

IN THE RECENT CASE OF *IN RE GLATT TECHNIQUES, INC.*, THE COURT OF APPEALS FOR THE FEDERAL CIRCUIT FINDS THAT THE U.S. PTO BOARD OF PATENT APPEALS AND INTERFERENCES FAILED TO MAKE A PROPER PRIMA FACIE CASE OF OBVIOUSNESS

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This case is discussed for you in the hope of once again showing yet another way of reasoning to overcome the stubborn stance often taken by an examiner and a subsequent affirmation by the U.S. Board of Patent Appeals and Interferences on obviousness issues.

“Because some of the Board’s key factual findings relating to its obviousness analysis are not supported by substantial evidence, and because the Board erred in concluding that the claims would have been obvious as a matter of law, we reverse.”

The *In re Glatt Techniques, Inc.* case, decided on January 5, 2011, involves a third party-requested ex parte reexamination of U.S. Patent No. 5,236,503. The invention involves a coating apparatus, which prevents the spray nozzle of the apparatus from being blocked by shielding the spray nozzle.

Claim 5, the claim at issue, is in Jepson format. That is, the preamble of claim 5 recites a well-known “Wurster coater.” The court highlighted, by citing another court case, that “the preamble elements in a Jepson-type claim are impliedly admitted to be old in the art.” The later part of claim 5 defines the invention as an “improvement [of the well-known Wurster coater] comprising shielding means positioned adjacent said spray nozzle for *shielding* the initial spray pattern developed by said nozzle against the entrance of particles moving upward through the upbed.”

The Examiner rejected claim 5 under 35 U.S.C. §103(a) based on the combined teachings of the presumed prior art recited in the preamble of claim 5 in view of a German patent publication (Naunapper). The examiner found that the Naunapper German reference teaches a “shielding means” for use in the admitted prior art Wurster coater.

In traversing the §103(a) obviousness rejection, the inventor “offered various types of secondary considerations evidence, including evidence of unexpected results, long-felt need, and commercial success due to the improvement.” However, the examiner found that the inventor’s evidence of commercial success was *not* in line with the scope of claim 5.

On appeal, the U.S. PTO Board of Patent Appeals and Interferences affirmed the examiner’s obviousness rejection. The PTO Board basically interpreted Naunapper’s shielding as “an *air* wall or [air] stream surrounding the [coating spray] nozzle;” and on this basis, agreed with the examiner’s finding of obviousness. In other words, the Board found that the Naunapper reference includes “an air source located below the coating spray nozzle,” which is used “to generate an air wall that shields the particles from the

initial spray pattern[; that is, the] ‘burst’ of air generated by this technique clears blockages by blowing through the agglomeration and dispersing the particles.”

As to the inventor’s secondary consideration evidence, the PTO Board interpreted “shielding means” to mean: (1) a physical shield, and (2) an air wall shield, and found that the inventor’s evidence of secondary considerations is insufficient in that it included only evidence for the physical shield. The Board went on to rule that the inventor’s evidence for secondary considerations did not include “a *comparison* of the claimed invention against an air wall shield such as the one taught by [the reference].”

The Court’s Findings: First, with respect to the obviousness rejection, the court found that the inventor’s spray coating “includes an element that reduces particle agglomeration- a shielding means that prevents the circulating particles from prematurely entering the initial spray pattern” and thereby providing the shielding means that prevents blocking of the spray nozzle by the coating spray. That is, the reference contains no such shielding element, despite the PTO Board’s finding that the reference contains a shield that is a mere air wall or burst of air that clears blockages by blowing through the agglomeration of the coating spray and dispersing the spray particles.

Second, the court found that the PTO Board is in error in requiring the inventor’s secondary considerations evidence to include multiple embodiments, one for the inventor’s embodiment and another embodiment taught in the reference. “It seems unlikely that a company would sell a product containing multiple, redundant embodiments of a patented invention.” In other words, it is sufficient for the inventor’s evidence to be directed solely to his sold invention, and “so long as what was sold was within the scope of the claims.”

The court thus held that “[b]ecause some of the Board’s key factual findings relating to its obviousness analysis are not supported by substantial evidence, and because the Board erred in concluding that the claims would have been obvious as a matter of law, we reverse.”

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