

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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID J. ZANIG,
PAUL H. SANDSTROM, JOSEPH W. MILLER
and RICHARD R. SMITH

Appeal No. 1998-3256
Application 08/692,325

ON BRIEF

Before WARREN, KRATZ and TIMM, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellants, in the brief, and based on our review, find that we cannot sustain the rejections of appealed claims 1 through 5, 7, 8 and 10 under 35 U.S.C. § 102(b) as being anticipated by Smith; of appealed claims 1 through 10 under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of Obrecht et al. (Obrecht) and Sandstrom et al. (Sandstrom); of 1, 2 and 6 through 10 under § 102(b) as being anticipated by Ogawa et al. (Ogawa); and of appealed claims 1 through 10 under § 103(a) as being unpatentable over Ogawa in view of Smith, Obrecht and

Sandstrom.^{1, 2} For the reasons pointed out by appellants in the brief, the examiner has failed to make out a *prima facie* case with respect to each of the grounds of rejection. We add the following for emphasis.

Appealed claim 1 is essentially styled in product-by-process format because the recitation “a dried rubber derived from a second blend of rubber lattices, said second blend of rubber latex containing styrene-butadiene rubber later and acrylonitrile-butadiene rubber latex” would be interpreted by one of ordinary skill in the art in light of the specification to include rubbers prepared by a process that includes drying the said blend of rubber lattices (see specification, e.g., page 5, lines 8-13). *See, e.g., In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A *prima facie* case of anticipation is established when it reasonably appears from the prior art that the claimed products are identical to the prior art products, and the PTO bears a lesser burden of proof with respect to claims styled in product-by-process format. *See generally, In re Spada*, 911 F.2d 705, 707-08, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990) (“The Board held that the compositions claimed by Spada ‘appear to be identical’ to those described by Smith. While Spada criticizes the usage of the word ‘appear’, we think that it was reasonable for the PTO to infer that the polymerization by both Smith and Spada of identical monomers, employing the same or similar polymerization techniques, would produce polymers having the identical composition.”).

In this case, the examiner initially stated that appealed claim 1 was anticipated by either Smith or Ogawa which disclosed the *mixing* of a *dried* styrene-butadiene rubber and a *dried* acrylonitrile-butadiene rubber, and did not rebut the appellants’ supported arguments that a different product was produced by *drying a blend* of styrene-butadiene and acrylonitrile-butadiene lattices as specified in this claim. Accordingly, to the extent that the examiner had established a *prima facie* case of anticipation, it was rebutted by appellants’ arguments, shifting the burden back to the examiner to again establish a

¹ Claims 1 through 10 are all of the claims in the application. See the specification, pages 19-21 and the amendments of January 16, 1995 in parent application 08/518,449 (Paper No. 3).

² The grounds of rejection are set forth on pages 3-4 of the answer.

prima facie case of anticipation in order to maintain the grounds of rejection under § 102(b). *See generally, Spada*, 911 F.2d at 707 n.3, 15 USPQ2d at 1657 n.3.

The examiner also does not address the apparent differences between the claimed and prior art products in the grounds of rejection under § 103(a), and in any event, as further pointed out by appellants, the examiner does not rely on either of Obrecht and Sandstrom with respect to the basic differences between the tread compositions of appealed claim 1 and those of Smith or Ogawa. Thus, the examiner has also failed to establish a *prima facie* case of obviousness as well. *See generally, In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

The examiner's decision is reversed.

Reversed

CHARLES F. WARREN)	
Administrative Patent Judge)	
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)	
PETER F. KRATZ)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
CATHERINE TIMM)	
Administrative Patent Judge)	

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