

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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN G. LAUBE
and
MICHAEL CURTIN

Appeal No. 2002-0466
Application No. 09/456,273

ON BRIEF

Before OWENS, LIEBERMAN, and JEFFREY T. SMITH, 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 41 and 47 through 53, as amended subsequent to the final rejection, which are all the claims pending in this application.

THE INVENTION

The invention is directed to a sidewall of a tire or a veneer thereof. The sidewall comprises at least one elastomer and a carbon black having specific DBP, Tint values and CTAB values. Additional limitations are described in the following illustrative claims.

THE CLAIMS

Claims 1, 33 and 47 are illustrative of appellants' invention and are reproduced below:

1. An article having a non-abrading surface, wherein at least said surface comprises at least one elastomer and a carbon black having a DBP value of at least about 50 cc/100g, a Tint value of at least about 100% ITRB, and a CTAB value of at least about 80m²/g, wherein said non-abrading surface is a sidewall of a tire or a veneer thereof.

33. An article of manufacture prepared from a composition comprising at least one elastomer and a carbon black having a DBP value of at least about 50 cc/100g, a Tint value of at least about 100% ITRB, and a CTAB value of at least about 80m²/g, wherein said article of manufacture is a sidewall of a tire or a veneer thereof.

47. A process for making a rubber article having a non-abrading surface, said process comprising the step of forming at least a portion of said non-abrading surface of said rubber article from a composition comprising an elastomer and a furnace carbon black having a DBP value of at least about 50 cc/100g, a Tint value of at least about 100% ITRB, and a CTAB value of at least about 80m²/g, whereby said article exhibits higher gloss and/or a lower jetness value relative to an article formed from a composition using N650 carbon black at the same loading level, wherein said non-abrading surface is a sidewall of a tire or a veneer thereof.

THE REFERENCES OF RECORD

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

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| Iwama et al. (Iwama) | 4,550,135 | Oct. 29, 1985 |
| Kikuchi et al. (Kikuchi) | 5,484,836 | Jan. 16, 1996 |

THE REJECTION

Claims 1 through 41 and 47 through 53 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Iwama or Kikuchi.

OPINION

We have carefully considered all of the arguments advanced by the appellants and the examiner, and agree with the appellants that the rejection of the claims under Section 103(a) is not well founded. Accordingly, we reverse this 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 either of two references to reject the claimed subject matter and establish a prima facie case of obviousness.

The examiner finds that, "Kikuchi discloses a rubber composition for a tire tread." See Answer, page 3. The examiner further finds that, "Iwama teaches that the entire tire is to be made of elastomer and carbon black having the three required properties." See

Answer, page 4. Hence the examiner concludes that, "it would be obvious to one of ordinary skill in the art to formulate a tire according to Iwama in which the rubber composition comprises elastomer and a carbon black having DBP value, tint value, and CTAB value within the ranges recited in appellants' claims and it is the Examiner's position that it would be obvious to one of ordinary skill in the art to make a tire according to Kikuchi in which the sidewall of the tire comprises a composition of elastomer and a carbon black having DBP value, tint value and CTAB value within the scope of appellants' claims." See Answer, page 3. We disagree.

Each of the independent claims before us requires that the claimed article, "is a sidewall of a tire or a veneer thereof." See claims 1, 33, and 47. The limitation is a positive requirement of each of the independent claims before us. Accordingly, the limitation must be disclosed or suggested by the references of record. Absent such a teaching or suggestion, the examiner has failed to establish a prima facie case of obviousness.

We find that Kikuchi as acknowledged by the examiner is directed to a rubber composition for a tire tread. See Abstract. See also column 1, lines 7-12, column 2, lines 3-5, 54-56, column 3, lines 1-3, column 8, lines 19-33 and claims 1 to 4. We find no suggestion or teaching for any portion of the tire other than a tire tread.

We find that Iwama teaches a rubber tire composition. See Abstract. We find that the invention is directed to "a tire rubber composition, more specifically, to a tire tread

rubber composition capable of providing a tire tread having a good balance between the rolling resistance and the coefficient of sliding friction on wet road surfaces.” See column 1, lines 6-11. The balance of Iwama is directed exclusively to tire treads. See column 1, lines 19-27, column 3, lines 26-35, column 5, lines 56-63, column 7, lines 37-43, and column 12, line 63 to column 13, line 23. Furthermore, we find that the Examples are directed to compositions wherein Tire Performance is measured. See the Tables in columns 7-12. Significantly, there is no teaching or suggestion that the entire tire is formulated from the tire composition disclosed by Iwama. Moreover, there is no suggestion that the tire sidewall or a veneer thereof is formulated from the composition disclosed by Iwama.

For the foregoing reasons, we determine that the examiner has not established a prima facie case of obviousness in view of the references of record. Accordingly, the rejection is reversed.

DECISION

The rejection of claims 1 through 41 and 47 through 53 under 35 U.S.C. §103(a) as being unpatentable over Iwama or Kikuchi is reversed.

The decision of the examiner is reversed.

REVERSED

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| TERRY J. OWENS |) | |
| Administrative Patent Judge |) | |
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| PAUL LIEBERMAN |) | APPEALS |
| Administrative Patent Judge |) | AND |
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