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PAT.&T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KARL-HEINZ HOLZ,
JOHANNES LUKE AND WOLFGANG RIEDERER

Appeal No. 94-0744
Application 07/700,341¹

ON BRIEF

Before GOLDSTEIN, WEIFFENBACH and PAK, Administrative Patent Judges.

PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the examiner's decision refusing to allow claims 11 and 13 through 20, which are all the claims remaining in the application.

¹ Application for patent filed May 7, 1991. According to applicants, this application is a continuation of Application 07/481,874, filed February 20, 1990, now abandoned.

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Rather than summarizing the subject matter on appeal, we attach a copy of the appealed claims to this decision as they appear in the appendix to appellants' brief.

The prior art of record relied upon by the examiner are:

Hudson	4,249,976	Feb. 10, 1981
Ragir	3,530,032	Sept. 22, 1970

Tsuruta et al. (Tsuruta)
(Japanese Patent Application) 63-72305 Apr. 02, 1988

Admitted Prior Art at pages 1 through 4 of the application.

The appealed claims stand rejected as follows²:

(1) Claims 11 and 17 through 20 under 35 U.S.C. § 102(a)³ or § 103 as being anticipated by or obvious over the teachings of Tsuruta.

(2) Claims 16 and 17 under 35 U.S.C. § 103 as being unpatentable over the combined teachings of Tsuruta and Ragir.

(3) Claims 13 through 15 under 35 U.S.C. § 103 as being unpatentable over the combined teachings of Tsuruta, Hudson and the admitted prior art.

² As urged by appellants, the appealed claims do not stand or fall together.

³ The examiner states at page 2 of the examiner's answer that the rejection based on Tsuruta is no longer based on 35 U.S.C. § 102(e). The examiner, recognizing that Tsuruta is qualified as a prior art reference under 35 U.S.C. § 102(a), makes the appropriate correction to the statement of rejection.

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Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants in support of their respective positions, reference is made to appellants' brief and to the examiner's answer for the full exposition thereof. For reasons set forth below, we shall reverse the rejections of claim 13 through 20 under 35 U.S.C. § 102 or § 103 but shall affirm the rejections of claim 11 under 35 U.S.C. § 102 or § 103.

OPINION

Anticipation under Section 102 requires a prior art reference to disclose, either expressly or under the principles of inherency, each and every element set forth in claims. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984), cert. dismissed sub nom., Hazeltine Corp. v. RCA Corp., 468 US 1228 (1984). It, however, does not require a prior art reference to recognize either the inventive concept of the claimed subject matter or inherent properties that may be possessed by the prior art reference's invention. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987), cert. denied, 484 U.S. 827 (1987). Rather it only requires that the appealed claims "read" on something disclose in a prior art reference. Kalman v. Kimberly-Clark

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Corp., 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983), cert denied., 465 U.S. 1026 (1984). Anticipation under this section is a factual determination. See, e.g., In re Baxter Travenol Labs., 952 F.2d 388, 390, 21 USPQ2d 1281, 1283 (Fed. Cir. 1991) (citing In re Bond, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990)).

The subject matter of claim 11 is directed to a process for the manufacture of a composite. The process comprises bonding an air-permeable core material and a facing with a liquid and/or pasty adhesive. On the air-permeable core material, a liquid solvent, which serves as a solvent and/or wetting agent for the liquid and/or pasty adhesive, is applied. The liquid solvent can be used alone or as a part of a mixture containing adhesive and/or other materials to wet the air-permeable core material. The term "comprising" permits inclusion of other non-recited steps, elements or materials. In re Baxter, 656 F.2d 679, 210 USPQ 795 (CCPA 1981). This interpretation is consistent with appellants' specification where it states that the wetting of the air-permeable core material maybe done "in a wide variety of ways", including the wetting of the core material with a mixture

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containing the liquid solvent and the adhesive.⁴ See page 5 of the specification.

