

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Gerhard Barich,
Appellant

Appeal 2008-5761
Application 10/398,722¹
Technology Center 1700

Decided: September 30, 2008

Before EDWARD C. KIMLIN, THOMAS A. WALTZ, and
MARK NAGUMO, *Administrative Patent Judges*.

NAGUMO, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application 10/398,722, *Method for the Production of at Least One Body and a Pourable Mixture for Use in Such a Method*, filed 26 September 2003, which is the national stage of an application filed under 35 U.S.C § 371 on 8 October 2001. The real party in interest is listed as Gerhard Barich. (Twice Amended Appeal Brief on Appeal, filed 5 October 2006 (“Br.”), 2.)

A. Introduction

Gerhard Barich (“Barich”) timely appeals under 35 U.S.C. § 134(a) from the final rejection of claims 28-65, which are all of the pending claims. We REVERSE.

The subject matter on appeal relates to a replacement for polyvinylchloride (“PVC”) suspensions that are cured, typically in molds. The claimed compositions comprise a thermoplastic elastomer, a non-PVC thermoplast, a filler, and a suspending fluid.

Claim 65 is representative and reads as follows:

Claim 65:

Flowable mixture for manufacturing at least one body, the flowable mixture comprising

- a) a powder comprising particles
 - with a grain size of at least predominantly below 500 μm
 - and which contain
 - at least one thermoplastic elastomer
 - and at least one of a further thermoplast other than PVC
 - and
 - at least one filler, and
- (b) a fluid in which the powder is suspended.

(Claims App., Br. 23, paragraphing and indentation added.)

The Examiner has maintained the following rejection:
claims 28-65 stand rejected under 35 U.S.C § 103(a) in view of
the combined teachings of Ruch² with either Breuer³ or
Lundberg.⁴

B. Discussion

The burden is on Barich, as the Appellant, to prove reversible error in the rejections on appeal. *See, e.g., In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). A prima facie case of obviousness is not established unless every limitation is shown to be taught or suggested by the applied prior art.

The claimed subject matter requires a powder having small particles, predominantly less than 500 µm, comprising a thermoplastic elastomer, a thermoplast other than PVC, and a filler, suspended in a fluid.

The Examiner finds that Breuer and Lundberg each differs “from the claimed invention in that they fail to specifically call for the incorporation of

² Klaus Ruch and Ingolf Scheffler, *Plastisol Composition*, U.S. Patent 5,668,209 (1997).

³ Olaf Kurt Breuer et al., *Elastosols, Process for the Preparation Thereof, Process for the Use of Such Elastosols and Products Derived From Them*, U.S. Patent 5,900,455 (1999).

⁴ Robert D. Lundberg and Henry S. Makowski, *Composition for Fabrication of Multiphase Plastics from Liquid Suspension*, U.S. Patent 4,125,506 (1978).

a filler.” (Ans. 4.) The Examiner finds that Ruch teaches methods of making bodies formed from flowable mixtures comprising particles made from styrene copolymers, plasticizers and “organic fillers.” (*Id.* at 4, citing Ruch, Abstract.) The Examiner cites the examples of Ruch as incorporating inorganic fillers such as carbon black and titanium dioxide. (*Id.*)

Barich objects, *inter alia*, that neither Breuer nor Lundberg teaches the added thermoplast, and that the combination with Ruch to add fillers is improper. (Br. 5-6.)

The Examiner does not address the first objection, and argues only that the record shows that the addition of fillers to compositions is well known and conventional. (Ans. 5.)

Only the first of Barich’s objections has merit. The Examiner appears to have overlooked the claim limitation that a thermoplast that is not PVC must be a component of the particles. Nor is such a teaching apparent from Breuer, Lundberg, or Ruch. The basis of the Examiner’s citation of teachings of “organic fillers” in the Abstract of Ruch is not apparent. The Ruch abstract states that “further crosslinkers or strengtheners can be added,” (Ruch, Abstract), but the descriptions in the Ruch specification refer to small molecules and prepolymers that react or crosslink with the thermoplastic elastomers. (Ruch 3:27-4:6.) There is no apparent basis to characterize these added materials as “thermoplasts,” i.e., thermoplastic polymers. It appears, particularly in light of the subsequent reference to the

teachings of inorganic fillers by Ruch, that the Examiner's reference to "organic fillers" is a typographical error for "inorganic fillers."⁵

The issue of whether it would have been obvious to add additional thermoplasts to the block copolymer particles has not been sufficiently developed for us to resolve on appeal.

C. Summary

In view of the record and the foregoing considerations, it is:

ORDERED that the rejection of claims 28-65 under 35 U.S.C § 103(a) in view of the combined teachings of Ruch with either Breuer or Lundberg is REVERSED.

REVERSED

rvb

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⁵ According to both Breuer and Lundberg, the block copolymer powders suspended in fluids are useful for forming objects such as toys (Breuer 1:28; Lundberg abstract; 9:38), and Lundberg mentions that its compositions could be useful for making automobile tubes or tires (Lundberg 11:65-67). As supported by Ruch, the use of fillers in polymeric compositions used for making such objects is notorious in the relevant arts.