

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. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DRAHOSLAV LIM,
DAVID A. GOUGH and ANDREA M. ROURKE

Appeal No. 1998-3267
Application 08/688,242

ON BRIEF

Before WARREN, TIMM and DELMENDO, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellants, in the brief, and based on our review, find that we cannot sustain either of the rejections of appealed claims 1, 3 through 6, 22 and 25 through 28,¹ under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a)

¹ Claims 1 through 6 and 21 through 28 were finally rejected in the Office action of March 21, 1997 (Paper No. 22). Subsequent thereto, appellants canceled claims 21, 23 and 24 and submitted new claims 29 through 31 in the amendment of September 25, 1997 (Paper No. 24) and the examiner allowed claims 29 through 31 upon entering the amendment with the filing of an appeal in the advisory

as being obvious over Protzmann, Kindt-Larsen et al., Horner et al. and both Brauer et al. references.² We find that, on this record, the examiner has failed to make out a *prima facie* case of anticipation and of obviousness.

It is well settled that the examiner has the burden of making out a *prima facie* case of anticipation in the first instance by pointing out where each and every element of the claimed invention, arranged as required by the claim, is described identically in the reference, either expressly or under the principles of inherency. *See generally, In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); *In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). It is also well settled that the examiner has the burden of establishing a *prima facie* case of obviousness by showing that some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in the 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, Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

The appealed claims, as represented by appealed claim 1, are drawn to an initiator system for polymerization of monomer mixtures wherein the diacyl peroxide component of the system has certain limitations. The examiner has advanced the position that the limitations on the diacyl peroxide component "does not distinguish structurally over the initiator system" shown in the references which "teach and/or describe initiator systems (for polymerization) which are (i) similar, (ii) identical in some instances and (iii), homologous in other instances" and thus "reasonably describe and overlap with claimed compositions which are homologous, similar or identical and possess similar structure and characteristics found in prior art components" (answer, pages 3-4).

action of October 24, 1997 (Paper No. 26). We note that appellants canceled claims 8 through 20 in the amendment of June 7, 1995, in parent application 08/236,974 (Paper No. 10).

² Answer, pages 3-4.

The examiner does not factually support his position by pointing to any specific disclosure of a diacyl peroxide in any of the references which is either identical to or which structurally differs from the diacyl peroxides specified in the appealed claims in one of the alleged structural relationships. Even if the examiner did point to a particular diacyl peroxide in a reference, the mere allegation of structural similarity is not sufficient to establish a *prima facie* case of obviousness. *See In re Jones*, 958 F.2d 347, 349-51, 21 USPQ2d 1941, 1943-44 (Fed. Cir. 1992) (“Conspicuously missing from this record is any *evidence*, other than the PTO’s speculation (if it be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modifications of the prior art salts necessary to arrive at the claimed . . . salt.”); *In re Grabiak*, 769 F.2d 729, 731-32, 226 USPQ 870, 872 (Fed. Cir. 1985) (“[W]e have concluded that generalizations should be avoided insofar as specific chemical structures are alleged to be *prima facie* obvious one from the other. . . . [I]n the case before us there must be adequate support in the prior art for the ester/thioester change in structure, in order to complete the PTO’s *prima facie* case and shift the burden of going forward to the applicant.”). The examiner’s position is further obfuscated by the allowance of claims 29 through 31 without a statement of reasons for allowance over the same references relied on here (*see above* note 1).

To the extent that a *prima facie* case of anticipation and obviousness had been made out by the examiner over the applied references, the factual arguments presented by appellants in rebuttal shifted the burden back to the examiner to again establish the factual underpinning of a *prima facie* case under § 102(b) and under § 103(a) in order to maintain each of the grounds of rejection. *See, e.g., Oetiker, supra; Spada*, 911 F.2d at 707 n.3, 15 USPQ2d at 1657 n.3. The examiner’s mere statement that “[a]lthough, applicants points [sic] out that references might differ,” there is no “evidence of record to factually establish these differences from properties and/or characteristics of prior art initiator systems” (answer, page 4), does not carry the burden.

The examiner’s decision is reversed.

Reversed

CHARLES F. WARREN)	
Administrative Patent Judge)	
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)	
CATHERINE TIMM)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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ROMULO H. DELMENDO)	
Administrative Patent Judge)	

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