

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

Appeal No. 1996-1045
Application No. 08/143,415¹

ON BRIEF

Before JOHN D. SMITH, OWENS, and SPIEGEL, *Administrative Patent Judges*.
SPIEGEL, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 3 through 10. Claims 1 and 2, the only other claims pending in the application, have been withdrawn from further consideration under 37 C.F.R. § 1.142(b) as not readable on the elected invention. Claim 3 is illustrative:

¹ Application for patent filed October 26, 1993.

3. A pigmented, stereoregular, branched-mono-1-olefin polymer composition comprising:

- (a) tris(3,5-di-tert-butyl-4-hydroxybenzyl)isocyanurate;
- (b) bis(2,4-di-tert-butylphenyl)pentaerythritol diphosphite;
- (c) a costabilizer selected from the group consisting of sodium stearyl lactylate, calcium stearyl lactylate, calcium lactate, and mixtures thereof;
- (d) 2-Naphthalenecarboxamide, N,N'-(2-chloro-1,4 phenylene)bis[4-[2,5-dichlorophenyl)azo]-3-hydroxy-;
- (e) a stereoregular, branched-mono-1-olefin polymer.

The examiner relies on the following reference in rejecting the appealed claims:

| | | |
|--------|-----------|---------------|
| Yukawa | 4,366,280 | Dec. 28, 1982 |
|--------|-----------|---------------|

Claims 3 through 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Yukawa. We **reverse** this rejection.

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art reference and to the respective positions articulated by the appellant and the examiner. We make reference to the examiner's answer (Paper No. 10, mailed August 17, 1995) for the examiner's reasoning in support of the rejection, and to the appellant's amended brief (Paper No. 11, filed September 5, 1995) for the appellant's arguments thereagainst.

Appellant's invention is directed to a pigmented, stereoregular, branched-mono-1-olefin polymer composition comprising (e) a stereoregular, branched-mono-1-olefin polymer, a **specific** pigment, i.e., (d) 2-Naphthalenecarboxamide, N,N'-(2-chloro-1,4 phenylene)bis[4-[2,5-

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dichlorophenyl)azo]-3-hydroxy, also commonly known as C.I. Pigment Red 144, and a thermostabilizing additive, i.e., (a) tris(3,5-di-tert-butyl-4-hydroxybenzyl)isocyanurate; (b) bis(2,4-di-tert-butylphenyl)pentaerythritol diphosphite; and (c) a costabilizer selected from the group consisting of sodium stearyl lactylate, calcium stearyl lactylate, calcium lactate, and mixtures thereof.

OPINION

To establish a *prima facie* case of obviousness, there must be both some suggestion or motivation to modify the reference or combine reference teachings and a reasonable expectation of success. Furthermore, the prior art must teach or suggest all the claim limitations.

In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

Yukawa discloses thermoxidatively stabilized polyolefin compositions comprising (e) polyolefin, (c) calcium stearyl lactylate, (a) tris-(3,5-di-tert-butyl-4-hydroxybenzyl)-isocyanurate, and (b) di-(2,4-di-tert-butyl-phenyl)pentaerythritol diphosphite (col. 1, lines 7-11, 23, 36-55; col. 2, lines 20-50; col. 3, lines 30-33; col. 4, lines 21-22; col. 5, line 16; col. 6, lines 14-15). Yukawa states that other additives such as pigments may also be combined in the composition (col. 6, lines 41-43).

According to the examiner,

[s]election of any of the disclosed parameters of the patented invention would have been obvious to one having ordinary skill in the art at the time of appellant's invention.
[Answer, page 4, first full para.]

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However, the examiner has failed to point out and we fail to find where Yukawa discloses or suggests use of the **specific** pigment (d), i.e., C.I. Pigment Red 144, required by the claimed invention. The examiner has not established on this record either that C.I. Pigment Red 144 was generally known to be used in polyolefin compositions, such those described by Yukawa, or that *any* pigment might be used in the polyolefin composition of Yukawa. Thus, the examiner has failed to explain what would have motivated the skilled artisan to use C.I. Pigment Red 144 in the composition of Yukawa. Rather, the only place we find such suggestion is in the appellant's specification. Thus, we find that the examiner has relied on impermissible hindsight in making his determination of obviousness. *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) ("It is impermissible to engage in hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps."). Therefore, we conclude that the examiner has not established a *prima facie* case of obviousness as to claims 3-10, which all require the specific pigment C.I. Pigment Red 144.

Having concluded that the examiner has not established a *prima facie* case of obviousness, we do not reach the rebuttal evidence of unexpected results discussed on pages 5-8 of the amended brief.

CONCLUSION

To summarize, the decision of the examiner to reject claims 3 through 10 under 35 U.S.C. § 103 as unpatentable over Yukawa is **reversed**.

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