

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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WARD W. OSTENDORF and ROBERT S. AMPULSKI

Appeal No. 1998-1075
Application No. 08/701,600

ON BRIEF

Before WARREN, WALTZ, and TIMM, Administrative Patent Judges.
WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 32, which are all of the claims in this application.

According to appellants, the invention is directed to a method for applying a curable resin to a substrate, where the substrate has a first surface and a second surface and fibers

defining voids intermediate the first and second surfaces, comprising coating at least some of the fibers with a second material, removing a portion of the second material, applying a curable liquid resin to the substrate, and curing the curable liquid resin (Brief, page 2). Appellants state that the voids adjacent the coated fibers must provide fluid communication from the first surface to the second surface of the substrate, thereby allowing trapped air to migrate into the voids rather than into the curable resin where the air bubbles could compromise the integrity of the cured resin structure (Brief, pages 2-3).

A copy of illustrative independent claim 1 is reproduced below:

1. A method of applying a curable resin to a substrate, the method comprising the steps of:

providing a curable liquid resin;

providing a substrate having a first surface and a second surface, the substrate comprising fibers defining voids intermediate the first and second surfaces, and the substrate comprising a second material different from the curable liquid resin, the second material coating at least some of the fibers;

wherein the voids adjacent the coated fibers provide fluid communication from the first surface of the substrate to the second surface of the substrate;

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removing at least some of the second material coating at
least some of the fibers;

applying the curable liquid resin to the substrate after
the step of removing at least some of the second
material; and

curing at least some of the curable liquid resin to
provide a resin layer on the substrate.

The examiner has relied upon Holker et al. (Holker), UK Patent Application 2 142 556 A, published on Jan. 23, 1985, as evidence supporting the rejections on appeal. Accordingly, the claims on appeal stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as unpatentable over Holker (Answer, page 3). We reverse these rejections for reasons which follow.

OPINION

It is well settled that the examiner bears the initial burden, on review of the prior art, of presenting a *prima facie* case of unpatentability. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In this appeal, the examiner finds that Holker discloses a method of coating a substrate such as knitted, woven or non-woven fabric comprising the steps of partially impregnating the substrate with a gel or organic polymer, wiping off the excess gel,

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coating the thus treated substrate, and drying the coated substrate (Answer, page 3, citing Holker, page 1, ll. 50-115). The examiner reasons that the partially impregnated substrate of the reference would have provided voids between the surfaces of the substrate and would have coated at least some of the fibers of the substrate (*id.*).

The examiner's findings are a combination of the general disclosure of Holker at page 1, ll. 50-59, with a specific example of Holker at page 1, ll. 95-116. Holker, at page 1, ll. 50-59, discloses his invention as follows:

According to the invention there is provided a method of substantially non-penetratively coating a porous substrate by filling the pores with a fluid impervious layer comprising, at least partially impregnating the substrate with a thixotropic gel or a suitably thickened or viscous polymer solution, coating the impregnated substrate with a substance adapted to form an outer layer and, *after* the said outer layer has formed, removing the thixotropic gel or polymer solution from the substrate. [Emphasis added].

It is clear from this disclosure that Holker does not teach removal of the gel (i.e., the second material) until *after* the outer layer (i.e., the curable liquid resin) has formed, contrary to the steps recited in claim 1 on appeal.

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At page 1, ll. 95-116, Holker exemplifies his invention by use of *three* glove layers. Although Holker does teach that the excess gel (i.e., the second material) which had been forced through the outer layer (of the third glove) "was wiped off" (page 1, l. 109) before the curable liquid resin was applied, all three layers or gloves were impregnated with gel by Holker in this example. The examiner has not established that the limitation of claim 1 on appeal "wherein the voids adjacent the coated fibers provide fluid communication from the first surface of the substrate to the second surface of the substrate" would have been taught or suggested by this example of Holker. The examiner has not shown by convincing evidence or reasoning that the three impregnated gloves of the product in the Holker example provide fluid communication from the first or outer surface of the product substrate to the second or inner surface of the product substrate.

Under 35 U.S.C. § 102(b), anticipation requires that the prior art reference disclose, either expressly or under the principles of inherency, every limitation of the claim. See *In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). For the reasons discussed above, we determine that the

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examiner has not shown that Holker discloses every limitation of claim 1 on appeal. Accordingly, the examiner's rejection of the claims on appeal under 35 U.S.C. § 102(b) over Holker is reversed.

In a rejection under 35 U.S.C. § 103 over a single prior art reference, the examiner has the initial burden of establishing a motivation or suggestion for modifying the reference to show the *prima facie* obviousness of all limitations in the claim. See *B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996). For the foregoing reasons, we determine that the examiner has not met this initial burden. Accordingly, the examiner's rejection of the claims on appeal under 35 U.S.C. § 103 over Holker is reversed.

The decision of the examiner is reversed.

REVERSED

Charles F. Warren)
Administrative Patent Judge)
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Thomas A. Waltz) BOARD OF

PATENT

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Administrative Patent Judge)	APPEALS AND
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Catherine Timm)	
Administrative Patent Judge)	

TAW:tdl

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Patent Division
The Procter & Gamble Company
Ivorydale Technical Center - Box 474
5299 Spring Grove Avenue
Cincinnati, OH 45217