

The opinion in support of the decision being entered today was **not** written
for publication and is **not** binding precedent of the Board.

Paper No. 37

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL J. CARADORI,
ROBERT A. SMITH,
and MICHAEL A. ZUMBRUM

Appeal No. 97-3050
Application No. 08/646,646

ON BRIEF

Before WALTZ, LIEBERMAN, and PAWLIKOWSKI, Administrative Patent Judges.
LIEBERMAN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner refusing to allow claims 1 through 4, 6 through 8, 10, 11 and 13, which are all the claims pending in this application.

THE INVENTION

The invention is directed to a method for the preparation of one component of a two component room temperature vulcanizable (RTV) silicone composition. The method consists essentially of adding unreactive silicone oil and agglomerated filler to a mixer. A filler treating agent is added to the mixture and the comp mixed under conditions to reduce the size of the agglomerated filler particles to less than 300 μm . Other features of the claimed subject matter are set forth in the following illustrative claim.

THE CLAIM

Claims 1 is illustrative of appellants' invention and is reproduced below.

1. A method of preparing the first component of a two component RTV silicone

composition, said method consisting essentially of:

(a) preparing a filler/oil masterbatch comprising:

(i) adding an unreactive silicone oil and untreated agglomerated filler particles to a mixer:

(ii) adding a filler treating agent selected from the group consisting of organosilanes, polymeric organosilanes and silazanes to said unreactive silicone oil/filler mixture; and

(iii) mixing the treating agent and silicone oil/filler mixture at mixing conditions sufficient to break down the aggregated filler particles to an average size of less than 300_{μm} in a time period of less than about 24 hours to form a filler/oil masterbatch; and

(b) adding said filler/oil masterbatch to a reactive silicone oil.

THE REFERENCES OF RECORD

As evidence of obviousness, the examiner relies upon the following references.

Ceyzeriat		3,133,891		May, 19, 1964	
Smith (Smith '743)		3,635,743		Jan. 18, 1972	
Beers			3,847,848		Nov. 12, 1974
Kratel et al. (Kratel)		3,929,718		Dec. 30, 1975	
Elias et al. (Elias '919)	4,116,919	Sep. 26, 1978			
Smith (Smith '500)		4,490,500		Dec. 25, 1984	
Suzuki	4,560,711	Dec. 24, 1985			
Elias et al. (Elias '368)	4,882,368				Nov. 21, 1989
Fujiki et al. (Fujiki)	5,013,772	May 07, 1991			

THE REJECTIONS

Claims 1 through 4, 6 through 8, 10, 11 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith '743 or Beers and Smith '500 in view of Kratel, Elias '368, and Suzuki or Ceyzeriat.

Claims 1 through 4, 6 through 8, 10, 11 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fujiki and Elias '919 in view of Kratel, Elias '368, and Suzuki or Ceyzeriat.

OPINION

We have carefully considered all of the arguments advanced by the appellants and the examiner and agree with the appellants that the rejections of claims 1 through 4, 6 through 8, 10, 11 and 13 on the grounds of obviousness are not well founded. Accordingly, we reverse these rejections.

[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability,⁷ whether on the grounds of anticipation or obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24

The Rejections under 35 Section 103(a)

The examiner's position, with respect to each of the two aforementioned rejections, is premised on the view that although the primary references to Beer, the two Smith patents, Fujiki and Elias '919 do not disclose or suggest the breakdown of the treated filler particles, Answer, pages 5 and 8, the secondary reference Elias '368 and Suzuki or Ceyzeriat relied upon in each of the two rejections disclose or suggest the mixing of the components of the claimed subject matter, i.e., unreactive silicone oil, agglomerated filler and a filler treating agent. See Answer, pages 6 and 8.

We find that Kratel is directed to a method of subjecting finely divided silicon dioxide particles to mechanical stress during treatment with an organic silicon compound. See column 2, lines 6-8. Suitable organo silicon compounds include silazanes. See column 3, lines 10-12. Although the particle size of the silicon dioxide is decreased, column 4, lines 29-34, there is no disclosure as to the final particle size. Moreover, one of the requisite components of the claimed subject matter, an unreactive silicone oil, is not present during the course of the reaction. See Example 1. Finally, although an organopolysiloxane is later added, it is vulcanized by reaction of vinyl groups contained therein with a peroxide compound and hence is not unreactive as required by the claimed subject matter. See column 2, lines 56-63 and Example 1.

We find that Elias '368 is directed to a blend of curable polydiorganosiloxane having vinyl radicals at the chain ends, silica and an organic peroxide. See column 3, line 65 to column 4, line 68. The number of repeating units is a minimum of 800. See column 4, lines 10-16. Silica is disclosed at column 39-41 and 66-67. Finally a curing amount of an organic peroxide is added. See column 4, line 68. Example 1 discloses that the components are mixed in a dough type mixer with a sigma blade. However, Elias is deficient in that there is no suggestion that the particle size of the silica is reduced. Further, the siloxanes are gums, not as silicone oils as required by the claimed subject matter. In addition, the gum is reactive under the conditions of the reaction to form a silicone rubber and there is no later addition of the components to a reactive silicone oil. Accordingly, the conditions required by the claimed subject matter for the breakdown of treated filler are not disclosed by Elias '368.

Although Suzuki and Ceyzeriat are relied upon to show that treated silica fillers may have particles sizes required by the claimed subject matter, Suzuki, column 3, lines 60-65 and Ceyzeriat column 2, lines 64-68, there is no disclosure of the method required by the claimed subject matter.

Based upon the above considerations, even if the examiner was correct in combining Smith '743 or Beers and Smith '500 with Kratel, Elias '368, and Suzuki or Ceyzeriat in the manner described in the Answer, the process created would, in any event, fall short of the invention defined by the claimed subject matter, as claimed subject matter requires features that cannot be achieved by combining the references of record. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988). Accordingly, the examiner has not established a prima facie case of obviousness.

Other Matters

The dependency of claim 10 upon canceled

claim 9 must be corrected prior to allowance.

Decision

The rejection of claims 1 through 4, 6 through 8, 10, 11 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Smith '743 or Beers and Smith '500 in view of Kratel, Elias '368, and Suzuki or Ceyzeriat is reversed.

The rejection of claims 1 through 4, 6 through 8, 10, 11 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fujiki and Elias '919 in view of Kratel, Elias '368, and Suzuki or Ceyzeriat is reversed.

The decision of the examiner is reversed.

REVERSED

THOMAS A. WALTZ
Administrative Patent Judge)

PAUL LIEBERMAN
) APPEALS
Administrative Patent Judge

BEVERLY A. PAWLKOWSKI
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Administrative Patent Judge
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Appeal No. 97-3050
Application No. 08/646,646

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