

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. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM ROBERT LANIGAN,
RICHARD J. LEGARE and SHIV SIBAL

Appeal No. 2003-2032
Application 09/116,371

ON BRIEF

Before WARREN, JEFFREY T. SMITH and POTEATE *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 brief¹ and reply brief, and based on our review, find that we cannot sustain the rejection of appealed claims 1 through 26² under 35 U.S.C. § 103(a) as being unpatentable over Harrington et al (Harrington) in view of Smith (answer, pages 3-4).

It is further well settled that in order to establish a *prima facie* case of obviousness under

¹ We have considered the brief filed October 29, 2002 (Paper No. 27).

² Claim 27 is also pending and has been withdrawn from consideration by the examiner under 37 CFR § 1.142(b).

§ 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 arranged as required by 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); *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). When appellants present factual argument in response to the initial *prima facie* case established by the examiner, the burden shifts back to the examiner to again establish the factual underpinning of a *prima facie* case of obviousness under § 103(a) in order to maintain the ground of rejection. *See, e.g., Oetiker, supra.*

It is further well established that the language of a claim must be interpreted prior to applying prior art thereto. In this respect, the language of the claim must be given the broadest reasonable interpretation in light of the written description in appellants' specification as it would be interpreted by one of ordinary skill in this art. *See, e.g., In re Thrift*, 298 F.3d 1357, 1364, 63 USPQ2d 2002, 2006 (Fed. Cir. 2002); *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). In doing so, *all* claim limitations must be given effect. *See In re Angstadt*, 537 F.2d 498, 501, 190 USPQ 214, 217 (CCPA 1976); *In re Geerdes*, 491 F.2d 1260, 1262-63, 180 USPQ 789, 791 (CCPA 1974); *In re Wilder*, 429 F.2d 447, 450, 166 USPQ 545, 548 (CCPA 1970).

We find it clear that the plain language of illustrative appealed claim 1 specifies a method of manufacturing thermally bonded fabric comprising at least the steps of forming a web of thermally bondable polypropylene fibers, passing said web over a *heated calender roll* having the specified patterned surface which includes at least "lands" as recited, and *thermally bonding* the fibers on the *calender roll* as specified such that fibers extending at least substantially in the machine direction on the *calender roll* "will only have one bond point for adjacent rows of

lands.” Thus, contrary to the examiner’s position “that calender rolls are not claimed” (answer, page 4), the calender roll is certainly an integral part of the claimed method as encompassed by appealed independent claims 1 and 26, and the limitations with respect thereto must be given effect in applying prior art to the appealed claims, as appellants argue (*see* brief and reply brief in entirety).

Upon comparing the claimed method as encompassed by appealed claim 1 with the combined teachings of Harrington and Smith, it seems to us that the disclosure of **FIG. 7**, page 51, lines 1-13, and the Examples of Harrington constitute the closest prior art of that applied by the examiner, differing from the claimed method in the calendar roll shown in Harrington **FIG. 7**, as appellants contend. Thus, on this record, it is this difference in claimed and prior art calender rolls which must be the focus of the inquiry under § 103(a). *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 460 (1966).

To the extent that it can be said that the examiner sufficiently considered this difference to the point of establishing a *prima facie* case of obviousness, appellants have brought forth argument, including objective evidence, in rebuttal (*see, inter alia*, brief and reply brief in entirety). Thus, the burden has been shifted back to the examiner to consider anew the record as a whole with respect to the issue of obviousness, and based on that review, again set forth a *prima facie* case of obviousness with respect to the claimed invention as a whole in order to maintain the ground of rejection. *See, e.g., Oetiker, supra*.

It is apparent from the examiner’s position stated at pages 4-6 of the answer, that the examiner has not reestablished a *prima facie* case based on the claimed invention as a whole in light of the record as a whole, and accordingly, *on this record*, we reverse the ground of rejection.

The examiner’s decision is reversed.

Reversed

Appeal No. 2003-2032
Application 09/116,371

1941 Roland Clarke Place
Reston, VA 20191