

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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASASHI OHARA
and EIJI TAKIGUCHI

Appeal No. 1997-2928
Application 08/320,781

ON BRIEF

Before WARREN, WALTZ and KRATZ, *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 2 through 8 and 10, which are all of the claims in the application.¹

We have carefully considered the record before us, and based thereon, find that we cannot sustain the ground of rejection of the appealed claims under 35 U.S.C. § 103 over JA 62-283001 (Kawaguchi et al.) in view of GB 2 150 509 (Kawabata et al.) and JA 63-90402 (Iwafune et al.).² We agree with the

¹ See specification, pages 20-21, and the amendment of November 15, 1995 (Paper No. 13).

² The references relied on by the examiner are listed at page 3 of the answer.

reasoning submitted by appellants in their brief (pages 6-15) that the examiner has failed to establish a *prima facie* case of obviousness and point out the following for emphasis.

As appellants point out, the examiner has simply not provide a logical reason to combine Kawaguchi et al. with Kawabata et al. The question raised by the examiner's position is why one of ordinary skill in this art would have looked to the teachings of the dynamic storage modulus of each of the inner and outer tread non-foamed rubber layers taught by Kawabata et al. with respect to improving the "gripping property against the road surface" for "high speed running" in order to modify the dynamic modulus of each of the inner foamed rubber and outer non-foamed rubber tread layers of the tire structure disclosed in Figure 3 of Kawaguchi et al. (see, e.g., pages 7-10, 13-14 and 17-18) wherein the tires are disclosed to have "significantly improved 'on-ice/snow capability'" (page 18). Even though the rubber layers of the tread of the tire of Figure 3 of Kawaguchi et al. could be modified to have the dynamic storage modulus of each of the inner and outer tread non-foamed rubber layers taught by Kawabata et al., we find no suggestion in either reference why this person would find the "gripping" property of a tire manifested at high speeds on dry pavement, which is the focus of Kawabata et al., to provide any reason or motivation with respect to modifying the "gripping" property of a tire manifested at slow speeds on ice/snow covered pavement, which is the focus of Kawaguchi et al., and no reason or motivation in this respect is provided by Iwafune et al., which is directed to the same "gripping" property on ice/snow covered pavement as Kawaguchi et al. *See In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989).

Thus, on this record, the examiner has not carried his burden of establishing a *prima facie* case of obviousness 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 this 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 appellants' 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, 1074-75, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988).

The examiner's decision is reversed.

Reversed

CHARLES F. WARREN)	
Administrative Patent Judge)	
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)	
THOMAS A. WALTZ)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
PETER F. KRATZ)	
Administrative Patent Judge)	

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