

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL-JOACHIM BREKNER, HANSOTTO DROTLOFF, OTTO
HERMANN-SCHONHERR and ARNOLD SCHNELLER

Appeal No. 94-2267
Application No. 07/896,799¹

ON BRIEF

Before GARRIS, PAK, and OWENS, Administrative Patent Judges.
PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 15, which are all of the claims in the application.

Claim 1 is representative of the subject matter on appeal and reads as follows:

¹ Application for patent filed June 9, 1992. According to the appellants the application is a continuation of Application 07/640,997, filed January 14, 1991, now abandoned.

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polymer alloy as a whole must be also transparent. Id.

According to page 1 of the specification, the transparency of the organic polymer alloy must be such that the organic polymer alloy is suitable for optical applications. The specification then goes on to state at page 2:

The transparency of films made from polymer alloys is an indication that the components are homogeneously mixed.

The requirement for transparency, therefore, limits the types of materials included in the claimed organic polymer alloys. None of the Lakshmanan, Gallucci and Ames references indicates otherwise. As indicated by appellants, they are directed to different polymers and are no use in determining the scope of the appealed claims.

As evidence of unpatentability, the examiner relies on the Robeson reference. The Robeson reference is relied upon to show that blends of a crystalline poly(aryl ether ketone) and the claimed polyarylate are known. According to the examiner, the crystalline poly(aryl ether ketone) of the Robeson reference inherently contains some amorphous phase as indicated by the Isayev reference. Although the examiner recognizes that the Robeson reference is silent as to the requirement for, inter alia, transparency, the examiner does not explain why the Robeson

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reference as a whole would have suggested such a feature. It appears that the examiner is arguing that the recited transparent polymer alloys are inherently obtained.

To establish a prima facie case of unpatentability under inherency, the examiner has the initial burden of establishing that the transparent polymer alloys are inevitably formed by blending the crystalline poly(aryl ether ketone) and the polyarylate described in the Robeson reference. In re Oelirich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981); Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Int. 1990). On this record, however, the examiner has not supplied any objective evidence or scientific reasoning that the Robeson references inherently produces transparent organic polymer alloys suitable for optical applications, when the crystalline portion of the crystalline poly(aryl ether ketone) is present. There is also no indication that the crystalline portion of the crystalline poly(aryl ether ketone) can be homogeneously mixed

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with the amorphous polyarylate. Thus, we are constrained to reverse the examiner's decision to reject the appealed claims.

REVERSED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
CHUNG K. PAK)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
TERRY J. OWENS)	
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APPLICATION NO. 07/896,799

APJ PAK

APJ OWENS

APJ GARRIS

DECISION: REVERSED

Typed By: Jenine Gillis

DRAFT TYPED: 30 Nov 98

FINAL TYPED: