

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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES L. BURDICK and THOMAS J. PODLAS

Appeal No. 1997-3307
Application No. 08/121,402

ON BRIEF

Before MCKELVY, Senior Administrative Patent Judges, PAK
and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-6, which are all of the claims pending in the application.

The subject matter on appeal is represented by product claim 1, and process claims 5 and 6, reproduced below:

1. An aqueous fluidized polymer suspension comprising at least 20% by total weight of the suspension of at least one polymer selected from the group of methylcellulose, methyhydroxypropylcellulose, and methyhydroxyethylcellulose polymer, the polymer having a bulk density of 0.03 g/cc or greater, dispersed in an aqueous solution of at least one salt dissolved therein.

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5. A method of preparing an aqueous fluidized polymer suspension of methylcellulose, methyhydroxylcellulose, and methyhydroxyethylcellulose polymer, having a bulk density of 0.3 g/cc or greater, comprising dissolving a salt in water to form a salt solution and then suspending such polymer in the salt solution to form a dispersion with a high solids content of 20% by weight or greater.

6. A method of preparing a joint compound with greater than 50% adhesion to wall board tape comprising adding the aqueous fluidized suspension of claim 1 to a joint compound formulation.

The examiner relies up the following prior art as evidence of unpatentability:

Bürge	4,069,062	Jan. 17, 1978
Burdick et al. (Burdick '908)	5,228,908	Jul. 20, 1993
Burdick et al. (Burdick '909)	5,228,909	Jul. 20, 1993
Knechtel et al. (Knechtel)	5,258,069	Nov. 02, 1993

The examiner also relies upon application serial number 08/168,895, filed on December 17, 1993.

The following grounds of rejection are presented for our review on this appeal:

I. Claims 1-5 stand previsionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of co-pending application S.N. 08/168,895.

II. Claims 1-5 stand rejected as unpatentable under 35 U.S.C. § 102(e) as anticipated by, or in the alternative under 35 U.S.C. § 102(e)/§ 103(a) as obvious over Burdick '908 and Burdick '909.

III. Claim 6 stands rejected as unpatentable under 35 U.S.C. § 102(e)/§ 103 for obviousness over Burdick '908 and Burdick '909 in view of Knechtel.

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IV. Claims 1-5 stand rejected as unpatentable under 35 U.S.C. § 103 over Bürge.

V. Claim 6 stands rejected as unpatentable under 35 U.S.C. § 103 over Bürge in view of Knechtel.

VI. Claims 1-6 stand rejected under 35 U.S.C. § 102(e)/§ 103(a) as obvious over Knechtel.

Before reaching the teachings of the applied art, we note the appellants argue that the Burdick '908 patent, the Burdick '909 patent, and the Knechtel patent cannot be applied under 35 U.S.C. § 102(e) or 35 U.S.C. § 103 because the case on appeal and each of these patents were the same assignee, Aqualon Company. (Brief pages 5, 7, and 8).

The examiner states that because these patents have different invention entities, these patents are "by another".

Paragraph (e) of 35 U.S.C. § 102 was amended by the American Inventors Protection Act of 1999. The new criteria for determining patentability under post-AIPA 102(e) applies to applications: (a) filed on or after November 29, 2000, or (b) that have been voluntarily published. Appellants' application was filed on September 14, 1993, and appellants have not indicated that their application was voluntarily published. Hence, post-AIPA § 102(e) does not apply to the present case. Hence, subject matter that qualifies as prior art under 35 U.S.C. § 102(e) can be applied in a rejection under 35 U.S.C. § 103(a). Because the applied patents have different inventive entities from the inventive entity of the present

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case, these patents are "by another" under 35 U.S.C. § 102(e). "Another" means other than applicants, In re Land, 368 F.2d 866, 875, 151 USPQ 621, 630 (CCPA 1966). Hence, the inventive entity is different if not all inventors are the same.

Accordingly, in view of the above, we find appellants' position that Burdick '908 and '909 and Knechtel cannot be applied under 35 U.S.C. § 102(e) and under 35 U.S.C. § 103 because of common assignee is incorrect.

Rejection I

Appellant argues that since no claim has been allowed in the co-pending 08/168,895 application, this rejection is most. (Brief, page 5). The examiner states that this rejection "will be held in abeyance until allowable subject matter in the '895 application is indicated." (Answer, page 11).

A patent has since issued for co-pending 08/168,895 application (U.S. Patent No. 6,025,311). Because the basis upon which this rejection was made has changed, we vacate the decision made by the examiner in this rejection, and remand to the examiner for further action with respect to U.S. Patent No. 6,025,311. In re Zamoro, provide cites for this case It's a case concerning vacating decisions, but I could not find it maybe spelling is slightly off.

