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EXAMINER

BUCHANAN, JACOB

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SUBRAMANIAN VENKATACHALAM, HERMAN LOPEZ, and
SUJEET KUMAR
(Applicant: ENVIA SYSTEMS INC.)¹

Appeal 2016-002835
Application 13/755,263
Technology Center 1700

Before MARK NAGUMO, MONTÉ T. SQUIRE, and LILAN REN,
Administrative Patent Judges.

SQUIRE, *Administrative Patent Judge.*

DECISION ON REHEARING

Appellant requests rehearing under 37 C.F.R. § 41.52 of a DECISION ON APPEAL docketed October 30, 2017 (“Decision”), wherein we affirmed the Examiner’s § 103 rejections of all appealed claims. Request for Rehearing filed December 28, 2017 (“Request”).

We have thoroughly reviewed the arguments set forth by Appellant in the Request, and we have reconsidered our Decision in light of those comments. We, however, are not persuaded of reversible error in the disposition of the rejections and decline to modify the Decision.

¹ Appellant is the Applicant, Envia Systems Inc., which, according to the Appeal Brief (“App. Br.”), is the real party in interest. App. Br. 3.

Appellant argues that the Decision should be modified because the Board misapprehended/overlooked issues related to the Examiner's rejection. Request 3. Appellant argues that the Board's finding regarding the combination of elements in the prior art is based on the "inappropriate use of hindsight analysis" and the Board considered the Matsumoto reference "out of context and not in view of the remaining references." *Id.* at 3, 4.

In particular, Appellant contends that Matsumoto is the least relevant reference of the three combined references (Request 4); none of the references alone or combined teach or suggest drying of any lithium metal hydroxide under an oxygen free atmosphere (*id.* at 5); and Lee teaches away from performing the drying in an oxygen free atmosphere (*id.* at 6), as required by the claims. Appellant also contends that combining the teachings of Matsumoto and Lee, as found by the Examiner, would render Lee's method unsuitable for its intended purpose. *Id.* at 6.

We do not find Appellant's arguments in this regard persuasive of reversible error because they are largely the same arguments Appellant made previously in the Appeal Brief and/or Reply Brief, which we considered in the course of rendering the Decision. *Compare* App. Br. 13 *with* Request 5 (arguing none of the references teach/suggest drying lithium metal hydroxide under an oxygen free atmosphere); *compare* Reply Br. 4 *with* Request 6 (arguing that Lee teaches away).

Contrary to what Appellant's argument suggests, the fact that in a prior art combination one reference may be more or less relevant than another reference with respect to certain claim elements does not negate the Examiner's findings regarding the combined teachings of the references and

what the combined teachings of the references would have suggested to one of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (“The test for obviousness . . . is what the combined teachings of the references would have suggested to those of ordinary skill in the art.”); *cf. also In re Burckel*, 592 F.2d 1175, 1179 (CCPA 1979) (“[A] reference must be considered not only for what it expressly teaches, but also for what it fairly suggests.”).

Appellant’s disagreement with the Examiner’s factual findings regarding the teachings of the prior art and contention that the Lee reference is a more relevant reference than the Matsumoto reference, without more, are insufficient to establish reversible error. *See SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1320 (Fed. Cir. 2006) (“[M]ere statements of disagreement . . . as to the existence of factual disputes do not amount to a developed argument.”).

Moreover, the fact that Lee discusses an experiment where certain “(Ni_{1/3}Co_{1/3}Mn_{1/3})(OH)₂ powders” were dried at 110°C in air (Lee 941) does not necessarily teach away from drying in an oxygen free atmosphere in the manner claimed. *See In re Fulton*, 391 F.3d 1195, 1201 (finding that there is no teaching away where the prior art’s disclosure “does not criticize, discredit, or otherwise discourage the solution claimed”).

Although Lee may describe certain powders being dried at 110°C in air, as the Examiner finds (Ans. 2–3), the reference also discloses that the lithium metal oxide powder can be made by using a co-precipitation process that occurs “under nitrogen atmosphere” (Lee 940) and an “inert atmosphere during co-precipitation” plays an important role to decide the purity of the metal hydroxide (*id.* at 941).

Appellant’s argument is also misplaced because, as previously discussed in the Decision (Decision 7), the Examiner relies on Matsumoto—and not Lee—for disclosing the claim step of drying the mixed metal hydroxide composition in an oxygen free atmosphere to form a dry mixed metal hydroxide composition. In particular, as the Examiner finds (Ans. 4), Matsumoto discloses a lithium battery material formed by co-precipitation of a lithium metal oxide and that the resulting precipitate is dried at 140°C in argon (an oxygen free atmosphere) before it is mixed with a lithium source and subsequently heat treated. Matsumoto ¶ 2, ll. 11–17, ¶ 3, ll. 3, 35–41.

