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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TERUYOSHI TAKATA

Appeal 2014-008153
Application 11/792,718
Technology Center 3700

Before ANNETTE R. REIMERS, THOMAS F. SMEGAL, and
ERIC C. JESCHKE, *Administrative Patent Judges*.

JESCHKE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Teruyoshi Takata (“Appellant”) seeks review under 35 U.S.C. § 134(a) of the Examiner’s decision, as set forth in the Final Office Action dated October 22, 2013 (“Final Act.”), rejecting claims 1–9 and 11–16.¹ We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Appellant identifies SHOWA GLOVE CO. of Himeji-shi, Japan as the real party in interest. Appeal Br. 3.

BACKGROUND

The disclosed subject matter “relates to a cut-resistant glove.”

Spec. 1. Claim 1, the sole independent claim, is reproduced below:

1. A cut-resistant glove which is formed of a composite yarn comprising a core and a covering layer formed by wrapping a covering fiber around the core, the core being composed of a metal thin wire having a thickness of 10 to 70 μm and an attending yarn comprising 100 to 1000 non-processed resin filaments, having 50 to 600 denier,

wherein the glove is plated with a synthetic fiber or a natural fiber in such a manner that the plated fiber is set in the inside of the glove, and

wherein the surface of the glove is coated with a rubber compound solution or a resin compound solution.

REJECTIONS

1. Claim 16 stands rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter regarded as the invention.²

2. Claims 1–8 and 11–16 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Bettcher (US 5,070,540, issued Dec. 10, 1991),

² The Examiner rejected claims 11 and 12 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter regarded as the invention. *See* Final Act. 4. In the Answer, the Examiner withdraws this rejection as to claim 12. *See* Ans. 2. Claim 11 was rejected as depending from a canceled claim. *See* Final Act. 4. In an Advisory Action dated April 9, 2014, the Examiner entered amendments (dated March 21, 2014) that address the issue regarding claim 11.

Andrews (US 5,965,223, issued Oct. 12, 1999), and Knudsen (US 2004/0069132 A1, published Apr. 15, 2004).³

3. Claim 9 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Bettcher, Andrews, Knudsen, and Olinger (US 6,880,320 B2, issued Apr. 19, 2005).

DISCUSSION

Rejection 1 – The rejection of claim 16 under 35 U.S.C. § 112, second paragraph

The Examiner rejected claim 16, stating that the following phrases lack sufficient antecedent basis: “the number”; “the wrapping turns”; and “the length.” Final Act. 4.

Appellant argues that “these terms have inherent antecedent basis in the recitation of the base claim, and therefore there is no need for additional antecedent basis.” Appeal Br. 7 (citing MPEP § 2173.05(e)). After highlighting the claim’s recitation of “a covering layer formed by wrapping a covering fiber around the core,” Appellant argues that “the process of wrapping a covering fiber would inherently produce wrapping turns, and that these turns could be counted, so there would inherently be a measurable ‘number of the wrapping turns.’” *Id.* at 8. Appellant argues that the recited “turns per one meter of the length of the core” is “an intrinsic unit having inherent antecedent basis, since there are inherently wrapping turns.” *Id.*

³ The Examiner does not list claims 11 and 12 in the header for Rejection 2 (Final Act. 4) but does discuss those claims in the body of Rejection 2 (*see id.* at 4–6 (claim 12), 7 (claim 11)). As such, we consider the failure to include claims 11 and 12 in the header for Rejection 2 as a typographical error.

The Examiner “disagrees . . . that the number of the wrapping turns is an inherent feature of the covering fiber” and states, “nor is the length an inherent feature of the core.” Ans. 2.

For the reasons argued by Appellant (Appeal Br. 7–8), we do not sustain the rejection of claim 16 under 35 U.S.C. § 112, second paragraph.

*Rejection 2 – The rejection of claims 1–8 and
13–16 under 35 U.S.C. § 103(a)*

For this Rejection, Appellant argues the patentability of independent claim 1 and does not separately argue claims 2–8 and 11–16, which depend from claim 1. Appeal Br. 9–14. Thus, we address only claim 1, with claims 2–8 and 11–16 standing or falling with claim 1. *See* 37 C.F.R. § 41.37 (c)(1)(iv) (2013). The Examiner rejected claim 1 as unpatentable over Bettcher, Andrews, and Knudsen. *See* Final Act. 4–6.

