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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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT GRAF and STEFAN KEIPL

Appeal No. 2003-0078
Application No. 09/257,066

ON BRIEF

Before OWENS, LIEBERMAN and KRATZ, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-8 and 11-20. Claims 9 and 10, which are all of the other claims pending in this application, have been indicated as free of the prior art (allowable) by the examiner (answer, page 3).

BACKGROUND

Appellants' invention relates to a composition that comprises a liquid foam extinguishing formulation. The composition includes a film forming amphoteric surfactant, a foam

forming amphoteric surfactant, a frost proofing agent and a water soluble ammonium salt. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A liquid foam extinguishing formulation comprising a water soluble ammonium salt, a film-forming amphoteric fluorine surfactant, a foam-forming amphoteric co-surfactant, and a frostproofing agent, wherein the formulation is a stable, storable, ready to use, and frostproof single solution.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Falk (Falk '967)	4,090,967	May 23, 1978
Wirtz et al. (Wirtz)	4,203,850	May 20, 1980
Falk (Falk '286)	4,472,286	Sep. 18, 1984
Pennartz	5,091,097	Feb. 25, 1992
Barbarin et al. (Barbarin)	5,997,758	Dec. 07, 1999
		(102(e) date - Nov. 28, 1997)

Claims 1-4, 7, 8, 11-17, 19 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over either Falk '967 or Falk '286. Claim 18 stands rejected under 35 U.S.C. § 103 as being unpatentable over either Falk '967 or Falk '286 in view of Wirtz. Claims 1-8 and 11-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Barbarin in view of Falk '967 or Pennartz.

Appellants have identified claims 1-8 and 12-20 as being grouped together (brief, page 7). We treat the claims in that claimed grouping separately only to the extent appellants have argued the limitations of the claim(s) from that grouping separately with respect to any of the rejections consistent with 37 CFR § 1.192 (c) (7) (1997). Since appellants have not furnished such separate arguments, we select claim 1 as the representative claim for that claim grouping.

OPINION

After careful consideration of the issues raised in this appeal and with the arguments of both appellants and the examiner, we find that the § 103 rejections of the appealed claims are well founded and are sustainable essentially for the reasons advanced by the examiner in the answer. Accordingly, we affirm the decision of the examiner, and offer the following in additional support thereof.

Rejection over Falk '967 or Falk '286

Like appellants, Falk '967 discloses an aqueous film forming foam (AFFF) composition including a fluorinated surfactant, such as an amphoteric fluorinated surfactant, a foam forming surfactant, such as an amphoteric fluorine - free surfactant, an antifreeze (frost proofing) material, and an electrolyte, such

as an ammonium salt. See, e.g., column 3, line 60 through column 4, line 8, column 4, line 52 through column 5, line 12, column 5, line 67 through column 6, line 15, column 9, lines 9-19 and column 11, lines 7-20 of Falk '967. Also, see, e.g., column 8, lines 43-57, column 9, lines 43-48, column 10, lines 32-34, and column 11, lines 5-10 of Falk '286. Based on those disclosures and for the reasons set forth in the answer, we agree with the examiner's determination that one of ordinary skill in the art following the teachings of either of the applied Falk patents would have been led to a composition as set forth in representative appealed claim 1.

Appellants note that Falk '967: (1) does not furnish an example or prefer using an ammonium salt electrolyte; (2) prefers an anionic fluorinated surfactant; and suggests that a combination of an amphoteric fluorinated surfactant and an amphoteric non-fluorinated surfactant do not perform satisfactorily without a fluorinated synergist. Furthermore, appellants note that Falk '286 includes ion pair complexes in an aqueous film forming foam and is otherwise similar to Falk '967.

Based on those observations, appellants argue that the Falk patents would not have led one of ordinary skill in the art to

choose appellants' claimed composition with a reasonable expectation of success in so doing. We disagree.

