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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARCO NAHMIAS, LUCA GIANNINI, and
ANGELA LOSTRITTO

Appeal 2019–003591
Application 14/536,641
Technology Center 1700

Before ROMULO H. DELMENDO, BEVERLY A. FRANKLIN, and
SHELDON M. MCGEE, *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner’s decision to reject claims 22–42. We have jurisdiction under 35 U.S.C. § 6(b). We heard oral arguments on February 13, 2020. On page 4 of the Appeal Brief, Appellant indicates that the present application is

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as Pirelli Tyre S.p.A.. Appeal Br. 4.

related to U.S. Application No. 14/575,015 (having Appeal No. 2019–003593).

We AFFIRM. Nevertheless, because our obviousness analysis relies on new factual findings and reasoning not previously communicated to the Appellant, we designate our decision as including a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) so as to preserve the procedural safeguards that must be afforded to the Appellant. *See In re Stepan Co.*, 660 F.3d 1341, 1346 (Fed. Cir. 2011) (“Had the Board labeled its rejection as a new ground of rejection, Stepan could have reopened prosecution to address the newly-alleged deficiencies in its Declaration with the examiner.”); *In re Leithem*, 661 F.3d 1316, 1319 (Fed. Cir. 2011) (“Mere reliance on the same statutory basis and the same prior art references, alone, is insufficient to avoid making a new ground of rejection when the Board relies on new facts and rationales not previously raised to the applicant by the examiner.”).

CLAIMED SUBJECT MATTER

Claim 22 is illustrative of Appellant’s subject matter on appeal and is set forth below:

- 22. A tire for motorcycle wheels comprising:
 - a carcass structure comprising at least one carcass layer;
 - a belt structure applied in a radially outer position with respect to said carcass structure;
 - a tread band applied in a radially outer position with respect to said belt structure;
 - and
 - at least one elastomeric material layer arranged between said carcass structure and said belt structure,
 - wherein said elastomeric material layer extends over a surface

substantially corresponding to a development surface of said belt structure, and

wherein said elastomeric material layer comprises an elastomeric material that comprises fibres formed of magnesium and/or aluminium chain silicates, said fibres having nanometric dimensions.

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Asari ² (Derwent abstract and full translation)	JP 2005-219523	Aug. 18, 2005
Augustin	US 2,689,841	Sept. 21, 1954
Santilli	US 4,419,273	Dec. 6, 1983
Cassidy	GB 1327197	Aug. 15, 1973
Rome	US 7,910,511 B2	Mar. 22, 2011
Bergman	US 7,649,043 B2	Jan. 19, 2010
Odidi	US 9,078,827 B2	July 14, 2015
Pagano	US 6,698,483 B2	Mar. 2, 2004

REJECTIONS

1. Claims 22–29, 31–35, and 40–42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Asari and further in view of Augustin.
2. Claim 30 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Asari and Augustin as applied in claim 29 above and further in view of Cassidy and/or Santilli and/or Rome .

² The Examiner refers to this reference as “Asazato” in the record, but we identify this reference as “Asari” which is the correct name of the inventor for this reference.

3. Claims 22–42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bergman and further in view of Augustin and/or Cassidy and Odidi, and optionally in view of Pagano.

OPINION

Our Decision addresses the claims separately to the extent they are so argued by Appellant. 37 C.F.R. § 41.37(c)(1)(iv).

Upon consideration of the evidence and each of the respective positions set forth in the appeal record, we find that the preponderance of evidence supports the Examiner’s findings and conclusion that the subject matter of Appellant’s claims is unpatentable over the applied art with regard to Rejection 3. Accordingly, we affirm Rejection 3. However, we reverse Rejections 1 and 2.

Rejections 1 and 2

We reverse Rejections 1 and 2 for the same reasons that we reversed Rejections 1–3 in related U.S. Application No. 14/575,015 (having Appeal No. 2019–003593). *See* pages 3–8 of our Decision in Appeal No. 2019–003593.

Rejection 3

We refer to pages 5–7 of the non-final Office Action dated June 4, 2018 regarding the Examiner’s findings and position for Rejection 3. It is noted that we have thoroughly considered Appellant’s arguments made in both the Appeal Brief and in the Reply Brief in making the following determinations.

Appellant argues that the Examiner disregards the “for motorcycle” limitation and that a motorcycle tire has particular features, such as a ratio of transverse curvature, f/C , typically greater than or equal to 0.20. Appeal Br. 23. In response, the Examiner states that the fact that a motorcycle tire “typically” has a certain structural feature fails to require that such a feature is present. Ans. 4. The Examiner also states that the tires of Asari and Bergman have the capability of being mounted on a motorcycle and thus, these tires are seen to satisfy the claimed tire construction having an intended use of being used in a motorcycle application. *Id.* We agree with the Examiner’s stated position and are unpersuaded by Appellant’s arguments in this regard.

On pages 23–24 of the Appeal Brief, Appellants submit that Bergman’s inclusion of sepiolite is an error in its disclosure. Appellant refers to ¶¶ 22–23 of the Declaration by Inventor Luca Giannini (hereafter “the Giannini Declaration”)³. Appeal Br. 25. Appellant also argues that there is no mention of fibers formed of chain silicates as claimed. We are unpersuaded by this line of argument. As stated by the Examiner, Bergman specifically teaches a tire including an elastomeric material layer or gas barrier layer comprising sepiolite. Ans. 6. The Examiner states that, as acknowledged by Applicant and affirmed by the disclosure of Rome, for example, sepiolite is, by its very nature, a fibrous chain silicate. *Id.* The Examiner states that the fact that Bergman also teaches the use of layered

³ On page 3 of the Answer, the Examiner notes that the correct copy of this declaration was filed on January 28, 2019 and this is the copy we use herein and is the copy that Appellant discusses on page 29–32 of the Appeal Brief.

silicates, such as montmorillonite, fails to render the claims unobvious. *Id.* The Examiner states that Bergman expressly teaches a composition comprising sepiolite. *Id.* We agree.

