

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 MASA AKI YAMANAKA,
HIROSHI KOYAMA and YASUHIRO UEDA

Appeal No. 2005-2639
Application 08/855,905

ON BRIEF

Before KIMLIN, GARRIS and WARREN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

On Request For Rehearing

This is a request for rehearing under 37 CFR § 41.52 (2005). Requests for rehearing must comply with 37 CFR § 41.52(a)(1) (2005) which specifies that “[t]he request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board.” *See also* Manual of Patent Examining Procedure (MPEP) § 1214.03 (8th ed., Rev. 3, August 2005).

Appellants request rehearing of our decision entered December 16, 2005, affirming the examiner’s rejection of appealed claims 1 and 28 through 49 under 35 U.S.C. § 103(a) as being unpatentable over Takashi in view of Ohba and Ueda (request, page 1). Appellants contend (1) that we failed to consider a three-layered synthetic paper specifically encompassed by appealed claim 47 and thus, improperly dismissed the experiments performed in the Yamanaka

III declaration, and (2) that we misinterpreted the Yamanaka III declaration on other grounds (*id.*, pages 2 and 3-4).

Appellants submit, with respect to their first contention, that we did not address the issue, raised in section II of the reply brief (page 2), that the examiner's statement that the comparison presented in the Yamanaka III declaration "does not agree in scope with the present claims because the claims do not require a 3-layered film" (answer, page 15) is contrary to claim 47 which specifies such a structure (request, page 2). Appellants further submit that the above statement of the examiner was preceded by the statement with respect to the evidence in the Yamanaka III declaration, that "[t]he inventive paper shows improvement with regard to antistatic properties and printability" (answer, page 15), which finding "cannot be dismissed since the experiments performed in this declaration agree with the scope of the invention, namely the three-layered film of Claim 47" (request, page 2; original emphasis deleted).

Appellants submit, with respect to their second contention, that we found "significant basic differences between [Takashi Example 12] and [Yamanaka III declaration] Experiments 1-3[,] . . . [i]n particular" our finding that "[t]he base layer of Takashi Example 12 contains an antistatic agent which was omitted in declaration III Examples 1-3, and the antistatic agent of the paper-like layer of Experiment 1 has been changed to a different type than used in Takashi Example 12" (request, page 3, quoting original decision, page 20). Appellants point out that "a review of table I (b) at columns 9-10 of [Takashi], which describes the base layer component of Experiment 12, does not, in fact, include an anti-static agent," and argue that Experiments 1-3 of Yamanaka III declaration are "in fact is consistent with Experiment 12" (request, page 3; original emphasis deleted). Appellants further point out that "the Yamanaka III declaration clearly states that the reason low molecular weight anti-static RESISTAT PE 132 of [Takashi] was not used in the numerated experiments was because it was no longer available" and a different antistatic was used (request, page 3; original emphasis deleted).

Our consideration of the Yamanaka III declaration did not turn solely on either of the grounds raised by appellants in their request (original decision, pages 20-21). Indeed, we found

significant basic differences between the ingredients and processing conditions used in the base and paper-like layers of the synthetic papers of Experiments 1-3 (*see* Takashi Tables I(b), II(b), III and IV, and declaration III Tables 1 and 2) and the synthetic paper of "Example 1 of the Present Application" in Experiment 4 (*see* specification

pages 29-31 and Table 1, page 36, and declaration III Table 2). These include, among others, the kind and amount of “Resin” (e.g., polyamide in Takashi Experiments and polyethylene in the claimed Experiment), the kind and amount of fine inorganic particulate filler, the thicknesses of the individual layers and the stretching ratios. [Original decision, page 20; underline emphasis supplied.]

The portion of our original decision quoted by appellants (request, page 3) immediately followed this passage. With respect to the use of a different antistatic agent, appellants’ selected quote omits the concluding phrase “as declarant Yamanaka explains (page 2),” which explanation at page 2 of the Yamanaka III declaration is the same as that set forth by appellants in the request (original decision, page 20). Appellants do not refer in their request to either this finding or our further finding in these respects that “[t]he antistatic agent used in paper-like layers of Experiments 2 and 3 is the polyetheresteramide used in specification Example 1 but in significantly reduced amounts and without a polyamide or a modified low-molecular weight polypropylene” (original decision, page 20).

We agree with appellants’ second contention to the extent that we erroneously found that Takashi Example 12 included an antistatic agent. However, it is apparent that the remaining considerable number of differences we found between the compared films provide substantial evidence supporting our conclusion that the Yamanaka III declaration does not present a side-by-side comparison wherein the sole difference is in the kind and amount of antistatic agent, which is the thrust of the ground of rejection, and thus, the evidence does not establish that the reported results would have been unexpected by one of ordinary skill in this art in view of the teachings of the applied references (original decision, page 21).

In view of our findings with respect to the evidence in the Yamanaka III declaration, we found it unnecessary to our original decision to consider whether the evidence was commensurate in scope with the claims, including appealed claim 47, and find it unnecessary to do so on rehearing.

Accordingly, we grant appellants’ request to the extent that we have reheard our original decision entered December 16, 2005, and we modify our original decision by withdrawing the language “base layer of Takashi Example 12 contains an antistatic agent which was omitted in declaration III Experiments 1-3, and the” from the penultimate sentence in the sole full paragraph on page 20 thereof.

We determined above that this matter does not change our consideration of the evidence in the Yamanaka III declaration, and accordingly, our so modified original decision does not become, in effect, a new decision. A second request for rehearing will not be permitted. 37 CFR § 41.52(a)(1) (2005).

This decision on appellants' request for rehearing is deemed to incorporate our original decision on appeal, except for the portion specifically withdrawn above, and is final for the purposes of judicial review. 37 CFR § 41.52(a)(1) (2005).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (2005).

GRANTED-IN-PART

