

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte
MICHAEL T. SHELTON, RANDALL R. HILLYER,
and DONALD W. RAWLINS

Appeal 2008-0152
Application 10/460,064
Technology Center 3600

DECIDED: February 21, 2008

Before TONI R. SCHEINER, LORA M. GREEN,
and RICHARD M. LEBOVITZ, *Administrative Patent Judges*.

SCHEINER, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 1-4, all the claims in the application, as obvious over the prior art. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

BACKGROUND

The claimed invention is directed to synthetic rubber fishing lures. According to Appellants, there are at least three properties that “must be balanced to achieve a good quality lure” (Spec. 3), specifically, surface tackiness, heat deformation, and “processibility” (*id.* at 2-3). “Heat deformation refers to the body losing its original shape after being exposed to an elevated temperature for a prolonged period of time” (*id.* at 2). “Processibility refers to the flowability of the extrudate into the cavities of the mold while retaining reasonable cycle times” during manufacture of the lure (*id.* at 2-3).

STATEMENT OF THE CASE

The claimed invention is directed to a fishing lure or bait made of a composition comprising a mixture of a styrenic block copolymer and at least two oils, of different viscosities, selected from mineral oils, silicone oils, and mixtures thereof.

Claims 1-4 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the “Admitted Prior Art”¹ in view of Hastings.²

Appellants have not argued the rejected claims separately. Therefore, we select claim 1 as representative of the claimed subject matter for the purpose of deciding this appeal, and claims 2-4 will stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii).

¹ The Examiner relies on Appellants’ description of the disclosure of U.S. Patent Application Publication No. 2002/01888057A1 [sic, 2002/0188057 A1], which is set forth on page 3 of Appellants’ Specification.

² U.S. Patent 4,589,223 to Hastings, issued May 20, 1986.

Claim 1 reads as follows:

1. A fishing lure or bait comprising a shaped body of a gelatinous elastomeric composition comprising a styrenic block copolymer and an oil mixture of a first oil and a second oil, where said first oil and said second oil are selected from the group consisting of: mineral oils, silicone oils or mixtures thereof;

the first oil having a viscosity and the second oil having a viscosity, the first oil viscosity being greater than the second oil viscosity, the second oil being in excess of the first oil.

FINDINGS OF FACT³

1. Citing U.S. Patent Application Publication No. 2002/01888057A1 [sic, 2002/0188057A1], the present Specification states that “[o]ne prior art composition of blended styrenic block copolymers (SEEPS (styrene ethylene/ethylene-propylene-styrene), SEBS (styrene ethylene/butylene styrene), and SEPS (styrene ethylene/propylene styrene)) and a single oil (SEMTOL) produced lures with unacceptable heat deformation. Another prior art composition of blended styrenic block copolymers (SEEPS, SEBS, SEPS) and equal amounts of two oils (BLANDOL and SEMTOL) had unacceptable processibility” (Spec. 3).

2. According to the present Specification, lures made from a mixture of styrenic block copolymers (8.96% SEEPS, 2.99% SEBS, and 1.04% SEPS), two mineral oils (34.70% BLANDOL, and 52.05% SEMTOL), a UV stabilizer (0.13% TIN P), and a heat stabilizer (0.13% IRGANOX 1010), “had excellent elasticity and tear resistance, good heat deformation properties, [and] good processibility” (Spec. 8).

³ Abbreviated “FF”.

3. “BLANDOL white mineral oil, specific gravity @ 25°C/25°C (ASTM D4052) – 0.839/0.855; Kinematic viscosity @ 40°C, CST (ASTM D445) – 14.2/17.0”, is a “heavy oil” (Spec. 6).
4. “SEMTOL white mineral oil, specific gravity @ 25°C/25°C (ASTM D4052) – 0.804/0.827, Kinematic viscosity @ 40°C, CST (ASTM D445) – 3.9/5.5”, is a “light oil” (Spec. 6).
5. According to the Specification, “increasing the amount of the heavier oils (i.e., greater molecular weight or greater viscosity) decreased heat deformation and processibility, and increased surface tack” (Spec. 6).
6. Hastings describes a composition for casting elastomeric fishing lures comprising styrenic block copolymers, fish oil, agricultural oil, and mineral oil, all in different weight percentages. For example, one composition contains a styrenic copolymer (30% by weight), cod liver oil (58% by weight), soybean oil (6% by weight), mineral oil (5% by weight), and a colorant (1% by weight) (Hastings, col. 4, ll. 15).
7. Hastings teaches that the mineral oil, which can constitute up to 35% by weight of the composition, “acts to make the composition less tacky” (Hastings, col. 3, ll. 17-25). Thus, persons of skill in the art would have known that varying the proportion of oil in a composition would affect its tackiness (Ans. 4-5).
8. Claim 1 is directed to a fishing lure comprising a styrenic block copolymer and a mixture of first and second mineral oils, silicone oils, or mixtures thereof, wherein the first and second oils have different viscosities. No particular viscosities or proportions are required, except that the oil of lesser viscosity must be in excess of the oil of greater viscosity.

