

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 JOHN R. CAMPBELL, PATRICK A. RODGERS,
RONALD J. WROCZYNSKI and JAMES P. BARREN

Appeal No. 2005-1529
Application No. 10/385,314

HEARD: AUGUST 9, 2005

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

PAK, *Administrative Patent Judge*.

ON REQUEST ON REHEARING

Pursuant to 37 CFR § 41.52 (2004), appellants request a rehearing of the Board's decision entered August 31, 2005 (hereinafter referred to as "Decision"), wherein we affirmed the examiner's decision rejecting the claims on appeal under 35 U.S.C. § 103.

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37 CFR § 41.52 states in relevant parts:

(a) (1) Appellant may file a single request for rehearing within two months of the date of the original decision of the Board The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a) (2) and (a) (3) of this section

(2) Upon a showing of good cause, appellant may present a new argument based upon a recent relevant decision of either the Board or a Federal Court.

(3) New arguments responding to a new ground of rejection made pursuant to § 41.50(b) are permitted.

The appellants have not challenged the examiner's position that "claims 1-17 stand or fall together" set forth at page 2 of the Answer. See the Brief and Reply Brief in their entirety. Nor have the appellants presented any substantive arguments for the separate patentability of the claims on appeal as discussed at page 3, footnote 1, of our Decision. The appellants, for the first time, argue the limitations of claims 6 and 12. The new arguments directed to claims 6 and 7 are not "based upon a recent relevant decision of either the Board or a Federal Court." See the Request for Rehearing in its entirety. Nor are these new arguments in response to any new ground of rejection made pursuant to 37 CFR § 41.50(b). Compare the

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Decision in its entirety with the Request for Rehearing in its entirety. Indeed, the appellants do not argue that our reference to the appellants' burden of proving unexpected results with respect to the claimed subject matter (e.g., a showing of unexpected results must be commensurate in scope with the claims on appeal) amounts to a new ground of rejection.¹ See the Request for Rehearing in its entirety. Thus, we decline to consider these new arguments.

Even if we were to consider these new arguments, however, the outcome of our Decision would not be altered. As recognized by the appellants (the Request for Rehearing, page 3), the sentence bridging pages 12 and 13 of our Decision contains an inadvertent, but harmless, error. That sentence, consistent with the appellants' understanding at page 3 of the Request for

¹ It is well settled that "[t]he appellants bear the burden of showing that the claimed invention imparts unexpected results. *In re Geisler*, 116 F.3d 1465, 1470, 43 USPQ2d 1362, 1364 (Fed. Cir. 1997); *In re Klosak*, 455 F.2d 1077, 1080, 173 USPQ154, 16 (CCPA 1972)." See the Decision, page 13. As indicated at page 14 of the Decision, this burden requires the appellants to evince that a showing of unexpected results is commensurate in scope with the degree of protection sought by the claims on appeal. Until the appellants discharge their burden, the examiner need not rebut the appellants' assertion of unexpected results. Here, we simply explain why the appellants fail to carry their burden of proving unexpected results with respect to the claimed subject matter. See the Decision, pages 15-16.

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Rehearing, should be changed as follows:

The second Figure at page 7 of the declaration shows that hydrolytic stability gradually [increases (weight loss gradually decreases)] as the total acid content of a given composition^[1] decreases from 1.6 and 04. [Footnote omitted.]

As also acknowledged by the appellants (the Request for Rehearing, page 3), BPA-DP3 results do not support the data point at an acid content of 3.25. To the extent they support the data point of an acid content of 3.2, the appellants have not demonstrated that they are reliable. See the Brief, Reply Brief and Request for Rehearing in their entirety. The appellants have acknowledged that even "[t]he datum for BPA-DP1 was omitted because of the anomalously low starting value for Mw." See the Decision, page 13. The appellants have not explained why BPA-DP3, unlike BPA-DP1, is reliable when BPA-DP3, like BPA-DP1, results in "the anomalously low starting value for Mw." See the Brief, Reply Brief and Request for Rehearing in their entirety. As indicated at pages 14 and 15 of our Decision, the appellants simply have not carried their burden of showing unexpected results.

Moreover, contrary to the appellants' arguments at page 2 of the Request for Rehearing, the appellants have not demonstrated that the showing relied upon by the appellants is commensurate in

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scope with the degree of protection sought by claims 6 and 12. As indicated at pages 12 and 13, footnotes 8 and 9, and at page 15 of our Decision, the showing in the specification and declarations is limited to couple very specific thermoplastic compositions. However, claims 6 and 12 still embrace multifarious thermoplastic compositions which are not supported by the showing in the specification and declarations. Claim 6, for example, broadly defines X of the already broadly recited formula in claim 5. It states that:

X is a divalent radical two or more aromatic rings joined by a non-aromatic linkage, any of which may be substituted at one or more sites on the aromatic rings with a halo group or (C1-C6)alkyl group and wherein the organophosphorus has an alkenyl phenyl diphenyl phosphate content of from 0 to 2000 parts by weight per million parts by weight of the organophosphorus compound.

Claim 12, on the other hand, does not require the presence of the additional polymers and compounds employed in the showing in the specification and declarations and is not limited to a "mixture of resocinol diphosphate oligomers having average degree of polymerization of 1.13" or a "[m]ixture of bisphenol A diphosphate [sic, diphosphate] oligomers with average degree of

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polymerization of 1.08" as indicated at page 15 of our Decision. Nor does claim 12 exclude the presence of material amounts of materially different ingredients, such as polymers and additives materially different from those employed in the showing in the specification and declarations. Thus, we determine that the showing of alleged unexpected results relied upon by the appellants is not commensurate in scope with the degree of protection sought by claims 6 and 12.

In view of the foregoing, the appellants' request for rehearing is granted to the extent of reconsidering our decision, but is denied with respect to making any change thereto.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REHEARING - DENIED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
CHUNG K. PAK)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
TERRY J. OWENS)	
Administrative Patent Judge)	

CKP:hh

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