THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT A. KELLER

Appeal No. 95-2622
Application 08/125,524[1]

HEARING: December 10, 1998

Before KIMLIN, GRON, and WARREN, Administrative Patent Judges.

GRON, Administrative Patent Judge.

DECISION ON APPEAL UNDER 35 U.S.C. § 134

This is an appeal under 35 U.S.C. § 134 from an examiner's rejections of Claims 1-10. Still pending,

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[1] Application for patent filed September 22, 1993.

restricted, nonelected Claims 11 and 12 have been withdrawn from further consideration by the examiner (page 7 of the Office Action mailed November 19, 1993 (Paper No. 2) and page 3 of the Examiner's Answer).

The propriety of the examiner's restriction requirement is petitionable to the Commissioner of Patents and Trademarks and is not a matter for review on appeal to this Board under 35 U.S.C.

§ 134. See In re Watkinson, 900 F.2d 230, 233, 14 USPQ2d 1407, 1409-10 (Fed. Cir. 1990); In re Hengehold, 440 F.2d 1395, 1404, 169 USPQ 473, 479 (CCPA 1971).

Introduction

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being described by Spencer, U.S. Patent 2,152,826, patented April 4, 1939. Claim 1 stands rejected under 35 U.S.C. § 103 as being unpatentable in view of the teaching of either Spencer or Gruhn et al. (Gruhn), U.S. Patent 4,661,406, patented April

28, 1987. Claims 2-4[2] and 8-10 stand rejected under 35 U.S.C. § 103 as being unpatentable in view of the combined teachings of either Spencer or Gruhn and either McKay, U.S. Patent 3,691,749, patented September 19, 1972 (McKay '749), or McKay, U.S. Re. 29,363, reissued August 23, 1977 (McKay '363). Claims 5-7 stand rejected under 35 U.S.C. § 103 as unpatentable in view of the combined teachings of Spencer or Gruhn, McKay ('749) or McKay ('363), and Bradley et al. (Bradley), U.S. 3,478,389, patented November 18, 1969, or Aharoni et al. (Aharoni), U.S. Patent 4,417,031, patented November 22, 1983. Appellants state, "Claims 1-4 and 10 are considered to stand together. Claims 5-9 are considered to stand together" (Br., p.3, Grouping Of Claims). The examiner replies:

> The brief includes a statement that claims do not stand of fall together but fails to present reasons in support thereof. Therefore, these claims are presumed to stand or fall together. (Ans., p. 3)

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[2] Appellant presumes that Claim 4 stands finally rejected (Brief For Appellant, (Br.), p. 2, third full para.) and groups Claim 4 with Claims 1-3 and 10 for our review of the appealed rejections (Br., p. 3, Grouping Of Claims). So shall we. The examiner includes Claim 4 in the ***Claims appealed*** (Ans., p. 3), even though it has not been explicitly rejected.

Consistent with both appellant's and the examiner's statements, we shall consider the merits of the appealed rejections as they separately apply to Claims 1, 2 and 5. However, because we enter new grounds of rejection under 37 CFR § 1.196(b), Claims 1-10 on appeal are transcribed below.

1. An oriented polymeric monofilament having a diameter of about from 4 to 60 mils and having a cross-sectional configuration characterized by 3 to 12 striations on the circumference, each striation having a depth of about from 4 to 20% of the diameter of the monofilament.

2. A monofilament of Claim 1 having a diameter of about from 6 to 30 mils.

3. A monofilament of Claim 1 having from 5 to 10 striations.

4. A monofilament of Claim 1 wherein the striations have a depth of about from 8 to 15% of the diameter of the monofilament.

5. A monofilament of Claim 1 consisting essentially of polyamide.

6. A monofilament of Claim 5 wherein the polyamide is selected from the group consisting of nylon 66, nylon 610 and nylon 6.

