

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KIN-YA HIYOSHI, TAKAYUKI FUKUCHI,
and TADAHIRO IWASAKI

Appeal No. 96-2726
Application 08/005,401¹

ON BRIEF

Before KIMLIN, WARREN and OWENS, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

¹ Application for patent filed January 19, 1993. According to appellants, this application is a continuation of Application 07/721,598, filed July 29, 1991, now abandoned.

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DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 and 4-8, all the claims remaining in the present application. Claim 1 is illustrative:

1. A method of producing watermark paper comprising:

fixing a lace having a through-hole-like pattern obtained by knitting a synthetic fiber or a natural fiber or by making an embroidery on a base fabric, to an entire surface of a wire cloth for paper making by sewing or by bonding using an adhesive to form a patterned wire;

fitting said patterned wire as a face wire to an entire circumferential surface of a cylinder mold of a cylinder-vat machine or a dandy roll; and

making said paper by using said cylinder mold or said dandy roll having said patterned wire fitted thereto.

The examiner relies upon the following references as evidence of obviousness:

Fearing	1,571,715	Feb. 2, 1926
Edge	1,901,024	Mar. 14, 1933
Denton	2,319,800	May 25, 1943
Waters	4,526,652	Jul. 2, 1985
Izard	WO 86/05220	Sep. 12, 1986
Horse et al. (Horse) (Kokai patent application)	49[1974]-21248	Feb. 25, 1974

Appellants' claimed invention is directed to a method of producing watermark paper. The method entails fixing a lace to a wire cloth by sewing or adhesive bonding to form a patterned wire, fitting the patterned wire to the circumferential surface

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of a cylinder or dandy roll, and employing the patterned roll to make the watermark paper.

Appealed claims 1 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Denton in view of Iazard. Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Denton in view of Iazard and Japanese '248. Also, claims 5, 7 and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Denton in view of Iazard and Edge and either Waters or Fearing.

We have carefully reviewed the respective positions advanced by appellants and the examiner. In so doing, we agree with appellants that the claimed subject matter would not have been obvious to one of ordinary skill in the art in view of the teachings of the applied prior art. Accordingly, for essentially the reasons expressed by appellants in their brief, we will not sustain the examiner's rejections.

All the applied references relating to making watermark paper, namely, Denton, Waters and Fearing, employ wire cloth on a dandy roll or the like. None of these references, either in the inventive disclosure or the discussion of the prior art, teaches or suggests using appellants' synthetic or natural fiber lace to produce watermark paper. On the other hand, both Iazard and Edge, the references which disclose the use of fabric patterns to

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impress wet fibrous material, fail to teach or suggest making watermark paper. Edge, who places the fabric pattern on felts, not the claimed cylinder mold or dandy roll, relates to manufacturing relatively thick sheet material such as wall boards or insulating boards. Similarly, Iazard, who fails to disclose the claimed step of fixing a fibrous pattern to a cylinder mold or a dandy roll, teaches the production of fiber board.

In our view, the only teaching of using lace made from natural or synthetic fiber to manufacture watermark paper emanates from appellants' specification which, of course, cannot be relied upon to establish obviousness under 35 U.S.C. § 103. In our opinion, the examiner has resorted to impermissible hindsight in concluding that the claimed method would have been obvious to one of ordinary skill in the art.

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims 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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TERRY J. OWENS)
Administrative Patent Judge)

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