

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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TAKEO KITAYAMA, KAORI TSUBOUCHI,
SHIGEYOSHI MATSUBARA, and TATSUHIRO NAGAMATSU

Appeal No. 2004-0018
Application No. 09/220,018

ON BRIEF

Before OWENS, KRATZ, and TIMM, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1-4, 6-8, and 13 as amended after the Final Rejection.¹ The only other claims pending in the application, claims 10-12, have been withdrawn by the Examiner as directed to a non-elected invention. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

¹We note that the Amendment under 37 CFR § 1.116 filed May 29, 2001 has not been physically entered even though the Advisory Action mailed June 8, 2001 indicates that the Amendment is to be entered upon the filing of a Notice of Appeal. We will treat the Amendment as entered. Upon return of the application to the jurisdiction of the Examiner, entry should be performed.

INTRODUCTION

The claims are directed to a foamed polypropylene sheet with cells which are oblong in the thickness direction of the sheet. Claim 1 is illustrative of the subject matter on appeal:

1. A foamed thermoplastic resin sheet, having a foaming ratio of not less than 2.5, wherein cells, existing in an interior part which extends inward from a depth of 20 percent of the whole thickness of said sheet from the front and rear surfaces thereof, respectively, in a thickness direction thereof and from 15 percent of the width of said sheet from both side edges, respectively, satisfy the following expressions (1) and [(2):]²

$$0.5 \leq D/C \leq 0.9 \dots (1)$$

$$0.5 \leq E/C \leq 0.9 \dots (2)$$

where C represents a mean cell diameter in the thickness direction of said formed sheet, D represents a mean cell diameter in an extrusion direction of the same, and E represents a mean cell diameter in the width direction of the same, and where the thermoplastic resin is polypropylene resin.

The Examiner rejects the claims as unpatentable over prior art. As evidence of unpatentability, the Examiner relies upon the following prior art references:

Shirai et al. (Shirai)	4,626,183	Dec. 2, 1986
Deblander	5,147,481	Sep. 15, 1992

²“(2):” was present in the claim before the Amendment of May 29, 2001 and it appears that its deletion was not intentional.

The specific rejections are as follows:

1. Claims 1 and 8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Deblander.
2. Claims 2-4, 6, 7, and 13 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Deblander.
3. Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Deblander in view of Shirai.

We reverse substantially for the reasons presented in Appellants' Amended Brief³ and Reply Brief and add the following for emphasis.

OPINION

For each of the rejections, the Examiner relies upon Deblander as describing “a foamed propylene sheet (column 3, lines 59-60) having the presently claimed cell sizes (Examples 1, 5, 6, 7, 9, and 10-13).” The problem is that Deblander does not describe such a propylene sheet. The examples the Examiner relies upon describe a polystyrene sheet not a polypropylene sheet. The fact that column 3, lines 59-60 mentions propylene polymer as useful in the foam insulation body of Deblander does not change the fact that the examples are specific to polystyrene foam bodies. Nor is there any disclosure in Deblander, relied upon by the Examiner, which indicates

³The Amended Brief replaces an earlier Brief.

that the cell sizes obtained in the exemplified polystyrene foam bodies would be the same in a polypropylene foam body. The Examiner simply has not met the burden of showing that Deblander discloses every limitation of the claimed invention, either explicitly or inherently, *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997), or that there was a suggestion within the art of how to obtain the claimed cell sizes in a polypropylene foam sheet or a motivation for doing so. *See In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002)(Anytime a teaching is modified, there must be a showing of a suggestion or motivation to make the modification.).

The Examiner does not rely upon Shirai in a manner that cures the deficiencies discussed above. We conclude that the Examiner has failed to establish either anticipation or a *prima facie* case of obviousness with respect to the subject matter of claims 1-4, 6-8, and 13.

CONCLUSION

To summarize, the decision of the Examiner to reject claims 1 and 8 under 35 U.S.C. § 102(b); claims 2-4, 6-8, and 13 under either 35 U.S.C. § 102(b) or 35 U.S.C. § 103, alternatively; and claim 8 under 35 U.S.C. § 103(a) is reversed.

REVERSED

TERRY J. OWENS)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
PETER F. KRATZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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CATHERINE TIMM)	
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Appeal No. 2004-0018
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Page 6

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