct. 13, 1997, Paper No. 12, entered as per the Advisory Action dated Oct. 16, 1997, Paper No. 13). These are the only claims remaining in this application.

Appeal No. 1998-2642
Application No. 08/697,339

Appeal No. 1998-2642
Application No. 08/697,339

According to appellants, the invention is directed to a method of coating particulate material comprising placing particulate material on an oscillating tray where oscillating movement causes the material on the support surface to climb the inclined tread surfaces and advance from the rear of the tray to the forward end while liquid coating solution is sprayed onto the material (Brief, pages 2-7). A copy of illustrative claim 12 is attached as an Appendix to this decision.

The examiner has relied upon the following references as evidence of obviousness:

Burgess 1975	3,894,508	July 15,
Staniforth et al. (Staniforth) 1995	5,470,603	Nov. 28,
	(section 102(e) date of	Oct. 19,
		1992)

The claims on appeal stand rejected under 35 U.S.C. § 103 as unpatentable over Staniforth in view of Burgess (Answer, page 2). We reverse this rejection for reasons which follow.

OPINION

The claims on appeal stand rejected under section 103 over the combination of Staniforth and Burgess (Answer, page

Appeal No. 1998-2642
Application No. 08/697,339

2). The examiner finds that Staniforth discloses a method of coating pharmaceutical tablets by feeding tablets on an inclined, vibrated and perforated conveyor and teaches that liquid and dry powder application is known in the prior art (Answer, pages 2 and 4). The examiner finds that Staniforth fails to disclose or teach a conveyor with treads and risers and therefore applies Burgess to show such a conveyor used for coating articles with the advantages of even coating and uniform coating of both sides of the article (Answer, paragraph bridging pages 2-3). From these findings, the examiner concludes that it would have been obvious to substitute the conveyor of Burgess for the conveyor of Staniforth for its attendant advantages (Answer, page 3).

Appellants argue that Burgess is non-analogous art and therefore improperly combined with Staniforth as the evidentiary basis for the rejection (Brief, pages 8-10; Reply Brief, page 4). Accordingly, before any review of the examiner's obviousness analysis, we must determine whether Burgess is analogous art and is properly combined with Staniforth. See *In re Clay*, 966 F.2d 656, 658-59, 23 USPQ2d

Appeal No. 1998-2642
Application No. 08/697,339

1058, 1060 (Fed. Cir. 1992).

Determination that a reference is from non-analogous art is two-fold. First, we must determine if the reference is within the field of appellants' endeavor. If it is not, then we must determine whether the reference is reasonably pertinent to the particular problems with which the inventor was involved. See *In re GPAC Inc.*, 57 F.3d 1573, 1577-78, 35 USPQ2d 1116, 1120 (Fed. Cir. 1995); *In re Clay, supra*; and *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). Here we agree with the examiner that Burgess is within the field of appellants' endeavor, since Burgess and appellants' invention are directed to applying coating material to a product as it proceeds on the treads and risers of a conveyor. Contrary to appellants' arguments, we determine no reason why the size of the product to be coated would remove Burgess from appellants' field of endeavor (Brief, page 9; Reply Brief, page 4). Accordingly, we determine that Burgess is analogous art. However, we do not agree with the examiner's underlying factual basis in the obviousness analysis. Staniforth is directed to the *dry*

Appeal No. 1998-2642
Application No. 08/697,339

powder coating of particulate pharmaceutical tablet cores and teaches the disadvantages of the prior art liquid coating (col. 1, ll. 4-8; ll. 52-61). The examiner has not provided any convincing reasons or evidence why one of ordinary skill in the art would have used the prior art liquid coating, as disclosed by Staniforth, instead of the dry powder coating advanced by Staniforth as an improved process. The examiner's only reasoning is that "page 1, liens 22-24 Staniforth et al [sic, col. 1, lines 22-24, of Staniforth] discloses that liquid and dry powder application is part of the prior art." Answer, page 4. Even assuming *arguendo* that there was some convincing reason for substituting the prior art liquid coating process disclosed by Staniforth in the dry powder process, the limitations of claim 12 on appeal would not have been disclosed or taught by the reference. The examiner has mischaracterized col. 1, ll. 22-24, of Staniforth, as being directed to liquid or dry powder coating applications but Staniforth actually discloses various past proposals for *electrostatically* coating tablets with a liquid or dry powder (see col. 1, ll. 22-24). The process of claim 12 on appeal

Appeal No. 1998-2642
Application No. 08/697,339

specifically requires "spraying a layer of liquid coating solution onto the material *without* electrostatic bonding" (emphasis added). Furthermore, the examiner has not shown or alleged that the "liquid" coating disclosed as "Background" in Staniforth is identical to or suggests the "spraying" of liquid coating solution as required by the process of claim 12 on appeal.

The examiner states that the elimination of the electrostatic means and its corresponding function would have been obvious (Answer, page 4). However, the examiner has not recognized that the "Background" of Staniforth is directed to electrostatic liquid and dry powder coating applications.

Thus

one of ordinary skill in the art, if selecting the liquid coating

application taught as known by Staniforth, would have had no reason to omit the electrostatic means.

As discussed above, Burgess was applied by the examiner to show a conveyor with treads and risers in the coating art

Appeal No. 1998-2642
Application No. 08/697,339

and thus does not remedy the deficiencies of Staniforth.

For the foregoing reasons, we determine that the examiner has not established a *prima facie* case of obviousness.

Accordingly, the rejection of the claims on appeal under 35 U.S.C. § 103 as unpatentable over Staniforth in view of Burgess is reversed.

The decision of the examiner is reversed.

REVERSED

)	
CHARLES F. WARREN)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
THOMAS A. WALTZ)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JEFFREY T. SMITH)	
Administrative Patent Judge)	

TAW:hh

KIRK M. HARTUNG
ZARLEY, MCKEE, THOMTE,
VOORHEES & SEASE
801 GRAND AVE., SUITE 3200

Appeal No. 1998-2642
Application No. 08/697,339

DES MOINES, IA 50309

Appeal No. 1998-2642
Application No. 08/697,339

APPENDIX

Claim 12.

A method of coating particulate material, comprising:

placing particulate material to be coated on an elongated tray having opposite inlet and outlet ends and a support surface with alternating treads and risers thereon and perforations therethrough substantially covering at least the treads between the inlet and outlet ends,

oscillating the tray to cause the material to traverse the treads and risers as the material moves from the inlet end to the outlet end of the tray;

spraying a layer of liquid coating solution onto the material without electrostatic bonding as the material moves along the tray; and

directing air around the coated material and then through the perforations to enhance drying of the solution on the material.