

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIROMICHI KANO

Appeal No. 1997-1916
Application 08/375,507

ON BRIEF

Before WARREN, OWENS 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 1, 2 and 4 through 10.¹

We cannot sustain the ground of rejection of claims 1, 2 and 4 through 9 under 35 U.S.C. § 112, first paragraph, in which the examiner finds that there is no “support in the originally filed specification for the limitation ‘whereby the coating layer is made to have permeability to air and moisture without addition of a separate forming agent’ (see claim 1)” (answer, pages 3 and 5). Appellant points to the recitation “layer 3 is rendered permeable to air and moisture by inclusion of the

¹ See the amendment of January 18, 1995 (Paper No. 11) and of July 18, 1995 (Paper No. 14), and specification, pages 11-12.

above-mentioned additive,” in the specification (page 7, lines 10-11) as describing “a way of making the coating layer permeable to air that does not require a separate pore forming agent” (brief, page 7). We agree with appellant that this section of the specification provides support for the stated negative limitation of claim 1. Accordingly, we reverse this ground of rejection.

We will also not sustain the ground of rejection of the appealed claims under 35 U.S.C. § 103 over Amemiya et al. in view of the definition of “silica” in *The Condensed Chemical Dictionary*.² It is well settled that in order to establish a *prima facie* case of obviousness, “[b]oth the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant’s disclosure.” *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991), citing *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Thus, a *prima facie* case of obviousness is established by showing that some objective teaching or suggestion in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in the art would have led that person to the claimed invention as a whole, including each and every limitation of the claims, without recourse to the teachings in appellant’s disclosure. *See generally, In re Oetiker*, 977 F.2d 1443, 1447-48, 24 USPQ2d 1443, 1446-47 (Fed. Cir. 1992) (Nies, J., concurring); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988).

We agree with appellant (brief, page 10) that the examiner has failed to carry his burden of making out a *prima facie* case of obviousness with respect to the claimed invention. As appellant points out, the combined teachings of Amemiya et al. and the definition of “silica” in *The Condensed Chemical Dictionary* would not have reasonably suggested to one of ordinary skill in this art that silica should be added to the compositions of Amemiya et al. (*id.*, pages 10-11). Indeed, even if there was, as noted by appellant, silica “is only one component of natural stone” (*id.*), and thus the incorporation of silica in the compositions of Amemiya et al would not result in the claimed invention. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-54, 5 USPQ2d 1434, 1438-41 (Fed. Cir. 1988).

Thus, it is manifest that the only direction to appellant’s claimed invention as a whole on

² The references relied on by the examiner are listed at page 2 of the answer.

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the record before us is supplied by appellant's own specification. *Vaeck, supra; Dow Chem.*, 837 F.2d at 473, 5 USPQ2d at 1531-32.

The examiner's decision is reversed.

Reversed

CHARLES F. WARREN)	
Administrative Patent Judge)	
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TERRY J. OWENS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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)	
THOMAS A. WALTZ)	
Administrative Patent Judge)	

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