

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. 56

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SUSUMU YAMAMOTO, TERUYUKI MURAI, NOZOMU KAWABE,
TOMOYUKI AWAZU, SHUJI YAZU, and TETSUJI JODAI

Appeal No. 2000-0491
Application No. 08/906,855

HEARD: March 15, 2001

Before CALVERT, ABRAMS, and GONZALES, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 97,98 and 100-118, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a process for producing a composite superconductor wire. An understanding of the invention can be derived from a reading of exemplary claim 97, which appears in the appendix to the appellants' Brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Jin <u>et al.</u> (Jin)	4,952,554	Aug. 28, 1990
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Claims 97, 98, 100-116 and 118 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claims 97, 98 and 100-118 stand rejected under 35 U.S.C. § 103 as being unpatentable over Jin.

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. 45) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 44) and Reply Brief (Paper No. 47) 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. As a consequence of our review, we make the determinations which follow.

The Rejection Under Section 112

There are two portions to the examiner's rejection under the second paragraph of 35 U.S.C. § 112. The first is that the phrase "improve superconductivity relative to the superconductivity which would result from a single wire-drawing and a single heat-treatment," which appears in the last few lines of independent claims 97 and 118, is vague and ambiguous. We do not agree. It is clear from the specification that the appellants consider their invention to be an improvement over those methods in the prior art that utilize a single wire-drawing step and a single heat-treatment step. The recitation in the claims with which the examiner takes issue is merely a conclusionary statement that sets forth the results that flow from the inventive method as compared to a method in which there is only a single wire-drawing and a single heat-treatment.

The second point of indefiniteness raised by the examiner is that it is not clear whether the "single wire drawing" and "single heat-treatment" are one of those recited in the steps of these two claims, or are different therefrom. This is related to the first portion of the Section 112 rejection, and we also do not agree that this language renders the claims indefinite. Rather, it is clear to us from the description of the method set out in the specification, and in the portions of the claims which precede the language here in issue,

that the “single” steps do not form a part of the inventive method, but are intended to put the results of it in a particular perspective.

The rejection under Section 112 is not sustained.

The Rejection Under Section 103

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

The examiner has rejected all of the claims as being unpatentable over Jin, admitting, however, that Jin fails to disclose, among other things, that the wire-drawing and heat-treating steps are repeated more than two times. The examiner takes the position that this limitation would have been obvious to one of ordinary skill in the art in view of the

teachings of Jin, setting forth several scenarios as to why this would be the case (Answer, pages 4 and 5).

As manifested in all three of the independent claims, the appellants' invention includes the steps of wire-drawing the metal pipe filled with the powder material, and then heat-treating it, at least two times. This is in stark contrast to the method taught by Jin in which, while there might be multiple wire-drawing steps, there is only one heat-treating step, and it occurs after all of the wire-drawing steps have been completed (see column 3, lines 10-15 and column 5, line 49 through column 6, line 11). Thus, from our perspective, there is absolutely no basis from which to conclude that one of ordinary skill in the art would have found suggestion, from the Jin patent itself, to modify the Jin method by interposing additional heat-treating steps between wire-drawing steps. We fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to modify the Jin method in the manner proposed by the examiner. The two scenarios set out by the examiner in support of the rejection are ill-conceived, for both are based upon producing a finished product that is later found to be undesirable, and then wire-drawing and heat-treating it again until it becomes desirable. In our view, the rejection is grounded in the hindsight accorded one who first viewed the appellants' disclosure which, of course, is not a proper basis for a rejection under Section 103. See In re Fritch, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

A prima facie case of obviousness has not been established with regard to the subject matter recited in independent claims 97, 117 and 118. The rejection of these claims and those that depend therefrom under 35 U.S.C. § 103 therefore cannot be sustained.

SUMMARY

Neither rejection is sustained.

The decision of the examiner is REVERSED.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JOHN F. GONZALES)	
Administrative Patent Judge)	

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