

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte KANAKO IDA and SHINICHI YACHIGO

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Appeal No. 95-4754  
Application No. 08/111,905<sup>1</sup>

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HEARD: April 5, 1999

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Before OWENS, WALTZ and LIEBERMAN, Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

**DECISION ON APPEAL**

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 2 through 7. These are all of the claims remaining in the application.

**THE INVENTION**

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<sup>1</sup> Application for patent filed August 26, 1993.

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Appellants' invention is directed to a thermoplastic composition comprising the copolymer prepared by polymerizing an unsaturated nitrile in the presence of a rubber polymer and containing at least 50% by weight of the residue of a nitrile moiety. In the alternative the thermoplastic copolymer may be one obtained from copolymerizing an unsaturated nitrile in the absence of a rubbery polymer. In either case the claimed subject matter requires the presence of 2,4-di-t-amyl-6-[1-(3,5-di-t-amyl-2-hydroxyphenyl)ethyl]phenylacrylate. Claim 7 is illustrative of appellants' invention and is reproduced below.

7. A thermoplastic resin composition comprising

(a) a resin prepared by copolymerizing at least an unsaturated nitrile compound as a polymerizing component in the presence of a rubber polymer and containing at least 50% by weight of a structural unit derived from the unsaturated nitrile compound, or a resin prepared by copolymerizing at least an unsaturated nitrile compound as a polymerizing component in the absence of a rubber polymer, and

(b) 2,4-di-t-amyl-6-[1-(3,5-di-t-amyl-2-hydroxyphenyl)ethyl]phenylacrylate.

**THE REFERENCE OF RECORD**

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The examiner relies upon the following sole reference of  
record.

Yachigo et al. (Yachigo) 25, 1994	5,281,646	Jan.
		(Filed Sep. 21, 1992)

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### **THE REJECTIONS**

There are two rejections before us. Claims 2 through 7 stand rejected under the judicially created doctrine of double patenting as being unpatentable over claim 19 of U.S. Patent No. 5,281,646 to Yachigo. Claims 2 through 7 stand provisionally rejected under 35 U.S.C. § 103 based upon the Yachigo reference qualifying as prior art under 35 U.S.C. § 102(f) or (g).

### **OPINION**

We have carefully considered all of the arguments advanced by appellants and the examiner with respect to the obvious double patenting rejection. We shall not sustain the examiner's rejection.

The examiner in his Answer relies on the disclosure of Yachigo in column 3, lines 44-45 to show the unsaturated nitrile resin in the claimed subject matter is within the scope of patentee. See the Answer page 5, lines 5-7. The examiner further relies on the disclosure of claim 4 of Yachigo to show that the claimed additive is one of Yachigo's preferred species. It is well settled that the disclosure of a

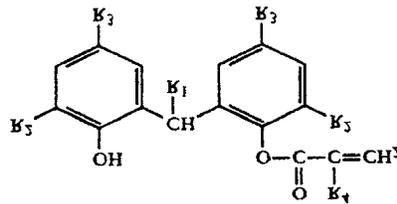
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patent cited in support of a double patenting rejection cannot be used as though it were prior art, even where the disclosure is found in the claims.

See General Foods v. Studiengesellschaft, 972 F.2d 1272, 1281, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992); In re Boylan, 392 F.2d 1017, 1018 n.1, 157 USPQ 370, 371, n.1 (CCPA 1968).

Accordingly, our analysis is limited to a determination of what has been patented, i.e. the subject matter which has been protected, not everything one may find to be disclosed by reading the patent.

