

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* OANA M. LEONTE  
LEV V. GINZBURG and ROBERT S. DE HEER

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Appeal No. 1997-0045  
Application 08/241,688

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ON BRIEF

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Before WARREN, WALTZ and JEFFREY T. SMITH, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

*Decision on Appeal and Opinion*

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellants, in the brief, and based on our review, find that we cannot sustain any of the three grounds of the rejections which encompass all of appealed claims 1, 3, 4, 7, 8, 41 and 42<sup>1</sup> under 35 U.S.C. § 103, all of which are based on Jablonsky in view of

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<sup>1</sup> These are all of the claims remaining in the application. See the amendment of May 15, 1995 (Paper No. 19). In the amendment of March 29, 1996 (Paper No. 26), appellants canceled appealed claims 43 and 44.

Gallay et al. (Gallay).<sup>2</sup> We determine that the examiner has failed to make out a *prima facie* case in this ground of rejection for the reasons pointed out by appellants in the brief, to which we add the following.

It is well settled that a *prima facie* case of obviousness under § 103 is established by showing that some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in the art would have led that person to the claimed invention as a whole, including each and every limitation of the claims, without recourse to the teachings in appellants' disclosure. *See generally, Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *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 at 473, 5 USPQ2d at 1531-32.

While we agree with the examiner that Jablonsky discloses a process of manufacturing reinforced structural products which includes the steps of adding an electrolyte to fibrous materials, which includes wood fibers, followed by adding an adhesive (col. 2, line 39, to col. 4, line 3), we cannot agree that the combined teachings of this reference and Gallay would have reasonably suggested to one of ordinary skill in this art to modify the step of applying the electrolyte in such manner that non-conductive pieces would reasonably be expected to become temporarily electrically conductive so that an electric current will pass through said pieces and generate heat within the same as required by claim 1. Similarly, we do not find that this person would have found in such teachings the reasonable suggestion to combine irregularly shaped pieces capable of absorbing and retaining moisture would be combined with sufficient moisture and electrolyte with the reasonable expectation that such pieces would become electrically conductive, apart from any adhesive additive, such that an electric current will pass through said pieces and generate heat within the same as required by claim 41. Both claims require that the pieces are made electrically conductive *before* being combined with adhesive.

We find that Jablonsky teaches that electrolytic materials, *inter alia*, acetylene black and organic acid or salt, are added to, *inter alia*, the adhesive or fibrous materials (col. 2, lines 35-46). The adhesive is later "applied by spraying, brushing, dipping or impregnating the fibrous material" (col.

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<sup>2</sup> The examiner in the answer (page 4) refers to the statement of the grounds of rejection in the Office

2, line 51, to col. 3, line 3). Jablonsky further teaches that where low frequencies can be employed if the electrolytic material will produce sufficient heat at such low frequencies which would be provided by, *inter alia*, “a metallic conductor . . . which affords a more or less continuous conductive path for electric currents in the fibrous body” (col. 3, line 61, to col. 4, line 9). This reference further discloses that the electrolytic material can also be added to, and thus applied with, the adhesive (col. 2, lines 38-39) and that the adhesive can be applied “by interleaving fibrous laminae with solid films of adhesive” which can contain “fibrous fillers” and can be paper (col. 3, lines 3-8).

We find that Gallay discloses “providing . . . efficient electrical resistance means in the glue line of laminated structures whereby, on application of an electric current to such glue line, sufficient heat is generated therein to set the same” (col. 2, lines 1-6). The electrolytic material used in the adhesive can be acetylene black and the adhesive can be used as a dispersion in water in the form of a paste to create the glue line by “brushing, spraying or the like” (e.g., col. 2, line 26, to col. 3, line 15). The reference further discloses that the adhesive can be applied as a film wherein “such film is preliminarily prepared . . . [from a] suitable base, such as paper or fabric . . . impregnated with a dispersion prepared as described above, and the resultant adhesive sheet allowed to dry” (col. 3, line 73, to col. 4, line 6).

We cannot agree with the examiner (answer, pages 7-8) that Gallay would have taught one of ordinary skill in this art to add electrolyte in water to fibrous material such that the “combination of electrolyte and fibrous material is made electrically conductive” because Gallay does not add an electrolytic material separate and apart from the adhesive and further teaches that the formation of the dispersion of the electrolytic material containing adhesive in water is for purposes of application to a formed ply or the formation of a solid film, not the separate pieces from which the ply is made. Thus, we determine that, at best, the combined teachings of Jablonsky and Gallay would have reasonably suggested to one of ordinary skill in this art that the adhesive to which the electrolytic material has been added as taught by Jablonsky can be dispersed in water for application purposes as taught by Gallay, and therefore the combination of references does not result in the claimed invention. *See Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-54, 5 USPQ2d 1434, 1438-41 (Fed. Cir. 1988).

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action of February 27, 1995 (Paper No. 16, pages 3-6).

The examiner's decision is reversed.

*Reversed*

CHARLES F. WARREN	)	
Administrative Patent Judge	)	
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	)	
THOMAS A. WALTZ	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
JEFFREY T. SMITH	)	
Administrative Patent Judge	)	

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