

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ROBERT GROTON,  
LINDA MOOSHIAN, and  
GEORGES RIBOULET

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

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Decided: December 31, 2007

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

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 12-28. We have jurisdiction under 35 U.S.C. § 6. We AFFIRM.

Appellants claim a textile light-protective material comprising multicomponent continuous filaments which have been split to a degree

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greater than 80% thereby forming continuous microfilaments. Appellants also claim a method for manufacturing such a material.

Representative claim 12 reads as follows:

12. A textile light-protective material comprising:

a microfilament non-woven fabric having a mass per unit area of 20 to 300 g/m<sup>2</sup>, the non-woven fabric including multicomponent continuous filaments, the filaments being melt-spun and drawn filaments having an original titer of 1.5 to 5 dtex deposited immediately to form a non-woven material;

the multicomponent continuous filaments of the non-woven material being split continuous microfilaments having a titer of 0.05 to 2.0 dtex and being bonded,

a degree of splitting of the multicomponent continuous filaments being greater than 80%.

The references set forth below are relied upon by the Examiner as evidence of unpatentability:

Groten (Groten '785)	5,899,785	May 4, 1999
Nishijima	5,965,084	Oct. 12, 1999
Marmon	6,200,669 B1	Mar. 13, 2001
Groten (Groten '652)	6,706,652 B2	Mar. 16, 2004

Claims 12-17, 20-23, and 25-28 are rejected under 35 U.S.C. § 102(a) or (e) as being anticipated by Groten '785.

Claims 18 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable under Groten '785.

Claims 12-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Marmon in view of Nishijima.

Claims 12-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of Groten ‘785 or claims 1-20 of Groten ‘652.<sup>1</sup>

The arguments advanced in the Appeal Brief are focused on the limitations of independent claim 12 (App. Br. 9, 12, 14, and 15). Like Appellants, we have focused on claim 12 in our assessment of this appeal.

We will sustain each of the above-noted rejections for the reasons well stated in the Examiner’s Answer. We add the following comments for emphasis.

#### The § 102 and § 103 Rejections

As detailed more fully in the Answer, the separation, (i.e., splitting) disclosures of Groten ‘785 (col. 4, ll. 40-54) and Marmon (col. 11, ll. 10-44) establish a basis-in-fact for believing that the degree of separation (i.e., splitting) achieved in these references is necessarily and inherently greater than 80% as required by claim 12. *See Ex parte Levy*, 17 USPQ2d 1461, 1464 (BPAI 1990).

Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the Patent and Trademark Office can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of the claimed product. Whether the rejection is based on

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<sup>1</sup> The appealed claims also were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of Application 10/168,432 and the claims of Application 10/203,905. However, these rejections no longer exist because the aforementioned applications are now abandoned.

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“inherency” under 35 U.S.C. § 102, on “prima facie obviousness” under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the inability of the Patent and Trademark Office to manufacture products or to obtain and compare prior art products. *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977). See also, *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990).

On the record before us, Appellants have submitted no proof that the materials of Groten and Marmon do not actually possess the “greater than 80%” characteristic of claim 12. Instead, Appellants simply argue that Groten and Marmon do not disclose the here-claimed degree of splitting (App. Br. 14, Reply Br. 4-5). This mere argument is no substitute for the above-discussed proof required to establish that the products of Groten or Marmon do not actually possess the claim 12 characteristic under review.

For the reasons discussed above and in the Answer, we hereby sustain: the § 102 rejection of claims 12-17, 20-23, and 25-28 as being anticipated by Groten ‘785; the (not separately argued) § 103 rejection of claims 18 and 19 as being unpatentable over Groten ‘785; and the § 103 rejection of claims 12-28 as being unpatentable over Marmon in view of Nishijima.

#### The Obviousness-type Double Patenting Rejections

Appellants argue that the claims of Groten ‘785 do not require the claim 12 splitting degree of greater than 80% (App. Br. 9) and that “[t]he product could be 5% split and still fall within the claims [of Groten ‘785]” (Reply Br. 2). However, we agree with the Examiner (Ans. 3 and 8) that the products encompassed by the claims of Groten ‘785 include products which

would necessarily and inherently possess a degree of splitting greater than 80% as required by claim 12. Because Appellants have provided this record with no proof that the products claimed by Groten ‘785 do not actually possess this degree of splitting, we hereby sustain the obviousness-type double patenting rejection of claims 12-28 as being unpatentable over the claims of Groten ‘785.

In addition, Appellants argue that the cleaning cloth claimed by Groten ‘652 and the textile light-protective material of claim 12 are not the same products (App. Br. 12, Reply Br. 3). This argument is unpersuasive. As correctly explained by the Examiner (Ans. 8-9), the respective products claimed by Groten ‘652 and by Appellants are structurally identical, and these structures do not somehow become different simply because their intended uses are different. That is, because the product claimed by Groten ‘652 is structurally identical to the claim 12 product, the former must necessarily possess the light-protective characteristic of the latter. Therefore, we hereby sustain the obviousness-type double patenting rejection of claims 12-28 as being unpatentable over the claims of Groten ‘652.

### Conclusion

The decision of the Examiner is affirmed.

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).

**AFFIRMED**

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