

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte THOMAS THOROE SCHERB
and
HARALD SCHMIDT-HEBBEL

Appeal No. 2005-0863
Application No. 09/769,462

HEARD: May 4, 2005

Before FRANKFORT, 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 10 and 13 to 54, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a machine for producing a tissue web having a forming area including at least one rotating continuous dewatering wire. The appellants' invention further relates to a process for producing a tissue web with the tissue machine (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

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

Bluhm et al. (Bluhm)	5,556,511	Sep. 17, 1996
Schiel	6,004,429	Dec. 21, 1999
Kamps et al. (Kamps)	WO 96/35018	Nov. 7, 1996

Claims 1 to 10 and 13 to 54 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kamps in view of Schiel or Bluhm.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (mailed August 10, 2004) for the examiner's complete reasoning in support of the rejection, and to the brief (filed May 17, 2004) and reply brief (filed October 12, 2004) 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 references, 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 10 and 13 to 54 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).

The appellants argue that the applied prior art does not suggest the claimed subject matter. We agree.

All the claims under appeal require a rotating continuous dewatering wire with a plurality of zones having different wire permeabilities and a shoe press having both a press nip length greater than about 80 mm and a pressure profile over the press nip length of a maximum pressing pressure of less than or equal to about 2 Mpa. However, these limitations are not suggested by the applied prior art. In that regard, neither Schiel nor Bluhm would have made it obvious at the time the invention was made to a person having ordinary skill in the art to have utilized a shoe press on Kamps' paper sheet formed with a decorative pattern since such a shoe press would negatively impact the decorative pattern desired by Kamps.

In our view, the only suggestion for modifying Kamps so as to arrive at the claimed subject matter stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claims 1 to 10 and 13 to 54 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 10 and 13 to 54 under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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