7. A monofilament of Claim 6 wherein the polyamide consists essentially of nylon 66.

8. A monofilament of Claim 1 consisting essentially of polyester.

9. A monofilament of Claim 8 wherein the polyester consists essentially of polyethylene terephthalate.

10. A monofilament of Claim 3 having 8 circumferential striations.

Discussion

1. Rejections under § 102 over Spencer

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being described by Spencer. We reverse.

In our view, the rejection stands or falls depending on the meaning to be accorded "oriented polymeric monofilament" in Claim 1. During prosecution in the Patent and Trademark Office, claim language is to be given the broadest reasonable interpretation which is consistent with the description of the invention in the specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).

Appellant's specification teaches (Spec., p. 3, l. 5-13):

> The polymeric material is extruded through the die and subsequently processed according to customary techniques. The molten polymer, blended with any desired additives, is extruded through the die into a quench medium, typically water, after which it is oriented. The monofilaments should be oriented by drawing about from 3.4 to 7.0 times their original length, and preferably about

> from 3.5 to 4.7 times their original length. The drawing is generally carried out in two stages but not limited to two stages. The diameter of the final monofilament is as noted above, and is measured from crest to crest in the striations.

Accordingly, we hold that the "polymeric monofilament" of Claim 1 is a polymer which has been melt-extruded through a die to form a monofilament and quenched. We hold that an "oriented polymeric monofilament" is a "polymeric monofilament" which has been drawn by customary techniques to about from 3.4 to 7.0 times its original length. Appellant's claims are directed to "oriented polymeric monofilament" (Claim 1, line 1; emphasis added).

Spencer describes elastic rubber threads or filaments having one or more compressible projections or fins on its surface.

See Spencer, p. 1, col. l, l. 1-4, and col. 1, l. 53, to col. 2,

l. 11; and p. 2, l. 3-9. While the ratio of the height of each of Spencer's fins to the mean diameter of each filament is between 1:2 and 1:5, Spencer's elastic fins, unlike the striations which impart abrasion resistance to appellant's oriented polymeric monofilament (Spec., p. 3, l. 33, to p. 4,

l. 1), are "sufficiently yieldable so as to be deformed by a covering yarn" (Spencer, p. 3, col. 1, l. 22-24).

Spencer states (Spencer, p. 2, col. 1, l. 52-75):

> The filaments may be formed by extruding or casting latex, rubber or rubber-containing fluids, or by collecting latex or the like upon a suitable heated member, or by any combination of these or other suitable processes. For example, all of the filaments shown in Figs. 1 to 12 inclusive, may be made by extrusion through a suitable orifice, using a rubber composition which has been thickened by suitable agents such as sodium silicate so that the extruded mass retains the cross-section of the orifice until coagulation occurs. . . .
>
> The rubber filament may be formed from any suitable rubber composition whether in the form of natural or artificial dispersions of rubber or solutions or plastic compositions of natural or synthetic rubbers or suitable mixtures of the same.

However, Spencer (1) prefers "to employ latex in the manufacture of the rubber filament of the invention" (Spencer, p. 2, col. 2, l. 2-4), and (2) lacks any teaching to draw the melt-extruded, elastic polymeric monofilament from 3.4 to 7.0 times its original length.

2. Rejection under § 103 in view of Spencer or Gruhn

Claim 1 stands rejected under 35 U.S.C. § 103 as being unpatentable in view of the teaching of either Spencer or Gruhn. We reverse both of these rejections.

We hold that the claimed subject matter would not have been obvious to persons having ordinary skill in the art in view of the teaching of either Spencer or Gruhn. In paragraph 1 above, we found that Spencer does not describe an "oriented polymeric monofilament" of the shape defined by Claim 1. Moreover, Spencer's teaching, as a whole, reasonably would not have led persons having ordinary skill in the art to orient filaments made from natural or synthetic rubbers which are elastic. Elastic filaments would appear to be resistant to drawing from about 3.4 to 7.0 times its original length, and preferably from about 3.5 to 4.7 times its original length. Thus, we find that Spencer's teaching would have led persons having ordinary skill in the art away from the invention appellant claims.

