

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES JOHN MCALPIN,
ASPY KEKI MEHTA,
and JEAN PHILIPPE AUTRAN

Appeal No. 2003-0695
Application No. 09/732,014

HEARD: July 15, 2003

Before PAK, WARREN and KRATZ, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 16, 36, 38-45, 47-49, 51-58, 60 and 61, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to an article comprising an isotactic copolymer of propylene and at least one alpha olefin having 5 or more carbon atoms, the article having a specified timed delayed compliance ratio property, which is a measure of relative cold flow resistance. An understanding of the invention can be derived from a reading of exemplary claim 36, which is reproduced below.

36. An article having an R_{ma} value of at least about 1.1 comprised of an isotactic copolymer of propylene and at least one α -olefin having 5 or more carbon atoms;

said at least one α -olefin or α -olefins being present in the copolymer at a total mole percentage of said at least one α -olefin or α -olefins in the range of from about 0.2 to about 6 mole percent based on the total moles of monomer in the copolymer;

wherein the ratio of the time delayed compliance (TDC) for an article of a metallocene catalyzed propylene ethylene copolymer, to the TDC of said article of said isotactic copolymer, is said R_{ma} and wherein the tensile modulus is substantially the same for both articles and said TDCs are measured at $25 \pm 2^\circ$, after 480 seconds.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Winter et al. (Winter)	5,145,819	Sep. 08, 1992
McAlpin et al. (McAlpin)	5,468,440	Nov. 21, 1995 (filed May 06, 1994)

Asanuma et al. (Asanuma)¹ 3-160030 Mar. 05, 1992
(published Japanese Kokai Patent Application)

Claims 16, 36, 38-45, 47-49, 51-58, 60 and 61 stand rejected under 35 U.S.C. § 102(e) as being anticipated by McAlpin. Claims 16, 36, 38-45, 47-49, 51-58, 60 and 61 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Asanuma² or, in the alternative under 35 U.S.C. § 103 as being unpatentable over Asanuma alone or in combination with Winters. Claims 16, 36, 38-45, 47-49, 51-58, 60 and 61 stand rejected under 35 U.S.C. § 103 as being unpatentable over Winters in view of Asanuma.

We refer to the briefs and to the answer for a complete exposition of the opposing viewpoints expressed by appellants and the examiner concerning the issues before us.

OPINION

Having carefully considered each of appellants' arguments set forth in the brief and reply brief, appellants have not persuaded us of reversible error on the part of the examiner. Accordingly, we will affirm the examiner's rejections for

¹ All references to Asanuma in this decision are to the English language translation thereof of record.

² The examiner refers to this reference as JP'030.

substantially the reasons set forth by the examiner in the answer. We add the following for emphasis.

Appellants state that "the claims stand or fall together" (brief, page 4). Consequently, we select claim 36 as the representative claim for each of the examiner's stated rejections and limit our discussion to that representative claim in deciding this appeal as to each ground of rejection before us.³

Appellants advance the same basic argument against each of the separately stated rejections of the examiner. In that regard, appellants do not specifically dispute the examiner's determination that McAlpin discloses the formation of articles from copolymer films made from propylene together with at least one other co-monomer such as 1-hexene using a metallocene catalyst and amounts of comonomer corresponding to the

³ While appellants refer to the third monomer of claims 16 and 52 in the reply brief in an attempt at asserting a product difference, we decide this appeal based on representative claim 36. See In re McDaniel, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002) ("[i]f the brief fails to meet either requirement, the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim").

representative claim amounts.⁴ Nor do appellants specifically dispute the examiner's determination that Asanuma describes (§ 102 rejection) or teaches alone or in combination with Winters (either of the § 103 rejections) the formation of a copolymer using a metallocene catalyst and propylene and hexene-1 as comonomers in amounts corresponding to the representative claim amounts and the formation of an article as claimed therefrom. Rather, appellants' primary argument in opposition to each of the examiner's rejections is that the applied prior art does not recognize that the use of a higher alpha olefin with propylene in making the polymer with a metallocene catalyst results in an article possessing time delayed compliance (TDC) characteristics, as claimed, that reflect greater cold flow resistance than when such an article is made from an ethylene-propylene copolymer. Consequently, in deciding this appeal, we focus our discussion on representative claim 36 and the arguments advanced in the briefs as to each ground of rejection before us with respect to that representative claim.⁵

⁴ Moreover, it is well settled that a prior art reference is not limited to the examples disclosed therein but is available as prior art as to all of the disclosure therein.

⁵ See 37 CFR § 1.192(a) (2002).

Whether the rejection is under 35 U.S.C. § 102 or 35 U.S.C. § 103, in a case such as this where the critical function for establishing novelty or unobviousness in the claimed subject matter is recited as a functional characteristic or property of the claimed article and that property reasonably appears to be a characteristic of the prior art article made from the same materials, it is incumbent upon appellants to prove that the prior art article does not in fact possess the characteristics relied on as distinguishing the claimed invention from that prior art. See In re Spada, 911 F.2d 705, 708, 15 USPQ 1655, 1658 (Fed. Cir. 1990); In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980); In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). Here, appellants have not satisfied this burden.

Concerning this matter, we do not agree with appellants' contention that the applied references must explicitly describe and recognize the here claimed functional characteristic. Rather, all that is required is that the examiner shows that the prior art product is identical or substantially identical to the claimed product. Here, the examiner reasonably determined that the claimed and prior art products are either identical or substantially identical because the references relied upon by the

examiner describe or teach making an article from the same materials in substantially the same way as appellants' representative claim requires. Since the U.S. Patent and Trademark Office does not have the facilities to make and compare products, it is appropriate to shift the burden of producing evidence in rebuttal to appellants to establish that products made from copolymers of propylene and hexene in a manner as taught by the applied references do not possess the claimed characteristics if such is the case.

Appellants have not satisfied that burden of producing evidence in rebuttal. Nor have appellants furnished any other persuasive arguments in the briefs with regard to the separate rejections advanced by the examiner for the reasons outlined by the examiner in the answer and above. Thus, on this record, we shall sustain the examiner's rejections.

CONCLUSION

The decision of the examiner to reject claims 16, 36, 38-45, 47-49, 51-58, 60 and 61 under 35 U.S.C. § 102(e) as being anticipated by McAlpin; to reject claims 16, 36, 38-45, 47-49, 51-58, 60 and 61 under 35 U.S.C. § 102(b) as being anticipated by

Asanuma or, in the alternative under 35 U.S.C. § 103 as being unpatentable over Asanuma alone or in combination with Winters; and to reject claims 16, 36, 38-45, 47-49, 51-58, 60 and 61 under 35 U.S.C. § 103 as being unpatentable over Winters in view of Asanuma is affirmed.

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

AFFIRMED

CHUNG K. PAK)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES F. WARREN)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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PETER F. KRATZ)	
Administrative Patent Judge)	

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APPEAL NO. - JUDGE KRATZ
APPLICATION NO.

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DECISION: **ED**

Prepared By:

DRAFT TYPED: 08 Jan 04

FINAL TYPED: