

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(2) is not binding precedent of the Board.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. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN CHARLTON,
PAUL F. CLARKE and ERNEST B. HAYES

Appeal No. 95-4253
Application 07/890,394¹

ON BRIEF

Before JOHN D. SMITH, WARREN and LIEBERMAN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner refusing to allow claims 10 through 13, 24, 26, 30 and 31 as amended subsequent to the final rejection.² Claims 14 through 16 and 18, also of record, have been withdrawn from consideration by the examiner under 37 CFR § 1.142(b).

¹ Application for patent filed May 26, 1992. According to appellants, this application is a continuation of application 07/584,293, filed September 18, 1990, now abandoned.

² Amendment of November 4, 1993 (Paper No. 21).

We have carefully considered the record before us, and based thereon, find that we cannot sustain the examiner's rejection of the appealed claims under 35 U.S.C. § 103 over Orrmins or Sublett et al. or Touey et al. or Tamblyn et al. (answer, pages 3-5).³

It is well settled that the application of the prior art to the claimed invention requires the determination of the claimed invention encompassed by the appealed claims and that in making this determination, the broadest reasonable interpretation must be given to the terms of the appealed claims consistent with appellants' specification as it would be interpreted by one of ordinary skill in this art. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). In doing so, the terms in the appealed claims must be given their ordinary meaning unless another meaning is intended by appellants. *See, e.g., Morris*, 127 F.3d at 1055-56, 44 USPQ2d at 1029; *York Prods., Inc. v. Central Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1572-73, 40 USPQ2d 1619, 1622 (Fed. Cir. 1996), and cases cited therein (a claim term will be given its ordinary meaning unless appellant discloses a novel use of that term); *Zletz, supra*.

The examiner has premised the rejection on his contention that "'tow' is synonymous with appellants [sic] claimed 'thread'" (answer, page 3) but has not submitted any reason why one of ordinary skill in the art would find that the broadest reasonable interpretation of the term "thread" based on appellants' specification would include a "tow" as this term is used in Sublett et al. or Touey et al. (note particularly the definition of "tow" at col. 1, lines 57-60) or Tamblyn et al.⁴ Indeed, as pointed out by appellants in their reply brief (Paper No. 27), the term "thread" as used in their specification (page 4, second full paragraph) would be interpreted by one of ordinary skill in this art to have its ordinary meaning which, as shown by their dictionary citation, is not inclusive of a "tow."

It is further well settled that the examiner must satisfy his burden of establishing a *prima facie* case of obviousness under § 103 by showing some objective teaching or suggestion in the

³ The references relied on by the examiner are listed at page 2 of the answer. We refer to these references in our opinion by the name associated therewith by the examiner.

⁴ As relied on by the examiner, Orrmins discloses a "loose, airy wadding *H* of loose, airy fibrous material" (col. 4, lines 8-9) which is not a "tow."

applied prior art taken as a whole or that knowledge generally available to one of ordinary skill in the art would have led that person to the claimed invention, including each and every limitation of the claims, 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); *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991) (“Both the suggestion and the reasonable expectation of success must be found in the prior art, not in applicant’s disclosure. [Citation omitted.]”); *In re Warner*, 379 F.2d 1011, 1014-17, 154 USPQ 173, 176-78 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). We must conclude that the examiner has failed to make out a *prima facie* case of obviousness with respect to the appealed claims as a whole since he has not provided evidence and/or scientific reasons in the record why one of ordinary skill in this art would have considered the “thread” of the claims to be the “tow” of the applied references and why one of ordinary skill in this art would have modified this “tow” as the examiner suggests in order to arrive at the filter elements defined by the terms of the appealed claims. Thus, 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

JOHN D. SMITH)	
Administrative Patent Judge)	
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CHARLES F. WARREN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
PAUL LIEBERMAN)	

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Administrative Patent Judge)

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