

**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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** JOHN R. FISCHER

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Appeal No. 1998-2702  
Application No. 08/466,507<sup>1</sup>

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ON BRIEF

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Before COHEN, ABRAMS and BAHR, ***Administrative Patent Judges.***

ABRAMS, ***Administrative Patent Judge.***

**DECISION ON APPEAL**

This is an appeal from the decision of the examiner finally rejecting claims 4-7, which constitute all of the claims remaining of record in the application.

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<sup>1</sup> Application for patent filed June 6, 1995.

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The appellant's invention is directed to a superplastically formed part made from a blank. The claims before us on appeal have been reproduced in an appendix to the Brief.

**THE REFERENCES**

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

Bertolini et al. (Bertolini)	5,215,600	Jun.
1, 1993		
Japanese Patent (Nakamura) <sup>2</sup>	1-197020	Nov. 8,
1989		

**THE REJECTIONS**

Claims 4, 5 and 7 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claim 4 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Nakamura.

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<sup>2</sup> A PTO translation is enclosed.

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Claim 6 stands rejected under 35 U.S.C. § 103 as being unpatentable over Nakamura.

Claims 5 and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bertolini.

Claims 5 and 7 also stand rejected under 35 U.S.C. § 103 as being unpatentable over Bertolini in view of Nakamura.

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 the appellant regarding the rejection, we make reference to the Examiner's Answer (Paper No. 22) for the reasoning in support of the rejections, and to the appellant's Brief (Paper No. 21), for the arguments thereagainst.

#### **OPINION**

*The Rejection Of Claims 4, 5 and 7 Under 35 U.S.C. § 112*

This rejection is not sustained.

From a review of the appellant's specification, as well as from the understanding of the technology that we have obtained from the further explanations provided in the Brief and from the applied prior art, it is our opinion that the

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examiner's positions with regard to the five instances of alleged indefiniteness are not well taken. Claim 4 states that the claim is directed to a "formed part made from a blank," which is confirmed by the appellant in the Brief (page 8). From our perspective, one of ordinary skill would not have been confused by the use in claim 4 of the terms "part," "blank" and "original blank," to which the examiner has taken exception. So too would the artisan have understood that the phrase "before reversing die pressure" refers to the preliminary step that occurs prior to the step of pressurizing the die in the direction in which the finished part will be formed. What constitutes the "peak" and the "part floor" recited in claim 5 would have been clear from a reading of the specification in conjunction with viewing the drawings. Finally, we agree with the appellant that the use of "optionally" in claim 7 does not give rise to indefiniteness, in that what is optional is readily apparent.

*The Rejection Of Claim 4 Under 35 U.S.C. § 102(b)*

This rejection is sustained.

It is uncontroverted that this is a product-by-process claim (see Brief, page 8). In the case of this type of claim,

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the guidance provided by our reviewing court is that the determination of patentability is based on the product itself, and not on its method of production. That is, if the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) and *Atlantic Thermoplastics Co. v. Faytex Corp.*, 970 F.2d 834, 843-47, 23 USPQ2d 1481, 1488-91 (Fed. Cir. 1992). Once a rationale has been provided tending to show that the claimed part appears to be the same or similar to that of the prior art, albeit that the prior art part might have been produced by a different process, the burden shifts to the appellant to come forward with evidence establishing an unobvious structural difference between the claimed part and the prior art part. See *In re Marosi*, 710 F.2d 799, 803, 218 USPQ 289, 292-93 (Fed. Cir. 1983).

Looking now to claim 4, the "part" defined therein, considered apart from the method steps in the claim, requires the presence of a deep draw corner having a substantially uniform thickness with a wall on the adjacent corner, with the

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wall being substantially uniformly thick where conventional superplastic forming would produce a tapered thickness. We agree with the examiner that this is found in Nakamura, and therefore the reference anticipates<sup>3</sup> the structure recited in claim 4. To wit, Nakamura is directed to a superplastic molded part, is concerned with the same problem as the appellant's invention (translation, pages 2 and 3), and discloses (in the figure shown on the lower right on patent page 123) a part having two deep draw corners that have a substantially uniform thickness with the adjacent walls (translation, page 6). Nakamura considers this to be an improvement over the part made by conventional means, which has a tapered thickness on its walls and bottom (figure shown on the lower right on patent page 122).

