

***THIS OPINION WAS NOT WRITTEN FOR PUBLICATION***

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* SCOTT B. BEIER  
and REX A. ADAMS

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Appeal No. 96-2178  
Application 08/146,901<sup>1</sup>

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ON BRIEF

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Before JOHN D. SMITH, PAK and WARREN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

*Decision on Appeal and Opinion*

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 1 through 21.<sup>2</sup>

We have carefully considered the record before us, and based thereon, find that we cannot sustain any of the grounds of rejection of claims 1 through 7 and 12 through 17 under 35 U.S.C.

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<sup>1</sup> Application for patent filed October 20, 1993.

<sup>2</sup> Amendment of August 22, 1994 (Paper No. 7).

§ 102(b) as clearly anticipated by Grant,<sup>3</sup> or of the grounds of rejection under 35 U.S.C § 103: claim 18 through 20 as unpatentable over Grant; claims 8 through 10 as unpatentable over Grant in view of Decker; and claims 11 and 21 as unpatentable over Kagawa.<sup>4</sup>

It is well settled that anticipation under § 102 is a question of fact, based on the limitations in the claims, and that in order to make out a *prima facie* case of anticipation, the examiner must point out where each and every element of the claimed invention, arranged as required by the claims, is found in a single prior art reference, either expressly or under the principles of inherency. *See generally In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1457, 221 USPQ 481, 485 (Fed. Cir. 1984). It is equally well settled that the examiner may satisfy his burden of establishing a *prima facie* case of obviousness under § 103 by showing some objective teachings or suggestions in the prior art taken as a whole or that knowledge generally available to one of ordinary skill in the art would have led that person to combine the relevant teachings of the applied prior art in the proposed manner to arrive at the claimed invention, including each and every limitation of the claims, without recourse to the teachings in appellants' disclosure. *See generally, In re Oetiker*, 977 F.2d 1443, 1447-48, 24 USPQ2d 1443, 1446-47 (Fed. Cir. 1992) (Nies, J., concurring); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed. Cir. 1988). The examiner has failed to make out a *prima facie* case under either statutory provision.

We begin our consideration of the issues in this appeal by determining the invention encompassed by independent claims 1, 11, 12 and 14. *See generally, Gechter v. Davidson*, 116 F.3d 1454, 1457, 1460 & n.3, 43 USPQ2d 1030, 1032, 1035 & n.3 (Fed. Cir. 1997). We find that claim 1 requires that the "second layer" has "a length and width *equal* to that of the first layer;"

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<sup>3</sup> Grant and other references relied on by the examiner are listed at page 2 of the answer. We refer to these references in our opinion by the name associated therewith by the examiner.

<sup>4</sup> We take the statement in the answer (page 4) that "[c]laims 8 through 11 and 18 through 21 are rejected under 35 USC 103" as "set forth in the prior Office action paper number 8" to refer to the three separate grounds of rejection set forth on pages 3-4 of the final rejection of November 29, 1994.

claim 12 specifies that the sole “layer” has “a plurality of spaced apart openings extending through *less* than the entire thickness of the layer;” and claim 14 requires that the sole “layer” has “a plurality of spaced apart openings extending *less* than the entire thickness of the layer” and the “walls separating said openings” have “an upper surface and side wall surfaces formed at an *angle* relative to the upper surface” (emphasis supplied). We further find that claim 11 specifies a method wherein “a first layer” (1) has “slits” cut “completely through the thickness” thereof, (2) is then stretched to “expand openings formed by the slits,” (3) is then fixed in the “expanded condition,” and (4) is then placed in “abutting contact with a second layer.”