Appellant argues that “there are unexpected results commensurate in scope with” claim 1, as evidenced by “the Examples in the specification and in the Declaration under 37 CFR 1.132 filed on June 19, 2013 (the Declaration by Teroyushi TAKATA signed May 1, 2013) demonstrating the unexpected results.” Appeal Br. 10.⁴

First, as to the Examples in the Specification, Appellant argues that “one of the effects of the present invention is that in the glove of the present invention, the rubber or the resin compound solution recited in the last clause of claim 1 does not strike through the surface of the knitted glove.” Appeal Br. 10. Appellant argues that “Examples 1 to 12 of the [S]pecification represent cases where the knitted glove fitted on a glove

⁴ We will refer to this declaration as the “Takata Declaration.”

mold is immersed in a coagulant prior to immersion in a rubber or resin compound solution, and the obtained glove has a contact of the wooly nylon with the skin of a hand.” *Id.* at 10–11 (citing various passages from the Specification). Appellant contends that “Examples 13 to 16 represent cases where the knitted glove fitted on a glove is heated prior to immersion, then immersed in a rubber or resin compound solution containing a heat sensitizer, and the obtained gloves have good touch and strong feeling and excellent sweat absorption property.” *Id.* at 11 (internal citation omitted) (citing various passages from the Specification). Appellant continues that “Example 19 represents a case where the knitted glove is subjected to oil repellent treatment prior to immersion, and the obtained glove has a contact of the FTY in the inside with the skin of a hand.”⁵ *Id.* (citing Spec. 45, ll. 2–3). According to Appellant, these “effects could not be provided if the rubber or the resin compound solution struck through the surface of the knitted glove.” *Id.* Appellant “submits that these effects of the present invention are commensurate in scope with the claims and represent an unexpected effect over the prior art.” *Id.*

The Examiner responds that the feature of the “rubber or resin compound solution . . . not strik[ing] through the surface of the claimed knitted glove . . . is not claimed and therefore has not been considered.” Ans. 2–3.

Appellant replies that “there is no requirement that the unexpected result explicitly be ‘claimed,’ that is, recited in the claim” and that “[t]he relevant requirement, as stated in MPEP 716.02(d), is for ‘unexpected results

⁵ “FTY” refers to “false twist yarn.” *See* Spec. 24, ll. 2–3.

commensurate in scope with the claimed invention.” Reply Br. 3–4. According to Appellant, “the unexpected result of the invention is supported by the disclosure in the specification, and the result is commensurate in scope with the claims.” *Id.* at 4.

We are not apprised of error in the rejection of claim 1 based on this argument. Claim 1 recites that “the surface of the glove *is coated* with a rubber compound solution or a resin compound solution.” Appeal Br. 18 (Claims App.) (emphasis added). Here, we agree with the Examiner that the relied-upon feature—the “rubber compound solution” or “resin compound solution” not penetrating through the inner “synthetic fiber” or “natural fiber” plating—is not recited and does not necessarily flow from claim 1. In other words, a glove could satisfy the limitation that “the surface of the glove is coated with a rubber compound solution or a resin compound solution” and *also* have the “rubber compound solution” or “resin compound solution” penetrate through the inner “synthetic fiber” or “natural fiber” plating. Thus, here, the allegedly unexpected results are not commensurate in scope with claim 1. *See In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983) (determining that results from experiments using only sodium could not provide evidence to rebut a prima facie case of obviousness where the claim was broader than compounds with just sodium).

Moreover, even if the relied-upon feature—again, the “rubber compound solution” or “resin compound solution” not penetrating through the inner “synthetic fiber” or “natural fiber” plating—were assumed to either be recited in or necessarily flow from claim 1 (and not be in the prior art), Appellant has not provided *objective evidence*—rather than attorney argument—showing that the results of this feature (underlined in Appellant’s

arguments above) were *unexpected*. See *In re Mayne*, 104 F.3d 1339, 1343 (Fed. Cir. 1997) (“With a factual foundation for its prima facie case of obviousness shown, the burden shifts to applicants to demonstrate that their claimed [invention] possess an unexpected property over the prior art.”); *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997) (stating that unsupported attorney argument as to unexpected results is entitled to little weight); see also *In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984) (“It is well settled that unexpected results must be established by factual evidence.”).

