

The opinion in support of the decision being entered today  
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JONATHON BALBAUGH and RANDAL TEDERS

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Appeal 2006-2812  
Application 10/149,490  
Technology Center 1700

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Decided: July 30, 2007

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Before MICHAEL R. FLEMING, *Chief Administrative Patent Judge*;  
EDWARD C. KIMLIN, *Administrative Patent Judge*;  
FRED E. McKELVEY, *Senior Administrative Patent Judge*; and  
CHUNG K. PAK and THOMAS A. WALTZ, *Administrative Patent Judges*.

KIMLIN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants request reconsideration of our Decision of  
October 31, 2006 wherein we sustained the Examiner's rejections of the  
appealed claims under 35 U.S.C. § 103(a).

We have reviewed our decision in light of the arguments presented by  
Appellants in the Request. However, we are not persuaded by Appellants'

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arguments that we have overlooked any relevant points in reaching our decision that the Examiner drew the proper legal conclusion that the claimed subject matter would have been obvious to one of ordinary skill in the art within the meaning of § 103 in view of the applied prior art.

It is Appellants' belief "that the Board overlooked the motivation requirement of combining Narayama and Smith" (Request 2, second para.). At the outset, however, it should be noted that the Supreme Court recently confirmed the principle that the analysis of obviousness under § 103 cannot be confined by a formalistic conception of words such as motivation. *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385 (2007). It is now settled that the motivation to combine the disclosures of the prior art does not have to be explicitly stated in the references, but may be implicit from a consideration of the prior art as a whole. *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), cited with approval in *KSR Int'l, supra*.

In the present case, our opinion specifically addressed Appellants' argument that there would have been no motivation to roughen the surface of Narayama's tubing since the reference discloses that perfect coupling or bonding is achieved by the application of sufficient pressure on the injected resin (*see* paragraph bridging Decision 3 and 4). In particular, we found that one of ordinary skill in the art would have been motivated to employ the known technique of roughening the surface of Narayama's tubing to enhance bonding as an alternative to the application of pressure. Certainly,

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it is often desirable in the world of industrial manufacturing to provide viable alternatives for any number of process steps, recognizing, of course, that a particular process may be unavailable or too costly.

Moreover, we are also satisfied that it would have been obvious for one of ordinary skill in the art to use the known technique of roughening the surface in conjunction with the application of pressure disclosed by Narayama with the reasonable expectation that the bonding would be improved. Smith is simply one piece of evidence that it was known in the art that bonding between surfaces is enhanced by roughening one or both of the surfaces due to the increase in surface area that is made available for bonding. Smith is particularly relevant here because it discloses roughening the surface to improve bonding between a tubular article and plastic material.

Accordingly, based on the state of the prior art as a whole, we remain of the opinion that it would have been obvious for one of ordinary skill in the art to roughen the surface of the tubing disclosed by Narayama to enhance bonding between the tubing and molding material.

In conclusion, based on the foregoing, we have granted Appellants' request to the extent that we have reconsidered our decision, but we deny Appellants' request to make any change therein.

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

DENIED

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