

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HILTON T. TOY, DAVID L. EDWARDS,
DA-YUAN SHIH, and AJAY P. GIRI

Appeal No. 1999-1143
Application No. 08/735,925

ON BRIEF

Before KIMLIN, GARRIS, and DELMENDO Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the refusal of the examiner to allow claims 22, 23, 26-29 and 31-34 as amended subsequent to the final rejection. These are all of the claims remaining in the application.

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The subject matter on appeal relates to a method for bonding a silicon-containing polymeric adhesive to a nickel metal surface having poor direct adherability to the adhesive which comprises depositing on the nickel metal surface a thin adherent metal film of chromium, molybdenum, tungsten and alloys thereof, contacting an uncured silicone elastomeric material to the thin adherent metal film and solidifying the silicone elastomeric material, wherein the thin adherent metal film has a thickness effective to bond the surface to the adhesive (e.g., see claim 22). The appealed subject matter also relates to the product resulting from this process (e.g., see claim 32). This appealed subject matter is adequately illustrated by independent claim 22 which reads as follows:

22. A method for bonding a silicon-containing polymeric adhesive to a metal having poor direct adherability to such polymeric adhesive, comprising the steps of:

(a) providing an uncured silicone elastomeric material and a substrate comprising a substrate surface containing nickel;

(b) depositing a thin adherent metal film on said substrate surface, wherein said thin adherent metal film is a metal selected from the group consisting of chromium, Mo, and W, and alloys thereof;

(c) contacting said silicone elastomeric material to said thin adherent metal film; and

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(d) solidifying said silicone elastomeric material, wherein said thin adherent metal film has a thickness effective to bond said substrate surface to said polymeric adhesive.

The references relied upon by the examiner in the rejections before us are:

Benko	4,446,197	May 1, 1984
Obayashi et al. (Obayashi)	4,749,625	Jun. 7, 1988
Yoshikawa et al. (Yoshikawa)	4,872,932	Oct. 10, 1989

Claims 22, 23, 26-28 and 31-34 are rejected under 35 U.S.C.

§ 102(b) as being anticipated by or in the alternative under 35 U.S.C. § 103 as being obvious over Obayashi.

Claim 27 is rejected under 35 U.S.C. § 103 as being unpatentable over Obayashi in view of Yoshikawa or Benko, and claim 29 is similarly rejected as being unpatentable over Obayashi in view of Benko.

We refer to the brief and reply brief and to the answer for a complete exposition of the opposing viewpoints expressed by the appellants and by the examiner concerning the above noted rejections.

OPINION

We cannot sustain any of these rejections.

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It is well settled that, for a section 102 rejection to be proper, the prior art reference must clearly and unequivocally disclose the claimed invention or direct those skilled in the art to the invention without any need for picking, choosing and combining various disclosures not directly related to each other by the teachings of the cited reference. In re Arkley, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972). Here, there is nothing in the teachings of Obayashi which "clearly and unequivocally" directs those skilled in the art to make the specific selections of materials for patentee's amorphous metal core layer, electroconductive metal plating layer, and polymeric coating layer which would be necessary in order to result in a method and product of the type claimed by the appellants. Therefore, we cannot sustain the examiner's section 102(b) rejection of claims 22, 23, 26-28 and 31-34 as being anticipated by Obayashi.

As for the section 103 rejection based on Obayashi, we understand the examiner's point that patentee discloses the individual materials involved in the appellants' claimed method and product. In our view, however, this fact merely

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establishes that it is possible to reproduce the here claimed method and product by appropriately selecting and appropriately combining particular materials from patentee's extensive listings. However, the mere fact that the prior art could be modified so as to result in a claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). For this reason and because we agree with the appellants that Obayashi would not have suggested the aforementioned selections and combinations needed to achieve the here claimed invention, we also cannot sustain the examiner's section 103 rejection of claims 22, 23, 26-28 and 31-34 as being obvious over Obayashi.

As correctly argued by the appellants, the above discussed deficiency of Obayashi is not supplied by the Yoshikawa or Benko references, and the examiner has not relied upon these references for this purpose. It follows that we cannot sustain the examiner's section 103 rejection of claim 27 over Obayashi in view of Yoshikawa or Benko or his section 103 rejection of claim 29 over Obayashi in view of Benko.

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The decision of the examiner is reversed.

REVERSED

	Edward C. Kimlin)	
	Administrative Patent Judge)	
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	Bradley R. Garris)	BOARD OF
PATENT)	
	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
	Romulo H. Delmendo))
	Administrative Patent Judge)	

BRG:tdl

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