DISCUSSION

The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) secondary considerations of nonobviousness, if any. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). “In determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls. What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741-42 (2007).

Appellants concede that “[t]he admitted prior art has all the elements [of claim 1] except the ratio of oils to one another” (Br. 10), but contend that “neither the admitted prior art nor Hastings . . . teach[es] or suggest[s] that the problem of heat deformation can be controlled through use of an oil mixture where the viscosity of the oil is the determining factor in their selection” (Br. 11). Appellants “submit that the suggestion for selection of an oil based on its viscosity from the group consisting of: mineral oils, silicone oils or mixtures thereof . . . originated only by their own teaching” (Br. 11).

Nevertheless, we find no error in the Examiner’s conclusion that it would have been obvious to vary the relative amounts of the lighter and heavier oils in the composition of the Admitted Prior Art.

The *only* difference between the composition of the Admitted Prior Art and that of the invention of claim 1 is that the higher and lower viscosity

oils are present in the prior art composition in equal amounts (FF 1, 2, 3, 4), while the lower viscosity oil is in “excess” of the higher viscosity oil in the claimed composition. However, persons of skill in the art would have known that varying the proportion of oil in a composition would affect its tackiness (FF 7). “The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims.” *In re Woodruff*, 919 F.2d 1575, 1578 (Fed. Cir. 1990) (citations omitted). “These cases have consistently held that in such a situation, the applicant must show that the particular range is *critical*, generally by showing that the claimed range achieves unexpected results relative to the prior art range.” *Id.* In addition,

[i]n order for a showing of “unexpected results” to be probative evidence of non-obviousness, it falls upon the applicant to at least establish: (1) that there actually is a difference between the results obtained through the claimed invention and those of the prior art; and (2) that the difference actually obtained would not have been expected by one skilled in the art at the time of invention.

In re Freeman, 474 F.2d 1318, 1324 (CCPA 1973).

Appellants have made no such showing. Appellants have merely stated that a prior art composition of blended styrenic block copolymers (SEEPS, SEBS, SEPS) and equal amounts of two oils (BLANDOL and SEMTOL) had “unacceptable processibility” (Spec. 3; FF 1), while Appellants’ mixture of styrenic block copolymers (8.96% SEEPS, 2.99% SEBS, and 1.04% SEPS), two mineral oils (34.70% BLANDOL, and 52.05% SEMTOL), a UV stabilizer (0.13% TIN P), and a heat stabilizer (0.13% IRGANOX 1010), “had excellent elasticity and tear resistance, good

heat deformation properties, [and] good processibility” (Spec. 8; FF 2). No objective comparison between the two compositions is provided.

In any case, we note that the composition described at page 8 of the Specification is not commensurate in scope with the composition of claim 1, as the claim does not require oils of any particular viscosity, nor does the claim require any particular proportion of the first oil to the second, or even to the to unspecified styrenic block copolymers.

We find that Appellants have not established that there is a difference between their results and the results obtained through the prior art relied upon, much less that any such difference would have been unexpected to one skilled in the art. Thus, on this record, Appellants have not established that the ratio of lower to higher viscosity oils is critical to improving heat deformability, or anything else.

We find no error in the Examiner’s *prima facie* case of obviousness. Accordingly, the burden of coming forward with evidence or argument was properly shifted to the Appellants. *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993). Appellants failed to carry their burden. Therefore, we affirm the rejection of claim 1 under 35 U.S.C § 103(a) as unpatentable over the “Admitted Prior Art” and Hastings. As discussed above, claims 2-4 fall accordingly. The Examiner’s rejection of claims 1-4 as unpatentable under 35 U.S.C. §103 is affirmed.

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

AFFIRMED

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