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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD C. DARR

Appeal No. 1998-3317
Application No. 08/575,347

HEARD: October 11, 2000

Before COHEN, NASE, and JENNIFER D. BAHR, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 3 to 9, which are all of the claims pending in this application.[1]

[1] Claims 3 and 4 were amended subsequent to the final rejection.

We REVERSE.

BACKGROUND

The appellant's invention relates to a method for making a multi-layer blow molded container. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.[2]

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Mente	4,818,465	April 4, 1989
Slat et al. (Slat)	5,443,766	Aug. 22, 1995

Claims 1 and 3 to 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Slat in view of Mente.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted

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[2] An error in claim 4 was noted by the examiner on page 2 of the answer.

rejection, we make reference to the answer (Paper No. 14, mailed August 17, 1998) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 12, filed March 16, 1998) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 and 3 to 9 under
35 U.S.C. § 103. Our reasoning for this determination follows.

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the

whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved

as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id.

Claim 1 (the only independent claim on appeal) reads as follows:

> A method for making a multi-layer blow molded container, comprising:
>
> moving a sheet of resin having oppositely facing first and second surfaces between a pair of spaced heaters to provide heating thereof;
>
> drawing a vacuum at a confined area of the first surface of the heated sheet of resin such that the first surface has a convex shape and the second surface has a concave shape;
>
> thereafter engaging a male vacuum mold with the second surface of the sheet of resin and drawing a vacuum through the male vacuum mold to thermoform the sheet of resin into a preform liner;
>
> injection molding an outer layer of resin around the preform liner to provide a multi-layer preform; and
>
> blow molding the multi-layer preform to provide the multi-layer blow molded container.

Slat discloses a method of making a multi-layer preform used for plastic blow molding. Slat does not teach or suggest the "drawing" and the "thereafter engaging" steps of claim 1. Mente discloses a process for the production of shaped plastic elements wherein a heated thermoplastic sheet is first drawn by a vacuum such that a first surface has a convex shape and a second surface has a concave shape and thereafter a male vacuum mold is engaged with the second surface of the sheet.

The appellant argues (brief, pp. 3-4) that the examiner has not offered any reason why it would have been obvious to combine the applied prior art to arrive at the claimed invention. We agree since after reviewing the teachings of the applied prior art, we find no teaching, reason, suggestion, or motivation to have combined the applied prior art to produce the claimed device. In our view, the only suggestion for modifying
the applied prior art in the manner proposed by the examiner (answer, pp. 3-4) to arrive at the claimed invention stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an

obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See In re Dembiczak, supra; W. L. Gore and Assocs., Inc. v. Garlock, Inc., supra. It follows that we cannot sustain the examiner's rejections of claims 1 and 3 to 9.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 and 3 to 9 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN Administrative Patent Judge	)	
JEFFREY V. NASE Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JENNIFER D. BAHR Administrative Patent Judge	)	

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