

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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARJA A. JAATINEN
and
JOHANES M. GOOSSENS

Appeal No. 2001-0218
Application No. 09/184,993

ON BRIEF

Before GARRIS, LIEBERMAN, and DELMENDO, Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner refusing to allow claims 1 through 28 and 31, which are all the claims pending in this application.

THE INVENTION

The invention is directed to a polycarbonate sheet comprising a polycarbonate resin, a phosphorous stabilizer and a processing release agent. The polycarbonate is limited to those which have a limited melt volume ratio, (MVR). Additional limitations are provided in the following illustrative claim.

THE CLAIM

Claim 1 is illustrative of appellants' invention and is reproduced below:

1. A fire resistant polycarbonate sheet comprising:
 - a) branched polycarbonate resin having an MVR above 11 cm³/10 minutes, wherein MVR is measured at 300°C and 2.16 kg,
 - b) a phosphorous-based stabilizer, and
 - c) a processing release agent.

THE REFERENCES OF RECORD

As evidence of obviousness the examiner relies upon the following references:

Lee (Lee '251)	4,399,251	Aug. 16, 1983
Lee (Lee '351)	4,409,351	Oct. 11, 1983
Mark	4,415,696	Nov. 15, 1983
Lee (Lee '268)	4,446,268	May 1, 1984
Miller	4,554,302	Nov. 19, 1985
Miller et al.	4,626,566	Dec. 2, 1986
Ishiwa et al. (Ishiwa)	5,484,874	Jan. 16, 1996
Obayashi et al. (Obayashi)	5,807,914	Sep. 15, 1998
De Bont et al. (De Bont)	5,852,158	Dec. 22, 1998
Sakashita et al. (Sakashita)	5,606,007	Feb. 25, 1997
Barren et al. (Barren)	5,786,411	Jul. 28, 1998

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THE REJECTION

Claims 1 through 28 and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Obayashi, De Bont, Barren, Sakashita, Ishiwa, Miller et al., Lee '251, Lee '351, Mark and Miller.¹

OPINION

We have carefully considered all of the arguments advanced by the appellants and the examiner, and agree with the appellants for the reasons set forth in the Brief and those herein that the rejection of record is not well founded. Accordingly, we reverse the rejection.

The Rejection Under Section 103(a)

"[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

The examiner relies upon a combination of ten separate and distinct references to establish a prima facie case of obviousness. Each reference discloses the preparation of a polycarbonate composition comprising a polycarbonate, a phosphorous stabilizer and a mold release agent.

¹Claims 29 and 30 were denied entry. See advisory action dated Jan. 27, 2000 (Paper No. 12).

In the sole rejection of the claimed subject matter, the examiner having incorporated the rejection present in the Office action mailed March 1, 1999, Paper No. 3, there are no findings made by the examiner, with respect to the presence of any limitations present in the references of record which suggest or teach how the limitations directed to the melt volume rating (MVR) are met by the references of record.

In the aforesaid rejection, the examiner states that, “the applied references, which span a period exceeding 16 years, relate, it is standard practice to utilize an organic phosphite antioxidant in PC formulations which also contain a mold release agent. Moreover[,] this practice is irrespective of either the spatial branching or non-branching configuration of the organic molecule portions of the polycarbonate resin or the presence or absence of other additives including flame retardants, in as much as their roles are different.” Id. The examiner thereafter proceeds to discuss the “attribtuion [sic, attribution] of unexpected melt viscosity properties in a flame retardant PC composition.” Id. These melt viscosity properties expressed in the claimed subject matter define the PC resin as one, “having an MVR above 11 cm³/10 minutes, wherein MVR is measured at 300°C and 2.16 kg.” The aforesaid limitation is an express limitation of the claimed subject matter and the burden is on the examiner to show that the evidence relied upon by the examiner teach or suggest a polycarbonate (PC) having the requisite melt viscosity property required by the claimed subject matter. This burden has not been met.

Furthermore, on the record before us, we find no teaching or suggestion that the polycarbonate sheet of the references of record is a product which appears to be identical or substantially identical as that of the claimed subject matter so as to fall within the doctrine established by In re Best. As is well settled, when appellants' product and that of the prior art appear to be identical or substantially identical, the burden shifts to appellants to provide evidence that the prior art product does not necessarily or inherently possess the relied-upon characteristics of appellants' claimed product. In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 597 (CCPA 1980); In re Best, 562 F.2d 1252, 1254-55, 195 USPQ 430, 433-34 (CCPA 1977). Furthermore, the discovery of a new property even when that property is unobvious from the prior art, cannot impart patentability to claims directed to a known composition. In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

The thrust of the invention however, is to enhance the fire resistant properties of a polycarbonate sheet by significantly reducing the viscosity of the polycarbonate resin in the sheet. See specification, page 3, lines 3-7. In the record before us, it has not been asserted by the examiner with any evidentiary basis, that the polycarbonate sheet of the references of record is a product which appears to be identical or substantially identical as that of the claimed subject matter. Based on the evidence before us, we decline to so assert.

Accordingly, the rejection of record cannot be sustained.

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DECISION

The rejection of claims 1 through 28 and 31 under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Obayashi, De Bont, Barren, Sakashita, Ishiwa, Miller et al., Lee '251, Lee '351, Mark and Miller is reversed.

The decision of the examiner is reversed.

REVERSED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
PAUL LIEBERMAN)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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ROMULO H. DELMENDO)	
Administrative Patent Judge)	

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