Gruhn describes a strength element for fiber optic cable comprising (Gruhn, Claim 1, col. 6-7):

> . . . an elongated central portion and at least three substantially longitudinally extending ribs . . . being integrally formed of a resin material reinforced with fibers . . . selected from the group comprising glass fibers, ceramic fibers, carbon fibers and aramid fibers.

Referring to Figs. 1 and 3, Gruhn teaches (Gruhn, col. 4, l. 58, to col. 5, l. 1):

> The strength element **10** is integrally formed from a fiber reinforced resin material, wherein the resin thereof preferably comprises an epoxy or polyester resin, although the use of other resins, such as polyurethane, phenolic, or acrylic resins or mixtures of resins is contemplated. Preferably the strength element **10** contains reinforcing fibers of glass, ceramic, carbon or aramid materials, such as Kevlar (Dupont TM), or other polymeric fibers which have high moduli of elasticity and high strengths and which are embedded in the resin thereof in substantially longitudinally extending relation . . . .

While persons having ordinary skill in the art reasonably could have expected to integrally form Gruhn's fiber reinforced polymeric strength element by extrusion through a die (Gruhn, col. 2, l. 10-17), we find no teaching in Gruhn which reasonably would have led persons of ordinary skill in the art to draw a fiber reinforced strength element from about 3.4 to 7.0 times its original length, and preferably from about from 3.5 to 4.7 times its original length. Gruhn's reinforcing fibers are preferably made of glass, ceramic, aramid materials, or other polymeric materials "which have a high moduli of elasticity and high strengths and which are embedded in the resin . . . in substantially longitudinally relation" (Gruhn, col. 4, l. 66, to col. 5, l. 1). Gruhn's fiber reinforced polymeric strength elements are designed for "increased resistance to breakage

during bending of the strength element" (Gruhn, col. 5, l. 12-14) by reducing the minimum bending radius of the strength element (Gruhn, col. 5, l. 23-24). In light of Gruhn's design to increase the resistance of the fiber reinforced polymeric strength element to breakage during bending, we find that persons having ordinary skill in the art reasonably would not have further drawn an integrally formed fiber reinforced polymeric strength element to from about 3.4 to 7.0 times its original length, and preferably from about 3.5 to 4.7 times its original length and expect the element to retain its resistance to breakage during bending.

3. Rejection under § 103 over Spencer or Gruhn in view of McKay ('363) or McKay ('749)

We agree with the examiner's conclusion that subject matter encompassed by Claims 2-4 and 8-10 is unpatentable under 35 U.S.C. § 103 in view the combined teachings of Spencer or Gruhn and McKay ('363) or McKay ('749). However, our reasons for affirming the rejection differ significantly from the examiner's explanation of the rejection. We rely exclusively on the teaching of McKay ('363) or McKay ('749). Accordingly, while we affirm the examiner's holding of unpatentability under section 103 in view of prior art

teaching including McKay (‘363) or McKay (‘749), appellant may treat our decision as a NEW GROUND OF REJECTION UNDER 37 CFR § 1.196(b).

McKay (‘749) describes multifilament yarn composed of monofilaments having multilobal cross sections (McKay (‘749), col. 2, l. 20-21). McKay (‘749) teaches at col. 2, l. 28-33:

> The filaments in the yarn have a multilobal cross section with at least five lobes (preferably five to 10 lobes), wherein the lobes are essentially symmetric about a center line through the lobe, are of substantially equal length, and are substantially equally spaced about the center of the filament.

