

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(2) is not binding precedent of the Board.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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MANFRED HEISLER,
FRIDOLIN STARY,
RUDOLF RATKA
and ALOIS SCHLIERF

Appeal No. 1997-0009
Application 08/074,819

ON BRIEF

Before CAROFF, OWENS and WALTZ, Administrative Patent Judges.

CAROFF, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the examiner's final rejection of
claims 1-10, all the claims pending in appellants'
application.

The claims are directed to a process for the continuous

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preparation of an HTV silicone composition by mixing diorgano(poly)siloxane and silicon dioxide in an oscillating single-shaft pilgrim-step kneader.

Appellants stipulate in their Brief (page 2) that the appealed claims stand or fall together. Accordingly, we shall limit our consideration to claim 1, the sole independent claim, which reads as follows:

1. A process for the continuous preparation of an HTV silicone composition which comprises mixing 100 parts by weight of diorgano(poly)siloxane which has a viscosity of 50 to 100,000 Pas at 25°C with at least 20 parts by weight of finely divided silicon dioxide which has a tamped density of more than 0.01 kg/l in an oscillating single-shaft pilgrim-step kneader.

The sole reference relied upon by the examiner on appeal is:

Ž Stary et al. (Stary) 4,737,561 April 12,
1988

The following references are cited by appellants:

Ž Vulkan, "Silicones Chemistry and Technology," Vulkan Publishing, 45-73 (1989).

Ž Noll, "Chemistry and Technology of Silicones," Academic Press, 400-09 (1968).

The following rejections are before us for consideration:

I. Claims 1-10 stand rejected under 35 U.S.C. § 102(b) as

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anticipated by, or in the alternative under 35 U.S.C.

§ 103 as obvious over, Sary.

II. Claims 1-10 also stand rejected under 35 U.S.C.

§ 112, first paragraph, for lack of enablement.

We have carefully considered the entire record¹ in light of the opposing arguments respectively presented by appellants and by the examiner. Having done so, we shall reverse each of the rejections at issue essentially for the reasons advanced by appellants.

With regard to the 35 U.S.C. § 102(b)/103 rejection, we find that appellants have established that there is a recognized distinction in the art between HTV (high

¹We note that appellants filed a paper on Feb. 7, 2000 (certificate of mailing: Feb. 2, 2000) styled "Reply Brief Under 37 CFR 1.193." That paper is belated and, thus, has not been considered by us. In this regard, we observe that appellants previously filed a Reply Brief on April 23, 1996 in which they responded to all grounds of rejection, including a new ground of rejection, applied in the examiner's Answer (Paper No. 16) dated Feb. 22, 1996. The Reply Brief filed on April 23 1996 has been considered. The examiner's Answer referred to in the belated paper as "dated Dec. 2, 1999" is, in actuality, merely a copy of the original Answer (Paper No. 16 dated Feb. 22, 1996) attached to a letter (Paper No. 25) indicating approval by the supervisory patent examiner. There is no indication that appellants would be given yet another opportunity to respond to the Answer.

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temperature vulcanizing) and RTV (room temperature vulcanizing) silicone compositions.

To wit, Noll in particular suggests, that HTV compositions basically contain at least 20 parts by weight of fillers, preferably reinforcing fillers such as silica (p. 400-401); whereas the fillers used in RTV formulations "are almost all inert materials" and the use of reinforcing fillers is limited (p. 407). To the same effect, appellants aver in their disclosure (page 1, l. 16-20):

One-component RTV silicone compositions contain reinforcing fillers in amounts of not more than 10% by weight. In contrast, the content of reinforcing filler in HTV silicone compositions is at least 20% by weight.

Bearing the foregoing in mind, we agree with appellant that Stary does not anticipate appellants' invention which relates to the processing of an HTV formulation containing "at least 20 parts by weight of . . . silicone dioxide." In contrast, the Stary process relates only to production of RTV formulations. Stary does indicate that a reinforcing filler, such as silica, may be present in the formulation and, in Example 1, apparently discloses an RTV composition having

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approximately 8 parts by weight of silica. However, in view of the art recognized distinction between RTV and HTV compositions, one of ordinary skill in the art would not infer from the Stary disclosure that the RTV compositions contemplated by Stary could include amounts of silica as high as "at least 20 parts by weight," as claimed.

This finding is not negated by the reference in Stary (col. 4, l. 23-26) to a broad range of filler concentrations since the broad range is inclusive of the total amount of filler present, not just reinforcing filler. In this regard, we note that Stary (col. 3, l. 53-68) discloses three broad categories of filler (reinforcing, fibrous and non-reinforcing), and the particular non-reinforcing fillers disclosed by Stary essentially correspond to the "inert" fillers which Noll (p. 407) suggests are the predominant fillers in RTV compositions.

With regard to the question of obviousness, the examiner has failed to explain why one of ordinary skill in the art would have found it obvious to apply the Stary process, which is limited on its face to production of RTV compositions, to production of HTV formulations.

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Turning to the 35 U.S.C. § 112 rejection, we find no basis whatsoever for the examiner's assertion that appellants' disclosure is enabling only for claims limited to a diorgano(poly)siloxane containing vinyl groups. According to the examiner, the disclosed diorgano(poly)siloxanes possess vinyl radicals which render the siloxanes incapable of room temperature vulcanization. We find this statement to be flawed in two respects. First, the diorgano(poly)siloxanes disclosed in appellants' specification do not necessarily possess a vinyl radical (see Formula I on page 4). Second, we find no basis for the examiner's assertion that vinyl radicals render the siloxanes incapable of room temperature vulcanization.

For the foregoing reasons, the decision of the examiner is reversed.

REVERSED

MARC L. CAROFF)
Administrative Patent Judge)
TERRY J. OWENS) BOARD OF PATENT

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