

THIS OPINION IS NOT BINDING PRECEDENT

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN B. YATES

Appeal 97-1803
Application 08/300,902¹

Before: McKELVEY, Senior Administrative Patent Judge, and
LEE and TORCZON, Administrative Patent Judges.

McKELVEY, Senior Administrative Patent Judge.

Decision on appeal under 35 U.S.C. § 134

Upon consideration of the BRIEF ON APPEAL (Paper 18) and
the EXAMINER'S ANSWER (Paper 19), there being no rely brief,
it is

¹ Application for patent filed 1 September 1994. The real party in interest is General Electric Company.

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ORDERED that the examiner's rejection of claims 1-5, 7 and 9-11 as being unpatentable under 35 U.S.C. § 103 over Gianchandai in view of Brown and Gallucci is reversed.

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The claimed composition calls for a three-element composition comprising (1) a poly(phenylene ether) resin, (2) a polyester resin and (3) a flow promoting amide. The examiner found prior art references describing each of the three elements, some in combination with others. Based on the prior art the examiner reasoned that the claimed three-element composition would have been obvious.

Our appellate reviewing court recently made the following observation in Smiths Industries Medical Systems v. Vital Signs, 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1420 (Fed. Cir. 1999):

There is no basis for concluding that an invention would have been obvious solely because it is a combination of elements that were known in the art at the time of the invention. The relevant inquiry is whether there is a reason, suggestion, or motivation in the prior art that would lead one of

ordinary skill in the art to combine the teachings of the references, and that would also suggest a reasonable likelihood of success. Such a suggestion or motivation may come from the references themselves, from knowledge by those skilled in the art that certain references are of special interest in a field or even from the nature of the problem to be solved. The district court never identified the source of the various claim limitations in the prior art, much less a motivation, teaching or suggestion to combine them.

The examiner has not identified in the prior art relied upon where there is a reason, suggestion or motivation to make the claimed three-element composition. Gianchandai describes compositions containing a poly(phenylene ether) resin and an amide. No mention is made of a polyester. Moreover, when Gianchandai gets around to talking about increased flow, it describes addition of a styrene resin, not a polyester (col. 5, line 60 et seq.).

When making a rejection, it is incumbent on the examiner to refer to specific passages in the prior art relied upon and

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not just a reference as a whole. Cf. Clintec Nutrition Co. v. Baxa Corp., 44 USPQ2d 1719, 1723 n.16 (N.D. Ill. 1997) (where a party points the court to multi-page exhibits without citing a specific portion or page, the court will not pour over the documents to extract the relevant information, citing United States v. Dunkel, 927 F.2d 955, 956 (7th Cir. 1991) (judges do not hunt for truffles buried in briefs)). The examiner's answer in this appeal is at best an invitation to the board to scour the record, research any legal theory that comes to mind, and serve generally the function of a patent examiner. We decline the invitation, believing it appropriate for the examiner in the first instance to fully explain why a rejection is proper. Cf. Ernst Haas Studio, Inc. v. Palm Press, Inc., 164 F.3d 110, 112, 49 USPQ2d 1377, 1379 (2d Cir. 1999).

REVERSED.

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FRED E. McKELVEY, Senior)	
Administrative Patent Judge)	
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JAMESON LEE)	BOARD OF PATENT
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