

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TSUYOSHI YAMASAKI, HIDEKAZU ANDOH,
and YOSHIHIRO TAMBA

Appeal 2008-2102
Application 10/484,807
Technology Center 1700

Decided: May 29, 2008

Before CHARLES F. WARREN, PETER F. KRATZ, and
CATHERINE Q. TIMM, *Administrative Patent Judges*.

KRATZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the Examiner's final rejection of claims 1-4 and 6-12. We have jurisdiction pursuant to 35 U.S.C. § 6. Oral arguments were presented on May 22, 2008.

Appellants' invention is directed to an artificial leather sheet. Claim 1 is illustrative and reproduced below:

1. An artificial leather sheet which comprises a napped part of ultrafine fibers and a grainy part of nonporous elastic polymer randomly existing in the surface of a substrate, wherein the grainy part may optionally include a portion of the napped ultrafine fibers taken into said nonporous elastic polymer, prepared by infiltrating a porous polymer elastomer into a three-dimensionally intermingled nonwoven fabric of ultrafine fibers of not more than 0.5 dtex, wherein the napped part and the grainy part are on the same surface of the substrate, wherein the nonporous elastic polymer is infiltrated into the substrate and is present from the surface of the substrate to a depth thereof of at least 5 μm and not more than 20 μm .

The Examiner relies on the following prior art reference as evidence in rejecting the appealed claims:

Takeyama

EP 0 940 492 A1

Sep. 8, 1999

Claims 1-4 and 6-12 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Takeyama. We reverse both rejections.

It is well settled that the burden of establishing a *prima facie* case of non-patentability resides with the Patent and Trademark Office (PTO). *See In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984).

All of the appealed claims require an artificial leather sheet, which includes, *inter alia*, a napped part comprising ultra fine fibers and a grainy part made of nonporous elastic polymer randomly existing in the surface of a substrate, "wherein the nonporous elastic polymer is infiltrated into the substrate and is present from the surface of the substrate to a depth thereof of at least 5 μm and not more than 20 μm " (independent claim 1).

The Examiner acknowledges that Takeyama does not explicitly describe the thickness (depth of penetration) of the non porous layer (Ans. 2-3). However, the Examiner makes the presumption that the product of Takeyama necessarily includes a nonporous elastic polymer that infiltrates the surface of the substrate surface of the Takeyama product based on alleged commonalities in Takeyama's and Appellants disclosed coating amounts and method of coating of the polymer (Ans. 3). However, Appellants' disclosed method of forming the claimed product includes the application of a penetrant (Specification 6, 15-19, Examples 1 and 2). On the other hand, the disclosed method of Takeyama does not include employing a penetrant. Thus, Takeyama's method does not substantially correspond with Appellants' method in a manner sufficient to warrant the Examiner's inherency assertion of infiltration of a nonporous polymer in Takeyama to the degree required by the appealed claims.

The inadequacy of this inherency position is further brought to light by Comparative Example 2 as set forth in the subject Specification and the Declaration under 37 C.F.R. § 1.132 of Hidekazu Andoh, a named co-inventor, which Declaration is of record and argued in the Appeal Brief and Reply Brief. In particular, the Comparative Example 2 and Andoh Declaration make it plain that the lack of use of a mechanism for achieving infiltration, such as employing a penetrant, in Takeyama is consistent with the Comparative Example 2 result wherein infiltration of a nonporous polymer beneath the surface of an artificial leather product, using a similar method to Takeyama's method, resulted in nonporous polymer penetration of a depth substantially less than the depth required by the appealed claims.

The Examiner's rejoinder to the Andoh Declaration, the Specification Comparison Example 2, and the arguments set forth in the Appeal Brief (Ans. 3-4) miss the mark in seemingly asserting that this evidence and argument fails to present data for each and every substantially equivalent option disclosed or suggested by Takeyama. Such a presentation is not required to disprove the Examiner's inherency theory for reasons stated in the Reply Brief. The Examiner cannot dismiss the burden of presenting a *prima facie* case of anticipation with conjectured inherency of polymer infiltration to the depth claimed. Moreover, after presenting such an inherency assumption, the Examiner does not effectively refute Appellants' evidence to the contrary by the mere suggestion that Appellants' evidence does not conclusively prove that there is no possibility for infiltration of the polymer, as claimed, for each possible variation of the disclosed method of Takeyama. The Examiner's speculation about the possibility of such an inherent outcome does not shift the burden to Appellants to conclusively demonstrate otherwise. Appellants have no such burden. This is particularly true here given that the Examiner has not established where Takeyama discusses how penetration of a nonporous polymer can be effected, much less to a particular depth as Appellants' claim.

As for the Examiner's alternative obviousness position, the Examiner indicates that it would have been obvious to an ordinarily skilled artisan to have selected a thickness (depth of penetration) of the nonporous polymer (presumably Polymer C) of Takeyama (¶¶ 0048 and 0049) and, in so doing, arrive at the claimed subject matter through routine experimentation (Ans. 3). However, the Examiner has not pointed to any evidence which discloses or implies that an ordinarily skilled artisan would have recognized that the

depth of penetration of the nonporous polymer was an art recognized result effective variable, much less a variable that could be controlled in a manner so as to arrive at Appellants' claimed depth of infiltration.

Rejections based on § 103(a) must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. *See In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). In other words, the Examiner's basis for the rejection falls short of identifying a viable rationale that would have led an ordinarily skilled artisan from the teachings of Takeyama to a product corresponding to Appellants' claimed product. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741 (2007).

On this record, we reverse both of the Examiner's rejections.

CONCLUSION

The decision of the Examiner to reject claims 1-4 and 6-12 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Takeyama is reversed.

REVERSED

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Application 10/484,807

PL Initial:
sld

OBLON, SPIVAK, MCCLELLAND,
MAIER & NEUSTADT
1940 DUKE STREET
ALEXANDRIA, VA 22314