In view of this showing in Nakamura, it is our opinion that the burden has been shifted to the appellant to provide evidence that there are unobvious differences in structure

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<sup>3</sup> Anticipation is established when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See *In re Paulsen*, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994).

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between the product produced by the claimed process and the product disclosed in the reference. Such evidence has not been presented.

*The Rejection Of Claim 6 Under 35 U.S.C. § 103*

This rejection is not sustained.

The test for obviousness 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 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, 1439 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

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Claim 6 recites a forming blank having a central bulge, a peripheral bulge, and at least one unthinned portion between the two bulges. While the forming blank disclosed by Nakamura and the method by which it is formed into a part have much in common with the appellant's invention, Nakamura does not teach that the various bulges shown in the upper right figure on patent page 123, which at that point are prethinned, are separated by an unthinned portion, nor does this appear to be inherent. Moreover, the examiner has not set forth, nor have we perceived on our own, any teaching, suggestion or incentive which would have led one of ordinary skill in the art to provide the Nakamura forming blank with the configuration of thinned and unthinned portions required by the claim.

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*The Rejection Of Claims 5 And 7 Under 35 U.S.C. § 102(b)*

This rejection is sustained.

Both of these claims require that there be an upstanding portion in the part, which is recited as a "peak" in claim 5 and a "male topographic feature" in claim 7. As we concluded above, independent claim 4 is a product-by-process claim and therefore claim 5, which depends from claim 4, is similarly directed. Claim 5 adds to the superplastic part that is the subject of claim 4 a "peak" connected to the part floor through the corner and the wall. Bertolini discloses a part manufactured of a superplastic material (column 1, line 13) in a pressurized molding process. The part has an upstanding "peak" formed over die portion 16, as seen in Figure 2. Although not explicitly stated in the patent, it would appear from Figure 2 that the thickness of all of the elements of the part shown therein, including the peak, corner and wall, are substantially the same and substantially uniform, as is broadly required by the part recited in the claim. From our perspective, therefore, all of the elements of the part recited in claim 5 (which, of course, includes those of claim

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4, from which claim 5 depends) are disclosed by Bertolini.  
Thus, Bertolini anticipates the subject matter of claim 5.

The same reasoning causes us to reach a like result with regard to independent claim 7. This claim also is a product-by-process claim, in that it is directed to a "superplastically formed part." While the method of forming the part in Bertolini might differ from that set forth in claim 7, the resulting part meets the structural requirements of claim 7, in that it has a male topographic feature protruding in at least one portion of a female configuration, with the male feature defining a steeply sloped wall of substantially uniform thickness. The rejection of claim 7 is affirmed.<sup>4</sup>

*The Rejection Of Claims 5 And 7 Under 35 U.S.C. § 103*

As we concluded above, all of the subject matter recited in claims 5 and 7 is disclosed in Bertolini; we consider the showing of Nakamura merely to be confirmatory. Anticipation being the epitome of obviousness (see *In re Fracalossi*, 681

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<sup>4</sup> While the presence of subparagraph (c) of claim 7 goes to the method of manufacture, we note that there appears to be no support in the original disclosure for "trimming the bulge from the formed blank," and thus it runs afoul of 35 U.S.C. § 112, first paragraph.

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F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982)), we will sustain the rejection of claims 5 and 7 on the basis of these two references.

We have carefully considered all of the arguments set out by the appellant as they might apply to those rejections which we have sustained. The arguments focus almost entirely upon the method by which the finished part is manufactured, that is, conditions that exist for a time prior to the final form of the part. However, the claims are not directed to a method of manufacturing a part, but to the part in its finished form. For this reason, the arguments are not persuasive.

#### **SUMMARY**

The rejection of claims 4, 5 and 7 under 35 U.S.C. § 112, second paragraph, is not sustained.

The rejection of claim 4 under 35 U.S.C. § 102(b) as being anticipated by Nakamura is sustained.

The rejection of claim 6 under 35 U.S.C. § 103 as being unpatentable over Nakamura is not sustained.

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The rejection of claims 5 and 7 under 35 U.S.C. § 102(b) as being anticipated by Bertolini is sustained.

The rejection of claims 5 and 7 under 35 U.S.C. § 103 as being unpatentable over Bertolini in view of Nakamura is sustained.

The decision of the examiner is affirmed-in-part.

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

***AFFIRMED-IN-PART***

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

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