The double rejection has claim 19 of depends on the



1. The product

19 requires that it be prepared from the process of claim 1

having a phenolic compound represented by the formula:

patenting been made over Yachigo which process of claim by process claim

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wherein R<sup>1</sup> is hydrogen or methyl, R<sup>2</sup> and R<sup>3</sup> independently of one another are each an alkyl of 1 to 9 carbon atoms, and R<sup>4</sup> is hydrogen or methyl. In order to arrive at appellants' single claimed additive one of ordinary skill in the art would have to make appropriate choices for each of R<sup>1</sup> through R<sup>4</sup>. In particular the independent choice of R<sup>2</sup> and R<sup>3</sup> would require choosing the appropriate number of carbons from 1 to 9, the appropriate structural isomer and the appropriate attachment point for each possible alkyl radical. Thereafter one would have to exercise a further choice as to the presence of sufficient vinyl cyanide compound to meet appellants' claimed limitations. Based upon the above considerations we conclude that the likelihood of arriving at appellants' claimed composition is extremely unlikely.

All proper double patenting rejections rest on the fact that a patent has been issued and a later issuance of a second patent will continue protection beyond the date of expiration of the first patent of the very same invention claimed therein or of a mere variation of that invention which would have been

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obvious to those of ordinary skill in the relevant art. See In re Kaplan, 789 F.2d 1574, 1579-80, 229 USPQ 678, 683 (Fed. Cir. 1986). The mere fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious. See In re Baird, 16 F.3d 380, 382, 29 USPQ2d, 1550, 1552 (Fed. Cir. 1994); In re Jones, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (Fed. Cir. 1992). As the disclosure of the Yachigo reference is unavailable to show obviousness of appellants' invention and there being no other evidence of record, there is no way this board can find an inconsequential occurrence of appellants' invention to be an obvious variant of Yachigo's claim 19. Accordingly, we conclude that there is no obviousness-type double patenting. Hence the requirement for a terminal disclaimer was improper.

We next turn to what appears to be a provisional rejection by the examiner over Yachigo under 35 U.S.C. § 103 based upon the Yachigo patent qualifying as prior art under 35 U.S.C. § 102(f) or (g) (Answer, page 6). The evidence present discloses that U.S. Patent 5,281,646 was issued to Shinichi Yachigo, Kanako Ida and Hiroshi Kojima and assigned to

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Sumitomo Chemical Company and Sumitomo Dow Limited. In contrast the instant application bears the names of Shinichi Yachigo and Kanako Ida as inventors, and Sumitomo Chemical Company as sole assignee.

As to the issue at hand, appellants have not commented on the examiner's rejection or acknowledged it as an issue. See appellants' Brief, page 2, section 4. The examiner, in contrast, appears to have made the provisional rejection supra. However, a rejection under § 103 relying on § 102(f) requires the examiner to establish a prima facie case of obviousness and show based on the evidence of record that, "he, did not himself invent the subject matter sought to be patented." The examiner has not met this burden. To constitute prior art under § 102(f) the examiner either would have to show that Shinichi Yachigo and Kanako Ida were not the inventors of the claimed subject matter in the instant application or that Hiroshi Kojima was the inventor of the subject matter sought to be patented. The examiner has not established that fact and there is no evidence of record to support such a finding. Accordingly, a § 103 rejection based upon 35 U.S.C. § 102(f) is not sustainable.

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As to the rejection under 35 U.S.C. § 102(g), we concluded supra that although the claimed invention was encompassed by claim 19 of Yachigo, it was not sufficient to render appellants' invention obvious, nor was it a mere variation of Yachigo's invention. Accordingly, a § 103 rejection based upon § 102(g) is not sustainable.

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**DECISION**

The rejection of claims 2 through 7 under the judicially created doctrine of double patenting as being unpatentable over claim 19 of U. S. Patent No. 5,281,646 is reversed.

The rejection of claims 2 through 7 under 35 U.S.C. § 103 based upon Yachigo qualifying as prior art under 35 U.S.C. § 102(f) or (g) is reversed.

**REVERSED**

TERRY J. OWENS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
THOMAS A. WALTZ	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
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	)	
PAUL LIEBERMAN	)	
Administrative Patent Judge	)	

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