

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KATSUYA SEKI,
HIDEO GOTO, and
SHINJI SAITO

Appeal 2007-1898
Application 10/360,622
Technology Center 1700

Decided: June 11, 2007

Before EDWARD C. KIMLIN, CHUNG K. PAK, and
THOMAS A. WALTZ, *Administrative Patent Judges*.

WALTZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the Primary Examiner's final rejection of claims 1, 4-8, 10, and 11, which are the only claims pending in this application. We have jurisdiction pursuant to 35 U.S.C. § 6.

According to Appellants, the invention is directed to a sealing member to be interposed between parts, where the sealing member is composed of rubber foam with closed cells and needle holes completely penetrating through the foam in only the compressing direction to yield specified permeability values A, B, and a ratio of A/B (Br. 2-3). Claim 1 is illustrative of the invention and is reproduced below:

1. A sealing member to be interposed between parts, said sealing member being composed of rubber foam and having permeability A between 0.01 and 30 L/min in a compressing direction at a non-compressed state, permeability B between 0.01 and 10 L/min in a direction perpendicular to the compressing direction at a 50% compressed state in the compressing direction, and a ratio of the permeability A to the permeability B of 2-20,

wherein said rubber foam forming the sealing member has closed cells therein, and needle holes completely penetrating therethrough in only the compressing direction.

The Examiner has relied on the following prior art references as evidence of unpatentability:

Tye	US 4,554,424	Nov. 19, 1985
Farison	US 6,398,029 B1	Jun. 04, 2002
Brandolini	US 6,432,512 B1	Aug. 13, 2002
Tadakatsu	JP 08-281558	Oct. 29, 1996
(as machine-translated, hereafter JP ‘558)		
Shiro	EP 1 108 500 A1	Jun. 20, 2001
(hereafter EP ‘500)		

ISSUES ON APPEAL

Claims 1, 4, 5, and 9 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as unpatentable over Tye (Answer 3).¹

Claims 1 and 4-8 stand rejected under 35 U.S.C. § 103(a) as unpatentable over JP ‘558 in view of EP ‘500 (Answer 4).

Claims 1, 4, 5, 7, 8, 10, and 11 stand rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as unpatentable over Brandolini (Answer 5).

Claim 6 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Brandolini (Answer 6).

Claims 1, 4-8, 10, and 11 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Brandolini in view of Farison (Answer 7).

Appellants contend that the examples of Tye have hole diameters of 7 mm and 12.7 mm, a hole center to center spacing of 25 mm and 19 mm, respectively, and thus are hardly anticipatory of “needle holes” as understood by one skilled in the art (Br. 4).

Appellants contend that Tye is silent on permeability, the Examiner’s position of “inherency” is completely unsubstantiated, and foam density alone would have an effect on permeability (Br. 5-6).

Appellants contend that the Examiner cannot apply an “inherency” theory to the rejection over JP ‘558 in view of EP ‘500 since inherency only may be applied under § 102 (Br. 8).

¹ We note that claim 9 has been cancelled by Appellants (Br. 2). Although Appellants list this claim as rejected over Tye (Br. 3), as does the Examiner (Answer 3), we do not consider claim 9 as included in the rejection over Tye.

Appellants contend that Brandolini discloses that his foam plank laminate is impermeable, and thus there is no reason for choosing rubber as a material to be used in Brandolini (Br. 9-10).

The Examiner contends that Tye discloses the same material as claimed with a plurality of holes formed in the compressing direction, and claim 1 on appeal is not specific about any hole diameter (Answer 3 and 8).

The Examiner contends that there is reasonable evidence that the foam structure of Tye is the same or substantially the same as the claimed foam structure (Answer 3-4 and 8-9).

The Examiner contends that “inherency” can be applied in a § 103(a) rejection (Answer 9-10).

The Examiner contends that Brandolini teaches that the foam plank laminate is impermeable, but notes that the rejection relies on the intermediate foam layer which is completely perforated and permeable (Answer 5 and 10-11).

Accordingly, the issues presented on the record in this appeal are as follows: (1) is there reasonable evidence that the foam structure of Tye will have the same or substantially the same properties or functions as the claimed foam structure?; (2) can an “inherency” theory be applied in a § 103(a) rejection?; and (3) does Brandolini disclose a permeable foam structure intermediate layer that reasonably appears to be the same or substantially the same as the claimed foam structure?

