

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREA SAVONUZZI

Appeal No. 1996-4072
Application No. 08/133,283¹

ON BRIEF

Before PAK, OWENS 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 46-57, 59, 61 and 63-65. Claims 58, 60

¹ Application for patent filed October 7, 1993. According to appellant, this application is a continuation of Application No. 07/780,060 filed October 21, 1991, now abandoned.

Appeal No. 1996-4072
Application No. 08/133,283

and 62, which are all of the remaining claims pending in this application, stand objected to as being dependent upon a rejected base claim (answer, page 2).

BACKGROUND

The appellant's invention relates to a method of forming a panel member useful in an automobile. An understanding of the invention can be derived from a reading of exemplary claims 46 and 59, which are reproduced below.

46. A method of producing an essentially self-supporting stratiform article usable as an interior automotive panel, comprising the steps of:

disposing a pre-formed, contoured laminate insert comprising a generally flexible outer cover and an inner thermoplastic layer in a female mold shaped in conformity with the outer cover of the insert, with the outer cover disposed in conformity with the female mold but having an exposed edge portion; and

injection molding a thermoplastic polymer composition that is substantially compatible with the inner thermoplastic layer into a mold cavity formed by a male mold and the female mold containing the insert so that the thermoplastic composition substantially fills the cavity, contacts the thermoplastic layer and interfuses therewith, and the thermoplastic polymer composition contacts and covers the exposed edge portion of the insert on its front, back and edge;

allowing the thermoplastic polymer composition to solidify, thereby forming a substrate which is interbonded to

Appeal No. 1996-4072
Application No. 08/133,283

the inner thermoplastic layer of the insert, and having a recess in which the edge portion of the insert is disposed, wherein the insert covers only a portion of an outer surface of the substrate, the substrate and insert together forming a panel member; and

removing the panel member from the mold cavity.

59. A method of producing an essentially self-supporting stratiform article usable as an interior automotive panel, comprising the steps of:

disposing a pre-formed, contoured laminate insert comprising a generally flexible outer cover consisting essentially of a material selected from a textile material and a leather, and an inner thermoplastic shielding layer, in a female mold shaped in conformity with the outer cover of the insert, with the outer cover disposed in conformity with the female mold;

then injection molding a thermoplastic polymer composition that is substantially compatible with the inner thermoplastic shielding layer into a mold cavity formed by a male mold and the female mold containing the insert so that the thermoplastic composition substantially fills the cavity, contacts the thermoplastic shielding layer and interfuses therewith, the thermoplastic shielding layer acting as a permeation barrier for the thermoplastic polymer composition;

allowing the thermoplastic polymer composition to solidify, thereby forming a substrate which is interbonded to the shielding layer of the insert, the substrate and insert together forming a panel member; and

removing the panel member from the mold cavity.

Appeal No. 1996-4072
Application No. 08/133,283

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

Morello et al. (Morello) 22, 1981	4,307,058	Dec.
Bree 06, 1984	4,481,160	Nov.
European Patent Application 1989 (Uchiyama)	0 326 408	Aug. 02,

Claims 46-57, 59, 61 and 63-65 stand rejected under 35 U.S.C. § 103 as being unpatentable over Morello in view of Bree and Uchiyama.

OPINION

Upon careful consideration of the opposing arguments presented on appeal, we concur with appellant that the applied prior art fails to establish a *prima facie* case of obviousness of the claimed subject matter. Accordingly, we will not sustain the examiner's rejections.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of

Appeal No. 1996-4072
Application No. 08/133,283

obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

The examiner relies on Morello for the teaching of placing an applique (15, fig. 3) in a molding cavity prior to injection molding a base material (11) in the formation of a panel. The examiner notes that Morello discloses forming more layers on the "resultant panel" (answer, page 3). Morello does not teach that the applique as placed in the mold comprises more than one layer. Moreover, the examiner acknowledges that Morello does not expressly disclose covering the exposed edge portion of the applique (insert) on its front, back and edge as called for in claim 46 (answer, pages 5 and 6).

Appeal No. 1996-4072
Application No. 08/133,283

Bree discloses a method of producing a decorative emblem using a multi-step casting method for encapsulating a foil in plastic material, the foil, for example, being inserted and pressed into a bezel base that is previously covered with plastic material so that the plastic material forms a bead around the upper periphery thereof (column 2, lines 20-60). Other methods of using plastic material, the foil, and bezel in forming a decorative emblem are also disclosed (column 3, lines 9-35).

