

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIROSHI AKITOMO and TSUGIO NOZOE

Appeal No. 95-0227
Application No. 08/061,406¹

ON BRIEF

Before CAROFF, METZ and WEIFFENBACH, Administrative Patent Judges.

CAROFF, Administrative Patent Judge.

DECISION ON APPEAL

This decision on appeal relates to the final rejection of claims 1-2, all the pending claims in the involved application.

The claims relate to a "clay-like" composition including a diorganopolysiloxane, a synthetic resin powder and a liquid paraffin.

¹ Application for patent filed May 12, 1993.

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We reverse each of the aforementioned rejections essentially for the reasons advanced by appellants in their brief, reply brief and supplemental reply brief. We add the following comments for emphasis.

I.

The examiner's case for nonenablement is based on an assertion that determination of whether a synthetic resin powder, other than one specifically disclosed by appellants, is suitable for inclusion in the claimed composition would involve undue experimentation. Thus, according to the examiner, the involved specification is enabling only for the particular resin powders exemplified in the disclosure on page 4, lines 6-12. We disagree.

As indicated by appellants, the examiner has failed to establish that undue experimentation would be involved in choosing a particular resin powder capable of producing a clay-like composition having a Williams Plasticity value within the claimed range, especially in view of the fact that the instant specification includes a number of specific examples of suitable resin powders. A broad assertion of a need for undue experimentation, unsupported by factual evidence and/or cogent

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technical reasoning, is insufficient to establish a case for nonenablement. Cf. Ex parte Forman, 230 USPQ 546, 547 (Bd. Pat. App. & Int. 1986).

II.

We agree with appellants that Sterling neither anticipates nor renders obvious the claimed subject matter. What the examiner apparently has failed to appreciate is that the maximum amount of polysiloxane in the Sterling composition is about 12 percent by weight; whereas present claim 1 in effect requires that over 14 percent by weight of polysiloxane be included in the composition at a minimum. Thus, it cannot be said that Sterling anticipates the claimed composition.

Moreover, with regard to obviousness, the examiner has not explained nor are we aware why it would have been obvious to increase the percentage of polysiloxane in the Sterling composition beyond the maximum percentage taught by Sterling. In this regard, we have little doubt that the properties of the Sterling composition necessary for production of medical grade tubings (the utility taught by Sterling) would be significantly affected by any adjustment of component proportions. Accordingly, we see absolutely no reason why a person of

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ordinary skill in that art would have found any need to use a greater amount of polysiloxane than taught by Sterling. On the other hand, we note that the presently claimed composition has been formulated by appellant for an entirely different purpose, i.e., for use as a clay-like handworking material for manual arts and crafts.

III.

In rejecting the claims under 35 U.S.C. § 112, second paragraph, the examiner asserts that the term "clay-like" is indefinite. With regard to that assertion we adopt as our own the position taken by appellants in their reply brief and supplemental reply brief. To effectively restate that position, we note that within the context of the instant specification and claims the term "clay-like" is reasonably construed as defining a composition which is "freely deformable and moldable at low stresses while being capable of retaining its induced shape when allowed to stand after molding" (specification: paragraph bridging pages 5-6). This is what we understand to be the commonly accepted attributes of a molding clay. In essence, "clay-like" as used in the claims is equivalent to a statement of intended use or function and, as such, is not indefinite per se.

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For the foregoing reasons, the decision of the examiner is reversed.

REVERSED

MARC L. CAROFF)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
ANDREW H. METZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
CAMERON WEIFFENBACH)	
Administrative Patent Judge)	

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APPLICATION NO. 08/061,406

APJ CAROFF

APJ WEIFFENBACH

APJ METZ

DECISION: **REVERSED**

Typed By: Jenine Gillis

DRAFT TYPED: 19 Feb 99

Revised: 15 Apr 98

FINAL TYPED: