

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NAVEEN CHOPRA, PETER M. KAZMAIER, PAUL F. SMITH,
and PAUL J. GERROIR

Appeal No. 2005-1087
Application No. 10/175,587

ON BRIEF

Before GARRIS, WARREN, and OWENS, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 11-16.

The subject matter on appeal relates to a composition comprising a plurality of microcapsules each including a polymerized micelle shell encapsulating a liquid droplet and a particle component. This appealed subject matter is adequately illustrated by independent claim 11 which reads as follows:

Appeal No. 2005-1087
Application No. 10/175,587

11. A composition comprising: a plurality of microcapsules each including a polymerized, optionally hardened, micelle shell encapsulating a liquid droplet and a particle component.

The following references are relied on by the examiner:

Chopra et al. (Chopra '870)	6,488,870	Dec. 3, 2002
Chopra et al. (Chopra '025)	6,492,025	Dec. 10, 2002

All of the appealed claims are rejected under 35 U.S.C. § 102(e) as being anticipated by either Chopra '870 or Chopra '025.¹

We refer to the brief and to the answer for a complete exposition of the opposing viewpoints expressed by the appellants and by the examiner concerning these rejections.

OPINION

We will sustain each of these rejections.

¹On page 3 of the brief the appellants state that "[t]he claims do not stand or fall together." However, in the "ARGUMENT" section of the brief, none of the here rejected claims have been separately argued. It is well settled that, in order to obtain separate consideration of commonly rejected claims, the claims must be not only separately grouped but also separately argued. See former regulation 37 CFR § 1.192(c)(7)(2003); compare current regulation 37 CFR 41.37(c)(1)(vii)(September 2004). Also see In re Dance, 160 F.3d 1339, 1340 n.2, 48 USPQ2d 1635, 1636 n.2 (Fed. Cir. 1998) and Ex parte Schier, 21 USPQ2d 1016, 1018 (Bd. Pat. App. & Int. 1991). Under these circumstances, our disposition of the above noted rejections will be based on representative claim 11 which is the sole independent claim on appeal.

Appeal No. 2005-1087
Application No. 10/175,587

On the record before us, the appealed claim 11 description of the here claimed shell as being a "micelle" shell is the one and only claim feature urged by the appellants as distinguishing from the respective compositions of the applied Chopra patents. In this regard, it is the appellants' position that "[t]he two documents [i.e., Chopra '870 and Chopra '025] describe microcapsules with a complex coacervation induced shell, but such a shell is different from a micelle shell" (brief, page 3). With further regard to this matter, the appellants point out that their specification discloses a process for fabricating a micelle shell which employs an amphiphile and that the applied Chopra patents contain no disclosure of such a process involving an amphiphile. The appellants' position lacks persuasive merit.

The independent claim on appeal contains no limitations relative to the manner in which the here claimed micelle shell has been fabricated and thus is not limited to a micelle shell fabricated via the process involving amphiphiles disclosed in the subject specification. On the other hand, commonly accepted definitions of the terms "coacervate" and "micelle" support the

Appeal No. 2005-1087
Application No. 10/175,587

examiner's viewpoint that the coacervation shell described in the Chopra references and the micelle shell recited in appealed claim 11 are indistinguishable.²

Because the prior art coacervation shell and the here claimed micelle shell appear to be indistinguishable, we consider it appropriate to require that the appellants prove a distinction actually exists between the here claimed and prior art shells. This requirement is especially appropriate in this case due to the fact that the Chopra patents and the subject application are all assigned to the same real party of interest (i.e., Xerox Corporation). The fairness of so allocating the burden of proof is evidenced by the inability of the Patent and Trademark Office to manufacture products or to obtain and compare prior art products. See In re Best, 652 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977).

²According to Webster's II New Riverside University Dictionary (1984): "coacervate" is defined as "a cluster of droplets separated out of a lyophilic colloid," and "micelle" is defined as "a submicroscopic aggregation of molecules, as a droplet in a colloidal system."

Appeal No. 2005-1087
Application No. 10/175,587

For the above stated reasons, we hereby sustain the examiner's Section 102 rejections of all appealed claims as being anticipated by either Chopra '870 or Chopra '025.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv)(effective September 13, 2004; 69 Fed. Reg. 49960 (August 12, 2004); 1286 Off. Gaz. Pat. and TM Office 21 (September 7, 2004)).

AFFIRMED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES F. WARREN)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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TERRY J. OWENS)	
Administrative Patent Judge)	

BRG/hh

Appeal No. 2005-1087
Application No. 10/175,587

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