

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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MARTIN D. SKIRHA,  
EDWARD R. NOVINGER and WILLIAM A. NYBERG

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Appeal No. 1997-1920  
Application 08/324,059

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ON BRIEF

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Before JOHN D. SMITH, WARREN and WALTZ, *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 9, which are all of the claims in the application.<sup>1</sup>

We have carefully considered the record before us, and based thereon, find that we cannot sustain the grounds of rejection of appealed claims 1, 4 and 5 under 35 U.S.C. § 103 over Durfee in view of Kulaszewicz et al. in further view of Ripplinger and of appealed claims 2, 3 and 6 through 9

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<sup>1</sup> Specification, pages 12-14.

under 35 U.S.C. § 103 over Durfee in view of Kulaszewicz et al. in further view of Ripplinger as described in the prior rejection in further view of Savovic et al.<sup>2</sup>

We find that the methods of the appealed claims differ from the individual references in the manner pointed out by appellants in their principal brief (pages 5-14). While we agree with the examiner that the subject matter disclosed in each of the references is related to the art of plastic welding, that fact alone does not establish that one of ordinary skill in the art would have found in the combined teachings thereof the reasonable suggestion to modify the abutting surfaces of the parts to be welded by the method of Durfee (see, e.g., Fig. 10) to contain so-called “energy directors” known in the art as evinced by the secondary references. Indeed, as appellants point out, the examiner must provide a logical reason why one of ordinary skill in the art would have combined the teachings of the references in the reasonable expectation of arriving at the claimed invention. The fact that the welding surfaces of Durfee can be modified to contain “energy directors” does not alone support a *prima facie* case of obviousness. See *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989).

Thus, on this record, the examiner has not carried his burden of establishing a *prima facie* case of obviousness by showing that some objective teaching or suggestion in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in this 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, *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, 1074-75, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) (“Both the suggestion and the expectation of success must be founded in the prior art, not in applicant’s disclosure.”); *In re Warner*, 379 F.2d 1011, 1014-17, 154 USPQ 173, 176-78 (CCPA 1967).

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<sup>2</sup> The references are listed at page 2 of the answer.

The examiner's decision is reversed.

*Reversed*

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

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Jay G. Taylor  
Ice Miller Donadio & Ryan  
One American Square, Box 82001  
Indianapolis, Indiana 46282