

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(2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN D. BASIL,
CHIA-CHENG LIN, ROBERT M. HUNIA
and HELMUT FRNZA

Appeal No. 95-4201
Application 07/799,805¹

ON BRIEF

Before KIMLIN, WARREN and OWENS, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

This is an appeal under 35 U.S.C. ¹ 134 from the decision of the examiner finally rejecting claims 1, 2, 11, 12, 14 and 15, and refusing to allow claims 3, 4 and 16 as amended

subsequent to the final rejection.²

¹ Application for patent filed November 29, 1991. According to appellants, this application is a continuation-in-part of application 07/546,069, filed June 29, 1990, now abandoned, and a continuation-in-part of application 07/546,484, filed June 29, 1990, now Patent No. 5,344,712, issued September 6, 1994, and a continuation-in-part of application 07/500,642, filed March 28, 1990, now U.S. Patent 5,401,579, issued March 28, 1995, which latter application is a continuation-in-part of application 07/133,831, filed December 16, 1987, now abandoned.

² See the amendment of April 11, 1994 (Paper No. 11) that has been entered as indicated by the

We will not sustain the ground of rejection of the appealed claims³ under 35 U.S.C. ' 103 over Jackel or Phillip in view of Klein.^{4,5} It is well settled that in order to establish a *prima facie* case of obviousness, A[b]oth the suggestion and the reasonable expectation of success must be found in the prior art and not in applicant's disclosure.® *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). Thus, a *prima facie* case of obviousness is established by showing that some objective teaching or suggestion 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 without recourse to the teachings in appellants' disclosure. *See generally In re Oetiker*, 977 F.2d 1443, 1447-48, 24 USPQ2d 1443, 1446-47 (Fed. Cir. 1992) (Nies, J., concurring).

We have carefully considered the record before us in this appeal and conclude therefrom that the examiner has failed to make out a *prima facie* case of obviousness with respect to the appealed claims. While we agree with the examiner that polyvinylpyrrolidone is recognized as, *inter alia*, a film forming material (answer, pages 5 and 6), we find that the examiner has not provided evidence and/or scientific reasoning in the record establishing why one of ordinary skill in this art would have used this knowledge to modify the coatings of Jackel or the materials for synthesizing materials for hard contact lenses in Phillip to arrive at the claimed invention because there is no teaching in either reference to form a siloxane organic hybrid polymer coating agent from such a vinyl polymer. Indeed, the vinyl substituted monomer used in both Jackel and Phillip referred to by the examiner (answer, page 5) is an olefinically unsaturated silane which is structurally unrelated to polyvinylpyrrolidone. Further, with respect to appealed claims 11, 12 and 14 through 16, we find no suggestion in the combination of references to add either an alkali metal carboxylic acid catalyst, such as sodium acetate, or cerium oxide to a siloxane coating.

examiner in his letter of January 24, 1995 (Paper No. 17) in which he identifies error in the claims as copied in the appendix to appellants' reply brief (Paper No. 16).

³ The examiner has not brought forward the rejection of appealed claims 3, 4 and 16 under 35 U.S.C. ' 112, second paragraph, apparently in view of his entry of the amendment of April 11, 1994.

⁴ The references relied on by the examiner with respect to the ground of rejection are listed at pages 2 and 3 of the answer. We refer to these references in our opinion by the name associated therewith by the examiner.

⁵ We have not considered the reference cited and discussed by the examiner in his answer (pages 6-7) that does not appear in the statement of the rejection (page 3). *Compare In re Hoch*, 428 F.2d 1341, 1342, n.3, 166 USPQ 406, 407, n.3 (CCPA 1970); *see Ex parte Raske*, 28 USPQ2d 1304, 1304-05 (Bd. Pat. App. & Int. 1993). Similarly, we have also not considered the two U.S. Patents cited on the Form PTO-892 attached without explanation to the answer (Paper No. 15).

Accordingly, it is manifest that the only direction to appellants' claimed invention as a whole on the record before us is supplied by appellants' own specification.

The examiner's decision is reversed.

Reversed

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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CHARLES F. WARREN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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