The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte JOHN S. HUBERTY

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Appeal No. 2003-0318
Application 09/377,262

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HEARD: April 2, 2003

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Before GARRIS, WARREN, and POTEATE, Administrative Patent Judges.

POTEATE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1-27. Claims 28 and 29 are pending but have been withdrawn from consideration as directed to a nonelected invention. See paper no. 4, mailed April 11, 2001.

Claim 1 is representative of the subject matter on appeal and is reproduced below:

1. A filter that comprises:

A fluid permeable first electret filter layer that comprises fibers that contain a first polymeric material, wherein the first electret filter layer exhibits nondecreasing removal efficiency at completion of the DOP Penetration/Loading Test and removes a majority of a challenge aerosol collected by the filter during the DOP Penetration/Loading Test; and

a fluid permeable second electret filter layer that comprises fibers that contain a second polymeric material, wherein the second electret filter layer exhibits decreasing removal efficiency at completion of the DOP Penetration/Loading Test, and further wherein the second electret filter layer exhibits an initial quality factor that is greater than an initial quality factor of the first electret filter layer as determined using the DOP Penetration/Loading Test.

The references relied upon by the examiner are:

Jones et al. (Jones)	5,411,576	May 2, 1995
Singer et al. (Singer)	5,817,584	Oct. 6, 1998

Ground of rejection

Claims 1-27 stand rejected under 35 U.S.C. § 103 as unpatentable over Jones in view of Singer.

We reverse.

Discussion

The initial burden of presenting a *prima facie* case of obviousness rest on the examiner. *In re Oetriker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In order to establish a *prima facie* case of obviousness, the examiner must

identify a suggestion or motivation to modify the teachings of the cited references to achieve the claimed invention. *In re Kotzab* 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). "[P]articular findings must be made as to the reason to skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." *Id.*, 217 F.3d at 1371, 55 USPQ2d at 1317. For the reasons discussed below, we conclude that the examiner has simply failed to satisfy this initial burden.

The examiner found that Jones discloses an oily-mist resistant electret filter as claimed, with the exception that Jones fails to disclose two electret layers. Examiner's answer, paper no. 11, mailed September 11, 2002, page 3, paragraph (10). The examiner notes that Singer teaches a breathing mask fabric having first and second electret treated microfiber webs. The examiner conclude that "[i]t would have been obvious to one having ordinary skill in the art to have used the teaching of two electret filter layers as shown in Singer et al. with the electret filter of Jones et al. motivated by the desire to obtain a filter with increased filtering efficiency." *Id.*

At the outset, we note that it is unclear as to precisely how the examiner's proposes to combine the teachings of Jones and Singer to achieve the claimed invention. It may be that the examiner is suggesting that it would have been obvious to have used two layers of Jones' polypropylene electret fibers instead of one layer to construct an oily-mist resistant electret filter based on Singer's disclosure of using a multilayer laminate structure in constructing a high efficiency breathing mask fabric. Alternatively, it may be that the examiner is proposing that Singer's first web (see Singer, claim 1) be combined with a layer of Jones' polypropylene electret fibers to achieve the claimed filter media. However, regardless of how the examiner has combined the teachings of Jones and Singer, it is clear that the examiner has concluded that the resultant filter would inherently exhibit the features of removable efficiency and initial quality factor as recited in claim 1. See examiner's answer, page 4 ("[A] filter fabric as shown by Jones and Singer et al. would have the same test results as Appellant's invention, because both filters have the same laminate structure and are made from the same meltblown polypropylene electret microfibers.")

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Int. 1990) (citations omitted). We are in agreement with appellant that the examiner has failed to provide the requisite factual basis in support of his conclusion that a filter resulting from the combined teachings of Jones and Singer would necessarily exhibit the features required in claim 1. See reply brief, paper 12, received October 3, 2002, page 1. As further noted by appellant, the examiner discusses various features of the Singer and Jones filters, such as weight percent and size of the fibers, but fails to state how these features relate to removal efficiency and quality factor. *See Id*.

As explained by appellant,

> [t]here are a number of structural factors that effect filtration performance in a filtering web. In order to satisfy the present invention, these structural factors need to be selected so that one layer exhibits nondecreasing removal efficiency and the other layer exhibits decreasing removal efficiency at the completion of the DOP penetration/loading test. Further, the second layer needs to be constructed so that it exhibits an initial quality factor that is greater than the initial quality factor of the first layer.

Reply brief, page 2. Although the examiner comments on the Frazier permeability and other features of the Jones and Singer references, the record is devoid of the examiner's reasoning as to how these factors correlate to removal efficiency and initial quality factor.

Moreover, we are in agreement with appellant that the record does not properly establish why one of skilled in the art would have been motivated to combine the teachings of Jones and Singer. The examiner seems to suggest that because Jones and Singer are drawn to the same field of endeavor, one having ordinary skill in the filter art would combine the teachings to arrive at a filter with high filtering efficiency. See examiner's answer, page 5. However, the fact that Jones and Singer may be in the same field of endeavor is not sufficient to establish that one of ordinary skill in the art would have been motivated to combine their teachings. In this regard, we note that the examiner has even failed to provide reasoning as to why one of ordinary skill in the art would have been motivated to look to Singer given the fact that Singer does not relate to breathing mask fabrics that are suitable for use in an oily-misk environment.

Accordingly, we conclude that the examiner has failed to establish a *prima facie* case of obviousness and the rejection of claims 1-27 is reversed.

REVERSED

BRADLEY R. GARRIS Administrative Patent Judge	)	
CHARLES F. WARREN Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
LINDA A. POTEATE Administrative Patent Judge	)	

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