

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GISULFO BACCINI

Appeal No.1996-1244
Application No.08/082,782¹

HEARD

Before JOHN D. SMITH, WARREN and KRATZ, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 21. Claim 22, which is the only other claim pending in this application, stands withdrawn from consideration by the examiner as drawn to a non-elected invention.

¹ Application for patent filed June 28, 1993.

BACKGROUND

Appellant's invention relates to a device for processing foils for green-tape circuits. The claimed device includes several structural elements including, *inter alia*, (1) a plurality of containers of supports for the foils, (2) a conveyor means for transporting the foils, (3) moveable carriage means for withdrawing the supports in a programmed manner, (4) a discharge or removal station wherein the supports may be removed from the foils, (5) an alignment station wherein the foils may be aligned, and (6) a superimposing and anchoring station wherein a number of the foils may be superimposed and anchored to one another. According to appellant's specification at pages 1 and 2, the green-tape foils have a "thickness of the order of 0.1 - 0.5 mm" and consist of:

ceramics pre-fired at a low temperature and containing glass fibers and possessing designed properties of viscosity and temperature, the foils consisting also of refractory materials used as fillers so as to be able to comply with the coefficient of thermal expansion of the alumina.

Appellant alleges that the foils possess no rigidity and require a support for their handling (specification, page 2).

The foils are described as having a printed circuit on one or both of their faces (specification, page 3). The claimed device serves to handle these foils so as to superimpose a number of them to form an anchored product that comprises a multi-layer pack (specification, page 2). A further understanding of the claimed invention can be derived from a reading of exemplary claim 1, which is reproduced below.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

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|----------|-----------|----------|
| Mintz | 4,149,925 | Apr. 17, |
| 1979 | | |
| Nakamura | 4,599,122 | Jul. 08, |
| 1986 | | |

Claims 1-8 and 10-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mintz. Claims 9 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mintz as applied to claims 1-8 and 10-20, further in view of Nakamura.

OPINION

We have carefully reviewed the respective positions presented by appellant and the examiner. In so doing, we find ourselves in agreement with appellant's position in almost every regard and hence reach the determination that the examiner has not met the initial burden of establishing a *prima facie* case of obviousness of the claimed subject matter. Accordingly, we will not sustain the examiner's rejections for essentially those reasons advanced by appellant², and we add the following primarily for emphasis.

The examiner, having correctly determined that the appealed claims are drawn to an apparatus, inexplicably fails to provide a colorably rationale explanation as to how Mintz alone or together with Nakamura³ would have suggested the claimed apparatus including, *inter alia*, a plurality of containers of supports of the foils and a removal or support discharge station as clearly called for by all of the appealed

²Since we find that the examiner has not established a *prima facie* case of obviousness, we do not reach the issue of the sufficiency of the rebuttal evidence furnished in the declaration of Armando Baesse. *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987).

³The combination of Nakamura and Mintz is only applicable to the examiner's rejection of claims 9 and 21.

claims. On this point, the examiner's unsubstantiated opinion (answer, page 3) regarding the ordinary skill in the art and obviousness of utilizing more than one card feeding stack in the magnetic strip application device of Mintz has no readily apparent bearing, at least to us, on the patentability of the dissimilar claimed structure at issue herein. The Nakamura patent as additionally applied by the examiner to claims 9 and 21 does not cure the above-noted deficiency. We will not further burden this record with a discussion of other claimed limitations which have not even been addressed in the examiner's rejections.

In our view, the examiner's stated rejections fall significantly short of presenting a *prima facie* case of obviousness for the reasons set forth in appellant's briefs and above. We note that "[w]here the legal conclusion [of obviousness] is not supported by facts it cannot stand." *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968).

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CONCLUSION

The decision of the examiner is reversed.

REVERSED

| | | |
|-----------------------------|---|-----------------|
| JOHN D. SMITH |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| CHARLES F. WARREN |) | APPEALS |
| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
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| |) | |
| PETER F. KRATZ |) | |
| Administrative Patent Judge |) | |

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APPEAL NO. - JUDGE KRATZ
APPLICATION NO.

APJ SMITH, JOHN

APJ WARREN

APJ KRATZ

DECISION: **REVERSED**

Prepared By: LESLEY BROOKS

DRAFT TYPED: 19 Jan 00

FINAL TYPED: 19 Jan 00