“[S]ubstantially all of the filaments should be PACM polyamide fibers with five to ten lobes . . .” (McKay (‘749), col. 3, l. 42-44; emphasis added). According to McKay (‘749)(col. 4, l. 55-67):

> . . . [I]t should be evident that filaments of a given modification ratio may have a variety of shapes. For example, while the tips of the lobes generally assume a circular configuration, this circle outlining the tip of the lobe may have a high or low radius, r_1, relative to the circumscribing radius, R_1, of the cross-section. In addition to the lobe angle, A, formed by two tangents laid at the points of inflection of curvature on each side of the lobe may be either negative or positive. The lobe angle, A, is considered to be positive when the two tangents converge outside of the cross-section on the same side of the fiber as the lobe. A positive lobe angle, A, is indicated in FIG. 1.

We find that the polyamide monofilament McKay (‘749) describes has a cross-sectional configuration characterized by 5 to 10 striations on the circumference, and each striation may have a depth within the range of about 4 to 20% of the diameter of the monofilament, as is required for the monofilaments of appellant’s Claim 1. Compare the eight lobe monofilament depicted in appellant’s only drawing.

In his single polyamide monofilament embodiment (McKay (‘749), cols. 5-6), McKay teaches (McKay (‘749), col. 5, l. 7-23; emphasis added):

> [A] PACM-12 polyamide was prepared . . . . Three different yarn samples were prepared from this type of polymer by melt spinning through a spinneret having 18 orifices. Each orifice consisted of six slots radiating from a central point with equal angles between the slots. Each of the slots was 0.004-inch wide and 0.009-inch long (maximum orifice diameter 0.018-inch). Three different modification ratios were obtained by varying the melt viscosity of the polymer within the spinneret capillary. The yarns obtained by this spinning technique were drawn about 1:6 X. The resulting yarns were about **62** denier with **18** filaments and zero twist.

This embodiment would have led persons having ordinary skill in the art to understand that the melt-extruded polyamide monofilaments which form the yarn McKay (‘749) describes are oriented polymeric monofilaments within the meaning of the term in appellant’s specification, i.e., they were melt

extruded through an orifice having a minimum diameter of 0.009-inch (9 mils)[3] and a maximum diameter of 0.018-inch (18 mils) and thereafter were drawn about from 3.4 to 7.0 times their original length (Spec., p. 3, l. 8-9).

McKay ('363) also describes multifilament yarn composed of monofilaments having multilobal cross sections (McKay ('363), col. 2, l. 32-35). However, McKay ('363) describes yarn made from polyester filaments (McKay ('363), col. 2, l. 33), preferably polyethylene terephthalate (McKay ('363), col. 3, l. 33). The yarns "comprise polyester filaments which have multilobal cross-section with 6-10 lobes which are essentially symmetric, of substantially equal length and equispaced radially about the center of the filament" (McKay ('363), col. 2, l. 43-47).

The cross-sectional view of the monofilament depicted in Fig. **1** of McKay ('363) is substantially identical to the Figure in McKay ('749) and is similarly described (McKay ('363), col. 3,

[3] According to Hackh's Chemical Dictionary, Fourth Edition, Julius Grant, ed., McGraw-Hill Book Company, New York, p. 430 (1969)(copy attached), a **mil** is "[a] measure of thickness, especially of wire: 1 mil = 1/1,000 in. . . . ."

l. 46-61). The polyester filaments "are prepared by melt-spinning filaments of higher denier and then drawing by known methods to produce filaments with denier in the required range" (McKay ('363), col. 5, l. 8-11). McKay ('363) teaches (McKay ('363), col. 5, l. 15-20):

> The drawing operation may occur after melt-spinning as a separate step or may be part of a coupled spinning and drawing operation as in Example 1. **[**On the other hand, the drawing may be done as part of a unitary draw-texturizing process as in Example IX. If one elects a "simultaneous" draw-texturizing process, partially oriented yarn is passed over a hot plate where it is both drawn and false-twisted.