In rejecting claim 11, the examiner found:

TSURUTA et al (JAPAN 63-72305) disclose a process for adhesively bonding two thermoplastic layers/substrates (ie a "core" layer and a "facing" layer) in the form of a microporous filter membrane and a substrate (thus resulting in the formation of an air/fluid permeable composite) utilizing as the adhesive a composition composed of a solution of an adhesive resin in a solvent therefor, which solvent not only dissolves the resin adhesive, but also activates the thermoplastic layers/substrates. (Figs. 2-3, and in the English Translation: page 2 lines 5-11 and 18-22, page 3 lines 1-12, page 8 lines 13-20, page 10 lines 5-25, page 11 lines 11-26). (Page 4 of the Examiner's Answer)

We shall adopt the examiner's factual finding as our own. This factual finding leads us to conclude that Tsuruta renders the subject matter of claim 11 anticipated within the meaning of 35 U.S.C. § 102(a) or obvious within the meaning of 35 U.S.C. § 103. Note that lack of novelty is ultimate of obviousness. In re Fracalossi, 681 F.2d 792, 215 USPQ 569 (CCPA 1982).

Appellants allege that Tsuruta fails to disclose certain of the limitations required in the instant invention as shown below:

- (1) a three layer composite;

⁴ See, e.g., In re Zletz, 893 F.2d 319, 13 USPQ 1320 (Fed. Cir. 1989) (During prosecution of a patent application, the claims therein are given the broadest reasonable interpretation consistent with the specification).

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- (2) a sandwich composite containing a structural honeycomb;
- (3) a composite having no swelling;
- (4) a composite useful for the building industry; and
- (5) a composite having a certain compressive strength.

Nowhere does claim 11, however, recite such limitations. Nor are we allowed to read such limitations from the application disclosure into claim 11. See, e.g., In re Prater, 425 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969). When the claim does not recite those allegedly distinguishable features, "appellant[s] cannot rely on them to establish patentability." In re Self, 671 F.2d 1344, 1350, 213 USPQ 1, 7 (CCPA 1982).

Appellants also allege that Tsuruta differs from the instant invention in that Tsuruta requires the removal of the applied solvent and the employment of a polymer adhesive containing a liquid solvent which causes solubilization of substrates. Appellants, however, refer to no limitations in claim 11, which will preclude such solvent removal step or such polymer adhesive. Again, when the claim does not preclude those allegedly distinguishable features, "appellant[s] cannot rely on them to establish patentability." In re Self, supra.

Further, appellants appear to argue at page 7 of the brief that the subject matter of claim 11 is patentable over Tsuruta because the composite resulting therefrom exhibits surprisingly

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"significantly enhanced compressive and shear strength[s] and compressive and shear modul[i]." In support of their position, appellants refer to the examples at pages 6 through 8 of the application. However, the rejection at issue is based on the ground that a prior art reference anticipates the claimed subject matter under 35 U.S.C. § 102. Such rejection cannot be overcome by a showing of unexpected or surprising results. See In re Malagari, 499 F.2d 1297, 182 USPQ 549 (CCPA 1974). In any event, such showing, in our opinion, is not commensurate in scope with claim 11 and thus cannot impart patentability to claim 11. In re Greenfield, 571 F.2d 1185, 1189, 197 USPQ 227, 230 (CCPA 1978). While the showing in the examples is directed to particular light-weight composite materials which are bound together by using water solvent having a particular surface-active chemical compound together with a particular chemical adhesive, claim 11 is not so limited. Since one of ordinary skill in the art would expect different results with different chemical solvents, adhesives and composites⁵, we find that it is reasonable for the U.S. Patent and Trademark Office to require a broader showing of unobvious results than has been presented here.

⁵ See, e.g., In re Carleton, 599 F.2d 1021, 1026, 202 USPQ 165, 170 (CCPA 1979) (Chemistry is largely empirical and there is often great difficulty in predicting how a given compound will behave in different chemical environments).

