

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NOBUYOSHI NISHIKAWA, EIICHI OKUNO,
TOSHIHARU HORIE, ZYUNZO MAKINO and HIROSHI AOKI

Appeal No. 1997-2495
Application 08/200,554

HEARD: October 24, 2000

Before KIMLIN, WARREN and JEFFREY T. SMITH, *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 9, 10, 12 through 14 and 18 through 21 which are all of the claims in the application.¹

We have carefully considered the record before us, and based thereon, find that we cannot sustain the rejection of the appealed claims under 35 U.S.C. § 103 over Gehle in view of “the prior art admission” and further in view of either Favre et al. or Gautier et al. (answer,

¹ See the amendments of September 11, 1995 (Paper No. 27), June 12, 1995 (Paper No. 21), and February 22, 1994 (Paper No. 13). We observe that the amendment of February 22, 1994 (Paper No. 13) has not been clerically entered with respect to the cancellation of claim 1 as seen from the amendment of June 9, 1993 in parent application 07/964,696 (Paper No. 6).

page 3). We note that the examiner has identified the disclosure at page 4, line 23, through page 6, line 12; and at page 2, line 24, through page 3, line 1 of appellants' specification as "the prior art admission" (answer, page 4).

It is well settled that "[t]he consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that [the claimed process] should be carried out and would have a reasonable likelihood of success viewed in the light of the prior art. [Citations omitted] Both the suggestion and the expectation of success must be found in the prior art, not in the applicant's disclosure." *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Thus, a *prima facie* case of obviousness is established by showing that some objective teaching, suggestion or motivation 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 appellants' disclosure. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Oetiker*, 977 F.2d 1443, 1447-48, 24 USPQ2d 1443, 1446-47 (Fed. Cir. 1992) (Nies, J., concurring); *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988).

The appealed claims, as represented by claim 9, encompass methods of "contact adhering" comprising at least the steps of (1) applying a layer of "a solvent-free moisture curable adhesive" comprising a specified "molecule," to at least one of two "adherends," (2) bringing the two "adherends" into contact after the layer of adhesive begins curing and develops tack in the presence of atmospheric moisture and (3) permitting the adhesive "to be cured in the absence of heat treatment, thereby adhering said adherends." Based on our review of the record in light of the examiner's position and the analysis in appellants' brief and reply brief, we must agree with appellants that neither the applied references nor "the prior art admission" disclose a process containing these three steps, the type of adhesive notwithstanding. With respect to the required adhesives, we find that none of the applied prior art references discloses adhesives that are defined in the appealed claims and indeed, neither Favre et al.

nor Gautier et al. disclose adhesives that are among those taught to be used in the process disclosed by Gehle. While appellants do acknowledge in their specification that adhesives as specified in the appealed claims are found in, *inter alia*, three United States Patents (page 4, line 26, and page 5, lines 9-10), as found by the examiner (answer, page 4), that is *all* that they acknowledge. Thus, this *limited* disclosure is the extent of the evidence of record concerning the knowledge of such adhesives in the prior art.² Such known adhesives also would not be used in the process disclosed by Gehle.

The examiner has provided no realistic rationale why one of ordinary skill in this art would have found in this obviously diverse collection of prior art disclosures and “prior art admissions,” which do not even set forth a bare outline of a three step adhering method, any objective teaching, suggestion or motivation leading to the claimed invention as a whole, including each and every limitation of the claims (see answer, e.g., pages 5-6). Accordingly, it is abundantly manifest from this record that the examiner has improperly indulged in hindsight by relying on appellants’ invention in reaching his conclusion that the invention encompassed by the appealed claims would have been obvious to one of ordinary skill in this art from such prior art information and knowledge. *See, e.g., Rouffet, supra* (the specific understanding or principal within the knowledge of one of ordinary skill in the art leading to the modification of the prior art in order to arrive at appellants’ claimed invention must be explained); *Dow Chem.*, 837 F.2d at 473, 5 USPQ2d at 1531-32.

The examiner’s decision is reversed.

² There is no indication in the record that the examiner has considered the disclosure of these three

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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JEFFREY T. SMITH)	
Administrative Patent Judge)	

United States Patents with respect to the claimed methods, and we have not done so.

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