Second, Appellant summarizes the Takata Declaration, which discusses (1) a “Glove A,” which, according to Appellant “[wa]s prepared, based on the glove of [Bettcher], modified to use a first filament bundle as in Knudsen” and (2) a “Glove B,” which, according to Appellant, was “the glove of Example 12 on page 35 of the present [S]pecification.” Appeal Br. 11, 12. Appellant argues that, “as evidenced in the [Takata] Declaration, the obtained Glove A is much tougher and coarser than Glove B.” *Id.* at 12; see also Takata Dec. 3 (“The thus obtain[e]d glove A is much tougher and coarser as compared with the glove B of the present invention (Example 12).”), 3–4 (stating that “even if the fiber strand of [Bettcher] is displaced with the first filament bundle of [Knudsen], the glove excellent in workability (softness) and touch feeling intended by the present invention cannot be provided”). Appellant contends that “a glove having the limitations of claim 1 of the present invention is clearly superior to the prior art, and moreover, even when a combination of Bettcher and Knudsen is prepared not meeting all of the limitations of claim 1, the result is clearly inferior to the present invention.” *Id.* at 14.

We are not apprised of error based on this argument. As noted by the Examiner, the Takata Declaration “is drawn to one example of what materials could be used for the glove and is not commensurate with the scope of the claims, which recites variable ranges for materials such as the range of thickness of the core, the number of attending yarns, and the denier of the filaments.” Ans. 3. Indeed, the discussion of Example 12 in the Specification identifies specific materials for the recited “composite yarn” and specific materials—namely “polyurethane fiber with 40D” and “wooly-processed nylon fibers with 70D/24F”—for the recited “plated fiber . . . set in the inside of the glove.” *See* Spec. 35–36. Thus, the allegedly unexpected results are not commensurate in scope with claim 1. *See Grasselli*, 713 F.2d at 743.

Further, although the Takata Declaration does state the alleged *superiority* of Glove B over Glove A, the Declaration does not provide objective evidence as to why these results would have been *unexpected*. *See, e.g., Mayne*, 104 F.3d at 1343 (“An applicant may make this showing with evidence that the claimed invention exhibits some superior property or advantage that a person of ordinary skill in the relevant art would find surprising or unexpected.”). Instead, Appellant provides only attorney argument that these results would have been unexpected. *See, e.g., Appeal Br. 14* (“The effect described is therefore an unexpected, advantageous result commensurate in scope with claim 1 . . .”). This does not suffice to demonstrate unexpected results. *See Geisler*, 116 F.3d at 1470.

Contrary to Appellant’s position, after the Examiner set forth a prima facie case of obviousness (which Appellant has not contested), the burden of production resided with Appellant to show the results were *unexpected*. *See*

Mayne, 104 F.3d at 1343. The Examiner did not need to show that the results were expected. *Cf.* Appeal Br. 13 (discussing Final Act. 3 and arguing that “the Examiner does not appear to have provided any citation of the references or the prior art indicating that the effects would have been expected”).

For these reasons, we sustain the rejection of independent claim 1. Claims 2–8 and 13–16 fall with claim 1.

Rejection 3 – The rejection of claim 9 under 35 U.S.C. § 103(a)

The Examiner rejected claim 9 as unpatentable over Bettcher, Andrews, Knudsen, and Olinger. *See* Final Act. 8.

Noting that claim 9 depends from claim 1, Appellant first relies on the arguments set forth above regarding claim 1 (*see supra* Rejection 2). Appeal Br. 15. Appellant also “submits that the effects of the present invention are unexpected over the Olinger reference.” *Id.* According to Appellant, “[t]here is nothing in [the relied-upon] disclosure [in Olinger] that would predict the demonstrated effect of the present invention.” *Id.* at 16.

We are not apprised of error in the rejection of claim 9. First, for the same reasons discussed above, Appellant has not demonstrated error in the rejection of claim 1, from which claim 9 depends. Second, as also discussed above, the Examiner does not (and need not) rely on Olinger to address the allegedly unexpected results argued with regard to claim 1. Thus, we sustain the rejection of claim 9.

DECISION

We REVERSE the decision to reject claim 16 under 35 U.S.C. § 112, second paragraph, and AFFIRM the decision to reject claims 1–9 and 11–16 under 35 U.S.C. § 103(a).⁶

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

⁶ See 37 C.F.R. § 41.50(a)(1) (“The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed.”).