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The examiner's rejection of claims 17 through 20 under 35 U.S.C. § 102(a) or § 103 based on Tsuruta, however, is on a different footing. As pointed out by appellants, Tsuruta does not mention any of the solvents specifically recited in claims 17 through 20. Nor does Tsuruta describe or suggest that its appropriate solvents embrace the claimed specific solvents which are used for particular purposes in particular adhesive systems. The examiner simply does not explain how Tsuruta's solvents, which must perform particular functions in the manufacture of pharmaceutical filtering materials, would have embraced or suggested the claimed specific solvents which are useful for different functional purposes in the context of producing light-weight building materials. Merely referring to Tsuruta's generic term "appropriate solvents" does not constitute an adequate explanation for the rejection under 35 U.S.C. § 102 or § 103 under this circumstance. See, e.g., In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Thus, we will not sustain the examiner's rejection of claims 17 through 20.

With respect to the examiner's rejection of claims 16 and 17 under 35 U.S.C. § 103 based on the combined teachings of Tsuruta and Ragir, we will not sustain it for the reasons expressed on pages 11 through 14 of appellants' brief.

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With respect to claims 13 through 15 under 35 U.S.C. § 103 based on the combined teachings of Tsuruta, Hudson and the admitted prior art, we will not sustain it for the reasons expressed on pages 15 and 16 of appellants' brief.

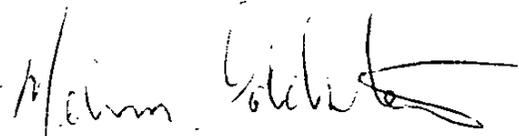
As a final point, we note that the examiner states that claim 18 through 20 do not further limit the process of claim 17 from which they depend. This statement is not specifically disputed by appellants. Although a new ground of rejection under the fourth paragraph of 35 U.S.C. § 112 may be appropriate in this circumstance pursuant to 37 CFR § 1.196(b), we recommend to the examiner and appellants that claim 18 be amended to positively recite water as the desired solvent to further limit the process of claim 17. Claim 18, for example, may recite that "A process as claimed in claim 17, wherein the solvent employed is water and wherein said water is being used together with a surface-active compound." This recommendation is made to expedite the prosecution of this application. Under 37 CFR § 1.196(c), our recommendation is binding on the examiner.

The decision of the examiner is affirmed-in-part. A recommendation under 37 CFR § 1.196(c) has been made. Should appellants elect to adopt the recommendation, the time within which they may file an amendment for that purpose is hereby set to expire two months from the date of this decision.

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

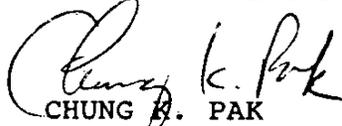
AFFIRMED-IN-PART
37 CFR § 1.196(c)



MELVIN GOLDSTEIN)
Administrative Patent Judge)



CAMERON WEIFFENBACH)
Administrative Patent Judge)



CHUNG K. PAK)
Administrative Patent Judge)

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CKP/cam

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Connolly and Hutz
P. O. Box 2207
Wilmington, DE 19899-2207

APPENDIX

11. A process for the manufacture of a composite from a core and a facing by bonding a core to a facing with a liquid and/or pasty adhesive, wherein the core is wetted with a liquid which also serves as a solvent and/or wetting agent for the adhesive wherein said core is an air-permeable material.

13. A process as claimed in claim 11, wherein an impregnated warp-knitted fabric to textile fabric with a mesh structure, shaped in three dimensions, is used as the air-permeable material.

14. A process as claimed in claim 13, wherein said textile fabric has a network structure with interconnecting webs, assemblage points and a large number of open interstices.

15. A process as claimed in claim 13, wherein a melamine resin and/or a phenolic resin is used as an impregnating agent for the textile fabric or warp-knitted fabric.

16. A process as claimed in claim 11, wherein said adhesive is an epoxy resin in combination with a modified polyamine hardener.

17. A process as claimed in claim 11, wherein said solvent and/or wetting agent is water, acetone, special petroleum ether 100/140, xylene, methyl ethyl ketone, methyl isobutyl ketone, methyl glycol acetate, ethyl glycol acetate, methyl glycol, ethyl glycol, ethanol, butanol, i-propanol and/or a mixture thereof.

18. A process as claimed in claim 17, wherein a surface-active compound is added when water is used.