In comparing the claimed invention as encompassed by independent claims 1, 12 and 14 with Grant in the manner applied by the examiner under § 102(b) and § 103, we agree with appellants (brief, pages 5-11 and 14-15) that the examiner has failed to make out a *prima facie* case of anticipation and of obviousness. We particularly find that Grant discloses a “filtration module **62**” in Grant Figs. **3** and **4** in which the “terminal elements **20**, **24**, **32** and **38** are *not disposed in overlying or underlying relationship* to the interior section **16**, and are thus *positioned so as not to obstruct* the interior section **16** and the *ribbon elements 58*” (col. 7, line 65, to col. 8, line 3<sup>5</sup>; emphasis supplied). The examiner merely points to Figs. 4, 8 and 9 without explanation why these disclosures meet all of the claim limitations (answer, pages 3 and 5).

Accordingly, based on this record, we find that the fluid filters taught by Grant do not have *any* of the elements specified in claims 1, 12 and 14 which we identified above, and thus, the reference does not describe a fluid filter which contains all of the required elements arranged as specified in claims 1

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<sup>5</sup> We observe that Grant teaches that the preparation of “filtration module **62**” involves the preparation of “first flexible sheet-terminal elements assembly **44**” as shown in Fig. 1, wherein “the first flexible sheet **10** is laminated between terminal elements at each edge section **12** and **14**” and “[p]referably, the terminal elements **20**, **24**, **32** and **38** are disposed so as not to obstruct the intermediate section **16** of the flexible sheet **10**” (col. 4, lines 24-30). Indeed, Grant discloses that “first flexible sheet **10**” has “first and second edge sections **12** and **14**” and an “intermediate” or “interior section **16**,” wherein the “first flexible sheet” is a “thin, lightweight, inert material” that can be, *inter alia*, “Mylar which most preferably is no more than 0.002 inches thick” (col. 1, line 60, to col. 2, line 3). A “plurality of slits **56** are cut in the interior section **16** of the first flexible sheet-terminal elements assembly **44**,” which slits define “an elongated ribbon element **58**” (col. 6, lines 1-9).

through 7 and 12 through 17 within the meaning of § 102(b). Furthermore, we find no teachings in Grant, taken alone or combined with Decker, which would have provided one of ordinary skill in the art with both the suggestion and the reasonable expectation of success of modifying the “filtration module **62**” in order to arrive at the claimed fluid filter as a whole encompassed by claims 8 through 10 and used in the method of claims 18 through 20. *Dow Chem.*, 837 F.2d at 473, 5 USPQ2d at 1531. Indeed, with respect to Decker, the examiner has not explained on this record why the combination of “sloped walls” of the tube filters of Decker and the “*ribbon elements 58*” of the “filtration module **62**” of Grant would have resulted in the claimed fluid filters. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-54, 5 USPQ2d 1434, 1438-41 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

Turning now to claims 11 and 21, we agree with appellants (brief, pages 11-14) that Kagawa does not disclose the *four* process steps specified in claim 11 as we construed this claim above. Kagawa teaches a process wherein a specified film is adhered to a fabric by hot pressing, which *sole* step causes the film to shrink, as well as simultaneously makes the film microporous (e.g., abstract). The examiner has not provided on this record any evidence or scientific explanation explaining why one of ordinary skill in this art would have been motivated to modify the process of Kagawa in order to arrive at the claimed invention. Indeed, even if the examiner had established that one of ordinary skill in this art would have recognized the alleged equivalence of the “formation of the opening being by cutting” and micropore formation by heat treatment (final rejection, Paper No. 8, page 3) there still remains several other differences between the claimed and prior art processes which have not been addressed. We further fail to find on this record any evidence or scientific explanation establishing that the resulting filter of the Kagawa process is the same or substantially similar to the filter prepared by the process of claim 11 and claimed in claim 21. *Compare In re Best*, 562 F.2d 1252, 1255-56, 195 USPQ 430, 433-34 (CCPA 1977).

Accordingly, it is inescapable that the only description of and the only direction to appellants’ claimed invention on the record before us is supplied by appellants’ own specification.

The examiner's decision is reversed.

*Reversed*

JOHN D. SMITH  
Administrative Patent Judge

CHUNG K. PAK  
Administrative Patent Judge

CHARLES F. WARREN  
Administrative Patent Judge

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