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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

Ex parte MICHEL DUBOIS, BEATRICE GUYOT
and RICHARD THOMMERET

Appeal No. 1995-4810
Application No. 08/011,499[1]

HEARD: November 2, 1999

Before OWENS, WALTZ, and KRATZ, Administrative Patent Judges.

WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the examiner's refusal to allow claims 4 through 10 and 12, as amended subsequent to the final rejection (see the amendment dated June 30, 1994, Paper No. 13, entered as per the Advisory Action dated July 11, 1994,

[1] Application for patent filed January 29, 1993.

Paper No. 14). Claims 4-10 and 12 are the only claims remaining in this application.

According to appellants, the invention is directed to a composition exhibiting good heat resistance, good tracking current resistance, and good arc resistance, comprising specific amounts of polyphenylene sulphide (PPS), a polyamide prepared by polycondensation of adipic acid with m-xylylenediamine, and a metal hydroxide in which the main constituent is magnesium hydroxide (Brief, page 2). Claim 12 is illustrative of the subject matter on appeal and is reproduced below:

12. A composition exhibiting heat resistance, tracking current resistance, and arc resistance containing polyphenylene sulphide, and per 100 parts by weight of polyphenylene sulphide:

about 10 to 300 parts by weight of a polyamide prepared by polycondensation of adipic acid and m-xylylenediamine; and

about 20 to 350 parts by weight of a metal hydroxide in which the main constituent is magnesium hydroxide.

The examiner has relied upon the following references as evidence of obviousness:

Ohara	5,021,497	Jun. 4, 1991

Abstract No. 88-260861/37, from Derwent Publications Ltd., London, an abstract of Japanese 63-189,458 (hereafter the "Abstract", with no specified date).

Williams 0 278 555 Aug. 17, 1988
(Published European Patent Application)

Claims 4 through 10 and 12 stand rejected under 35 U.S.C. § 103 as unpatentable over the Abstract in view of Ohara and Williams (Answer, page 4).[2] We have considered the countervailing arguments presented by appellants in the Brief and the examiner in the Answer.[3] We *reverse* the examiner's rejection for essentially the reasons set forth in the Brief, page 6, first paragraph, and page 10, first paragraph. We add the following comments for completeness and emphasis.

OPINION

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[2]The examiner inadvertently lists the rejected claims as claims **5**-10 and 12 (Answer, page 4, first paragraph, see also the Answer, page 2).

[3]We note that appellants' Reply Brief was refused entry by the examiner (see the Reply Brief dated March 27, 1995, Paper No. 21, and the examiner's Response to Reply Brief dated July 11, 1995, Paper No. 24). Since the time for petition of this matter under 37 CFR § 1.181 has expired, appellants' Reply Brief has not been considered on the record before us.

The composition of appealed claim 12 requires certain amounts of at least three components, i.e., PPS, a polyamide prepared by polycondensation of adipic acid with m-xylylenediamine (e.g., PAMXD6, see the specification, page 4, lines 20-25), and magnesium hydroxide.

The examiner finds that the Abstract discloses polymer blends of PPS[4] and a polyamide with additional filler, such as aluminum hydroxide, to “provide sealing compositions for electronic parts which deter water seepage between the interfaces of wire and polymer.” (Answer, page 4). The examiner further finds that Ohara discloses that magnesium hydroxide used in conjunction with glass fibers in PPS compositions for electronic parts yields excellent arc resistance for these compositions, as opposed to the results for aluminum hydroxide (*Id.*). Finally, the examiner applies Williams for the teaching that magnesium hydroxide provides good electrical tracking resistance when used in polyamide compositions (*Id.*). From these findings, the examiner

[4]Actually the Abstract only discloses a "polyarylene sulphide" resin composition (see lines 1, 2 and 3 of the Abstract).

concludes that it would have been obvious to utilize magnesium hydroxide in lieu of the aluminum hydroxide of the Abstract since Ohara and Williams teach “the advantages in electrical arc resistance and tracking resistance to be afforded by such a variation.” (Answer, page 5).

“When determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. [Internal quotes and citations omitted].” *In re Rouffet,* 149 F.3d 1350, 1356, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). We determine that the examiner has not established the desirability, motivation or suggestion for combining the Abstract with the teachings of the secondary references to Ohara and Williams. Ohara teaches the improved arc resistance when using magnesium hydroxide in a PPS composition (column 1, lines 61-63) while Williams teaches the improvement in electrical tracking resistance with magnesium hydroxide in polyamide compositions (page 2). However, the Abstract relied upon by the examiner as the primary reference

does not disclose either of these properties taught to be improved in Ohara and Williams. The Abstract teaches that good adhesion is a desired property, as well as the ability of the composition to deter water seepage between the interfaces of the polymer and wire (see the Abstract, last four lines). Therefore we determine that the examiner has failed to present any reason or motivation for the combination of the secondary references to Ohara and Williams with the primary reference of the Abstract.

For the foregoing reasons, we find that the examiner has failed to establish a *prima facie* case of obviousness. Thus we need not reach the issue of the sufficiency of appellants' showing of unexpected results. See the Brief, pages 4-5 and 9, and the Table on page 9 of the specification. *See In re Geiger,* 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). Accordingly, the examiner's rejection of claims 4-10 and 12 under 35 U.S.C. § 103 as unpatentable over the Abstract in view of Ohara and Williams is reversed.

The decision of the examiner is reversed.

REMAND TO THE EXAMINER

Upon the return of this application to the jurisdiction of the examiner, the examiner and appellants should review the patentability of the claimed subject matter in view of a *full English translation* of the Japanese Kokai underlying the "Abstract" used as the primary reference in the rejection discussed above. From the limited disclosure of the Abstract, we cannot determine if "polyarylene sulphide" specifically includes PPS, if the "copolymeric polyamide" includes the specific polyamide of appellants' claims, if the melting point desired for the polyamide is less than 170EC.,[5] what other fillers are disclosed other than those exemplified in the Abstract, or if any electrical properties are desired for the compositions set forth in the Abstract. The examiner should make these and any other appropriate determinations following review of the full English translation of the reference.

This application is being remanded to the examiner for appropriate action, including review and reconsideration of the foregoing matters.

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[5]Note that the melting point listed for these same nylon polyamides in Williams is "above 180EC." (page 2, lines 21-22).

This application, by virtue of its “special” status, requires an immediate action, *MPEP* § 708.01 (D). It is important that the Board be promptly informed of any action affecting this application.

REVERSED & REMANDED

TERRY J. OWENS Administrative Patent Judge	)	
THOMAS A. WALTZ Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
PETER F. KRATZ Administrative Patent Judge	)	

lp

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Appeal No. 95-4810
Application No. 08/011,499

APJ WALTZ

APJ OWENS

APJ KRATZ

DECISION: REVERSED/REMANDED
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s):

Prepared: December 12, 2001

Draft Final

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OB/HD GAU

PALM / ACTS 2 / BOOK
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