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Rejection II¹

Appellants argue that their claimed bulk density property is not set forth in Burdick '908 and Burdick '909. (Brief, pages 5-6).

The examiner rebuts and states that Appellants have not convincingly established that their claimed bulk densities are contradicted by the Burdick references. The examiner points out that the art of record employs the same salts and polymer suspensions as claimed. (Answer, page 11).

We find that appellants' specification indicates that a wide variety of methylcellulose derivatives of varying bulk densities are generally available in the marketplace. (Specification, page 3). The Bulk density is determined according to the description found on pages 4-5 of appellants' specification variable. When an examiner relies upon a theory of inherency, "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Int. 1990). Inherency "may not be established by probabilities or possibilities.

¹ Appellants argue that the Burdick references are not prior art not because these patents have the same assignee as the instant application (Aqualon Company) (Brief, page 5).

The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Ex parte Skinney, 2 USPQ2d 1788, 1789 (Bd. Pat. App. & Int. 1986). Here, the examiner has not provided the required evidence or technical reasoning showing that the methylcellulose derivative of the Burdick references would necessarily have a bulk density of 0.30 g/cc or greater. The examiner has the initial burden of providing evidence or technical reasoning which shows that the methylcellulose derivative of Burdick '908 and '909, and the examiner has not carried out this burden. See In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138-39 (Fed. Cir. 1986).

Moreover, the examiner has not explained why one of ordinary skill in the art would have been motivated to modify the bulk density of the methylcellulose derivative to arrive at appellants' claimed invention.

Hence, we reverse both the 35 U.S.C. § 102(e) and 35 U.S.C. § 103 rejection over Burdick '908 and '909.

Rejection III²

Because the reference of Knechtel does not cure the aforementioned deficiencies of the Burdick references (for reasons discussed later in this opinion) we also reverse

² Appellants argue that Knechtel cannot be applied as prior art for the same reasons given in footnote 1. (Brief, page 8).

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the rejection of claim 6 under 35 U.S.C. § 102(e)/§ 103 over Burdick '908 and '909 in view of Knechtel.

Rejection IV

Appellants argue that Bürge also does not disclose that the polymer must have a bulk density of at least 0.30 g/cc. (Reply Brief, page 2).

The examiner states it would have been obvious to express the viscosity set forth in Bürge terms of bulk density. (Answer, page 8).

The examiner has the initial burden of factually supporting any prima facie conclusion of obviousness. Ex parte Clapp, 227 USPQ 972, 973 (Bd. App. & Int. 1985). Here, the examiner does not support his statement by facts. In this context, we argue with appellants' statements made on page 3 that the examiner should provide documentation showing that a mathematical relationship exists between viscosity and bulk density.

Moreover, the examiner has not explained why one of ordinary skill in the art would have altered the bulk density of the methylcellulose derivative of Bürge to a value of 0.30 g/cc or greater.

Hence, we reverse the rejection of claims 1-5 under 35 U.S.C. § 103 over Bürge.

Rejection V

Because the reference of Knechtel does not cure the aforementioned deficiencies of the Bürge reference, for the reasons discussed below, we also reverse the 35 U.S.C. § 102/§ 103 rejection of claim 6 over Bürge in view of Knechtel.

Rejection VI

Appellants argue the Knechtel does not disclose the use of polymers having a bulk density of 0.30 g/cc or greater. The examiner recognizes this deficiency of Knechtel. (Answer, page 10). Yet, the examiner states that such a property is anticipated by or an obvious characteristic in view of Knechtel. (Answer, page 10).

We reiterate that when an examiner relies upon a theory of inherency, he must provide a basis in fact and/or technical reasoning to reasonably support the alleged inherency. Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Int. 1990). Here, the examiner states that Knechtel employs the some polymer (s), stabilizer and salt solution. However, the examiner overlooks that fact that bulk densities of methylcellulose derivatives vary among different samples. Yet the examiner does not explain why Knechtel's methylcellulose derivatives would

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necessarily have a bulk density of 0.30 g/cc or greater. Nor does the examiner explain why one skilled in the art would be motivated to change the bulk density to a value of 0.30 g/cc or greater. Hence, the examiner has failed to meet his burden. In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); In re King, 801 F.2d 1324, 1327, 231 USPQ 1036, 138-39 (Fed. Cir. 1986).

CONCLUSION

We vacate and remand rejection I. We reverse rejection II-VI.

REVERSED

and

VACATED AND REMANDED

FRED E. MCKELVEY)	
Senior Administrative Patent Judge)	
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)	BOARD OF PATENT
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Administrative Patent Judge)	INTERFERENCES
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