

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(2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHIGERU OHTAWA
JUNICHI ONODERA and KOUJI HARADA

Appeal No. 95-3945
Application 08/204,922¹

ON BRIEF

Before WEIFFENBACH, WARREN and WALTZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

This is an appeal under 35 U.S.C. ' 134 from the decision of the examiner finally rejecting claims 22 through 27.

The examiner has premised his rejection of the appealed claims under 35 U.S.C. ' 103² on his

¹ Application for patent filed March 2, 1994. According to appellants, this application is a continuation of application 07/871,142, filed April 20, 1992, now Patent No. 5,344,747, issued September 6, 1994, which is a division of application 07/622,320, filed December 6, 1990, now Patent No. 5,147,759, issued September 15, 1992, which is a continuation of application 07/332,917, filed April 4, 1989, now abandoned.

² In his letter of March 1, 1995 (Paper No. 12), the examiner withdrew the new ground of rejection of the appealed claims under the judicially created doctrine of obviousness-type double patenting over

contention that ¹as set forth in [*In re Durden*, 763 F.2d 1406, 226 USPQ 359 (Fed. Cir. 1985)] a [photopolymerizable] composition, even if non-obvious from the prior art,³ does not impart non-obviousness to an old and obvious process² as evinced by Takeda⁴ (answer, page 3; see also page 5, first full paragraph). In the absence of an analysis establishing the *prima facie* obviousness of the claimed invention *as a whole*, thus including consideration of the non-obvious photopolymerizable composition specified in the appealed claims, the examiner's rejection cannot be sustained. *In re Brouwer*, 77 F.3d 422, 426, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996); *In re Ochiai*, 71 F.3d 1565, 1569-71, 37 USPQ2d 1127, 1131-32 (Fed. Cir. 1995).

The examiner's decision is reversed.

Reversed

CAMERON WEIFFENBACH)	
Administrative Patent Judge)	
)	
)	
)	
CHARLES F. WARREN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
THOMAS A. WALTZ)	
Administrative Patent Judge)	

Holly D. Kozlowski
Lowe, Price, LeBlanc & Becker
Suite 300, 99 Canal Center Plaza
Alexandria, VA 22314

Ohtawa 747 (answer, Paper No. 9, page 4) in view of the terminal disclaimer filed by appellants (Paper No. 11).

³ The claimed method of forming a dry film resist specifies a photopolymerizable composition which is encompassed by the claims of Ohtawa 759.

⁴ Takeda, Ohtawa 759 and Ohtawa 747 are listed at page 3 of the answer.