

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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JO-ANN E. BICE, STUART D. HELLRING,
TIMOTHY A. OKEL and JAMES R. HAHN

Appeal No. 2004-0448
Application No. 09/636,311

ON BRIEF

Before PAK, OWENS, and TIMM, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1-17, which are all of the claims in the application.

THE INVENTION

The appellants claim a method for making a hydrophobic particulate inorganic oxide having a carbon content that is substantially non-extractable and an M1 Standard White Area of less than 0.4%.¹ Claim 1 is illustrative:

¹ The procedure for determining the M1 Standard White Area is described in the appellants' specification (page 30, line 7 - page 40, line 29).

1. In the method of producing a hydrophobic particulate inorganic oxide by contacting an acidic aqueous suspension of a particulate inorganic oxide selected from the group consisting of precipitated silica, colloidal silica and mixtures of such inorganic oxides, with an organometallic compound to form an acidic aqueous suspension of hydrophobic particulate inorganic oxide, optionally in the presence of a surfactant and/or a water miscible solvent, and recovering said hydrophobic particulate inorganic oxide, the improvement comprises using said organometallic compound in an amount sufficient to hydrophobize the inorganic oxide, such that the inorganic oxide has a hydroxyl content of from 2 to 15 OH/nm², a carbon content of from 0.1 to 6 weight percent, and a methanol wettability of from 15 to 45 percent, in an aqueous suspension of inorganic oxide having a pH of 2.5 or less, and treating the acidic aqueous suspension of the hydrophobic particulate inorganic oxide with acid neutralizing agents to produce a hydrophobic particulate inorganic oxide having a pH of from 3 to 10, a carbon content that is substantially non-extractable and an M1 Standard White Area of less than 0.4 percent.

THE REFERENCES

Griffith et al. (Griffith)	5,908,660	Jun. 1, 1999
Lightsey et al. (Lightsey)	5,985,953	Nov. 16, 1999
Burns et al. (Burns)	6,051,672	Apr. 18, 2000

THE REJECTIONS

Claims 1-17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Griffith in view of Lightsey and/or Burns.

OPINION

We reverse the aforementioned rejection. We need to address only the sole independent claim, i.e., claim 1.

The appellants' claim 1 requires that the hydrophobic particulate inorganic oxide has an M1 Standard White Area of less

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than 0.4%. The examiner argues that "[t]he same materials treated in similar processes would be expected to exhibit similar properties such as M1 standard white area" (answer, page 4).

The examiner has not provided any evidence or technical reasoning which shows that the process in any of the relied-upon references is sufficiently similar to that of the appellants that there is a basis for reasonably believing that the hydrophobic particulate inorganic oxide has an M1 Standard White Area of less than 0.4%. Also, the examiner has not pointed out any disclosure in the applied references which shows that the hydrophobic particulate inorganic oxide has a high degree of dispersibility in cured rubber compositions which, as pointed out by the appellants (specification, page 3, lines 14-18; page 26, lines 11-13), is characterized by a low M1 Standard White Area. Nor has the examiner explained why the applied references would have led one of ordinary skill in the art to obtain high dispersibility in cured rubber compositions such that it reasonably appears that the M1 Standard White Area is the same as that of the appellants' hydrophobic particulate inorganic oxide.

The examiner's mere speculation is not sufficient for showing inherency, see *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981), or obviousness, see *In re Warner*, 379 F.2d

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1011, 1017, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968), of a hydrophobic particulate inorganic oxide having and M1 Standard White Area of less than 0.4%.

For the above reasons we reverse the examiner's rejection.

DECISION

The rejection of claims 1-17 under 35 U.S.C. § 103 over Griffith in view of Lightsey and/or Burns is reversed.

REVERSED

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Chung K. Pak)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
Terry J. Owens)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
Catherine Timm)	
Administrative Patent Judge)	

TJO/eld

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