

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JAMES R. BUTLER, BILL LEE HUMBLE and PAUL J. BURAS

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Appeal No. 2006-1330  
Application No. 10/212,927

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ON BRIEF

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Before KIMLIN, TIMM and FRANKLIN, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 4-10, 13-17 and 20-24. Claims 25-27 have been objected to by the examiner. Claim 1 is illustrative:

1. A method for preparing asphalt and polymer compositions comprising: (a) heating an asphalt; and consisting essentially of (b) adding a polymer to the asphalt; (c) adding a crosslinker to the polymer; (d) adding an activator to the polymer, where the activator is selected from the group consisting of oxides of metals from groups 2, 8, 9, 10, 11, and 12 of the Periodic Table (new IUPAC notation) in the absence of zinc, and mixtures thereof, where the activator is present in an amount sufficient to improve



Appeal No. 2006-1330  
Application No. 10/212,927

We have thoroughly reviewed the respective positions advanced by appellants and the examiner. In so doing, we find that the examiner's Section 112, second paragraph rejection is not sustainable. However, we fully concur with the examiner that the claimed subject matter is unpatentable under Section 102 and Section 103 over the applied reference. Accordingly, we will sustain the Examiner's Section 102 and Section 103 rejections for the reasons set forth in the answer.

We consider first the examiner's Section 112 rejection of claims 5, 14 and 21. According to the examiner, the claim language "thiazole derivatives" is indefinite since one of ordinary skill in the art "would not know which compounds are considered to be derivatives of thiazole and which thiazole derivatives would be effective in appellants' formulations, since these are no examples of said derivatives can be found [sic] in the specification" (page 3 of answer, penultimate paragraph).

It is well settled that claim language is not to be read in a vacuum but in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983); In re

Appeal No. 2006-1330  
Application No. 10/212,927

Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). In the present case, we agree with appellants that one of ordinary skill in the art would reasonably interpret the claim language as encompassing compounds that are derivatives of the basic thiazole structure that is well known in the art. It must be borne in mind that the breadth of a claim is not synonymous with indefiniteness, and the examiner's concern about whether all thiazole derivatives would be effective in appellants' formulations speaks to the enablement requirement of Section 112, first paragraph. The examiner has not made out a prima facie case that one of ordinary skill would be unable to practice the breadth of the claimed invention. Nor has the examiner made out the prima facie case that the appealed claims embrace a considerable number of inoperative thiazole derivatives. We point out, however, that it is not the function of the claims to specifically exclude possible inoperative embodiments. In re Dinh-Nguyen, 492 F.2d 856, 858-59, 181 USPQ 46, 48 (CCPA 1974).

We now turn to the examiner's Section 102 rejection of the appealed claims. The singular argument advanced by appellants is that the asphalt/polymer composition of Guo includes a

Appeal No. 2006-1330  
Application No. 10/212,927

compatibilizer and an organic polar compound that are not recited in the appealed claims. According to appellants, the claim language "consisting essentially of" excludes the compatibilizer and organic polar compound of the reference inasmuch as the presence of such compounds in the claimed composition would materially affect the basic and novel characteristics of the claimed composition.

We agree with the examiner that the language of the appealed claims fails to exclude the presence of the reference compatibilizer and organic polar compound from the claimed composition. For one, claim 1 on appeal, as well as independent claims 10 and 17, recite the open language "comprising" before listing claimed steps (a) through (e). Hence, the appealed claims are "open" to the inclusion of additional steps, such as the addition of the compatibilizer and organic polar compound of Guo. Secondly, although appellants make the assertion that the addition of the compatibilizer and organic polar compound of Guo would materially affect the basic and novel characteristics of the claimed composition, the examiner has properly pointed out that appellants have not offered any rationale, let alone

Appeal No. 2006-1330  
Application No. 10/212,927

objective evidence, which demonstrates that the claimed asphalt composition would be materially affected by such addition of components. Appellants have not established that asphalt/polymer compositions within the scope of the appealed claims are materially different than the asphalt/polymer compositions fairly taught by Guo.

As for the examiner's Section 103 rejection over Guo, it logically follows from our discussion above that we agree with the examiner that the claimed subject matter would have been obvious to one of ordinary skill in the art. Anticipation is the epitome of obviousness.

As a final point, we note that appellants base no argument upon objective evidence of nonobviousness, such as unexpected results.

Appeal No. 2006-1330  
Application No. 10/212,927

In conclusion, based on the foregoing, the examiner's rejection under Section 112 is reversed, whereas the examiner's rejections under Section 102 and Section 103 are affirmed. Consequently, the examiner's decision rejecting the appealed claims 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

EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
CATHERINE TIMM	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
	)	
	)	
	)	
BEVERLY A. FRANKLIN	)	
Administrative Patent Judge	)	

ECK/hh

Appeal No. 2006-1330  
Application No. 10/212,927

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