

File

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

MAR 29 1996

Ex parte KENNETH E. ATKINS

PAT & TM OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 94-1667
Application 07/799,727¹

ON BRIEF

Before TURNER, WEIFFENBACH and WARREN, Administrative Patent Judges.

TURNER, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the Examiner's decision finally rejecting claims 3, 4, 10, 12-17 and 19, which are all of

¹ Application for patent filed November 22, 1991. According to applicant, the application is a continuation of Application 07/331,696, filed March 31, 1989, now abandoned.

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the claims remaining under rejection. Claims 5-7 have been withdrawn from consideration under 37 C.F.R. § 1.142(b). Claims 1, 2, 8, 9, 11 and 18 have been cancelled. A copy of claim 19 as it appears in the appendix to the Brief is attached to this decision.

The references of record relied upon by the Examiner are:

Baum	3,721,722	Mar. 20, 1973
Atkins	4,374,215	Feb. 15, 1983
Takiyama et al. (Takiyama) (Japan, Koho)	71-36,462	Oct. 26, 1971

Chemical Abstracts, Vol. 77, Nr. 12, p. 49, No. 76144k, Sep. 18, 1972.

The appealed claims stand rejected under 35 U.S.C. § 103 as unpatentable over Takiyama (Japanese patent which has also been cited as Chemical abstracts No. 77: 76144k), Atkins and Baum. The appealed claims also stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite (this rejection was presented for the first time in the Examiner's Answer).

The subject matter on appeal is directed to a polyester based molding composition comprising 1) an unsaturated polyester resin, 2) a copolymerizable olefinically unsaturated monomer, 3) a pigment, 4) fiber reinforcement and 5) a poly(vinyl

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ether)polymer for control of shrinkage of the molding composition. A more detailed description can be gleaned from a reading of claim 19.

According to Appellant, the claims do not stand or fall together as to the prior art rejection. However, since Appellant has failed to separately argue the patentability of the claims, all of the contested claims will stand or fall together. In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claims are said to stand or fall together as to the rejection under § 112, second paragraph.

OPINION

We have carefully reviewed the record before us, including each of the arguments and comments advanced by Appellant and the Examiner in support of their respective positions. This review leads us to conclude that the Examiner's position is not well founded as to the prior art rejection. Accordingly, we will not sustain the rejection. We will, however, sustain the rejection under 35 U.S.C. § 112, second paragraph. Our reasons follow.

REJECTION OF CLAIMS 3, 4, 10, 12-17 AND 19 UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

We will affirm this rejection. The gravamen of the rejection is that the metes and bounds of the molecular weight of the poly(vinyl ether) polymer is not clearly defined since it is

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not clear whether number average molecular weight, weight average molecular weight or some other measurement is intended when describing the molecular weight of the poly(vinyl ether) polymer. Appellant has not provided any substantive response to the rejection, apparently believing that a proposed amendment would overcome the rejection. That proposed amendment was not entered. Accordingly, we will perforce affirm the rejection. We offer, however, the following comments. A first inquiry as to whether the claims satisfy the requirements of § 112, second paragraph, is to determine whether the claims set out and circumscribe a particular area with a reasonable degree of precision and particularity. It is here that definiteness of the language employed is analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing an ordinary level of skill in the pertinent art. In re Johnson, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977). It is axiomatic that limitations in the specification which are not a part of the claims are not read into the claims. Here, the specification, as indicated by the Examiner, describes two recognizably different molecular weights. We find ourselves at a loss to determine the molecular weight basis used to define the polymer based upon the claim language employed to describe the poly(vinyl ether)

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polymer. Consequently, the claims are, as indicated by the Examiner, indefinite.

REJECTION UNDER 35 U.S.C. § 103 OVER TAKIYAMA, ATKINS AND BAUM

We will not affirm this rejection. On this record, the Examiner has not, in the first instance, established a prima facie case of obviousness. The flaw in the Examiner's position is that there are no references applied against the claims which establish or make obvious a molding composition having a poly(vinyl ether) polymer and a pigment component. The Atkins reference has no poly(vinyl ether) low profile additive component in the molding composition and neither Takiyama nor Baum teaches a pigment component in the described resin compositions. Thus, based upon the undisputed recognition of generally accepted knowledge in the art regarding low profile additives which give good shrinkage control and poor pigmentability (Brief, pages 7 and 8 and specification, pages 4 and 5), we are of the view that the Examiner's conclusion of obviousness relies upon impermissible hindsight. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make the modifications, and here, the claimed invention, obvious unless the desirability of such modification is suggested by the prior art; the claimed invention cannot be used as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. In re

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Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). We conclude, therefore, that the Examiner has not established a prima facie case of obviousness and reverse.

Under the provisions of 37 C.F.R. § 1.196(c), we recommend that the claims be allowed if claim 19 is amended to make clear that the molecular weight of the poly(vinyl ether) polymer component has a weight average molecular weight of at least 50,000. Such an amendment would, in our opinion, make the claims allowable in the absence of new references or grounds of rejection.

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

AFFIRMED

Vincent D. Turner
VINCENT D. TURNER)
Administrative Patent Judge)

Cameron Weiffenbach
CAMERON WEIFFENBACH)
Administrative Patent Judge)

Charles F. Warren
CHARLES F. WARREN)
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APPENDIX

19. A polyester-based molding composition, comprising:
- a) an unsaturated polyester resin;
 - b) an olefinically unsaturated monomer that is copolymerizable with said unsaturated polyester resin;
 - c) a pigment;
 - d) fiber reinforcement; and
 - e) a poly(vinyl ether) polymer which is effective to control shrinkage of the molding composition and to promote uniform distribution of said pigment in the molding composition; said poly(vinyl ether) polymer having a molecular weight of at least 50,000 and being selected from the group consisting of:
 - 1) homopolymers of vinyl ethers of formula $\text{CH}_2=\text{CHOR}$; and
 - 2) copolymers of vinyl ethers of formula $\text{CH}_2=\text{CHOR}$ and olefins of formula $\text{R}'\text{CH}=\text{CHR}''$, in which at least 50 mole percent of the repeating units of said copolymers are derived from vinyl ether; andwherein:

R in each repeating unit containing an R moiety is independently selected from the group consisting of:

 - alkyl of 1-18 carbon atoms;
 - cycloalkyl of 3-8 carbon atoms;
 - phenyl;

alkylcycloalkyl having 1-8 carbon atoms in the alkyl moiety thereof; and

alkylphenyl having 1-8 carbon atoms in the alkyl moieties thereof; and

R' and R'' in each repeating unit containing these moieties are independently selected from the group consisting of:

hydrogen;

alkyl of 1-12 carbon atoms;

phenyl;

acyloxy;

alkoxycarbonyl;

hydroxyalkoxycarbonyl;

hydroxyl; and

carboxyl.