We determine that the Examiner has established a prima facie case of anticipation/obviousness in view of the reference evidence, which prima facie case has not been adequately rebutted by Appellants’ arguments.

Therefore we AFFIRM all grounds of rejection in this appeal essentially for the reasons stated in the Answer, as well as those reasons set forth below.

OPINION

We determine the following factual findings from the record in this appeal:

- (1) Tye discloses a closed cell foamed neoprene rubber perforated strip 60 with closely spaced holes 61 formed in the compressing direction (Tye, Fig. 5; col. 7, ll. 49-61; Answer 3);
- (2) JP '558 discloses a polyurethane or rubber foam polishing pad with a plurality of holes made by needle punching, where the holes are exemplified as being about 0.5 mm in diameter (Abstract; ¶¶ [0009] and [0011]; Answer 4);
- (3) EP '500 discloses a polyurethane and rubber foam polishing pad with closed cell structure for higher toughness and hardness (Abstract; ¶¶ [0001], [0007], [0011], [0014], and [0066]; Answer 4); and
- (4) Brandolini discloses a foam plank laminate comprising at least two expanded open or closed cell foam sheets, where the foam plank laminate is impermeable but has an inner sheet that can be completely perforated by needles, with the diameter and spacing of the holes as desired (Abstract; col. 1, ll. 9-12; col. 3, ll. 5-6; col. 3, ll. 49-57; col. 5, ll. 21-46; col. 6, ll. 61-63; col. 7, ll. 4-11; and col. 8, ll. 47-52; Answer 5-6).

“Appellants have chosen to describe their invention in terms of certain physical characteristics of the roughened substrate surface. They couch their claims in terms of the abraded surface being rough on a microscale,

exhibiting low specular reflectivity and having a dull appearance. Merely choosing to describe their invention in this manner does not render patentable their method which is clearly obvious in view of Baer et al. [Citation omitted].” *In re Skoner*, 517 F.2d 947, 950, 186 USPQ 80, 82 (CCPA 1975). Choosing to define an element functionally carries with it a risk:

Where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997), quoting *In re Swinehart*, 439 F.2d 210, 213, 169 USPQ 226, 229 (CCPA 1971).

“Whether the rejection is based on ‘inherency’ under 35 USC 102, on ‘prima facie obviousness’ under 35 USC 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO’s inability to manufacture products or to obtain and compare prior art products. [Citation and footnote omitted].” *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977). When the PTO shows sound basis for believing that the products of the applicant and the prior art are the same, such as the same starting materials and process of making, the applicant has the burden of showing that they are not. See *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Applying the preceding legal principles to the factual findings in the record of this appeal, we determine that the Examiner has met the initial burden of proof in establishing that the products of the prior art are identical or substantially identical to the products claimed, and Appellants have not

met their burden of showing that they are not. For each ground of rejection, we determine that the Examiner has established that the prior art discloses a rubber foam having closed cells with holes completely penetrating therethrough in only the compressing direction (*see* factual findings (1) through (4) listed above). We determine that claim 1 on appeal merely requires a closed cell rubber foam with needle holes penetrating through the foam in only the compressing direction, with a property of a specified permeability.² Although Appellants correctly state that the references are silent as to the degree of permeability (e.g., Br. 5), the recitation of a property not disclosed by the prior art does not render an otherwise known product patentable. *See Skoner, supra.* We determine that the Examiner has established that the references disclose a product identical or substantially identical to the claimed closed cell rubber foam with holes, where the product has closely spaced holes in the compressing direction (factual finding (1) listed above), has holes within the claimed diameter range made by needle punching (factual findings (2) and (4) listed above), and contains a teaching that the diameter and spacing between holes depends on the perforation (i.e., permeability) desired (factual finding (4) listed above). Accordingly, we determine that the Examiner has established a sound basis that the products of the prior art and the claimed products are the same or substantially the same, and Appellants have not submitted any convincing evidence or arguments to the contrary.

For the foregoing reasons and those stated in the Answer, we affirm all grounds of rejection in this appeal.

² Appellants do not argue any claim with specificity. Therefore we select claim 1 on appeal as a representative claim. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2006).

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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) (2006).

AFFIRMED

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