

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(2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAZUYUKI OKUI
and MAKOTO SHIOKAWA

Appeal No. 96-0898
Application 08/083,838

ON BRIEF

Before GARRIS, WARREN and KRATZ, *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 8 through 22 and 24 as amended subsequent to the final rejection, which are all of the claims remaining in the application.¹

We have carefully considered the record before us, and based thereon, find that we cannot sustain the ground of rejection of the appealed claims, of which claim 8 is representative, under 35

¹ See the amendment of November 4, 1994 (Paper No. 9), in which claim 23 was canceled.

U.S.C. § 103 as being unpatentable over Marwick in view of Saito et al.² advanced by the examiner on appeal.³ It is well settled that in order to establish a *prima facie* case of obviousness, “[b]oth the suggestion and the expectation of success must be founded in the prior art, not in the applicant’s disclosure.” *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Thus, a *prima facie* case of obviousness can be 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 as a whole, including each and every limitation of the claims, without recourse to the teachings in appellant’s 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 Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *Dow Chemical, supra*. We reverse the ground of rejection because the prior art as applied by the examiner does not address the limitations of claim 8 and thus does not establish a *prima facie* case of obviousness.

In order to consider the issues in this appeal involved with the application of the prior art to the claimed invention encompassed by appealed claim 8 in the ground of rejection advanced by the examiner on appeal, we first must determine the invention encompassed by this claim as it stands before us, mindful that we must give the broadest reasonable interpretation to the terms thereof 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 considering the plain language of claim 8 and the interpretation of the terms thereof in light of appellants’ specification as it would be interpreted by one of

² The references are listed in the examiner’s answer of July 3, 1995 (Paper No. 14, page 3).

³ In response to our remand of August 31, 1999 (Paper No. 21), in which we required “a complete statement of the ground of rejection under § 103” (page 2), the examiner supplied a second supplemental examiner’s answer on October 20, 1999 (Paper No. 22). Thus, we have considered this document to constitute the complete statement of the ground of rejection. In the absence of a response to the examiner’s second supplemental answer, we find that appellants have elected to stand on the record. In view of the examiner’s statements on page 5 of the second supplemental answer, we state again here as we did in our remand (pages 1-2), that the objection to the disclosure set forth in the examiner’s answer is not before us.

ordinary skill in this art, we must agree with appellants (principal brief, pages 27-28; reply brief, pages 7-8) that claim 8 would not include a step or steps involved with the replacement of the naturally occurring oxide film by an oxide layer formed by a pretreatment step, even in view of the transitional term “comprising,”⁴ and that claim 8 specifies that the lubricant is applied on *the* surface of the aluminum “alloy plate having a naturally occurring oxide film,” contrary to the position of the examiner (second supplemental answer, page 4).

Upon carefully considering the combined teachings of the applied references to the limitations of appealed claim 8, we agree with appellants’ arguments (principal brief, pages 25-26) that this combination of references, and specifically the teachings of Marwick, differs from the claimed method in the specific teaching that the “aluminum plate to be pretreated to form a strongly bonded artificial surface layer thereon” (*id.*, page 25; see Marwick, e.g., col. 1, lines 16-18, col. 4, lines 4-6 and 29-52, and Example 2). Thus, we find that the issue raised by the difference pointed out by appellants is whether one of ordinary skill in this art would have reasonably modified the method thus taught by the combined teachings of the applied references by applying the lubricant and subsequently the adhesive of Saito et al. to the surface of “an Al alloy plate having a naturally occurring oxide film” rather than replacing that oxide film with an artificial oxide film as taught in Marwick (*id.*). However, we further find that the examiner does not recognize this difference in the statement of the ground of rejection (second supplemental answer, pages 2-3) and does not provide any evidence or scientific explanation in the second supplemental answer with respect to this issue in response to appellants’ arguments (pages 3-4).

Accordingly, on this record, we reverse the examiner’s ground of rejection because it is inescapable that the combined teachings of the references as applied by the examiner taken as a whole would not have resulted in the claimed method encompassed by the appealed claims. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-54, 5 USPQ2d 1434, 1438-41 (Fed. Cir.). Thus, it is

⁴ See *In re Baxter*, 656 F.2d 679, 686-87, 210 USPQ 795, 802-03 (CCPA 1981) (“As long as one of the monomers in the reaction is propylene, any other monomer may be present, because the term ‘comprises’ permits the *inclusion* of other steps, elements, or materials.”)

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

The examiner's decision is reversed.

Reversed

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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CHARLES F. WARREN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
PETER F. KRATZ)	
Administrative Patent Judge)	

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