

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT GROTN,
LINDA MOOSHIAN, and
GEORGES RIBOULET

Appeal 2007-4410
Application 11/145,695
Technology Center 1700

Decided: July 2, 2008

Before BRADLEY R. GARRIS, CHARLES F. WARREN, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

This is in response to a request, filed March 5, 2008, for rehearing of our Decision, mailed December 31, 2007, wherein we sustained each of the appealed § 102, § 103, and obviousness-type double patenting rejections "for the reasons well stated in the Examiner's Answer" (Decision 3).

Concerning the § 102 rejection based on Groten '785 and the obviousness-type double patenting rejection based on the claims of Groten '785, Appellants argue that Groten fails to disclose or claim several features recited in product claim 12 such as the claim feature "the filaments being melt-spun and drawn filaments" (Request 3, 5). However, these claim features relate to the process by which the claim 12 product is made. As properly indicated in the Answer, the patentability of a product does not depend on its method of production (*see, e.g.*, Ans. 8). This is a well established legal principle. *See In re Thorpe*, 777 F.2d 695, 697 (Fed. Cir. 1985).

Appellants "respectfully submit that the Examiner's Answer or [sic] the Board's Decision fails to provide any support for the assertion that the fabrics of Groten ['785] have the same structure as the product of the present invention" (Request 3). We do not agree. For the reasons detailed in the Answer and emphasized in the Decision, a *prima facie* case exists for considering the product of Groten '785 as identical to Appellants' claim 12 product, and Appellants have failed to carry their burden to prove that the prior art product does not necessarily or inherently possess the characteristics of the claim 12 product. *See Thorpe*, 777 F.2d at 698.

As for the § 103 rejection over Marmon in view of Nishijima, Appellants argue there is no teaching or suggestion for combining these references in the manner proposed by the Examiner (Request 4). This argument is fully rebutted by the Examiner's reasons for combining Marmon and Nishijima (Ans. 6-8, 13-14). Significantly, the subject Request does not point to any specific error in the Examiner's reasoning.

With further regard to the obviousness-type double patenting rejection based on Groten '785, Appellants argue that patentee's claimed product would not inherently possess the 80+ percent degree of splitting required by appealed claim 12 because "the claim [of Groten '785] covers filaments not split at all" (Request 5). We do not share this quoted viewpoint. The claims of Groten '785 expressly recite elementary filaments having particular characteristics which can only be formed by splitting the continuous or composite filaments of the claims. Moreover, for the reasons expressed in the Answer and emphasized in the Decision, the recited characteristics of the elementary filaments claimed by Groten '785 reasonably support a determination that Groten's claimed product possesses the 80+ percent degree of splitting required by appealed claim 12.

In addition, Appellants seem to argue that the above-noted obviousness-type double patenting rejection is improper because "[i]nherency is not an obviousness argument" (Request 5). It is well settled, however, that the question of inherency may properly arise in the context of obviousness. *See In re Napier*, 55 F.3d 610, 613 (Fed. Cir. 1995).

Finally, Appellants argue that the obviousness-type patenting rejection based on the claims of Groten '652 is improper because patentee claims a cleaning cloth rather than "a textile light-protective material" as recited in appealed claim 12 (Request 6). According to Appellants, "[t]he Examiner's Answer states a cleaning cloth 'could be used' as light-protective material, but this is not the standard for an obviousness-type double patenting rejection" (*id.*). Appellants' reasoning is not well taken. As emphasized in our Decision, "because the product claimed by Groten '652 is structurally identical to the claim 12 product, the former must necessarily possess the

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light-protective characteristic of the latter" (Decision 5). *See In re Best*, 562 F.2d 1252, 1255 (CCPA 1977) (where the claimed and prior art products appear to be identical, an applicant has the burden to prove that the prior art products do not necessarily or inherently possess the characteristics of the claimed product).

In light of the foregoing, we adhere to our decision sustaining all appealed rejections.

The Request for rehearing is denied.

DENIED

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DAVIDSON, DAVIDSON, KAPPEL, LLC
485 7TH AVENUE
14TH FLOOR
NEW YORK, NY 10018