

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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HANS O. CEDERBLAD

Appeal No. 1998-2534
Application No. 08/533,366

ON BRIEF

Before GARRIS, WALTZ and JEFFREY T. SMITH, Administrative Patent Judges.

WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 15 through 17 as amended subsequent to the final rejection (see the amendment dated May 27, 1997, Paper No. 6, entered as per the Advisory Action dated June 5, 1997, Paper No. 7). Claims 15-17 are the only claims remaining in this application.

According to appellant, the invention is directed to a method of stretch modifying an extruded net containing elastomeric strands to produce desired predetermined

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beneficial properties (Brief, pages 2-3). A copy of illustrative claim 15 is reproduced below:

15. The method of modifying elastic properties of extruded net containing elastomeric strands, comprising:

providing extruded net having extruded strands, at least some of which are elastomeric strands;

selecting end use performance criteria for desired final elastic properties for the elastomeric material making up the elastomeric strands in the net;

determining, based on hysteresis performance data, the stretch conditions necessary to achieve the desired final properties, and

stretching the elastomeric stands under the determined conditions to achieve the desired final properties in the elastomeric strands.

The examiner has relied upon Himmelreich, Jr. (Himmelreich),

U.S. Patent No. 4,469,738, issued on Sep. 4, 1984, as evidence of obviousness. Accordingly, the claims on appeal stand rejected under 35 U.S.C. § 103 as unpatentable over Himmelreich

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(Answer, page 3).¹ We reverse this rejection for reasons which follow.

OPINION

The examiner finds that Himelreich discloses a net support material made from a thermoplastic elastomer where the net is prepared by extruding a plurality of monofilaments, placing the monofilaments into a net-like configuration, and then orienting the net in both the machine and transverse directions (Answer, page 3). The examiner finds that Himelreich does *not* disclose using hysteresis data to determine the stretch conditions as required by claim 15 on appeal (*id.*). The examiner concludes that "[t]he use of such data, however, would have been obvious to one of ordinary skill in the art at the time the invention was made" since

¹ Claims 15-17 were rejected under 35 U.S.C. § 112, ¶2, in the Final Rejection dated Mar. 4, 1997, Paper No. 5, page 2. Contrary to appellant's statement on page 2, paragraph (3), of the Brief, the examiner's Advisory Action dated June 5, 1997, Paper No. 7, fails to discuss the rejection under section 112, much less remove the rejection. However, this rejection under the second paragraph of section 112 has not been repeated in the Answer and thus we consider it as withdrawn. See *Paperless Accounting v. Bay Area Rapid Transit Sys.*, 804 F.2d 659, 663, 231 USPQ 649, 652 (Fed. Cir. 1986).

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hysteresis data shows the behavior of a material under cyclic loading conditions and Himelreich does disclose using cyclic testing to determine dynamic creep of the net (*id.*, citing col. 12, l. 8 *et seq.*).

Appellant agrees with the examiner that Himelreich does not disclose any determinations based on hysteresis performance data and furthermore argues that there is no teaching or suggestion in the reference to alter the method by adding hysteresis analysis to achieve desired elasticity and recovery properties of the extruded net strands (Brief, pages 7-9). Appellant also argues that the general statement by the examiner that "hysteresis data shows the behavior of a material under cyclic loading conditions" cannot substitute for a specific suggestion in the reference (Brief, page 11). Appellant submits that the dynamic creep testing taught by Himelreich measures totally different properties than those analyzed with hysteresis data (Reply Brief, page 2).

It is well settled that the initial burden of presenting evidence to support a *prima facie* case of obviousness rests with the examiner. See *In re Oetiker*, 977 F.2d 1443, 1445, 24

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USPQ2d 1443, 1444 (Fed. Cir. 1992). In appropriate circumstances, a single prior art reference can render a claim obvious. See, e.g., *B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996); *In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). However, there must be a showing of a suggestion or motivation to modify the teachings of that reference to the claimed invention in order to support a conclusion of obviousness. This suggestion or motivation may be derived from the prior art reference itself, from the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996).

Himmelreich does disclose the determination of the stretch conditions necessary to achieve the final desired properties but, as stated by the examiner, this reference does not disclose using hysteresis data to determine these stretch conditions (see Himmelreich, col. 9, ll. 29-45; Answer, page 3). The examiner has not presented any convincing evidence or

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reasoning to support the legal conclusion of obviousness (Answer, page 3). A general statement that hysteresis data shows the behavior of a material under cyclic loading conditions (*id.*) is not sufficient evidence alone as to why one of ordinary skill in the art would have used hysteresis data analysis to determine the stretch conditions to achieve the desired final properties of Himelreich. See *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)(The showing of evidence of a suggestion, teaching, or motivation must be clear and particular). The examiner's finding that Himelreich teaches cyclic testing to determine dynamic creep (Answer, pages 3-4) similarly provides no evidence that the analysis of hysteresis data would have been suggested to one of ordinary skill in the art. Appellant submits that dynamic creep measures totally different properties than those analyzed with hysteresis data (Reply Brief, page 2). The examiner has not challenged this statement.

The examiner has not presented any evidence or reasoning that hysteresis data was ever known or considered by one of

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ordinary skill in this art. Thus there is no factual basis on this record for the examiner's statement that "[t]he use of hysteresis data in the design of elastomeric parts is widespread in the elastomer art." Answer, page 4.

For the foregoing reasons, we determine that the examiner has not met the initial burden of presenting a *prima facie* case of obviousness. Accordingly, the rejection of claims 15-17 under 35 U.S.C. § 103 as unpatentable over Himelreich is reversed.

The decision of the examiner is reversed.

REVERSED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
THOMAS A. WALTZ)	APPEALS
Administrative Patent Judge)	AND
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