

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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LORENZO SCALIA
and BARRY DONALD SEWING

Appeal No. 2000-1176
Application 08/928,902

ON BRIEF

Before WARREN, OWENS and WALTZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellants, in the brief and reply brief, and based on our review, find that we cannot sustain the rejection of appealed claims 9, 10, 15 and 16, under 35 U.S.C. § 102(b), as being clearly anticipated by Suzuki et al. (Suzuki); of appealed claims 9 through 16 under 35 U.S.C. § 103(a) as being unpatentable over Suzuki; and of appealed claims 17 through 25 under 35 U.S.C. § 103(a) as being unpatentable over Elderbaum in view of Carlson.^{1,2}

¹ These are all of the claims in the application. See the amendment of December 8, 1998 (Paper No. 4).

Our consideration of the examiner's application of prior art to appealed claims must, of course, begin with interpreting the language of the claims in light of the written description in appellants' specification as it would be interpreted by one of ordinary skill in this art. *See In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997) (“[T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification.”); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (“During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. When the applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art. *See In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) (before the application is granted, there is no reason to read into the claim the limitations of the specification.)” In doing so, we will give the terms used in the claims their ordinary meaning unless another meaning is intended by appellant as established in the written description of the specification. *See, e.g., Morris, supra; Zletz, supra.*

It is clear from the written description in the specification (page 6, lines 5-7) that the term “ceramic green sheet” has its recognized meaning in the art as a sheet of ceramic material that has not been “fired.” It is also clear from the plain language of the preamble and the body of appealed claims 1 and 17 that this term represents the substrate that is acted upon by the “at least one slitting wheel inside at least one heating zone,” and thus there is no claim language that can be construed as an “intended use” as alleged by the examiner. *See generally, Corning Glass Works v. Sumitomo Elect. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989); *In re Stencel*, 828 F.2d 751, 754-55, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987). It is further clear that one of ordinary skill in this art would interpret the term “heating zone” to mean a zone in which the ceramic green sheet is specifically heated.

² Answer, pages 4-7. The ground of rejection under 35 U.S.C. § 112, second paragraph, is withdrawn by the examiner (answer, page 2).

Turning now to the grounds of rejection, it is well settled that under § 102(b), the examiner has the burden of making out a *prima facie* case of anticipation in the first instance by pointing out where each and every element of the claimed invention, arranged as required by the claim, is described identically in the reference, either expressly or under the principles of inherency. *See generally, In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). The examiner's statement of the rejection does not state any basis for the rejection (answer, page 4), and thus we reverse this ground of rejection.

It is further well settled that in order to establish a *prima facie* case of obviousness under § 103(a), the examiner must show 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 this 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); *B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996); *In re Fritch*, 972 F.2d 1260, 1265-66, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *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 requirement for objective factual underpinnings for a rejection under § 103(a) extends to the determination of whether the references can be combined. *See In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002), and cases cited therein.

We agree with appellants that Suzuki neither discloses nor suggests a "ceramic green sheet" or "a slitting wheel in a heating zone," as these terms are used in the appealed claims, and thus, we reverse the ground of rejection under § 103(a) based on Suzuki.

With respect to the ground of rejection under § 103(a) based on the combined teachings of Elderbaum and Carlson, we agree with appellants that neither reference discloses scoring a material in a heating zone, as required by the appealed claims, and we find that one of ordinary

skill in this art would not have combined the straight line scoring device of Carlson with the requirement of Elderbaum to score square or rectangular patterns. Thus, we reverse this ground of rejection.

The examiner's decision is reversed.

Reversed

CHARLES F. WARREN)	
Administrative Patent Judge)	
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TERRY J. OWENS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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THOMAS A. WALTZ)	
Administrative Patent Judge)	

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