

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HENDRIKUS H. T. M. KETELS and CINZIA A. RITA DI FEDE,
and HERMANNUS B. SAVENIJE

Appeal No. 94-4034
Application No. 07/804,160¹

ON BRIEF

Before JOHN D. SMITH, PAK and WARREN, Administrative Patent Judges.

PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 5 through 14. The examiner has withdrawn the rejection of claims 15 through 20 subsequent to the appeal. See Answer, pages 2 and 4.

Claim 5 is representative of the subject matter on appeal and reads as follows:

¹ Application for patent filed December 6, 1991.

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5. A polymer mixture comprising:

- (A) 20-60 parts by weight of polyphenylene ether resin;
- (B) 40-70 parts by weight of polystyrene resin, high-impact polystyrene resin, or a mixture thereof;
- (C) 5-20 parts by weight of an impact strength agent; and
- (D) 2-10 parts by weight of talcum,
wherein component (C) comprises a mixture of 2 linear block copolymers.

The references of record relied upon by the examiner are:

Kosaka et al. (Kosaka)	4,483,958	Nov. 20, 1984
Abe et al. (Abe)	5,086,105	Feb. 04, 1992
		(Filed Dec. 11, 1989)

Claims 5 through 14 stand rejected under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Kosaka and Abe.²

We have carefully reviewed the entire record before us, including each of the arguments and comments advanced by the examiner and appellants in support of their positions. This review leads us to conclude that the examiner's § 103 rejection is well-founded. Accordingly, we will sustain the examiner's § 103 rejection. Our reasons for this determination follow.

As a preliminary matter, we note the examiner's statement (Answer, page 2) that the appealed claims stand or fall together because appellants do not state that the appealed claims do not stand or fall together. Nowhere do appellants dispute this

² At page 2 of the Answer, the examiner has withdrawn the remaining rejections made in the final Office action dated February 2, 1993.

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examiner's statement. Accordingly, for purposes of this appeal, we will consider the issues as they apply to claim 5, the broadest claim on appeal. See 37 CFR § 1.192(c)(5)(1993); now 37 CFR § 1.192(c)(7).

Appellants do not argue that the Kosaka reference discloses a polymer composition containing the claimed amounts of a polyphenylene ether, a rubber modified high impact polystyrene, an impact modifier (thermoplastic block elastomer) and an inorganic filler. See Brief, page 5. Also, appellants acknowledge at page 5 of the Brief that "[o]ne of the nineteen inorganic fillers that are mentioned [in the Kosaka reference] is talc." Compare In re Petering, 301 F.2d 676, 681, 133 USPQ 275, 280 (CCPA 1962) (a prior art genus containing only 20 compounds anticipated a claimed species within the genus because "one skilled in [the] art would *** envisage each member" of the genus). Note also that Abe describes talc as the preferred inorganic filler in a similar polymer composition. See Abe, the abstract.

Appellants argue that the Kosaka reference teaches or suggests using only a single impact modifier (a single linear block copolymer), rather than two impact modifiers (a mixture of two linear block copolymers). See Brief, page 5. However, as

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correctly noted by the examiner at page 4 of the Answer, Kosaka teaches that thermoplastic block elastomers (impact modifier), such as a mixture of styrene-conjugated diolefin block copolymers, can be employed in the polymer composition. See Kosaka, column 3, lines 16-39. Thus, we agree with the examiner that Kosaka and Abe as a whole would have rendered the claimed subject matter prima facie obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103.

Even were we to accept appellants' argument that the Kosaka reference describes employing only one of the listed styrene-conjugated diolefin block copolymers in the polymer composition, our conclusion would not be altered. In the first place, it would have been prima facie obvious to combine two styrene-conjugated diolefin block copolymers, each of which is taught by the Kosaka reference to be useful for the same purpose, in order to form a composition which is to be used for the very same purpose. See In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). In the second place, it would have been prima facie obvious to employ the block elastomers of the type described by the Kosaka reference either individually or in combination since the examiner states at page 4 of the Answer

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and appellants do not dispute that Abe teaches at column 6, lines 45-68, that "impact modifiers such as the rubber-like materials can be [employed] individually or as mixtures thereof " in a similar polymer composition.

Appellants also argue that the examples in the specification rebut the prima facie case of obviousness proffered by the examiner. See Brief, page 6. The examples show a comparison between two compositions having specific impact modifiers individually (designated as B* and C*) and a composition having a mixture of the same two specific impact modifiers (designated as I). See specification, pages 6-8. According to appellants, the showing in the specification examples demonstrates that the claimed composition employing two impact modifiers imparts unexpected results over that described in the applied prior art references. See Brief, page 6. We are not persuaded by this argument.

First, it is not enough for appellants to show that the results for appellants' invention and the comparative examples differ. Appellants have the burden of showing that the differences are significant and unexpected. See In re Freeman, 474 F.2d 1318, 1324, 177 USPQ 139, 143 (CCPA 1973)(the burden of showing unexpected results rests on appellants who rely on them);

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In re D'Ancicco, 439 F.2d 1244, 1248, 169 USPQ 303, 306 (CCPA 1971)(the difference in results must be significant and of practical advantage). This, appellants have not done. In fact, the specification does not even state that these differences are "unexpected". See In re Geisler, 116 F.3d 1465, 1470, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997).

Second, the showing in the specification examples is not reasonably commensurate in scope with the degree of the protection sought by appealed claim 5. See In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 778 (Fed. Cir. 1983); In re Clemens, 622 F.2d 1029, 1035, 206 USPQ 289, 296 (CCPA 1980). While the showing is limited to employing a particular polymer composition having specific portions of specific ingredients, including two specific impact modifiers, appealed claim 5 is not so limited. Appellants, however, have not offered any evidence to support that the demonstrated results based on a single representative polymer composition can reasonably be extrapolated to the plethora of polymer compositions having multifarious ingredients (including multifarious impact modifiers) embraced by appealed claim 5.

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Thus, having considered all of the evidence or record, we determine that the evidence of obviousness, on balance, outweighs the evidence of nonobviousness. Hence, we agree with the examiner's conclusion that the claimed subject matter as a whole would have been obvious to one of ordinary skill in the art . Thus, we affirm the examiner's decision to reject claims 5 through 14 under 35 U.S.C. § 103.

The decision of the examiner is affirmed.

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

AFFIRMED

JOHN D. SMITH,)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
CHUNG K. PAK,)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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)	
CHARLES F. WARREN,)	
Administrative Patent Judge)	

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APPLICATION NO. 07/804,160

APJ PAK

APJ WARREN

APJ SMITH, JOHN D.

DECISION: **AFFIRMED**

Typed By: Jenine Gillis

DRAFT TYPED: 19 Feb 99

FINAL TYPED: