

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(2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENNETH B. HIGGINS and
THOMAS E. AUSTIN

Appeal No. 96-0596
Application No. 08/069,887 ¹

ON BRIEF

Before METZ, PAK, and WALTZ , Administrative Patent Judges.

WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the
examiner's final rejection of claims 1, 2, 4 through 6, 8
through 11, 13 through 15, 17 through 23, 25 and 27 (answer,

¹ Application for patent filed June 1, 1993. According to
appellants, the application is a continuation of Application
07/660,296, filed February 22, 1991, now abandoned.

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page 1). Claims 28 through 30 stand withdrawn from consideration by the examiner as being drawn to a nonelected invention (brief, page 1). Claims 3, 7, 12, 16, 24, and 26, the remaining claims in this application, stand objected to as being dependent upon a rejected base claim but allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims (brief, page 3, and the final rejection dated July 1, 1994, Paper No. 9, page 2).

According to appellants, the invention is directed to a bituminous composition incorporating a finely divided inorganic filler and an acid functionalized polyolefin polymer having a plurality of pendant acid or acid anhydride groups (brief, page 1). This composition is used as a backing for carpet tiles (brief, page 1, and the specification, page 1). Claim 1 is illustrative of the subject matter on appeal and is reproduced below:

1. A bitumen composition comprising:

12 to 35 weight % of bitumen having a ring and ball softening point ranging from 100°F to 200°F and a needle point penetration of from 20 to 200;

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containing an inorganic metal compound and a polyethylene wax terminally functionalized with acid groups (answer, page 3, citing Woodhams, column 2, lines 13-26, and column 3, lines 9-68). As also noted by the examiner, the composition of Woodhams can be useful in adhesives, coatings, etc. (answer, page 3, citing Woodhams, column 6, lines 22-30).

The examiner concedes that there are two distinctions between Woodhams and the subject matter of appealed claim 1 (final rejection dated July 1, 1994, Paper No. 9, page 5). Namely, the weight percentages of bitumen and inorganic filler taught by Woodhams are different² than those of appealed claim 1 and the acid functionalized polyolefin polymer of Woodhams has terminal acid groups while the acid functionalized polyolefin polymer of appealed claim 1 recites "a plurality of

²Woodhams teaches that the relative proportions of bitumen, polyolefin, emulsifying agent and metal compound (filler) may vary according to the desired level of performance but generally the inorganic metal compound should be present in amounts of from about 1 to about 10 wt.% (column 5, lines 24-40). The amount of bitumen, although not specifically disclosed, should range from 65 to 96.9 wt.% (brief, page 4), as calculated from the ranges cited by Woodhams for all other components.

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pendant acid...groups"³ (brief, pages 3 and 6, and answer, pages 5-6).

The examiner concludes that "it would have been obvious to one of ordinary skill in the art to modify Woodhams by...using different weight percents since each of the components of the instant invention are disclosed in Woodhams." (final rejection dated July 1, 1994, Paper No. 9, page 5). The examiner also maintains the position that "the terminally acid functionalized polyolefins of Woodhams are equivalent to the pendent acid functionalized polyolefins of the instant invention." (answer, page 5) and "it would have been obvious to one of ordinary skill in the art to modify Woodhams by changing the location of the acid group on the polyolefin" (final rejection dated July 1, 1994, Paper No. 9, page 5, and the answer, page 6). We disagree.

"[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima*

³Terminal acid groups are acid groups attached to the end (or terminal) of the polyolefin backbone while pendant acid groups are attached to the interior of the polyolefin backbone (see "BP performance polymers," *Polybond® Product Bulletin*, ©BP Performance Polymers Inc., Hackettstown, New Jersey, June 1986, copy of record in parent Application No. 07/660,296).

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facie case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). On this record, the examiner has failed to show that the objective teachings of the applied prior art would have led one of ordinary skill in this art to modify the amounts of the components, e.g., to modify the maximum amount of inorganic metal compound (filler) in Woodhams from the disclosed maximum of 10% by weight to the minimum amount of 50% by weight recited in appealed claim 1. Although large amounts of fillers have been used in the prior art for the backing of carpet tiles,⁴ Woodhams is not directed to backings useful in carpet tiles. Accordingly, the examiner must show why one of ordinary skill in Woodhams' art would have been led to modify the amounts of the disclosed components in the bitumen composition.

On this record, the examiner has also failed to establish the equivalence of the acidic terminally functionalized polyethylene wax of Woodhams and the acid functionalized polyolefin with a plurality of pendant acid groups as recited

⁴See European Patent No. 309,674, cited at page 3 of the specification, and made of record in parent Application No. 07/660,296.

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in appealed claim 1. The burden is on the examiner to show that the commercially available modified polyethylene waxes preferred by Woodhams (column 4, lines 21-29) are inclusive of or encompass the preferred modified polyolefins disclosed by appellants (see the specification, page 6, line 13-page 7, line 5). See *Oetiker, supra*. The examiner has not cited any objective evidence⁵ to support the conclusion that the acidic polyethylene waxes of Woodhams are equivalent to the acid functionalized polyolefins recited in appealed claim 1.

For the foregoing reasons, we conclude that the examiner has not met the initial burden of presenting a *prima facie* case of obviousness. Since we find that the examiner has not established a *prima facie* case of obviousness, we need not reach the issue of the sufficiency of the showing of unexpected results. *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). Accordingly, the rejection of

⁵It should be noted that the "trade mark EPOLENE" disclosed at column 4, line 26, of Woodhams differs in spelling from the "brand name Epoleen" disclosed by appellants in the specification at page 7, lines 1-2.

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the appealed claims under 35 U.S.C. § 103 as unpatentable over Woodhams is reversed.

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

REVERSED

ANDREW H. METZ)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHUNG K. PAK)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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)	
THOMAS A. WALTZ)	
Administrative Patent Judge)	

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Application No. 08/069, 887

APJ WALTZ

APJ PAK

APJ METZ

DECISION: REVERSED
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s): 103

Prepared: August 16, 1999

Draft Final

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PALM / ACTS 2 / BOOK
DISK (FOIA) / REPORT