

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERIK LARIDON, GEOFFREY HAAS, and ROBERT DANKEL

Appeal 2008-5913
Application 10/454,348
Technology Center 1600

Decided: December 30, 2008

Before DONALD E. ADAMS, RICHARD M. LEBOVITZ, and
MELANIE L. MCCOLLUM, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal under 35 U.S.C. § 134 involves claims 1, 3, and 4, the only claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF THE CASE

The claims are directed to a styrenic thermoplastic article. Claim 1 is illustrative:

1. A styrenic thermoplastic article consisting essentially of at least one inorganic silver-containing compound and at least one carboxylic acid salt, wherein said styrenic thermoplastic article exhibits a surface-available amount of silver compound of at least 0.80 micrograms of silver/square decimeters of said surface, as measured by a salt-extraction test of 24 hours at room temperature.

The Examiner relies on the following prior art references to show unpatentability:

Konagaya et al. US 6,013,275 Jan. 11, 2000

The rejection as presented by the Examiner is as follows:
Claims 1, 3, and 4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Konagaya.

We affirm.

ISSUE

Does Appellants' claim 1 exclude a styrenic thermoplastic article wherein the inorganic silver-containing compound and carboxylic acid salt are not incorporated within the article?

FINDINGS OF FACT

1. Claim 1 is directed to a styrenic thermoplastic article. The claimed article consists essentially of at least one inorganic silver-containing compound and at least one carboxylic acid salt. According to claim 1 the styrenic thermoplastic article exhibits a surface-available amount of silver compound of at least 0.80 micrograms of silver/square decimeters of said surface, as measured by a salt-extraction test of 24 hours at room temperature.
2. Appellants do not dispute and therefore concede that Konagaya teaches “[a]n antibacterial laminate prepared by laminating the antibacterial composition . . . on at least one surface of an . . . organic substrate . . . [that] is a molded product prepared from a thermoplastic resin” (App. Br. 3).
3. Konagaya teaches that the “antibacterial agent is an inorganic compound which carries the particles and/or ions of at least one metal selected from the group consisting of silver (Ag), zinc (Zn) and copper (Cu), and/or an organic compound having said metallic ions attached thereto” (Konagaya, col. 3, ll. 41-45).
4. Appellants do not dispute and therefore concede to the Examiner’s finding that Konagaya teaches an article with a “carboxylic acid salt (e.g., magnesium acetate)” (Ans. 3).

PRINCIPLES OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over

the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

“It is well settled that a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it. Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates.” *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002) (citations and internal quotation marks omitted). “[A] prima facie case of anticipation [may be] based on inherency.” *In re King*, 801 F.2d 1324, 1327 (Fed. Cir. 1986). Once a prima facie case of anticipation has been established, the burden shifts to the Appellant to prove that the prior art product does not necessarily or inherently possess the characteristics of the claimed product. *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977) (“Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product.”). See also *In re Spada*, 911 F.2d 705, 708-09 (Fed. Cir. 1990).

Arguments not made are waived. See 37 C.F.R. § 41.37(c)(1)(vii) (“Any arguments or authorities not included in the brief or a reply brief ... will be refused consideration by the Board, unless good cause is shown.”).

ANALYSIS

The claims have not been argued separately and therefore stand or fall together. 37 C.F.R. § 41.37(c)(1)(vii). Claim 1 is representative.

Claim 1 is directed to a styrenic thermoplastic article (FF 1). The claimed article consists essentially of at least one inorganic silver-containing compound and at least one carboxylic acid salt (*id.*). Appellants argue that claim 1 is drawn to “a styrenic thermoplastic article that contains silver and a carboxylic acid salt incorporated within the article” (App. Br. 4). We disagree. We find nothing in claim 1 that would require that silver and a carboxylic acid salt are *incorporated* within the article. To the contrary, claim 1 simply requires the article to consist essentially of at least one inorganic silver-containing compound and at least one carboxylic acid salt. The claim is open to the location of these ingredients (e.g., in the article or on the article’s surface) as long as the article exhibits “a surface-available amount of silver compound.” As the Examiner explains, Appellants’ “claim does not require the styrene of the article to be, e.g., homogeneously embedded with the inorganic silver-containing compound or the carboxylic acid salt. Rather, the claim broadly recites an article consisting essentially of said elements” (Ans. 4). We agree.

Claim 1 further requires the styrenic thermoplastic article to exhibit a surface-available amount of silver compound of at least 0.80 micrograms of silver/square decimeters of said surface, as measured by a salt-extraction test of 24 hours at room temperature (FF 1).

The Examiner finds that Konagaya teaches a styrenic thermoplastic article that contains a carboxylic acid salt, an inorganic silver-containing compound (Ans. 3; FF 2-4). The Examiner concludes that “[a]pplicant’s

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[sic] article (as claimed) is the same as the prior art. It contains the same components in the same configuration. Properties are the same when the structure and composition are the same” (Ans. 3).

Appellants argue that Konagaya’s “styrene substrate itself does not contain silver and carboxylic acid salt incorporated within the substrate” (App. Br. 4). For the foregoing reasons we are not persuaded by Appellants’ argument. Appellants do not dispute and therefore concede that Konagaya’s article will exhibit a surface-available amount of silver compound of at least 0.80 micrograms of silver/square decimeters of said surface, as measured by a salt-extraction test of 24 hours at room temperature.

CONCLUSION OF LAW

Appellants’ claim 1 reads on an article wherein the inorganic silver-containing compound and carboxylic acid salt are not incorporated within the article. Accordingly, the rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Konagaya is affirmed. Claims 3 and 4 fall together with claim 1.

TIME PERIOD FOR RESPONSE

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

AFFIRMED

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WILLIAM S. PARKS
P.O. BOX 1927
SPARTANBURG SC 29304