

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAZUYA KOBAYASHI,
TAKASHI YAMATE, and MOTOH ASAKURA

Appeal No. 1999-0349
Application No. 08/621,379

HEARD: JANUARY 11, 2001

Before FLEMING, RUGGIERO, and LEVY, Administrative Patent
Judges.

LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 2-20¹, which are all of the claims pending in this application.

BACKGROUND

¹ Claims 5 and 15 were cancelled in an amendment filed under 37 CFR 1.116 (Paper No. 11B, filed April 23, 1998). The amendment was entered for purposes of appeal by the examiner in a subsequent advisory action (Paper No. 12, mailed May 7, 1998). Claims 2-4, 6-14, and 16-20 remain before us for decision on appeal.

The appellants' invention relates to a laminated glass used in a head-up display system for an automobile.

An understanding of the invention can be derived from a reading of exemplary claim 2, which is reproduced as follows:

2. A laminated glass defining a passenger compartment of an automobile, comprising:

first and second glass plates which are respectively located at an inside where a person resides and an outside opposite to the inside;

an antireflection film formed on an inside surface of said first glass plate;

an intermediate film disposed between and in contact with said first and second glass plates;

a polarization-direction changing film disposed between the first and second glass plates for changing a direction of polarization of light to be incident thereon;

a light-transmittable reflection film disposed between said polarization-direction changing film and said first glass plate;

an adhesive disposed between said polarization-direction changing film and said second glass plate to bond said polarization-direction changing film to said second glass plate; and

means by which said polarization-direction changing film is separate from said first glass plate so that said intermediate film resides between said polarization-direction changing film and said first glass plate.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

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Wood et al. (Wood) 1993	5,231,379	Jul. 27,
L'Her et al. (L'Her) 1994	5,352,528	Oct. 4,
Hashimoto et al. (Hashimoto) 1996	5,510,913	Apr. 23,

(filed July 20, 1993)

Claims 2-4, 6-14, and 16-20 stand rejected under 35
U.S.C.

§ 103 as being unpatentable over Hashimoto in view of L'Her
and Wood.

Rather than reiterate the conflicting viewpoints advanced
by the examiner and the appellants regarding the above-noted
rejections, we make reference to the examiner's answer (Paper
No. 16, mailed August 26, 1998) for the examiner's complete
reasoning in support of the rejections, and to the appellants'
brief (Paper No. 15, filed July 22, 1998) for the appellants'
arguments thereagainst. Only those arguments actually made by
the appellants have been considered in this decision.

Arguments which the appellants could have made but chose not

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to make in the briefs have not been considered. See 37 CFR 1.192(a).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. 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 rejections 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 invention as set forth in claims 2-4, 6-14, and 16-20. Accordingly, we reverse.

We turn first to independent claim 2. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the

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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 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

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Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicants to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. 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).

The appellants assert (brief, pages 11 and 12) that

None of the cited references provides the teaching, suggestion or motivation to combine their disparate disclosures to practice the claimed combination of an antireflection film, a polarization-direction changing film, an adhesive disposed between the polarization-direction changing film and a second glass plate, and a light-transmittable reflection film disposed between a polarization-direction changing film and a first glass plate, as recited in independent Claims 2, 7 and 9

The examiner takes the position (answer, page 3) that

Hashimoto et al teaches all of the features of the claimed invention except for the use of an adhesive to adhere the polarizing film to the outside glass, the antireflection film on the inside surface of the first glass plate and the light-transmittable reflection film between the

polarization direction changing film and the first glass plate.

To overcome the deficiencies of Hashimoto, the examiner turns to L'Her and Wood. As stated by the examiner (answer, page 4), L'Her teaches the use of an adhesive 2, 4 to attach a plastic film 3 to inner and outer sheets of glass in order to strengthen the laminated glass. In the opinion of the examiner, it would have been obvious to have attached the polarization changing film of Hashimoto to the glass to increase the safety of the glass.

We find that Hashimoto teaches (col. 1, lines 11-14) a head-up display system for a vehicle which allows the driver of a car to view vehicular information while looking out from the front windshield of the car. L'Her discloses (col. 1, line 67 - col. 2, line 3) a laminated glass for a windshield of a vehicle comprised of two glass sheets and an intermediate assembly formed of a core of PVC disposed between two adhesive films. L'Her further discloses (col. 2, lines 62-65) that the adhesive film retains glass splinters in case of glass breakage. Although L'Her teaches the use of a plastic film adhesively secured between two sheets of glass, we find that

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L'Her considered with Hashimoto do not suggest the adhesive layer or its specific location, i.e., between the polarization-direction changing film and the second glass plate, because the polarization-direction changing film of Hashimoto could be kept in place by the intermediate film.

