

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MINORU YOSHIDA, TOSHIHIRO SASAKI,  
TOSHIAKI UEDA, MASATOSHI AOYAMA and MASARU SUZUKI

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Appeal No. 1996-2593  
Application No. 08/119,075<sup>1</sup>

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ON BRIEF

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Before KIMLIN, ELLIS and OWENS, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-4,

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<sup>1</sup> Application for patent filed September 22, 1993. According to appellants, this application is a National stage application under 35 U.S.C. § 371 of PCT/JP93/00073, filed January 27, 1993.

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6-11 and 14-20, all the claims remaining in the present application. Claims 1 and 20 are illustrative:

1. A thermoplastic polyester lamination structure comprising 1) at least one layer of a thermoplastic polyester (A) prepared from i) an acid component mainly comprising an aromatic dicarboxylic acid and a glycol component mainly comprising an aliphatic glycol and ii) **2**-type aluminum oxide particles (B) and 2) at least one layer of another thermoplastic polyester laminated to said layer of a thermoplastic polyester (A).

20. A thermoplastic polyester lamination structure comprising at least one layer of a thermoplastic polyester (A) prepared from i) an acid component mainly comprising an aromatic dicarboxylic acid and a glycol component mainly comprising an aliphatic glycol and (ii) **2**-type aluminum oxide particles (B), said particles having an acicular or platy shape.

The examiner relies upon the following reference as evidence of obviousness:

Murooka et al. (Murooka)	5,252,388	Oct. 12, 1993 (filed Dec. 13, 1991)
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Appealed claims 1-4, 6-11 and 14-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Murooka.

Upon careful consideration of the opposing arguments presented on appeal, we find that the examiner has failed to establish a prima facie case of obviousness for the claimed subject matter. Accordingly, we will not sustain the examiner's rejection.

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At the outset, we note that the examiner erred in not giving separate consideration to specific claims separately argued by appellants. The examiner's statement at page 2 of the Answer explaining why the claims stand or fall together does not withstand scrutiny. Since all the appealed claims are directed to a thermoplastic polyester lamination structure, it is manifestly clear that the examiner's statement that "all claims are ultimately directed to a composition (which is used to prepare a laminated structure)" is without merit. Furthermore, the examiner's rationale for holding that all the appealed claims stand or fall together totally misses the point. Even if it was the case that all the appealed claims are directed to a composition, this certainly does not preclude appellants from separately arguing different claims which recite different features of a composition. Once an appellant separately groups and argues different claims on appeal, it is the examiner's responsibility to address the merits of appellant's arguments.

We now turn to the examiner's § 103 rejection of the appealed claims. With the exception of claim 20, each of the appealed claims requires at least one layer of another

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thermoplastic polyester laminated to the thermoplastic layer comprising the aluminum oxide particles. Although appellants stress this point in their principal and reply briefs, the issue has apparently escaped the examiner. While appellants give a detailed explanation why the magnetic layer of Murooka does not qualify as the claimed thermoplastic polyester layer, the examiner responds that "Murooka's polyester film and a magnetic layer formed thereon . . . is, according to the examiner, a laminate" since the "Examiner interprets a laminate as an article made of at least two layers which two layers need not be the same in form and shape" (sentences bridging pages 3 and 4 of Answer). Notwithstanding the accuracy of the examiner's definition of a laminate, the examiner totally fails to address appellants' argument that the magnetic layer of Murooka does not meet the claim requirement for another thermoplastic polyester laminated layer. Simply put, the examiner has not pointed out where Murooka teaches or suggests appellants' additional thermoplastic polyester layer.

Regarding separately argued claim 20 which requires that the aluminum oxide particles have "an acicular or platy

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shape," the examiner takes the position that all claim features regarding particle size, shape and relationship between diameter of particle and thickness of thermoplastic layer are satisfied by Murooka in the "absence of a showing of a criticality thereof by the appellants" (page 4 of Answer). Here, the examiner has perpetrated clear error by placing the cart before the horse. It is axiomatic that before the burden shifts to an applicant to provide evidence of nonobviousness, such as evidence of criticality or unexpected results, the examiner must establish, in the first instance, that the claimed features would have been prima facie obvious to one of ordinary skill in the art. In the present case, the examiner has made no attempt to establish on this record that the use of aluminum oxide particles having an acicular or platy shape in a polyester composition would have been obvious to one of ordinary skill in the art. In the absence of such a finding by the examiner, appellants are under no burden to demonstrate that the claimed acicular and platy shapes are critical to the claimed invention. Consequently, we find it unnecessary to evaluate the comparative data in appellants' specification as evidence of nonobviousness.

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In conclusion, based on the foregoing, we are constrained  
to reverse the examiner's rejection.

REVERSED

EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
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	)	
JOAN ELLIS	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
	)	
TERRY J. OWENS	)	
Administrative Patent Judge	)	

ECK:clm

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