

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(2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HITOSHI FUKUI and
KENJI TANAKA

Appeal No. 1998-0080
Application 08/177,763

ON BRIEF

Before HAIRSTON, JERRY SMITH, and HECKER, Administrative
Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

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Application No. 08/177,763

Claims 1-7 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers the admitted prior art of appellants' Figure 18 in view of Schmidt.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-7. Accordingly, we reverse.

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Appellants have indicated that for purposes of this appeal the claims will all stand or fall together as a single group [brief, page 5]. Consistent with this indication appellants have made no separate arguments with respect to any of the claims on appeal. Accordingly, all the claims before us will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Therefore, we will only consider the rejection against independent claim 1 as representative of all the claims on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem

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from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been

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considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

With respect to representative, independent claim 1, the examiner notes that the admitted prior art of appellants' Figure 18 essentially shows a plurality of polarizer elements connected end-to-end on a single releasable strip. The examiner notes that the salient difference between Figure 18 and the claimed invention is in the claimed plurality or series of releasable strips connected end-to-end by adhesive strips. The examiner cites Schmidt as teaching that it was well known to connect releasable strips to each other by an adhesive strip. The examiner concludes that it would have been obvious to modify the single releasable strip of appellants' Figure 18 to include a series of at least three releasable strips connected longitudinally by adhesive strips as claimed [answer, pages 2-3].

Appellants argue that Schmidt at best teaches connecting two webs together with adhesive strips on the transverse side of the webs rather than in the longitudinal direction. Appellants note that there is no suggestion in

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Schmidt of connecting additional webs in the transverse direction. Appellants also argue that whatever advantage is alleged to be gained by the use of Schmidt's adhesive strips does not apply for the claimed polarizer labeling tape. Thus, appellants urge there is no motivation to combine Schmidt's teachings with the admitted prior art. Appellants additionally argue that the only basis for combining the teachings of Schmidt with the admitted prior art is based on an improper attempt to reconstruct appellants' invention in hindsight. Finally, appellants argue that Schmidt does not relate to the art of liquid crystal displays and does not relate

to the problem solved by the invention so that Schmidt is not analogous art [brief, pages 7-10].

The examiner responds that the connection in Schmidt can be considered to be longitudinal along the horizontal direction. The examiner also responds that Schmidt teaches the obviousness of splicing releasable strips together in order to increase the overall length or width of the releasable strip and that it would have been obvious to make

this modification to appellants' Figure 18 strip to increase the overall length of the releasable strip [answer, pages 4-5]. Appellants dispute that the connection in Schmidt can be considered to be longitudinally end-to-end [reply brief].

We essentially agree with all of appellants' arguments as set forth in the briefs. Schmidt does not teach the longitudinal connection of a series of at least three releasable strips. Schmidt only connects two releasable webs together with adhesive strips in the transverse or lateral direction of the webs. The examiner's proposed modification of appellants' prior art essentially requires that the releasable strip 71' of Figure 18 be cut into a plurality of smaller strips that are then simply reconnected together using adhesive strips. We can see no reason why the artisan would have cut the integral unit of the admitted prior art into a plurality of units and then put them back together with adhesive. None of the alleged problems solved by the applied prior art are present in the device of appellants' Figure 18. The only possible motivation for modifying the admitted prior art by the teachings of Schmidt would be based on an improper attempt to recreate the claimed invention in hindsight. As

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argued by appellants, however, even the improper modification of the admitted prior art by the teachings of Schmidt would not result in the invention of claim 1.

In summary, we do not sustain the examiner's rejection of claims 1-7 under 35 U.S.C. § 103 based on the admitted prior art and Schmidt. Therefore, the decision of the examiner rejecting claims 1-7 is reversed.

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REVERSED

Kenneth W. Hairston)	
Administrative Patent Judge)	
)	
)	BOARD OF PATENT
Jerry Smith)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
Stuart N. Hecker)	
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JS/dm

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