

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREAS SEIDEL and THOMAS ECKEL

Appeal 2008-5946
Application 10/395,408
Technology Center 1700

Decided: January 15, 2009

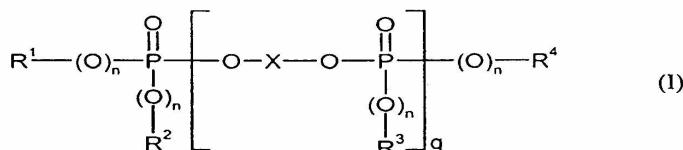
Before EDWARD C. KIMLIN, JEFFREY T. SMITH, and
CATHERINE Q. TIMM, *Administrative Patent Judges*.

KIMLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-16. We have jurisdiction pursuant to 35 U.S.C. §§ 6 and 134. A copy of illustrative claim 1 appears below:

1. A thermoplastic molding composition comprising polycarbonate and/or polyestercarbonate, a graft polymer and at least one oligomeric phosphoric acid ester conforming to formula (I),



wherein

$\text{R}^1, \text{R}^2, \text{R}^3$ and R^4 independently one of the others denote C_1 to C_8 alkyl, C_5 to C_6 cycloalkyl, C_6 to C_{20} aryl or C_7 to C_{12} aralkyl,

n independently one of the others denotes 0 or 1

q denotes 0.8 to 30 and

X denotes a member selected from the group consisting of mononuclear or polynuclear aromatic radical having 6 to 30 C atoms, and linear or branched aliphatic radical having 2 to 30 C atoms,

and calcined talc, the composition exhibiting improved toughness and weld line strength, UV and flame resistance, flowability and heat resistance in comparison to corresponding compositions in which the included talc is not calcined.

The Examiner relies upon the following references as evidence of obviousness:¹

Clauss	5,229,094	Jul. 20, 1993
Seidel '074	WO 01/48074 A1	Jul. 5, 2001
Seidel '465	6,737,465	May 18, 2004

¹ Both Appellants and the Examiner reference U.S. Patent No. 6,737,465 to Seidel as an accurate translation of WO '074.

Appellants' claimed invention is directed to thermoplastic molding compositions comprising a polycarbonate and/or poly(ester)carbonate, a graft polymer, at least one oligomeric phosphorous acid ester defined by the recited formula, and calcined talc. According to Appellants, the claimed composition comprising calcined talc exhibits improved color stability and flame resistances compared to corresponding compositions comprising talc that is not calcined.

Appealed claims 1-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over WO '074 in view of Clauss.

Appellants do not present separate arguments for any particular claim on appeal. Accordingly, all the appealed claims stand or fall together with claim 1.

We have thoroughly reviewed each of Appellants' arguments for patentability, as well as the declaration evidence relied upon in support thereof. However, we are in full agreement with the Examiner that the claimed subject matter would have been obvious to one ordinary skill in the art within the meaning of § 103 in view of the applied prior art.

Accordingly, we will sustain the Examiner's rejection for essentially those reasons expressed in the Answer, and we add the following for primarily for emphasis.

There is no dispute that WO '074, like Appellants, discloses a thermoplastic molding composition comprising polycarbonate, a graft polymer and a phosphorous acid ester in accordance with the claimed formula, as well as talc. WO '074 teaches that the talc may be naturally occurring or a synthetically prepared variety, but does not expressly disclose

calcined talc as one of the synthetic forms (col. 12, ll. 16-17). However, as pointed out by the Examiner, Clauss specifically teaches that calcined talc provides advantages over generic talc, for example, increasing the mechanical proprieties of thermoplastics (col. 2, l. 24 at sic). Accordingly, based on the collective teachings of WO ‘074 and Clauss, we concur with the Examiner that it would obvious for one of ordinary skill in the art to use calcined talc in the thermoplastic composition of WO ‘074 with the reasonable expectation of improving the mechanical properties of the composition. The fact the Clauss does not teach improved color stability and flame resistance as additional advantages of using calcined talc does not undermine the obviousness of using calcined talc in a thermoplastic molding composition of the type disclosed by WO ‘074. It is well settled that one can not gain patentability by simply finding another advantage of using a known or obvious composition, and it is not required for a finding of obviousness that the motivation for the skilled artisan to make a claimed composition be the same as an applicant’s motivation. *In re Kemps*, 97 F.3d 1427, 1430 (Fed. Cir. 1996). *See also In re Dillion*, 919 F.2d 688, 693 (Fed. Cir. 1990) (*en banc*). In the present case one of ordinary skill in the art would have found ample motivation for using calcined talc in the thermoplastic molding composition of WO ‘074.

Appellants rely upon comparative data in the Specification for showing that “the inventive composition in which the including talc is calcined exhibits improved color stability and considerably shorter burning time than does a corresponding composition where the included talc is uncalcined” (page 4 of principle Brief, first paragraph, citing the table at page 30 of the Specification). However, to the extent Appellants cite the

comparative data as evidence of unexpected results, the showing falls far short of being commensurate in scope with the degree of protection sought by the appealed claims. *In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983); *In re Clemens*, 622 F.2d 1029, 1035 (CCPA 1980). Claim 1 on appeal encompasses molding compositions comprising any polycarbonate and/or poly(ester)carbonate, any graft polymer, and any oligomeric phosphorous acid ester within the claimed formula. Also, the components recited in claim 1 may be present in any relative proportion inasmuch as no amounts are specified for the recited components. On the other hand, Appellants' Specification data is limited to two specific compositions which differ only in the type of talc used. In particular, the Specification examples use a linear polycarbonate based on bisphenol A with a relative solution viscosity of 1.24, a graft polymer of 40 parts by weight of a copolymer of styrene and acrylonitrile in the ratio 73:27 and 60 parts by weight of particulate crosslinked polybutadiene rubber, a styrene/acrylonitrile copolymer with a ratio of styrene to acrylonitrile of 72:28, a specific phosphate based on bisphenol A, chlorite talc with a chlorite content of 20 wt. %, tetrafluoroethylene polymer, pentaerythritol tetrastearate as a release agent, and phosphate stabilizer. Manifestly, the number of myriad molding compositions within the scope of the appealed claims far exceeds the single composition of the specification comparative data that is representative of the claimed invention. Appellants have made no showing that the exemplary composition is fairly representative of the thermoplastic molding compositions within the broad scope of the appealed claims.

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The Hager Declaration is offered only as evidence that UV stability and flame resistances are non-mechanical properties. The declaration fails to present any evidence of unexpected results.

In conclusion, based on the foregoing, it is our judgment that the evidence of obviousness presented by the Examiner outweighs the evidence of nonobviousness proffered by Appellants. Accordingly, 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 C.F.R. § 1.136(a)(I)(iv).

AFFIRMED

PL initial:
sld

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