

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MIZUO SOEDA, AKIMASA ARITA and TAKEO ITO

Appeal No. 96-1178
Application No. 08/160,324¹

ON BRIEF

Before PAK, WARREN, and KRATZ, 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 1 and 2 which are all of the claims pending in the application.

¹ Application for patent filed December 2, 1993. According to appellants, the application is a continuation of Application No. 07/941,124, filed October 30, 1992, now abandoned.

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The subject matter on appeal is directed to carbon blacks having specific properties, which are useful for imparting improved abrasion resistance and reduced hysteresis loss to rubber compositions. See specification, page 1. According to appellants, "[c]laims 1 and 2 stand, or fall, together for consideration of the 35 U.S.C. § 102(b) or 35 U.S.C. § 103 issues." See Brief, page 4. Therefore, for purposes of this appeal, we will limit our discussion to claim 1, the broadest claim on appeal. See 37 CFR § 1.192(c)(5)(1993). Claim 1 is reproduced below²:

1. Carbon blacks having a CTAB of from 65m²/g to 85 m²/g, a DBP of from 139 cc/100g to 160 cc/100g, a CTAB/I₂ No. ratio of from 1.15 to 1.35, a \hat{I} DBP of from 20 cc/100g to 40cc/100g, a Tint value of from 85 to 100, a Dmode of from 115 nm to 135 nm and a \hat{I} D₅₀/Dmode ratio of from 0.65 to 0.90.

As evidence of obviousness, the examiner relies on the following prior art:

Nagata et al. (Nagata)	4,548,980	Oct. 22,
		1995

²The Preliminary amendment dated December 22, 1993 has not been clerical entered. Upon return of this application, the examiner should have this amendment entered.

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Claims 1 and 2 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as unpatentable over the disclosure of Negata.

We have carefully reviewed the specification, claims and applied prior art, including all of the arguments advanced by both the examiner and appellants in support of their respective positions. This review leads us to conclude that the examiner's § 102/103 rejection is well founded. Accordingly, we will sustain the § 102/103 rejection for substantially those reasons set forth in the Answer. We add the following primarily for emphasis and completeness.

As evidence of unpatentability of claims 1 and 2 under Section 102 or 103, the examiner relies on the disclosure of Negata. The examiner finds, and appellants do not dispute, that Nagata in its example 23 at column 8 describes "carbon blacks having the claimed tint [value], CTAB and CTAB/iodine value." Compare Answer, page 3, with Brief in its entirety. We also note that the carbon blacks employed in example 23, like appellants' carbon blacks, are furnace carbon blacks. Compare Negata, column 1, line 64, with specification, pages 7 and 10. Although Negata does not mention that its carbon

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blacks have the additional properties recited in claim 1, we are of the view that appellants' discovery of these additional properties in known carbon blacks does not impart patentability. ***Titanium Metals Corp. v. Banner***, 778 F.2d 775, 780-82, 227 USPQ 773, 777-78 (Fed. Cir. 1985); ***In re Pearson***, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974). When, as here, the carbon blacks involved are either identical or substantially identical and are from the same source, i.e., a furnace³, the burden is on appellants to prove that the exemplified carbon blacks of Negata do not possess characteristics or properties attributed to the claimed carbon blacks⁴. ***In re Spada***, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). As stated in ***In re Best***, 562 F.2d 1252, 1255, 195 USPQ 430, 433-434 (CCPA 1977):

³ The furnace conditions employed in Negata are presumably similar or the same as those disclosed in the specification since the resulting carbon blacks have at least three properties which are embraced by the claims.

⁴ This is especially compelling in the present situation since the claimed properties, which are not mentioned in Negata, are a function of those claimed properties disclosed in Negata as, e.g., shown by U.S. Patent 3,922,335 referred to at page 7 of the specification.

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("Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product.... Whether the rejection is based on "inherency" under 35 U.S.C. § 102, on "prima facie obviousness" under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art products. **See In re Brown**, 59, CCPA 1036, 459 F.2d 531, 173 USPQ 685 (1972).

However, on this record, we find no evidence proffered by appellants, which demonstrates that the carbon blacks employed in example 23 of Negata do not possess the additional or new properties attributed to the claimed carbon blacks.

Appellants argue that Negata does not teach, nor would have suggested, delta Tints greater -3. However, as indicated by the examiner at page 4 of the Answer, such delta Tints are not claimed. When the claims do not recite allegedly distinguishable features, "appellant[s] cannot rely on them to establish patentability." **In re Self**, 671 F.2d 1344, 1350-1351, 213 USPQ 1, 7 (CCPA 1982).

In view of the foregoing, we agree with the examiner that the disclosure of Negata would have rendered the claimed

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subject matter unpatentable within the meaning of 35 U.S.C. §
102/103. Accordingly, the decision of the examiner 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

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Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
PETER F. KRATZ)	
Administrative Patent Judge)	

CKP:lp

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LAWRENCE A. CHALETSKY
CABOT CORPORATION
BILLERICA TECHNICAL CENTER
CONCORD RD.
BILLERICA, MD 02181

Leticia

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APJ PAK

APJ KRATZ

APJ WARREN

DECISION: AFFIRMED
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s):

Prepared: July 10, 2002

Draft Final

3 MEM. CONF. Y N

OB/HD GAU

PALM / ACTS 2 / BOOK
DISK (FOIA) / REPORT