Appellant also argues that the disclosure of Bergman does not teach or suggest a barrier layer between the carcass structure and a belt structure. Appeal Br. 26. We agree with the Examiner's stated response made on page 6–7 of the Answer. Therein, the Examiner states that Bergman teaches an exemplary embodiment in which barrier layer 50 is arranged as an inner most tire component. The Examiner states that, however, Bergman further teaches that the barrier layer can be arranged in alternate locations, such as in the middle of the carcass 12. *See Bergman*, col. 9, ll. 42–44. The Examiner states that Pagano is applied to evince the conventional arrangements of similar gas barrier layers and such includes between a carcass and a belt structure. Pagano, col. 4, ll. 7⁺. Ans. 7. The Examiner emphasizes that the desired reduction in air flow within the tire structure is achieved when the gas barrier layer is positioned in any number of locations, including that required by the claims. The Examiner states that absent a conclusive showing of unexpected results, one skilled in the art would have found it obvious to position the gas barrier layer of Bergman in accordance to the claimed invention. Ans. 7.

With respect to Odidi, Appellant argues that the disclosure does not teach or suggest that layer silicates and chain silicates are suitable equivalents for the purpose of Bergman's compositions. Appeal Br. 27. We agree with the Examiner's position on page 7 of the Answer. The Examiner explains that in light of Appellant's previous arguments that Bergman erred

in its disclosure with regard to sepiolite, the Examiner states that Odidi was cited as evidence that layered silicates and chain silicates are disclosed in the same applications (Odidi, col. 12, ll. 1⁺), and that there is nothing in Bergman that suggests the inclusion of sepiolite was in error. Ans. 7.

As to claims 36–38 and 40–42, Appellant argues that there is no rationale as to why a person of ordinary skill in the art would apply the modified Bergman composition to a specific motorcycle tire. Appeal Br. 28. Reply Br. 17. We are unpersuaded by this line of argument for the reasons presented by the Examiner on pages 7–8 of the Answer. Therein, the Examiner states that the benefits of reduced gas permeability are highly desirable in all tire constructions, including motorcycle tires. The Examiner states that Bergman is broadly directed to various articles that are designed to hold a gas under pressure, such as tires (Bergman, col. 1, ll. 15⁺). The Examiner states that motorcycle tires, in a similar manner to passenger car tires, construction tires, etc., are designed to hold gas under pressure and as such, the disclosed benefits are applicable to any tire construction, including motorcycle tires. With specific respect to claim 40, the Examiner states that the claimed inclusion of a zero degree layer is well known and conventional, and that this position has been previously set forth by the Examiner and remains unchallenged. Ans. 7.

Appellant further refers to the Giannini Declaration as rebuttal evidence. Appeal Br. 29–32.

In response, on page 8 of the Answer, the Examiner refers to Examples 7 and 7a, Comparative Example 8, and Table 3 of the declaration, but such examples or table 3 do not exist in the Giannini Declaration which

Appellant discuss on pages 29–32 of the Appeal Brief. So, it appears the Examiner considered the wrong declaration.

Regarding the Giannini Declaration, we note that Appellant can rebut a *prima facie* case of obviousness by showing “unexpected results,” *i.e.*, showing that the claimed invention possesses a superior property or advantage that a person of ordinary skill in the art would have found surprising or unexpected. *See In re Geisler*, 116 F.3d 1465, 1469 (Fed. Cir.1997) (quoting *In re Soni*, 54 F.3d 746, 750 (Fed. Cir. 1995)). The burden is on Appellant to show why the comparative data establishes unexpected results. *See In re Klosak*, 455 F.2d 1077, 1080 (CCPA 1972). Appellant has not shown why this comparison is believed to be with the closest prior art. *See In re Burckel*, 592 F.2d 1175, 1179 (CCPA 1979). Furthermore, Appellant must also explain why the showing is commensurate in scope with the claimed subject matter. *See In re Boesch*, 617 F.2d 272, 276 (CCPA 1980). In the instant case, Appellant has not adequately done so. We are thus unpersuaded by the Giannini Declaration and by Appellant’s discussion of it in the Appeal Brief and Reply Brief.

In view of the above, we affirm Rejection 3. Because it appears the Examiner did not properly consider Appellant’s proffered evidence of unexpected results, *i.e.*, the Giannini Declaration, we designate our affirmance of Rejection 3 as a new ground of rejection.

CONCLUSION

We affirm the Examiner’s decision.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Reversed	Affirmed	New Ground
22–29, 31–35, 40–42	103	Asari, Augustin	22–29, 31–35, 40–42		
30	103	Asari, Augustin, Cassidy, Santilli, Rome	30		
22–42	103	Bergman, Augustin, Cassidy, Odidi, Pagano		22–42	22–42
Overall Outcome				22–42	22–42

FINALITY AND RESPONSE

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(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 the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

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

AFFIRMED; 37 C.F.R. § 41.50(b)