

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Liza M. Monette, Arnold Lustiger, Michael P. Anderson, John P. Dismukes, H. Daniel Wagner, Cary N. Marzinsky, and Russell R. Mueller

Appeal No. 1996-3974
Application 08/198,808

ON BRIEF

Before STONER, Chief Administrative Patent Judge,
HARKCOM, Vice Chief Administrative Patent Judge, and
WILLIAM F. SMITH, Administrative Patent Judge.

Per Curiam.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 19-23 and 25, all of the claims in the application. The claimed invention is directed to a computer-implemented method for making a composite, incorporating a fiber, a matrix and an interphase, that has optimum properties. Claim 19, the only independent claim, is reproduced at page 11 of the brief.

The following reference is relied on by the examiner:

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Hobbs

3,812,077

May 21, 1974

Claims 19-23 and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hobbs. Alternatively, claims 19-23 and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hobbs.

Rather than reiterate the arguments of the appellant and the examiner, reference is made to the Appeal Brief and the Examiner's Answer, where appropriate, for the respective details thereof.

OPINION

As a preliminary matter, claims 20-23 and 25 are dependent upon independent claim 19. The appellant states that the claims should be considered as a single grouping and that they stand or fall together. [See Appeal Brief, page 5.] We concur with appellant's position. Accordingly, with respect to patentability, all of the claims stand or fall together. [See 37 C.F.R. § 1.192(c)(5) and M.P.E.P. § 1206.]

We have carefully reviewed the positions of the appellant and the examiner, and have conducted a thorough study of the reference relied on by the examiner in formulating the rejections. As a result of this review, we reverse the rejections of claims 19-23 and 25.

Independent claim 19 is rejected under 35 U.S.C. § 102 (b) as being anticipated by Hobbs. Anticipation analysis is a two-step process. In the first step, the claim must be properly construed. Elmer v. ICC Fabricating, Inc., 67 F.3d 1571, 1574, 36 USPQ2d 1417, 1419 (Fed. Cir. 1995). In this case that means that claim 19 must be given its broadest reasonable interpretation. See, e.g., In re Graves, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995). Thus, a determination must be made whether the interpretation of the disputed claim language is "reasonable." In re Morris, 127 F.3d 1048, 1055, 44 USPQ2d 1023, 1028-29 (Fed. Cir. 1997). In the second step, a determination must be made whether all of the elements of the claim, as properly construed, are disclosed in the prior art reference.

In the present instance, the examiner's determination of anticipation fails both steps in the anticipation analysis.

Method claim 19 comprises an introduction and six distinct steps (a) through (f). The examiner states that the recitation of the use of the "nodal model" should be construed as the equivalent of mental steps and should not be given "probative value over and above a mental step." In essence, the examiner construes claim 19 as merely the "making a selection of fiber, matrix and interphase and the formation of a composite." [See Examiner's Answer, page 3.]

In construing claim 19 as stated above, the examiner has totally disregarded method steps (a) through (e). These steps actually contain the detailed provisions of the computer-

implemented process, which implement the “nodal model” on either an analog or digital computer. We find the examiner’s total disregard for these claim provisions to be unreasonable. In order to properly evaluate this claim, all of the method steps must be considered.

So far as the second step of the anticipation analysis is concerned, the examiner has provided Hobbs merely to show that a composite incorporating a fiber, a matrix and an interphase can indeed be formed. [See Examiner’s Answer, pages 3-4.] Hobbs fails to disclose the detailed computer-implemented process steps (a) through (e). Thus, we reverse the rejection of claim 19 under 35 U.S.C. § 102 (b).

Independent claim 19 is also rejected under 35 U.S.C. § 103 as being unpatentable over Hobbs. In making a rejection under 35 U.S.C. § 103, the burden is on the examiner to establish a prima facie case of obviousness. In order to carry this burden, the examiner must establish why one having ordinary skill in the art would have been led to the claimed invention by the reasonable teachings or suggestions found in the prior art, or by a reasonable inference to the artisan contained in such teachings or suggestions. See In re Semaker, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983).

The examiner’s only support for this rejection is stated as “it is the position of the examiner that it would have been well within the scope to the ordinary skill in the art to consider any of the parameters claimed by applicant and make a determination of suitable values for such parameters consistent with the intended end use.” [See Examiner’s Answer, page 4.] The above statement of the examiner’s position fails to demonstrate how or why the claim limitations would have been obvious to one of ordinary skill in the art at the time of the invention. As a result, the examiner has failed to make a prima facie case of obviousness. Thus, we reverse the rejection of claim 19 under 35 U.S.C. § 103.

In summation, we reverse the final rejection of claims 19-23 and 25 under 35 U.S.C. § 102(b) as being anticipated by Hobbs, and alternately, under 35 U.S.C. § 103 as being unpatentable over Hobbs.

REVERSED

BRUCE H. STONER, JR., Chief)
Administrative Patent Judge)
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) BOARD OF PATENT
GARY V. HARKCOM, Vice Chief) APPEALS AND
Administrative Patent Judge) INTERFERENCES
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