



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/629,084	09/27/2012	Rodney Stuart McKenzie	069826-0272	7698
127052	7590	11/26/2018	EXAMINER	
Foley & Lardner LLP 3000 K Street N.W. Suite 600 Washington, DC 20007-5109			KOROVINA, ANNA	
			ART UNIT	PAPER NUMBER
			1729	
			NOTIFICATION DATE	DELIVERY MODE
			11/26/2018	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipdocketing@foley.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RODNEY STUART MCKENZIE and
JEFFREY A. POIRIER

Appeal 2018-000811
Application 13/629,084
Technology Center 1700

Before LINDA M. GAUDETTE, AVELYN M. ROSS, and
DEBRA L. DENNETT, *Administrative Patent Judges*.

DENNETT, *Administrative Patent Judge*.

DECISION ON APPEAL¹

STATEMENT OF THE CASE

Appellant² appeals under 35 U.S.C. § 134(a) from a rejection of claims 1–8, 10–18, and 20–22. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ In our Opinion, we refer to the Specification filed September 27, 2012 (“Spec.”); the Final Office Action dated April 7, 2017 (“Final Act.”); the Appeal Brief filed June 7, 2017 (“App. Br.”); the Examiner’s Answer dated August 30, 2017 (“Ans.”); and the Reply Brief filed October 30, 2017 (“Reply Br.”).

² Appellant is the applicant, Spectrum Brands, Inc., identified in the Appeal Brief as the real party in interest. App. Br. 3.

The claims are directed to electrochemical cells and zinc anodes comprising an anode can, wherein the entire anode can consists of an alloy comprising copper. App. Br. 22 (Claims App'x). Claim 1, reproduced below from the Claims Appendix, is illustrative of the claimed subject matter:

1. An electrochemical cell comprising:
 - a zinc anode comprising an anode can, wherein the entire anode can consists of an alloy comprising copper, wherein the alloy is selected from the group consisting of an alloy of copper, aluminum, silicon and cobalt; an alloy of copper, zinc, aluminum and cobalt; and, an alloy of copper, silicon, tin and chromium;
 - a cathode;
 - a gasket disposed between the anode and the cathode;and,
 - an electrolyte comprising a solute and an aqueous solvent.

REFERENCES

The Examiner relies on the following prior art in rejecting the claims on appeal:

Friedman	US 2,495,247	Jan. 24, 1950
Ruben	US 2,620,368	Dec. 2, 1952
Shapiro et al. ("Shapiro")	US 3,923,555	Dec. 2, 1975
Hutchison	US 3,984,166	Oct. 5, 1976
Cheskis et al. ("Cheskis")	US 4,071,359	Jan. 31, 1978
Shapiro et al. ("Shapiro II")	US 4,242,360	Dec. 30, 1980
Parikh et al. ("Parikh")	US 4,264,360	Apr. 28, 1981

Smith, III et al. ("Smith III")	US 4,409,295	Oct. 11, 1983
Drosdick	US 4,589,938	May 20, 1986
Breedis et al. ("Breedis")	US 6,471,792 B1	Oct. 29, 2002
Buckle et al. ("Buckle")	US 2002/0187391 A1	Dec. 12, 2002

REJECTIONS

The Examiner maintains and Appellant seeks review of the following rejections under 35 U.S.C. § 103(a): (1) claims 1–8, 11–18, and 21 over Ruben, Friedman, Cheskis, Smith III, Hutchison, Drosdick, Parikh, and Shapiro; (2) claims 1–3, 5, 8, 11–13, 15, 18, and 22 over Ruben, Friedman, Smith III, Breedis, and Shapiro II; and (3) claims 10 and 20 over Ruben, Friedman, Cheskis, Smith III, Hutchison, Drosdick, Parikh, and Shapiro in view of Buckle, or over Ruben, Friedman, Smith III, Breedis, and Shapiro II in view of Buckle. Final Act. 10–16; App. Br. 8–21.