Uchiyama (column 2, line 36 through column 3, line 11) discloses a method of forming a multilayered molding that includes the steps of bringing a multi layer sheet or film including an intermediate foamed layer or a single layer film into contact with a mold inner surface, clamping the mold, and injecting synthetic resin into the mold to form the composite product molding. The various layers are comprised of specified resins with the outer layer including a rubber material. The resultant product may be used in automobile parts.

According to the examiner (answer, page 4), it would have been obvious to use a multi layer laminate in the process of

Appeal No. 1996-4072
Application No. 08/133,283

Morello (presumably as the applique thereof) and to "encapsulate the ends of the decorative film." Appellant argues, in effect, (brief, pages 10-13) that the examiner has not established how the subject matter defined by the appealed claims can be arrived at from the applied references' teachings without the application of impermissible hindsight reasoning. On this record, we agree with appellant.

With regard to claim 46 and the claims depending therefrom, the examiner has not adequately explained how the cited art would have reasonably suggested a modification to the process of Morello to include the use of a preformed, contoured laminate having both a flexible outer cover and an inner thermoplastic layer with an exposed edge portion as a mold insert (applique) wherein the insert covers only a portion of an outer surface of the substrate formed in the injection mold and includes an exposed edge portion that is covered on its front, back and edge by the injection molded polymer. In this regard, we note that Uchiyama, which is relied upon by the examiner for showing the use of a multi layer film positioned in a mold before injection molding, does not teach the provision of an exposed edge portion of the

Appeal No. 1996-4072
Application No. 08/133,283

multi layer film being covered on its front, back and edge with polymer during the injection molding step so as to cover only a portion of the substrate formed in the injection mold. Rather, Uchiyama teaches using a multi layer film to "cover the opening portion of the cavity" (page 5 and figure 1), which would result in the substrate formed in the mold being covered with the multi layer film as apparently intended by Uchiyama to obtain a desired surface layer. Additionally, it is our opinion that the teachings of Bree regarding the migration of plastic around the edges of a foil in the manufacture of a decorative emblem using a preformed bezel to which the foil is thereby bonded would not have suggested a modification of the injection molding process of Morello as suggested by the examiner.

The examiner apparently appreciates that the laminate insert called for in claim 59 requires an outer cover made of leather or textile material (answer, page 7); however, the mere assertion by the examiner that such materials are known (answer, page 7) does not adequately explain how the examiner considers that it would have been obvious to form the applique of Morello with separate inner and outer layers as called for

Appeal No. 1996-4072
Application No. 08/133,283

by claim 59. In this regard, we also note that the relied on Uchiyama reference does not disclose or suggest the use of leather or textile materials for forming the outer layer of a multi layer film placed in the mold, but rather specifically calls for resinous materials and rubber as the outer layer thereof (page 3, lines 24-59).

From the above, it is not clear how the teachings of Uchiyama and Bree would have suggested modifications of the process of Morello to arrive at the claimed invention herein. Here, the most that can be concluded from the collective teachings of the applied references is that it might have been obvious for one of ordinary skill in the art to try selecting a multi layer preformed laminate as the applique to be used in the process of Morello as generally taught by Uchiyama. Of course, it is by now well settled that such is not the proper standard for determining obviousness under 35 U.S.C. § 103. In this regard, our court of review has made clear that "obvious to try" is not the correct standard for determining obviousness under 35 U.S.C. § 103. See In re O'Farrell, 853 F.2d 894, 903-04, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988). In our view, the examiner has not furnished an adequate

Appeal No. 1996-4072
Application No. 08/133,283

evidentiary foundation from which a conclusion of obviousness can be reached.

Accordingly, we are constrained to reverse the rejection of the appealed claims under 35 U.S.C. § 103 because the examiner has simply failed to meet his burden of establishing an evidentiary record to establish a *prima facie* case of obviousness of the claimed subject matter as a whole within the meaning of 35 U.S.C. § 103.

Appeal No. 1996-4072
Application No. 08/133,283

CONCLUSION

To summarize, the decision of the examiner to reject claims 46-57, 59, 61 and 63-65 under 35 U.S.C. § 103 as being unpatentable over Morello in view of Bree and Uchiyama is reversed.

REVERSED

CHUNG K. PAK)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
TERRY J. OWENS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
PETER F. KRATZ)	
Administrative Patent Judge)	

Appeal No. 1996-4072
Application No. 08/133,283

bae

Appeal No. 1996-4072
Application No. 08/133,283

Timothy G. Newman
Brooks & Kushman
1000 Town Center
Twenty-Second Floor
Southfield, MI 48075