McKay ('363) indicates (McKay ('363), col. 5, l. 33-44; emphasis added):

> While [draw] ratio may vary according to tension and other factors, the maximum . . . *ratio* (R) of output-to-input speed in the draw-texturing operation which is operable without excessive filament breakage is established by testing the feed yarn under a number of draw-texturing conditions. For high-speed spun partially oriented filaments, the ratio (R) is between 1.2 and 2. For slow speed spun partially oriented yarns, <u>the ratio may be as high as 6</u>. For so-called drawn yarns which are highly oriented, the maximum ratio may be as low as 1:1; in practice, such drawn yarns may be overfed to the machine to give an actual operating ratio as low as 0.90.

The respective minimum and maximum diameters of the orifices used to melt-extrude the oriented polyester monofilaments

embodied in the examples of McKay (‘363), as determined from the length of the lobe slots, are:

	Orifice Diameter	
Example	Minimum	Maximum
I	0.016 inch (16 mils)	0.032 inch (32 mils)
II	0.018 inch (18 mils)	0.036 inch (36 mils)
III-1	0.018 inch (18 mils)	0.036 inch (36 mils)
III-2	0.018 inch (18 mils)	0.036 inch (36 mils)
III-3	0.026 inch (26 mils)	0.052 inch (52 mils)
III-4	0.018 inch (18 mils)	0.036 inch (36 mils)
III-5	0.018 inch (18 mils)	0.036 inch (36 mils)
IV-1	0.015 inch (15 mils)	0.030 inch (30 mils)
IV-2	0.024 inch (24 mils)	0.048 inch (48 mils)
VI	0.016 inch (16 mils)	0.032 inch (32 mils)
VII	0.018 inch (18 mils)	0.036 inch (36 mils)
IX	0.0112 inch (11.2 mils)	0.0224 inch (22.4 mils)

In view of the teaching of McKay (’749) or (McKay (‘363), we hold that subject matter of appellant’s Claims 2-4 and 8-10 is prima facie unpatentable under 35 U.S.C. § 103. An oriented polyamide monofilament of Claim 5 would have been prima facie obvious to a person having ordinary skill in the art in view of the teaching of McKay (‘749) alone. An oriented polyester monofilament of Claims 8 and 9 would have been prima facie obvious to a person having ordinary skill in the art in view of the teaching of McKay (‘363) alone.

Appellant attempts to distinguish the claimed oriented monofilaments from the oriented polymeric monofilaments taught in McKay (‘749) and McKay (‘363) on the basis of size and utility. In his Brief, appellant argues that McKay (1) uses his monofilaments to improve the visual aesthetics of fabrics made from yarn composed of the monofilaments, and (2) is not at all interested in abrasion resistance and does not recognize the

uses which appellant alone discovered for abrasion resistant monofilaments of the same cross-sectional configuration (Br., pp. 6-7, bridging para.). In the Amendment filed January 24, 1994 (Paper No. 4), appellant pointed to distinctions in both size and purpose (pp. 3-4, bridging para.):

> . . . McKay, in both ‘363 and ‘749, deals with textile filaments which differ in size and purpose from the presently claimed monofilaments. Specifically, the objects of the McKay patent are to provide a textile filament having reduced glitter or sparkle . . . . The solution provided by McKay, in a textile filament, is to provide false-twist textured yarns having recognizable multi-lobal cross-section having deviations from pure symmetry. The required number of lobes (N) is between 6-10, and the modification ratio (M) is between 1.17 and 1.85 and the filament denier is more

> than 3.8 and less than (5.88M-10+N). The applicants have calculated the maximum denier of McKay to be 10.88. By contrast, the required diameter in the present claims would result in a product several times as big, ranging from 78-22,608 denier per filament. It is respectfully submitted that the skilled artisan would have no reason to extrapolate any teachings relating to the fine textile filaments shown in either of the McKay patents to the large monofilaments of the present claims, particularly when the basic advantages of the McKay patents, that is, visual aesthetics, are entirely inapplicable to the present striated monofilaments, designed for papermaking belts.