OPINION

The claims require an “entire anode can” consisting of one of three alloys: an alloy of (a) copper, aluminum, silicon and cobalt; (b) copper, zinc, aluminum and cobalt; or (c) copper, silicon, tin and chromium. App. Br. 22–24 (Claims App’x). The Examiner relies on Ruben as the primary reference in each of the rejections. Final Act. 10–16. The Examiner finds that Ruben teaches all elements of the claims except the alloys. *See id.* at 10–13; Ans. 9. The Examiner relies on three sets of references (Cheskis, Smith III, Hutchison, and Drosdick; or Parikh and Shapiro; or Smith III, Breedis, and Shapiro II) as each teaching one of the three claimed alloys. Final Act. 11–13.

Appellant argues that the Examiner fails to establish the requisite reasoning to combine Ruben with any of the secondary references, and instead, relies on hindsight. App. Br. 10–13, 16, 20. Appellant’s argument is persuasive for the reasons discussed below.

Common to each rejection, the Examiner states that Ruben seeks the advantageous properties of conductivity, strength, low resistance, and corrosion resistance in an electrical contact material of the anode cup. Final Act. 12, 14, 15; Ans. 13–15. The Examiner finds that each of the secondary references teaches one or more of these advantageous properties, therefore concluding that it would have been obvious to one of skill in the art at the time of the invention to have combined Ruben with the secondary references to reach the claimed invention. *See* Final Act. 12–15.

Ruben, however, merely teaches that its cathode is conductive and its electrolyte may have low internal resistance. Ruben col. 1, ll. 7–8; col. 5, ll. 12–19. Ruben does not teach a desire for any allegedly advantageous properties identified by the Examiner. *See* Ruben, *generally*. The Examiner’s rationale for combining secondary references with Ruben is based on purported advantages in Ruben that are not disclosed in the reference. Instead, these desirable properties appear to be drawn from Appellant’s Specification:

The selection of an appropriate alloy of copper combined with other metals for the anode can is essential to the present disclosure. In particular, an appropriate alloy of copper will impart strength and corrosion resistance, as well as maintain low contact resistance and a quiescent surface relative to the wetted contact with the anode metal.

...

Appropriate metals will impart improved strength, prevent surface oxidation where low contact resistance is maintained, and enhance visual appearance.

Specification ¶¶ 23, 24. The Examiner appears to have used the Specification as a roadmap to locate secondary prior art references that teach certain advantageous properties, and hindsight to combine those secondary references with Ruben. “To imbue one of ordinary skill in the art with knowledge of the invention . . . , when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983).

It is improper to base a conclusion of obviousness upon facts, such as the advantages of using certain alloys, gleaned only through hindsight. “The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made.” *Sensonics Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570 (Fed. Cir. 1996) (citing *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138 (Fed. Cir. 1985)). Using the claimed invention as a template for its own reconstruction is “an illogical and inappropriate process by which to determine patentability.” *W.L. Gore & Assocs., Inc.*, 721 F.2d at 1553.

It is not enough for the Examiner to merely demonstrate that elements of the claimed invention were independently known in the prior art, as every element of a claimed invention often can be found in the prior art. *MetalCraft of Mayville, Inc. v. The Toro Co.*, 848 F.3d 1358, 1367 (Fed. Cir. 2017) (citing *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000)).

“Knowledge of a problem and motivation to solve it are entirely different from motivation to combine particular references.” *Id.* (citing *Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1373 (Fed. Cir. 2008)). Finding the Examiner’s explanation for concluding that the skilled artisan would have combined Ruben with the secondary references seriously flawed, we are left with only hindsight bias of which *KSR* warns us. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 401 (2007).

That one of ordinary skill at the time of the invention, presented with Ruben and the secondary references, *could have* combined them is not enough; it does not imply motivation to select those references and combine them to arrive at the claimed invention. *See Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015) (“[O]bviousness concerns whether a skilled artisan not only *could have made* but *would have been motivated to make* the combinations or modifications of prior art to arrive at the claimed invention.”) (citing *InTouch Techs., Inc. v. VGO Communications, Inc.*, 751 F.3d 1327, 1352 (Fed. Cir. 2014)).

We do not sustain the Examiner’s rejections of claims 1–8, 10–18, and 20–22.

DECISION

The rejections of claims 1–8, 10–18, and 20–22 are reversed.

REVERSED