We note that the Falk patents are not limited to the preferred or exemplified embodiments disclosed therein as appellants would appear to argue. Rather, the Falk patents may be relied upon for all they would have reasonably conveyed to one having ordinary skill in the art. See In re Beattie, 974 F.2d 1309, 24 USPQ2d 1040 (Fed. Cir. 1992); In re Young, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991); Merck & Co., Inc. v. Biocraft Laboratories, Inc., 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir. 1989).

Falk '967¹ discloses three subgeneric choices (anionic, amphoteric or cationic) for both the fluorinated and non-fluorinated surfactants. Clearly, one of ordinary skill in the art would have recognized that the combination of amphoteric fluorinated and amphoteric non-fluorinated surfactants were one of the limited number of choices available for those components. Moreover, Falk '967 teaches that an electrolyte may be employed in the composition and lists ammonium salts as one of a few

¹ Our rebuttal of appellants' arguments with respect to Falk '967 also applies to Falk '286 since Falk '286 refers to the AFFF composition of Falk '967 as a composition which would benefit from the ion pair complex addition described in Falk '286.

electrolytes that were singled out as being typical. As explained above, the mere fact that Falk '967 refers to three other polyvalent salts as exemplifying preferred salts does not detract from the explicit suggestion in Falk '967 to employ ammonium salt with a reasonable expectation of success in so doing.

As referred to by appellants, Falk' 967 does explain that Table 10 shows that amphoteric fluorinated surfactant provided less than satisfactory surface tension properties when combined in the particularly tested formulations without a fluorinated synergist. Falk '967 provides a solution to that problem. Add a fluorinated synergist. As such, the limited testing provided by Falk '967 can hardly be considered to constitute a teaching away from the use of amphoteric fluorinated surfactants as urged by appellants. Indeed, Falk '967 teaches that adding a fluorinated synergist with the preferred anionic fluorinated surfactant is also a predicate for achieving desirable low surface tensions. See Table 9.

In reaching the conclusion that the herein claimed subject matter is prima facie obvious over the teachings of the applied references, we also note that the prior art references in question need not provide all of appellants' reasons, such as an

alleged increase in stability of the composition (reply brief), to establish a prima facie case of obviousness. See In re Kemps, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1311 (Fed. Cir. 1996) (the motivation to combine features need not be identical to that of appellant to establish a prima facie case of obviousness). Furthermore, to the extent appellants may have recognized another potential advantage of the claimed composition that would have arisen by otherwise following the teachings of the prior art, that recognition does not necessarily form a basis for patentability. See In re Woodruff, 919 F.2d 1575, 1577-1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

As for separately argued claim 11, we agree with the examiner that Falk '967 teaches that a mixture of compounds may be employed for the fluorinated surfactant, which would include a mixture of amphoteric compounds. See, e.g., column 4, lines 7 and 8 of Falk '967. As reasonably determined by the examiner, one of ordinary skill in the art in employing more than one of the fluorinated amphoteric surfactants, such as listed in Table 1b of Falk '967, would have reasonably expected that the selected amphoteric surfactants would have differing physical properties, including different temperature resistances. While counsel asserts that such a temperature resistance difference may not be

inherent for different amphoteric surfactants (reply brief, page 6), no evidence to substantiate that any two or all of the amphoteric surfactants listed in Table 1b of Falk '967 do in fact have the same temperature resistance has been furnished by appellants. Appellants are in the best position to provide such evidence. Unsupported arguments of counsel simply cannot take the place thereof. See In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974).

Appellants also contend that the specification examples furnish indicia of unobviousness. To the extent that appellants are asserting that the examples establish unexpected results for the claimed composition, we note that the question as to whether unexpected advantages have been demonstrated is a factual question. In re Johnson, 747 F.2d 1456, 1460, 223 USPQ 1260, 1263 (Fed. Cir. 1984). Thus, it is incumbent upon appellants to supply the factual basis to rebut the prima facie case of obviousness established by the examiner. See, e.g., In re Klosak, 455 F.2d 1077, 1080, 173 USPQ 14, 16 (CCPA 1972). Appellants, however, do not provide an adequate explanation regarding any factual showing in the specification referred to in the briefs to support a conclusion of unexpected advantages.