The argued distinction based on utility is immaterial to the patentability of the claimed subject matter under 35 U.S.C. § 103 in view of the monofilament taught by McKay. See In re Dillon, 919 F.2d 688, 693, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (in banc), cert. denied sub nom. Dillon v. Manbeck, 500 U.S. 904 (1991)(footnote omitted):

> Each situation must be considered on its own facts, but it is not necessary in order to establish a *prima facie* case of obviousness that both a structural similarity between a claimed and prior art compound . . . be shown and that there be a suggestion in or expectation from *the prior art* that the claimed compound or composition will have the same or a similar utility *as one newly discovered by applicant* . . . .[T]he statement that a

> prima facie obviousness rejection is not supported if no reference shows or suggests the newly-discovered properties and results . . . is not the law.

Appellant's arguments with regard to size distinctions and his support therefor are somewhat confusing. First, the record does not show how McKay's maximum acceptable denier of 10.88 was calculated. Second, given that maximum calculated denier, the record is unclear as to why the diameter of the presently claimed oriented polymeric monofilament is necessarily several times bigger than the diameter of the monofilaments taught by McKay. Hackh's Chemical Dictionary, supra, at page 202 (copy attached), defines "denier" as "[t]he thickness of a thread or yarn expressed as the weight in grams of 9,000 meters. Cf. *tex*." However, the thickness of the oriented polymeric monofilament of appellant's claims is defined solely in linear terms, i.e., in mils. Appellant has not explained why the claimed oriented polyamide or polyester multilobal monofilament which has a diameter of about 4 to 60 mils would not have been obvious to persons having ordinary skill in the art in view of McKay's teaching of polyamide or polyester multilobal monofilament having a diameter of about 11 to 52 mils.

We say again, during prosecution in the Patent Office, claim language is to be given the broadest reasonable interpretation which is consistent with the description of the invention in the specification. In re Zletz, 893 F.2d at 321, 13 USPQ2d at 1322; In re Prater, 415 F.2d at 1404-05, 162 USPQ at 550-51. The oriented polymeric monofilament of appellants' claims is defined solely in terms of monofilament configuration, monofilament diameter, and polymer type. An invention encompassed by appellant's claims would have been obvious to a person having ordinary skill in the art in view of McKay's teachings of monofilaments of the same configuration, the same diameter, and the same polymer type. As said in In re Zletz, 893 F.2d at 321, 13 USPQ2d at 1322:

> During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. . . . The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.

4. Rejection under § 103 in view of the teaching of Spencer or Gruhn in view of McKay ('749) or McKay ('363) and Bradley or Aharoni

We agree with the examiner's conclusion that subject matter encompassed by Claims 5 to 7 is unpatentable under

35 U.S.C. § 103 in view the combined teachings of Spencer or Gruhn, McKay (‘363) or McKay (‘749), and Bradley or Aharoni. However, our reasons for affirming the rejection again differ significantly from the examiner’s explanation of the rejection. We rely exclusively on the teachings of McKay (‘749) and Bradley. Accordingly, while we affirm the examiner’s holding of unpatentability under section 103 in view of combined prior art teachings including McKay (‘749) and Bradley, appellant also may treat this decision as a NEW GROUND OF REJECTION UNDER 37 CFR
§ 1.196(b).

More specifically, we affirm the examiner’s rejection of Claims 5 to 7 under 35 U.S.C. § 103 in view of all combinations of prior art including McKay (‘749) and Bradley. We reverse the examiner’s rejection of Claims 5 to 7 under 35 U.S.C. § 103 in view of all combinations of prior art including McKay (‘363). Claims 5 to 7 are directed to oriented polyamide monofilament. McKay (‘749) teaches oriented polyamide monofilament. McKay (‘363) teaches oriented polyester monofilament. Since Bradley’s teaching is cumulative of Aharoni’s teaching relative to the subject matter claimed, we only need consider Bradley’s teaching.

