

***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(2) is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* TETSUJI KAWAZURA  
and ERI MIURA

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Appeal No. 94-4354  
Application 08/037,363<sup>1</sup>

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ON BRIEF

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Before GARRIS, WARREN and OWENS, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

*Decision on Appeal and Opinion*

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner refusing to allow claims 1 through 7 as amended subsequent to the final rejection.<sup>2</sup>

We reverse the rejection of the appealed claims under 35 U.S.C § 103 as being unpatentable over Aonuma in view of Schenck,<sup>3</sup> as set forth in the answer (Paper No. 15), for the reasons set forth by appellants in their main and reply briefs (Papers No. 13 and 18). We particularly find that even if a *butyl* rubber containing composition of Aonuma, which can include

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<sup>1</sup> Application for patent filed March 26, 1993.

<sup>2</sup> Amendments of April 13, 1994 (Paper No. 8) and July 22, 1994 (Paper No. 12).

<sup>3</sup> The references are listed at page 4 of the answer.

a filler and plasticizer (e.g., col. 3, line 37), was modified to include a polyether ester plasticizer along with the requisite amount of filler as disclosed in Schenck (e.g., col. 8, lines 54-59, and col. 9, lines 20-37), it is inescapable that such a combination would *not* have resulted in a composition containing a base rubber that would be encompassed by the appealed claims. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-54, 5 USPQ2d 1434, 1438-41 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

The examiner's decision is reversed.

*Reversed*

BRADLEY R. GARRIS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
CHARLES F. WARREN	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
TERRY J. OWENS	)	
Administrative Patent Judge	)	

Appeal No. 94-4354  
Application 08/037,363

Garrett and Dunner  
1300 I Street, N.W.  
Washington, D.C. 20005