

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAN AGEHEIM
and
THOMAS ANDERSSON

Appeal No. 1998-2732
Application No. 08/244,163

ON BRIEF

Before OWENS, LIEBERMAN, and DELMENDO, Administrative Patent Judges.

DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 1 through 3, 5, 7, 9 through 13, and 15.¹ Claim 8, which is the only other pending

¹ In response to the final Office action mailed August 14, 1996 (paper 13), the appellants submitted an amendment under 37 CFR § 1.116 (1981) proposing a change to claim 1. The examiner indicated in the advisory action of March 11, 1997 (paper 17) that the amendment will be entered upon the filing of a notice of appeal and an appeal brief. Notwithstanding the examiner's

claim, has been allowed. (Examiner's answer, page 2.)

The subject matter on appeal relates to a tube of a layered material consisting of a particular first layer and a particular second layer. According to the appellants, the invention provides "tubes for the transport or storage of petrol, or hydrocarbons having similar properties, the tubes being manufactured from a material which is both chemically compatible with the hydrocarbons and which has a reduced absorption of the transported or stored hydrocarbons." (Appeal brief, pages 3-4.) The tubes are also said to "have a higher resistance to the diffusion of the hydrocarbons therethrough, so that they may be installed in the ground with a higher degree of safety than those of the prior art." (Id. at page 4.) Further details of this appealed subject matter are recited in illustrative claim 1 reproduced below:

1. A tube of layered material consisting of a first layer and a second layer characterized in that said first layer consists essentially of a material selected from the group consisting of polyethylene and polypropylene, and said second layer, constituting a barrier layer for reducing the diffusion outward through said tube of hydrocarbons transported or stored within said tube, comprises a material selected from the group consisting of polyethylene and

statement in the advisory action, we note that the amendment has not been clerically entered. We trust that the amendment will be properly entered on return of this application to the examiner's jurisdiction.

polypropylene in combination with any of the components selected from the group of components consisting of butyl rubber, polyamide and polyester, said first layer and said second layer being coextruded with each other.

The examiner relies on the following prior art references as evidence of unpatentability:

Preto et al. (Preto)	3,873,667	Mar. 25, 1975
Russell	4,196,464	Apr. 1, 1980

In addition, the examiner relies on the appellants' admissions regarding the prior art at page 2, lines 14 through 20, and page 3, lines 27 through 29, of the present specification.

Claims 1 through 3, 5, 7, 9 through 13, and 15 on appeal stand rejected under 35 U.S.C. § 103(a) as unpatentable over Russell in view of Preto and the appellants' admissions regarding the prior art.² (Examiner's answer, pages 4-5.)

We reverse the aforementioned rejection for reasons which follow.

² As we indicated above, the examiner has allowed claim 8. Accordingly, the rejection under 35 U.S.C. § 103(a) of claim 8 as unpatentable over Russell in view of Preto and the appellants' admissions regarding the prior art, and further in view of U.S. Patent 4,264,490 to Berejka issued on Apr. 28, 1981 and U.S. Patent 5,271,977 to Yoshikawa et al. issued on Dec. 21, 1993, as set out in the final Office action, has been withdrawn.

Under 35 U.S.C. ' 103, the initial burden of establishing a prima facie case of obviousness rests on the examiner. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). In this case, it is our determination that the examiner has not met the initial burden of proof.

The examiner found that Russell describes a two-layered fuel tube comprising of an inner barrier layer coextruded with an outer layer. (Id. at page 4.) According to the examiner, Russell teaches that "the inner barrier layer is nylon and the outer layer is an ethylene-based polymer..." (Id.) The examiner further found that Russell teaches the use of other polymeric materials for the outer and/or inner layers. (Id.)

Nevertheless, the examiner admitted that Russell's tube differs in two respects. (Id.) First, the examiner determined that Russell does not teach the appellants' claimed first layer. Second, the examiner also acknowledged that Russell does not teach the appellants' claimed second layer.