Appellants have not furnished test results that are reasonably commensurate in scope with the here claimed invention. We note that representative claim 1 and separately argued claim 11 are not limited to a particular composition including the particular betaines and other surfactants and amounts thereof as prepared by the specific procedures outlined in the referenced examples of the specification. Nor are those claims limited to using diammonium phosphate or monoammonium phosphate in the amounts employed in the examples. We note that the representative claim 1 does not specify any particular amount of surfactants, frost proofing agent and ammonium salt. Thus, it is apparent that appellants' evidence is considerably more narrow in scope than the representative appealed claim 1 and separately argued claim 11. See In re Dill, 604 F.2d 1356, 1361, 202 USPQ 805, 808 (CCPA 1979).

Moreover, appellants simply have not shown any examples prepared for comparison as representing the closest prior art. Hence, we are not satisfied that the evidence of record that is offered demonstrates results that are truly unexpected and commensurate in scope with the claims. Nor have appellants satisfied their burden of explaining how the results reported in those limited samples presented can be extrapolated therefrom so

as to be reasonably guaranteed as attainable through practicing the invention as broadly claimed.

Having reconsidered all of the evidence of record proffered by the examiner and appellants, we have determined that the evidence of obviousness, on balance, outweighs the evidence of nonobviousness. Hence, we conclude that the claimed subject matter as a whole would have been obvious to one of ordinary skill in the art. Accordingly, we affirm the examiner's § 103 rejection over the Falk patents.

Falk '967 or Falk '286 in view of Wirtz

Concerning the examiner's rejection of claim 18, appellants do not specifically argue the combination of either Falk patent with Wirtz as to establishing the obviousness of using butyl diglycol in the composition of either Falk patent. Rather, appellants argue for the patentability of dependent claim 18 based on their arguments for the patentability of independent claim 1. It follows that we shall sustain the examiner's rejection of claim 18 for the reasons discussed above.

Barbarin in view of Falk '967 and Pennartz

We agree with the examiner that the combination of Barbarin, Falk and Pennartz establish the prima facie obviousness of the subject matter of representative claim 1 and separately argued

claim 11 for the reasons discussed above with respect to the teachings of Falk '967 alone and for the additional reasons set forth by the examiner in the answer.

Appellants' arguments with respect to liquid foam stability are noted but not found persuasive since representative claim 1 and separately argued claim 11 do not specify any particular degree of foam stability. The combination of the amphoteric surfactants is explicitly suggested by Falk '967. Moreover, Barbarin discloses that an AFFF composition can include amphoteric fluorine containing surfactants (column 2, lines 52-57), including mixtures thereof (column 3, lines 40 and 41), as well as other non-fluorinated amphoteric surfactants (column 5, lines 1-7 and 13-16). Falk '967 and Pennartz both teach that ammonium compounds may be added to AFFF compositions, Falk '967 for use as an electrolyte and Pennartz for use to retard flammability. Consequently, for the reasons discussed above and in the answer, we will sustain the examiner's rejection.

CONCLUSION

The decision of the examiner to reject claims 1-4, 7, 8, 11-17, 19 and 20 under 35 U.S.C. § 103 as being unpatentable over either Falk '967 or Falk '286; to reject claim 18 under 35 U.S.C. § 103 as being unpatentable over either Falk '967 or Falk '286 in view of Wirtz; and to reject claims 1-8 and 11-20 under 35 U.S.C. § 103 as being unpatentable over Barbarin in view of Falk '967 or Pennartz 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

TERRY J. OWENS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
PAUL LIEBERMAN)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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Appeal No.2003-0078
Application No.09/257,066

Page 14

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