

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LIKUO SUN

Appeal No. 1997-4305
Application No. 08/477,023

ON BRIEF

Before WINTERS, ROBINSON, and ADAMS, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 7-12, which are all the claims pending in the application.

Claim 7 is illustrative of the subject matter on appeal and is reproduced below:

7. A process for making a mono-axially oriented polypropylene film comprising:
 - 1) [b]lending sodium benzoate at a level up to 1000 ppm into polypropylene;
 - 2) plasticating the polypropylene-sodium benzoate mix in an extruder,
 - 3) extruding the polypropylene-sodium benzoate mix through a flat sheet die to produce a polypropylene sheet,
 - 4) contacting the polypropylene sheet with a cooling cylinder or a water quenched bath,
 - 5) drawing the polypropylene sheet longitudinally with respect to the direction of extrusion at a temperature below the melting point of the polypropylene and at a draw ratio in the longitudinal direction of at least about 4:1.

The references relied upon by the examiner are¹:

Hughes	3,540,979	Nov. 17, 1970
Kitamura et al. (Kitamura I)	4,675,247	Jun. 23, 1987
Kitamura et al. (Kitamura II)	4,761,462	Aug. 2, 1988

GROUND OF REJECTION

Claims 7-12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kitamura I, Kitamura II in view of Hughes and applicant's specification.

We reverse.

¹ We note that the examiner lists (Answer, page 2) the following documents as relied upon: United States Patent Nos.: 5,112,894, 5,118,566 and 5,135,975, and Japanese Patent Application 80329/1983. However, in our review of the examiner's statement of the rejection, we find that the examiner did not rely on these documents, but instead relied upon appellant's specification (page 3) which discussed these documents. Accordingly, we did not include these references in the above citation of references relied upon by the examiner, and we will not consider these reference any further than they are characterized by appellant's specification as relied upon by the examiner.

DISCUSSION

“The name of the game is the claim.” In re Hiniker Co., 150 F.3d 1362, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). In considering the issues raised in this appeal, we point out that “analysis begins with a key legal question – what is the invention claimed?” since “claim interpretation . . . will normally control the remainder of the decisional process.” Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1596 (Fed. Cir.), cert. denied, 481 U.S. 1052 (1987). On this record, instead of beginning his analysis with this “key legal question,” the examiner concludes his analysis with an interpretation of the claimed invention. Specifically, the examiner finds (Answer, page 3) that “the use of ‘up to 1000 ppm’ embraces ‘zero to 1000 ppm’ and reads on [the] absence of sb [sodium benzoate].”

However, when the claims are considered as a whole, we can not agree with the examiner’s interpretation. The limitation “up to 1000 ppm” appears in claim 7, step 1, which requires the blending of sodium benzoate at a level up to 1000 ppm into polypropylene. The very next step, step 2, of claim 7 resolves the examiner’s issue, and demonstrates that up to 1000 ppm must be something more than zero, since this step requires a “polypropylene-sodium benzoate mix.” In the absence of sodium benzoate there would be no polypropylene-sodium benzoate mix and we could not move past the second step of appellant’s claimed process.

The examiner must have realized this, for in his response to appellant's arguments he states (Answer, page 4) "Hughes PPF contains and/or suggests amounts of sb [sodium benzoate] within [the] range of 'up to 1,000 ppm' (see column 3, line 1)." According to the examiner (Answer, page 3) the only difference between the claimed invention and either Kitamura patent is the use of sodium benzoate.

However, we note that Hughes teaches (column 3, lines 7-14) that "[n]ot all nucleating agents promote the formation of hexagonal crystals, ... on the contrary, most nucleating agents presently appear to promote the formation of monoclinic crystals. For example, ... sodium benzoate ... preferentially promote[s] the formation of monoclinic crystals rather than hexagonal crystals." This teaching in Hughes is important when considering the examiner's suggestion that Hughes teach sodium benzoate within the range of "up to 1,000 ppm" at column 3, line 1.

According to Hughes (column 2, line 71 to column 3, line 5):

crystalline polypropylene having a preponderance of hexagonal crystals, i.e. at least 50 percent of the crystals are in the hexagonal form, can be made by dispersing in the polypropylene from about 0.05 to about 5, ... weight percent, based on the total weight of the polymer, of a nucleating agent that preferentially causes the formation of hexagonal crystals rather than monoclinic crystals [emphasis added].

While it is unclear if this weight percent is comparable to the claimed range of up to 1,000 ppm, it is clearly not relevant to sodium benzoate, since sodium benzoate, as taught by Hughes, "preferentially promotes the formation of monoclinic crystals rather than hexagonal crystals." As a result, the examiner failed to account for this limitation of the claimed invention. Kitamura I, Kitamura II and

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applicant's specification as relied upon by the examiner all fail to make up for this deficiency in Hughes.

We remind the examiner, as set forth in Ecolochem Inc. v. Southern California Edison, 227, F.3d 1361, 1375, 56 USPQ2d 1065, 1075 (CAFC 2000) “[a] rejection cannot be predicated on the mere identification ... of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”

The initial burden of presenting a prima facie case of obviousness rests on the examiner. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In satisfying this initial burden, “it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art.” In re Wesslau, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965); see also In re Mercer, 515 F.2d 1161, 1165-66, 185 USPQ 774, 778 (CCPA 1975).

On the record before us, we find no reasonable suggestion for combining the teachings of the references relied upon by the examiner in a manner which would have reasonably led one of ordinary skill in this art to arrive at the claimed invention. On these circumstances, we find that the examiner failed to provide the evidence necessary to support a prima facie case of obviousness.

Where the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d

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1596, 1598 (Fed. Cir. 1988). Accordingly, we reverse the rejection of claims 7-12 under 35 U.S.C. § 103 over Kitamura I, Kitamura II in view of Hughes and applicant's specification.

REVERSED

Sherman D. Winters)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
Douglas W. Robinson)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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Donald E. Adams)	
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