Bradley describes an improved spinneret assembly, including specially shaped extrusion die orifices, for extruding molten polymer into filaments of noncircular cross section and melt spinning the filaments into yarn. See Bradley, col. 2, l. 2-15, and col. 2, l. 42-44. See especially Figures 4 and 5 for five and ten-lobal cross sectional filaments (Bradley, col. 4, l. 1-21). Bradley's modification of conventional spinneret assemblies (Bradley, col. 6, l. 65, col. 7, l. 11):

> . . . extends the range of shape definition possible for a given spinneret orifice under practical operating spinning conditions. It is particularly applicable to orifices comprised of multiple intersecting slots, such as Y-section, cruciform, star, and like sections. The invention is applicable to wet spinning and dry spinning but is especially useful in melt-spinning. Specific polymeric materials capable of being melt-spun include nylon-66 (polyhexamethylene adipamide), nylon-6 (polycaprolactam), nylon-4, nylon-610, nylon-11 and their filament-forming copolymers; e.g., nylon-6/66, nylon-6/610/66, etc.; polyesters derived for example from terephthalic acid or derivatives thereof . . . . With an appropriate molten polymer distribution system the spinneret herein can be used to produce multi-component filaments having an eccentric arrangement of dissimilar polymers. The actual dimensions of the openings and ball depend, of course, upon the characteristics of the polymer, the filament size or denier, the spinning speed, the temperature, and other factors in the particular spinning process.

The melt-spinning processes of Bradley's Examples II and III are particularly relevant to appellant's claimed invention because they respectively describe production of five- and ten-star Nylon-66 filaments and yarn melt-spun therefrom (Bradley, col. 5, l. 25, to col. 6, l. 64). In Example II, each slot of the five slot die used to produce five-lobe, star-shaped filament was 25 mils long, i.e., minimum orifice diameter of 25 mils and maximum orifice diameter of 50 mils (Bradley, col. 5, l. 31-33). In Example III, each slot of the ten slot die used to produce ten-lobe, star-shaped filament was 50 mils long (including the 10 mil diameter of the orifice core), i.e., a minimum orifice diameter of 50 mils and a maximum orifice diameter of 100 mils (Bradley, col. 6, l. 14-20). Bradley further teaches that the Example II "[s]amples of yarn were drawtwisted at a draw ratio of 4.23 . . . and the pentagonal filaments had more luster . . . and superior snag resistance . . . " (Bradley, col. 5, l. 74, to col. 6, l. 7). The spun filaments of Example III "were subsequently drawtwisted at 3.93 draw ratio" (Bradley, col. 6, l. 33-35) and "these filaments imparted a highly attractive soft silky sheen" (Bradley, col. 6, l. 63-64).

We find that Bradley broadly describes production of oriented polyamide filaments of a kind, size and configuration encompassed by appellant's Claims 1, 3, 5, 6, and 7. Moreover, we find Bradley's teaching as pertinent, if not more pertinent, to the subject matter appellant claims than McKay's disclosures. Bradley describes oriented polyamide filaments of a kind, size and configuration encompassed by appellant's Claims 1, 3, 5, 6, and 7. Moreover, we conclude that oriented polyamide monofilament of a kind, size, and configuration indicated in appellant's Claims 1-7 would have been prima facie obvious to persons having ordinary skill in the art in view of the combined teachings of McKay ('749) and Bradley. Furthermore, we conclude that an oriented polyester monofilament of a kind, size, and configuration indicated in appellant's Claims 1-4 and 8-10 would have been prima facie obvious to persons having ordinary skill in the art in view of the combined teachings of McKay ('363) and Bradley.

We have discussed appellant's response to the teachings of McKay. Appellant's remarks with regard to Bradley's disclosure are even less convincing. Appellant argues (Br., p. 7, second full para.):

> Bradley et al. describes a spinneret assembly. The

present application does not relate to a spinneret assembly.
The subject matter is thus unrelated and 35 U.S.C. § 103 is
not applicable.