To account for these significant differences between the invention recited in appealed claim 1 and Russell's tube, the examiner relied on Preto and the appellants' admitted prior art. Regarding Preto, the examiner found that this reference teaches a polyolefin/polyamide blend comprising 10 to 60% by weight of

polyamide and 40 to 90% by weight of polyethylene or polypropylene and having "excellent impermeability to both liquid and gaseous organic compounds such as hydrocarbons."

(Id.) With respect to the appellants' admitted prior art, the examiner alleged that "it is conventional to use medium density polyethylenes to form the outer layer of a fuel tube..." (Id.)

On the basis of these findings, the examiner concluded as follows:

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize a hydrocarbon-impermeable polyolefin/polyamide blend as disclosed in PRETO ET AL as the inner barrier layer and a conventional polyolefin as the outer layer as admitted by the Appellants to form a coextruded tube as disclosed in RUSSELL in order to obtain a delamination-resistant hydrocarbon-impermeable article having good mechanical properties and barrier properties. [Id. at p. 5.]

In our judgment, the examiner has erred in both the findings of fact and the conclusion of law. Contrary to the examiner's allegation, the appellants' admissions regarding the prior art does not state that "it is conventional to use medium density polyethylenes to form the outer layer of a fuel tube..." (Id. at page 4; emphasis added.) Instead, the appellants' admission merely states that polyethylene tubes are conventional

in the art. (Specification, pages 2-3.) Also, the examiner's characterization of Preto on page 4 of the examiner's answer is incomplete because it fails to mention, much less account for, the teaching in the reference that the blend of the polyolefin and the synthetic linear polyamide must be heated at a temperature between about 140°F and 250°F for a period between about 0.1 minute and about 30 minutes to effect the disclosed impermeability property. (Column 2, lines 28-37.) Nor does the examiner's rejection clearly acknowledge that Preto does not teach a tube.

As to the examiner's conclusion of obviousness, it is important to emphasize that both the suggestion to combine the references and the reasonable expectation of success must be founded in the prior art, not from the appellants' own disclosure. In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991) (citing In re Dow Chemical Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988)).

Here, the examiner has not pointed to any evidence that would have suggested to one of ordinary skill in the art that Preto's polyolefin/polyamide blend can be coextruded as a barrier layer having the recited characteristics together with a polyethylene to form a tube. In this regard, the broad teaching

in Russell concerning the inner and outer layers of the tube (column 2, lines 54-61), the teaching in Preto concerning a hollow container or collapsible bag made of a polyolefin/polyamide blend which is impermeable to propellant gases, and the appellants' admissions regarding a tube made of a polyolefin are insufficient. At best, the combined teachings of the prior art might have led one of ordinary skill in the art to make a tube made from Preto's blend. Such a tube, however, is not the invention recited in appealed claim 1.

The remaining appealed claims all depend from appealed claim 1. It follows then that the examiner has also failed to establish a prima facie case of obviousness against these dependent claims.

Because the examiner has not pointed to a specific teaching, motivation, or suggestion in the prior art to combine the references so as to arrive at the here claimed invention with a reasonable expectation of success, we hold that the examiner has engaged in impermissible hindsight reconstruction using the appellants' own specification as a template. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992);

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Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227
USPQ 543, 547 (Fed. Cir. 1985); W. L. Gore & Assoc. v. Garlock,
Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir.
1983).

In summary, the examiner's rejection of claims 1 through 3,
5, 7, 9 through 13, and 15 under 35 U.S.C. § 103(a) as
unpatentable over Russell in view of Preto and the appellants'
admissions regarding the prior art is reversed.

The decision of the examiner is reversed.

REVERSED

TERRY J. OWENS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
PAUL LIEBERMAN)	
Administrative Patent Judge)	APPEALS AND
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ROMULO H. DELMENDO)	
Administrative Patent Judge)	

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