

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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte THOMAS F. CORBIN, OTTO M. ILG and ROBERT N. ARMSTRONG

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Appeal No. 1997-3897  
Application No. 08/458,930

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ON BRIEF

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Before STAAB, McQUADE, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2 and 4 to 16, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a process for manufacturing substantially 100% nylon 6 carpet. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Carpenter 8, 1972	3,640,786	Feb.
Culp et al. 1973 (Culp)	3,717,524	Feb. 20,
Norris 1977	4,028,159	June 7,
Thompson et al. 1980 (Thompson)	4,224,092	Sep. 23,
Hackler 1989	4,871,604	Oct. 3,
Kliene 1968	GB 1,106,473	Mar. 20,
Weisbart	DE 2,105,137 <sup>1</sup>	Aug. 10, 1972
Fryer 14, 1973	GB 1,306,691	Feb.

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<sup>1</sup> In determining the teachings of Weisbart, we will rely on the translation of record provided by the appellants.

Claims 1, 2, 4 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Norris in view of the collective teachings of Carpenter and Hackler, and further taken with Thompson.

Claims 5 to 7 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over the references as applied to claim 1 above, and further in view of Kliene.

Claim 8 stands rejected under 35 U.S.C. § 103 as being unpatentable over the references as applied to claim 7 above, and further in view of Fryer.

Claims 9, 10, 12 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over the references as applied to claim 1 or 11 above, and further in view of Weisbart.

Claims 14 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over the references as applied to claim 1 above, and further in view of Culp.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 14, mailed May 1, 1997) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 13, filed February 5, 1997) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1, 2 and 4 to 16 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

When it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the appellants. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the appellants' structure as a template and selecting elements from references

to fill the gaps. The references themselves must provide some teaching whereby the appellants' combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (citations omitted).

As set forth above, teachings of references can be combined only if there is some suggestion or incentive to do so. Here, the prior art contains none. The disparate teachings of the applied prior art (i.e., Norris, Carpenter, Hackler and Thompson) and the manner in which they are proposed to be combined (answer, pp. 4-7) indicate, in our view, that the examiner has engaged in an impermissible hindsight reconstruction of the appellants' invention using the claims as a template to selectively piece together isolated disclosures in the prior art. Thus, we find ourselves in agreement with the appellants' position (brief, pp. 11-12) that the applied prior art (1) does not suggest or teach any benefit from using all nylon 6 materials; (2) presents a myriad of teachings that would not have led one skilled in the art to the claimed invention; and (3) is devoid of any guidance to combine the prior art to arrive at the

claimed invention.<sup>2</sup> Even if the Thompson reference is considered to be analogous prior art (the appellants argue that it is not), the combined teachings of the applied prior art would not have suggested a process for manufacturing substantially 100% nylon 6 carpet as set forth in independent claim 1 (the only independent claim on appeal).

We have also reviewed the references additionally applied in the rejection of dependent claims 5 to 10 and 12 to 16 but find nothing therein which makes up for the deficiencies discussed above regarding claim 1.

For the reasons set forth above, the decision of the examiner to reject claims 1, 2 and 4 to 16 under 35 U.S.C. § 103 is reversed.

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<sup>2</sup> Claim 1 recites a process for manufacturing substantially 100% nylon 6 carpet which includes the following steps:

(a) making an unbound carpet by inserting nylon 6 face yarn into a nylon 6 support means; (b) melting nylon 6 to form molten nylon 6; and (c) binding the face yarn to the support means by providing the molten nylon 6 at points where the face yarn and the support means contact each other, and allowing the molten nylon 6 to cool, thereby forming a substantially 100% nylon [6] bound carpet.

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CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2 and 4 to 16 under 35 U.S.C. § 103 is reversed.

REVERSED

LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JOHN P. McQUADE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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