Moreover, Appellant does not direct us to sufficient evidence or provide an adequate technical explanation explaining how the combined teachings of Matsumoto and Lee would render Lee’s method unsuitable for its intended purpose. Attorney argument is not evidence. *In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984).

Appellant further argues that the Decision is not based on a proper obviousness analysis under the law (Request 7); the Examiner provides no motivation for combining the references in the manner claimed (*id.* at 10); and the “motivation cited by the Examiner for combining elements from the references . . . is pulled out of thin air” (*id.* at 11).

These arguments are not persuasive of reversible error because they are, again, essentially the same arguments Appellant made in the Appeal Brief, which were considered in the course of rendering the Decision. *Compare* App. Br. 11–13 *with* Request 10–11 (arguing there is no motivation to combine the references).

As previously stated in the Decision (Decision 7–8) and contrary to what Appellant argues, we find that the Examiner does provide a reasonable

basis and identifies a preponderance of the evidence in the record to evince why one of ordinary skill would have combined the teachings of the references to arrive at Appellant's claimed invention. Ans. 3–4; Final Act. 4.

The fact that Appellant disagrees with the Examiner's reasons for combining the references, without more, is insufficient to rebut the Examiner's findings or otherwise establish reversible error. *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 420 (2007) (explaining that any need or problem known in the art can provide a reason for combining the elements in the manner claimed).

Appellant also argues that the Decision improperly shifts the burden of proof to the Appellant, i.e., it requires Appellant to prove that the claimed invention is nonobvious. Request 14.

We do not find this argument persuasive because the Decision does not shift the burden of proof of nonobviousness to Appellant. Rather, in conformity with long-standing appellate practice, Appellant does bear the burden of identifying harmful error in the decision below, or in our previous decision. *See In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011) (“[I]t has long been the Board's practice to require an applicant to identify the alleged error in the examiner's rejections.” (citing *Ex Parte Frye*, 94 USPQ2d 1072 (BPAI 2010) (precedential))).

As previously discussed at pages 6–9 of the Decision, we find that a preponderance of the evidence and sound technical reasoning support the Examiner's fact finding and determination that the combination of Kang, Lee, and Matsumoto suggests all of the steps of claim 1 and conclusion that the combination would have rendered the claimed method obvious. Kang,

Abstract, ¶ 25; Lee, Abstract, 939–940; Matsumoto ¶ 2, ll. 11–17, ¶ 3, ll. 3, 35–41.

We find further (Decision 7–8) that the Examiner provides articulated reasoning with rational underpinning for combining the teachings of the cited art to arrive at the claimed invention, and thus, establishes a prima facie case of obviousness. *See In re Huang*, 100 F.3d 135, 139 (Fed. Cir. 1996) (“Once a prima facie case of obviousness has been established, the burden shifts to the applicant to come forward with evidence of nonobviousness to overcome the prima facie case.”).

Appellant argues that, with respect to the patentability of claim 12, the Board misapprehended/overlooked Appellant’s arguments regarding unexpected results and improperly imposed the burden of persuasion on Appellant. Request 18–19. Appellant further argues that, with respect to the patentability of claims 17–20, the Board improperly applied the law on inherency. *Id.* at 21.

We do not find Appellant’s arguments in this regard persuasive of reversible error because, once more, they are essentially the same arguments Appellant made previously in the Appeal Brief and/or Reply Brief, which were considered in the course of rendering the Decision. *Compare* App. Br. 16–20 *with* Request 17–22; *compare* Reply Br. 8–10 *with* Request 17–22.

Accordingly, for principally the same the reasons previously discussed in our Decision, we continue to agree with the Examiner that the combinations of prior art references would have suggested all of the limitations of the claims and maintain our finding that the Examiner provides a reasonable basis and identifies sufficient evidence in the record to

evinced why one of ordinary skill would have been motivated to combine the teachings of the references to arrive at Appellant's claimed invention.

Appellant's Request does not reveal any factual findings regarding the prior art's teachings and the claimed invention which we have misapprehended or overlooked or that otherwise establishes reversible error in this regard.

Accordingly, we have considered the request, but decline to modify our Decision affirming the Examiner's § 103 rejections of the appealed claims. Hence, we deny Appellant's Request for Rehearing.

DENIED