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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PAUL DUNNWALD

Appeal 2018-009238
Application 13/576,472
Technology Center 2800

Before KAREN M. HASTINGS, MERRELL C. CASHION, JR, and
JANE E. INGLESE, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ requests review under 35 U.S.C. § 134(a) of the Examiner's decision rejecting claims 1, 3, 7–10, 17, 20, and 21 under 35 U.S.C. § 103(a) over the combined prior art of Pawloski et al. (US 3,425,950, issued Feb. 4, 1969) and Martin (US 6,311,538 B1, issued Nov. 6, 2001), with claims 4, 6, 11–17 and 22–25 rejected over Pawloski, Martin, and Kelvin et al. (FR 1,287,266, published Mar. 9, 1962).

We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Illinois Tool Works Inc. (Appeal Br. 4).

All of the independent claims are directed to a test panel. Independent claims 1 and 4 are illustrative of the subject matter on appeal (emphasis added to highlight key limitations in dispute):

1. A fluid penetrant inspection test panel comprising:
an uncoated substrate having a first surface and an opposing second surface,
the first surface configured to receive a dye penetrant thereon; and
a plurality of sensitivity indicators formed as blind holes by removing material in the first surface, the plurality of sensitivity indicators having a cross-sectional profile defined by a continuous edge, *wherein at least two of the plurality of sensitivity indicators differ in one or both of diameter and depth.*

4. A fluid penetrant inspection test panel comprising:
a substrate having a first surface and an opposing second surface, the first surface configured to receive a dye penetrant thereon; and
a plurality of sensitivity indicators formed by removing material in the first surface, the plurality of sensitivity indicators having a cross-sectional profile defined by a continuous edge, *wherein at least one of the plurality of sensitivity indicators has a non-circular cross-sectional profile.*

ANALYSIS

We review the appealed § 103(a) rejection for error based upon the issues identified by Appellant and in light of the arguments and evidence produced thereon. *Cf. Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential) (cited with approval in *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”). After having

considered the evidence presented in this Appeal and each of Appellant's contentions, we are not persuaded that Appellant identifies reversible error, and we affirm the Examiner's § 103 rejections for the reasons expressed in the Final Office Action and the Answer.

We add the following primarily for emphasis.

It has been established that "the [obviousness] analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). Likewise, it is well settled that a reference stands for all of the specific teachings thereof as well as the inferences one of ordinary skill in the art would have reasonably been expected to draw therefrom. *See In re Fritch*, 972 F.2d 1260, 1264–65 (Fed. Cir. 1992).

Appellant's arguments are unavailing because, as pointed out by the Examiner, they address the references individually but do not address sufficiently the Examiner's obviousness position (e.g., Ans. 4; *see generally* Appeal Br. and Reply Br.).

The Examiner aptly points out that merely stating that Martin has a brittle coating does not address the Examiner's position that it would have been obvious to use holes of varying sizes as exemplified in Martin's test panel in the test panel of Pawloski. Indeed, Appellant's Specification describes that the use of varying sizes of starburst shapes were known to be used in test panels to indicate different levels of sensitivity (Spec. ¶ 4).²

² An applicant cannot defeat an obviousness rejection by asserting that the cited references fail to teach or suggest elements which the applicant has acknowledged are taught by the prior art. *Constant v. Advanced Micro-Devices, Inc.*, 848 F. 2d 1560, 1570 (Fed. Cir. 1988) ("A statement in a

One of ordinary skill would have readily inferred from the applied prior art the use of holes of varying sizes in Pawloski's test panel. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981) ("The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference. . . . Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art"); *In re Nievelt*, 482 F.2d 965, 968 (CCPA 1973) ("Combining the teachings of references does not involve an ability to combine their specific structures").

Further, as we "take account of the inferences and creative steps that a person of ordinary skill in the art would employ," we find a person of ordinary skill in the art would have, within their level of skill, made the holes of various shapes and sizes, including a noncircular shape (claim 4, as exemplified by the grooves of Kelvin's Figures 1–4A), and would have used a triangular substrate (claims 11–14, as exemplified by the triangular substrate of Kelvin's Figures 1, 3, and 4) based on the combined teachings of the applied prior art for reasons articulated by the Examiner (*see generally* Ans.³). *KSR Int'l*, 550 U.S. at 418; *see also id.* at 421 ("A person of ordinary skill is also a person of ordinary creativity, not an automaton"); *Ball Aerosol & Specialty Container, Inc. v. Limited Brands, Inc.*, 555 F.3d

patent that something is in the prior art is binding on the applicant and patentee for determinations of anticipation and obviousness.") and *In re Nomiya*, 509 F.2d 566, 571 n.5 (CCPA 1975) (A statement by an applicant that certain matter is prior art is an admission that the matter is prior art for all purposes).

³ The Examiner did not, however, need to repeat all of Appellant's arguments made in the Appeal Brief at length as was done in this Answer.

984, 993 (Fed. Cir. 2009) (under the flexible inquiry set forth by the Supreme Court, the PTO must take account of “the inferences and creative steps,” as well as routine steps, that an ordinary artisan would employ)).

Accordingly, we affirm the Examiner’s prior art rejections under 35 U.S.C. § 103(a) for the reasons given above and presented by the Examiner.

DECISION

| Claims Rejected | Basis | Affirmed | Reversed |
|---------------------------|---|------------------------------|-----------------|
| 1, 3, 7–10, 17, 20 and 21 | 35 U.S.C. § 103(a) Pawloski, Martin | 1, 3, 7–10, 17, 20 and 21 | |
| 4, 6, 11–17 and 22–25 | § 103(a) Pawloski, Martin, Kelvin, Hughes | 4, 6, 11–17 and 22–25 | |
| Overall Outcome | | 1, 3, 4, 6–17 and 20–25 | |

The Examiner’s § 103(a) rejection is affirmed.

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1).

AFFIRMED