

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

Appeal No. 95-4453
Application 07/885,419¹

ON BRIEF

Before PAK, WARREN and WALTZ, Administrative Patent Judges.

PAK, Administrative Patent Judge.

DECISION ON APPEAL

Morita et al. (appellants) appeal from the examiner's final rejection of claims 15 through 21 and

¹ Application for patent filed May 19, 1992.

23, which are all of the claims pending in the application.

For purposes of this appeal, we will limit our discussion to the broadest claim on appeal, claim 15, since appellants state at page 3 of the Brief that “[t]he pending claims stand or fall together as a group.” See 37 CFR § 1.192(c)(5)(1993). Claim 15 is reproduced below:

15. A method of coating silicone rubber particles with metal oxide particles comprising the steps of:

forming a water-based dispersion of silicone rubber particles;

adding to said dispersion a water-based metal oxide sol; and

removing the water from the above mixture by spray-drying.

The references of record relied upon by the examiner are²:

Willing	4,248,751	Feb. 3, 1981
Shimizu et al. (Shimizu)	4,911,974	Mar. 27, 1990

Oniwa et al (Oniwa), Japanese Kokai Patent Application 62-257939, “Method for Preparing Silicone Elastomer Spherical Fine Powders,” Nov. 10, 1987.

Ikeda et al. (Ikeda), Japanese Kokai Patent Application 64-306471 (HEI 1[1989]-306471), “A Method for Producing Silicone Resin Microparticle,” Dec. 11, 1989.

² Our reference to the Japanese Kokai patent applications is to their corresponding English translations of record.

Claims 15 through 21 and 23 stand rejected under 35 U.S.C. § 103 as unpatentable over the combined teachings of Willing, Shimizu, Oniwa and Ikeda.³

We reverse.

The examiner's Section 103 rejection is predicated on the ground that it would have been obvious to one of ordinary skill in the art to employ the spray drying technique described in either Oniwa or Ikeda in Willing's evaporation step. See Answer, page 6. The examiner, however, has not supplied any evidence or sound scientific reasoning to establish why one of ordinary skill in the art would have been led to employ Oniwa's or Ikeda's spray drying technique for producing fine dry powder in Willing's evaporation step involving drying coated or impregnated substrates, such as latex particle and colloidal silica coated papers. See Answer in its entirety. Significantly, there is no evidence in the record that a spray drying technique for producing fine dry powder is

³ In his statement of rejection, the examiner refers to, *inter alia*, Oniwa which is incorporated by reference in Ikeda. To avoid any confusion and piece meal appeal, we will presume that the examiner is relying on both Oniwa and Ikeda, in addition to Willing and Shimizu.

useful for drying the coating of the type described in Willing. Thus, we conclude that the examiner has not carried his burden of establishing a *prima facie* case of obviousness.⁴ Accordingly, we reverse the examiner's decision rejecting the appealed claims under 35 U.S.C. § 103.

REVERSED

CHUNG K. PAK)
Administrative Patent Judge)
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)
) BOARD OF PATENT
CHARLES F. WARREN)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)
THOMAS A. WALTZ)
Administrative Patent Judge)

⁴ Since the examiner has not established a *prima facie* case of obviousness, we need not determine the sufficiency of the comparative results submitted by appellants to rebut a *prima facie* case of obviousness. *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987).

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