

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(2) is not binding precedent of the Board.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 TAKASHI ONISHI and TOSHIKAI HATA

Appeal No. 96-2185
Application 08/205,821¹

ON BRIEF

Before METZ, PAK and WARREN, *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 finally rejecting claims 1, 5 and 6.²

We have carefully considered the record before us, and based thereon, find that we cannot sustain the ground of rejection of claims 1, 5 and 6 under 35 U.S.C. § 103 over Mraz et al. in

¹ Application for patent filed March 2, 1994. According to appellants, this application is a continuation of application 07/699,110, filed May 13, 1991, now abandoned.

² See amendment of March 2, 1994 (Paper No. 22).

view of Uda.³ It is well settled that the examiner must satisfy his burden of establishing a *prima facie* case of obviousness by showing some objective teaching or suggestion in the 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 as a whole, 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 Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed. Cir. 1988).

We agree with appellants that the examiner has failed to make out a *prima facie* case of obviousness with respect to the claimed invention as a whole for essentially the reasons set forth in appellants' brief, to which we add the following for emphasis. The appealed claims encompass process having two molding steps to prepare molded circuits wherein an intermediate molded unit, produced as specified, is further contacted with resin in a different mold to obtain a final molded unit. We find that both Mraz et al. and Uda teach a process wherein there is a single molding step. In the process of Mraz et al., the "lace curtain" circuit network is placed in a mold, and worked into the desired form therein, that is, the circuit network is severed and bent by means of a punch in the mold framework, with the resulting circuitry contacted with resin to form a final molded product. In the process of Uda, each of a plurality of spark gaps contained in a frame is fixed by forming a separate molding piece around each, followed by working the frame of the final molded product into the desired form, that is, by severing and bending the frame, for insertion into sockets of a preformed unit.

We fail to find in the position advanced by the examiner any evidence and/or scientific evidence why one of ordinary skill in this art would have modified the *single* molding step processes disclosed by the teachings of Mraz et al. and Uda in order to arrive at the process having *two* molding steps encompassed by the appealed claims. Indeed, it is manifest that the combined teachings of the references applied by the examiner taken as a whole would not have resulted in the claimed process because one of ordinary skill in the art would have modified the single molding step process of Mraz

³ The references relied on by the examiner are listed at page 2 of the answer.

et al. by performing some of the work on the circuit framework subsequent to the molding step as suggested by Uda. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-54, 5 USPQ2d 1434, 1438-41 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

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

ANDREW H. METZ)	
Administrative Patent Judge)	
)	
)	
)	
CHUNG K. PAK)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
CHARLES F. WARREN)	
Administrative Patent Judge)	

Appeal No. 96-2185
Application 08/205,281

Sughrue, Mion, Zinn, MacPeak & Seas
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3202