Needless to say, we are not persuaded by appellant's argument that the subject matter claimed is patentable over the applied prior art. It is an axiom of patent law that a patent cited as basis for a rejection under 35 U.S.C. § 103 should be read for everything it fairly teaches, and not be limited to the subject matter the patentee regards as his invention and claims. See EWP Corp. v. Reliance Universal Inc., 755 F.2d 898, 907, 225 USPQ 20, 25 (Fed. Cir.), cert. denied, 474 U.S. 843 (1985)("A reference must be considered for everything it teaches by way of technology and is not limited to the particular invention it is describing and attempting to protect."); see also In re Lamberti, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976)(A reference must be considered in its entirety. The disclosure is not limited to the specific working examples.)

Conclusion

1. We reverse the examiner's rejection of Claim 1 under 35 U.S.C. § 102(b) over Spencer.

2. We reverse the examiner's rejection of Claim 1 as being unpatentable under 35 U.S.C. § 103 in view of the teaching of Spencer or Gruhn.

3. We affirm the rejection of Claims 2-4 and 10 as being unpatentable under 35 U.S.C. § 103 in view of the teaching of McKay ('749) or McKay ('363), with or without the teaching of Spencer or Gruhn.

4. We affirm the rejection of Claims 8 and 9 as being unpatentable under 35 U.S.C. § 103 in view of the teaching of McKay ('363), with or without the teaching Spencer or Gruhn.

5. We reverse the rejection of Claims 8 and 9 as being unpatentable under 35 U.S.C. § 103 in view of the combined teachings of McKay ('749) and Spencer or Gruhn.

6. We affirm the rejection of Claim 5 as being unpatentable under 35 U.S.C. § 103 in view of the teaching of McKay ('363), with or without the teaching of Bradley or Aharoni.

7. We affirm the rejection of Claims 5-7 as being unpatentable under 35 U.S.C. § 103 in view of the combined teachings of McKay ('363) and Bradley or Aharoni.

8. We affirm the rejection of Claims 5-7 as being unpatentable under 35 U.S.C. § 103 in view of the teaching of Bradley.

9. We dismiss the appeal as it applies to the invention of restricted Claim 12. Claim 12 was withdrawn from further consideration by the examiner as drawn to a nonelected invention subject to restriction. The examiner's restriction requirement is not subject to review on appeal under 35 U.S.C. § 134.

Because we affirm the rejections in paragraphs 3, 4, 6, 7 and 8 above for reasons which are substantially different than those proffered by the examiner, appellant may treat the rejections affirmed in paragraphs 3, 4, 6, 7, and 8 above as NEW GROUNDS OF REJECTION UNDER 37 CFR § 1.196(b).

NEW GROUNDS OF REJECTION UNDER 37 CFR § 1.196(b)

1. Claim 1 is hereby newly rejected under 35 U.S.C. § 103 as being unpatentable in view of McKay ('749) or McKay ('363). See pages 9-16, supra.

2. Claims 1, 3, 8 and 9 are hereby newly rejected under 35 U.S.C. § 103 as being unpatentable in view of Bradley. See pages 18-21, supra.

3. Claims 1-4 are hereby newly rejected under 35 U.S.C. § 103 as being unpatentable in view of the combined teachings of either McKay ('749) or McKay ('363) and Bradley. See pages 9-21, supra.

4. Claims 8-10 are hereby newly rejected under 35 U.S.C. § 103 as being unpatentable in view of the combined teachings of McKay ('363) and Bradley. See pages 9-21, supra.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

> (b) Appellant may file a single request for rehearing within two months from the date of the original decision . . . .

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere

incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART, 37 CFR § 1.196(b)

EDWARD C. KIMLIN Administrative Patent Judge	)	
TEDDY S. GRON Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES

)
)
CHARLES F. WARREN)
Administrative Patent Judge)

bae

Appeal No. 95-2622
Application 08/125,524

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