

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 AKIO UEKI

Appeal No. 1999-0702
Application No. 08/858,564

ON BRIEF

Before COHEN, FRANKFORT, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 10 to 22, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a disposable body warmer for use in footwear (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Mitchell 1974	3,802,951	April 9,
Valenta 1974	3,828,792	Aug. 13,
Haley 1984	4,434,565	March 6,
Shiraki et al. 9, 1986 (Shiraki)	4,628,072	Dec.
Schroer, Jr. et al. 1, 1994 (Schroer)	5,282,326	Feb.
Sinclair-Day et al. 28, 1995 (Sinclair-Day)	5,470,893	Nov.
Kiyohara ¹	JP 5-176951 ²	July 20, 1993

¹ The examiner and the appellant have referred to this reference by the inventor's first name, Takashi.

² In determining the teachings of Kiyohara, we will rely on the translation provided by the USPTO. A copy of the translation is attached for the appellant's convenience.

Claims 10 to 16 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Kiyohara.

Claim 18 stands rejected under 35 U.S.C. § 103 as being unpatentable over Kiyohara in view of Valenta.

Claim 21 stands rejected under 35 U.S.C. § 103 as being unpatentable over Kiyohara in view of Mitchell.

Claims 19 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kiyohara in view of Shiraki.

Claim 17 stands rejected under 35 U.S.C. § 103 as being unpatentable over Kiyohara in view of Haley.

Claims 10 to 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kiyohara in view of Schroer.

Claim 18 stands rejected under 35 U.S.C. § 103 as being unpatentable over Kiyohara in view of Schroer and Valenta.

Claim 21 stands rejected under 35 U.S.C. § 103 as being unpatentable over Kiyohara in view of Schroer and Mitchell.

Claims 19 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kiyohara in view of Schroer and Shiraki.

Claim 17 stands rejected under 35 U.S.C. § 103 as being unpatentable over Kiyohara in view of Schroer and Haley.

Claim 22 stands rejected under 35 U.S.C. § 103 as being unpatentable over Kiyohara in view of Schroer and Sinclair-Day.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 24, mailed October 21, 1998) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 23, filed September 30, 1998) and reply brief (Paper No. 25, filed December 21, 1998) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The anticipation rejection

We will not sustain the rejection of claims 10 to 16 under 35 U.S.C. § 102(a).

To support a rejection of a claim under 35 U.S.C. § 102(a), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

All the claims under appeal are drawn to a body warmer comprising, inter alia, an air-permeable bag accommodating an

exothermic composition capable of generating heat in the presence of air wherein the air-permeable bag is formed with a non-slip layer in at least a portion thereof, the non-slip layer being an outermost layer of the air-permeable bag; and an airtight bag sealingly enveloping the air-permeable bag.

Kiyohara discloses a disposable foot warmer. As shown in Figures 1-2, the foot warmer includes an air-permeable bag 10 accommodating an exothermic composition 16 capable of generating heat in the presence of air and an airtight bag 20 sealingly enveloping the air-permeable bag. The air-permeable bag 10 is coated with an acrylic resin tackifier in at least a portion thereof for securing the air-permeable bag 10 in place during use after the air-permeable bag 10 has been removed from the airtight bag 20. The tackifier coating layer 14 is covered with a piece of peelable paper 15 which is removed to expose the tackifier coating layer 14 after the air-permeable bag 10 has been removed from the airtight bag 20.

The appellant argues (brief, pp. 3-4; reply brief, p. 1) that claims 10 to 16 are not anticipated by Kiyohara.

Specifically, the appellant points out the warmer of Kiyohara does not have an airtight bag sealingly enveloping an air-permeable bag having a non-slip layer as an outermost layer of the air-permeable bag as recited in claims 10 to 16. We agree. The examiner's position (answer, p. 4) that since the peelable paper 15 is removed prior to use of the air-permeable bag 10 thus establishing the tackifier coating layer 14 as the outermost layer of the air-permeable bag 10 during use is without merit with regard to the subject matter of claims 10 to 16. In that regard, the claimed subject matter requires the non-slip layer to be an outermost layer of the air-permeable bag while the air-permeable bag is sealingly enveloped by an airtight bag.³ Clearly, Kiyohara does not teach or suggest the subject matter of claims 10 to 16.

³ We understand this claimed limitation to require, in light of the underlying disclosure, that the air-permeable bag is free of any layer, covering, etc. overlaying the non-slip layer of the air-permeable bag (e.g., no release layer such as Kiyohara's peelable paper 15) while the air-permeable bag is sealingly enveloped by an airtight bag. That is, there is no layer, covering, etc. between the outermost non-slip layer of the air-permeable bag and the inside surface of the airtight bag while the air-permeable bag is sealingly enveloped by the airtight bag.

For the reasons set forth above, the decision of the examiner to reject claims 10 to 16 under 35 U.S.C. § 102(a) is reversed.

The obviousness rejections

We will not sustain the rejection of claims 10 to 22 under 35 U.S.C. § 103.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

With regard to the rejection of claims 10 to 16 as being unpatentable over Kiyohara in view of Schroer, we have reviewed the references to Schroer and Kiyohara and fail to find any teaching, suggestion or motivation therein for a person having ordinary skill in the art at the time the invention was made to have modified Kiyohara's tackifier coating layer 14 and peelable paper 15 so as to arrive at the

claimed invention, absent the use of impermissible hindsight.⁴
It follows that we cannot sustain the examiner's rejection of
claims 10 to 16 under 35 U.S.C.
§ 103.

We have also reviewed the references to Valenta,
Mitchell, Shiraki, Haley and Sinclair-Day additionally applied
in the respective rejections of claims 17 to 22 but find
nothing therein which makes up for the deficiency of Kiyohara
or the deficiency in the combined teachings of Kiyohara and
Schroer discussed above. Accordingly, we cannot sustain the
examiner's rejection of appealed claims 17 to 22 under 35
U.S.C. § 103.

CONCLUSION

⁴ Hindsight knowledge derived from the appellant's own
disclosure to support an obviousness rejection under 35 U.S.C.
§ 103 is impermissible. See, for example, W. L. Gore and
Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ
303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851
(1984).

To summarize, the decision of the examiner to reject claims 10 to 16 under 35 U.S.C. § 102(a) is reversed and the decision of the examiner to reject claims 10 to 22 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
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