

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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YASUHIKO KENMOCHI and HIROKI ISHIKAWA

Appeal No. 1999-2159
Application No. 08/746,953

ON BRIEF¹

Before COHEN, McQUADE, 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 1 to 5 and claim 7 added subsequent to the final rejection, which are all of the claims pending in this application.

We REVERSE.

¹ On September 21, 2000, the appellants waived the oral hearing (see Paper No. 21) scheduled for October 25, 2000.

BACKGROUND

The appellants' invention relates to a disposable wipe-off article. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

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

Balch et al. (Balch)	3,505,155	April 7,
1970		

In addition, the examiner also relied upon Official Notice concerning heat-sealable bonding.

Claims 1 to 5 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Balch taken with Official Notice.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 14, mailed November 16, 1998) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 13, filed October 19, 1998) and reply brief (Paper No. 16,

filed January 19, 1999) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 5 and 7 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would

have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Claim 1, the sole independent claim on appeal recites a disposable wipe-off article comprising, inter alia, a heat-sealable sheet and a heat-sealable wipe-off layer including an expanded bundle of continuous filaments. Claim 1 further recites that the wipe-off layer is "bonded to the base sheet [sic, the heat-sealable sheet] by a plurality of heat-seal lines extending to cross the continuous filaments and intermittently arranged longitudinally of the continuous filaments."

Balch discloses (see, for example, column 2, lines 7-15) a nonwoven continuous filament product which is formed into a spread web and then is preferably dimensionally stabilized by bonding and/or stitching and/or laminating the spread web to a sheet material. Balch teaches (column 4, lines 64-71) that a

particularly useful nonwoven continuous filament material is polyethylene terephthalate polyester and cellulose acetate. Balch further teaches (column 8, lines 9-15) that the sheet material may be any of numerous materials including plastic sheeting.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

The examiner ascertained (answer, p. 4) that Balch does not explicitly teach using a heat-sealable bonding method. In our view, this is not a correct assessment of the differences between the prior art (i.e., Balch) and the claims at issue (e.g., claim 1). Based on our analysis and review of Balch and claim 1, it is our opinion that the only difference is the limitation that the wipe-off layer is "bonded to the base sheet [sic, the heat-sealable sheet] by a plurality of heat-seal lines extending to cross the continuous filaments

and intermittently arranged longitudinally of the continuous filaments."

After the examiner ascertained the difference noted above, the examiner then took Official Notice that (answer, p. 4) that "heat-sealable bonding or embossing was well-known and interchangeably used with other bonding methods, such as adhesive bonding, in the art of nonwoven laminates." The examiner then determined that

[i]t would have been obvious for a person having ordinary skill in the art to have employed a heat-seal bonding method to stabilize the laminate in Balch. One of ordinary skill in the art would have been motivated to do this in order to modify the bonding strength and/or texture of the nonwoven laminate.

The appellants argue (brief, p. 4) that there is no disclosure, teaching or suggestion of using a plurality of heat-seal lines as claimed. That is, that there is no disclosure, teaching or suggestion in the applied prior art (i.e., Balch and Official Notice) of bonding the wipe-off layer to the heat-sealable sheet by "a plurality of heat-seal lines extending to cross the continuous filaments and

intermittently arranged longitudinally of the continuous filaments." We agree. In addition, even if the examiner's above-noted determination of obviousness was correct, we fail to find any disclosure, teaching or suggestion in the applied prior art that would have been suggestive of bonding Balch's wipe-off layer to his heat-sealable sheet by "a plurality of heat-seal lines extending to cross the continuous filaments and intermittently arranged longitudinally of the continuous filaments."

Moreover, in this case the examiner has relied upon a statement of Official Notice in determining that the subject matter of claim 1 was unpatentable under 35 U.S.C. § 103. However, the examiner's taking of Official Notice was seasonably challenged by the appellant in the amendment after final (Paper No. 9, filed July 20, 1998) and the brief. Thus, the burden to supply evidence to support this statement shifted to the examiner² and the examiner has not supplied any such evidence. Consequently, there is no factual basis to

² See Manual of Patent Examining Procedure § 2144.03.

support the examiner's determination that the subject matter of claim 1 was obvious under 35 U.S.C. § 103.

For the reasons set forth above, the decision of the examiner to reject claim 1, and claims 2 to 5 and 7 dependent thereon, under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 5 and 7 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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LOWE HAUPTMAN GOPSTEIN
GILMAN AND BERNER LLP
SUITE 310
1700 DIAGONAL ROAD
ALEXANDRIA, VA 22314

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