With respect to Wood, the examiner asserts (answer, pages 4 and 5) that it would have been obvious to have used the reflecting film 78 of Wood in the windshield of Hashimoto. The appellants assert (brief, page 9) that Hashimoto teaches away from the use of any reflection film. We disagree. The appellants are correct that Hashimoto discloses problems associated with the use of a reflection film (col. 1, lines 18-28). However, Hashimoto, in the discussion of the prior art, also discusses (col. 1, lines 34-37) the problems associated with not using a reflection film. In addition, Hashimoto teaches (col. 9, lines 23-25) that "[t]he optical rotary film may be used with a conventional reflective film in a head-up display system according to the present invention." We agree with the examiner that Wood uses a reflecting film 78, in a head-up display for an automobile. However, the reflection film of Wood is not used in conjunction with a

polarization-direction changing film. We find that Hashimoto and Wood do not provide any suggestion of the specific claimed location of the reflection film; i.e., disposed between the polarization-direction changing film and the first glass plate.

The examiner takes the position (answer, page 4) that antireflection films are old and well known and that it would have been obvious to have added an antireflection film to the inner window of Hashimoto. The appellants assert (brief, page 10) that appellants requested (Amendment filed April 23, 1998 under 37 CFR § 1.116, Paper No. 11) that the examiner provide evidence to support the examiner's assertion. We note that in the amendment (page 8), the appellants requested the examiner to provide a reference to support the examiner's assertion and to establish that it would have been obvious to have used an antireflection film on the inner window of Hashimoto. The examiner asserts (answer, page 6) that the appellants' traversal of the examiner's well-known statement is untimely because it was not made in the amendment following the Office action in which the well-known statement was made. The

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examiner cites In re Chevenard, 139 F.2d 71[sic: 711], 160
USPQ 239 (CCPA 1943).

In In re Soli, 317 F.2d 941, 946, 137 USPQ 797, 800 (CCPA
1963) the court stated

This court has long held that wherever possible,
issues should be crystallized *before* appeal to
this court. It is neither the function of oral
arguments nor briefs before this court to question
for the first time the propriety of actions of the
examiner or the board to which a response conveniently
could have been made before the Patent Office. See
In re Chevenard, 31 CCPA 802, 139 F.2d 711, 60 USPQ 239.

We find that although the appellants should have traversed the
examiner's statement of well-known prior art in the subsequent
response instead of the response filed under 37 CFR § 1.116,
the examiner could have added a reference showing the well-
known prior art in the examiner's answer. Such a showing by
the examiner would not have created a new ground of rejection
on appeal. While antireflection coatings on glass are
commonly known, there is no evidence of record to establish
the obviousness of the specific claimed location on the inside
of the inner glass plate of Hashimoto, because of the claimed
placement of the reflection film between the polarization-
direction changing film and the first (inner) glass plate.

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Neither the references relied upon by the examiner, nor the examiner's asserted well known prior art teaches providing a reflection film between the polarization-direction changing layer and also providing an antireflection film on the inside of the inner glass plate as claimed. It is the claim as a whole which must be compared with the prior art to which the subject matter pertains. In our view, from all of the above, we find that the only suggestion for modifying Hashimoto in the manner proposed by the examiner to meet the above-noted limitations stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See W. L. Gore Inc. & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor. Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995)(citing W. L. Gore Inc. & Assocs., v. Garlock, Inc., 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983)). "It is impermissible to

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use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992)(citing In re Gorman, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)).

We conclude that the examiner's determinations have not been supported by any evidence that would have led an artisan to arrive at the claimed invention. The examiner has therefore failed to establish a prima facie case of obviousness of the claimed invention. Accordingly, the rejection of claim 2 under 35 U.S.C. § 103 is reversed. As the two other independent claims 7 and 9 contain similar limitations as claim 2, and claims 3, 4, 6, 8, 10-14, and 16-20 depend from claims 2, 7, or 9, the rejection of claims 3, 4, 6-14, and 16-20 under 35 U.S.C. § 103 is reversed.

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CONCLUSION

To summarize, the decision of the examiner to reject claims 2-4, 6-14, and 16-20 under 35 U.S.C. § 103 is reversed.

REVERSED

MICHAEL R. FLEMING)
Administrative Patent Judge)
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JOSEPH F. RUGGIERO
Administrative Patent Judge

STUART S. LEVY
Administrative Patent Judge

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