

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGE J. VIKSNE

Appeal No. 1998-2653
Application No. 08/656,681

ON BRIEF

Before KIMLIN, PAK and KRATZ, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-7, all the claims in the present application. Claim 1 is illustrative:

1. A method for reducing the coefficient of friction of a gasket subject to lateral forces, comprising;

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- A. applying to said gasket a curable silicone coating composition comprising,
- i a curable silicone resin
 - ii a catalyst
 - iii at least one lubricating filler not soluble in the coating composition, and
 - iv optionally a solvent
- and
- B. curing the silicone coating composition.

The examiner relies upon the following references as evidence of obviousness:

Viksne	5,368,315	Nov. 29, 1994
Bilgrien	5,399,650	Mar. 21, 1995

Appealed claims 1-7 stand rejected under 35 U.S.C. § 112, first and second paragraphs. Claims 1-5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Viksne. Also, claim 6 stands rejected under 35 U.S.C. § 103 as being unpatentable over Viksne in view of Bilgrien, while claim 7 also stands rejected under § 103 as being unpatentable over Viksne in view of Bilgrien and the admitted prior art.

Upon careful review of the opposing arguments presented on appeal, we will not sustain the examiner's rejections.

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We reverse the examiner's rejections of the appealed claims under 35 U.S.C. § 112, first and second paragraphs, for the reasons set forth in appellant's Brief. The examiner has not met the initial burden of demonstrating with objective evidence or scientific reasoning that one of ordinary skill in the art would not understand the meaning of the claimed step "curing." Also, the examiner has not met the initial burden of establishing that one of ordinary skill in the art would be unable to practice the claimed invention, including the claimed curing method and treated talc, without resorting to undue experimentation. Also, since the examiner states at page 4 of the Answer that "[t]he MSDS for 'Talc Texas 4411' makes it clear that this is the proper name of the material, and therefore is not new matter," we consider the examiner's rejection under § 112, first paragraph, stated at page 4 of the final rejection, to have been withdrawn.

We now turn to the examiner's § 103 rejections. We agree with appellant that Viksne, the primary reference for all the rejections, fails to disclose or suggest the claimed step of

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applying to a gasket a curable silicone resin. The present specification states the following at page 4:

The curable silicone resin of the present invention are those resins known in the art. Silicone resins are highly cross-linked high molecular weight siloxane systems and are thus available as powders or flakes or as solutions in organic solvents.

In addition, the following is stated at page 7 of appellant's specification:

The curable silicone composition is applied to the gasket by brushing, dipping, or spraying. If the resin, catalyst and lubricant are mixed together without a solvent, the resulting dry mixture is applied by dusting the gasket substrate.

Hence, as urged by appellant, it is clear that when the claimed language "a curable silicone resin" is read in light of the present specification, the resin is a solid material, not a liquid one. On the other hand, Viksne discloses a coating composition for a gasket comprising polymeric fluorocarbon particles dispersed in a saturant, which saturant is absorbed in a resilient material of the gasket, "leaving a sealant coating 15 of polymeric fluorocarbon on the surface of the resilient material 14" (column 3, lines 23-25). The

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reference also discloses that the saturant may be any silicone composition in which the fluorocarbon is dispersed, and the reference exemplifies silicone fluids which penetrate and are absorbed by the porous resilient material. Accordingly, based on the disclosure of Viksne, including Figure 2 which depicts a gasket coating wherein the surface layer comprises only polymeric fluorocarbon, we concur with appellant that Viksne does not teach or suggest the claimed application of a curable silicone resin.

The secondary references applied by the examiner for various dependent claims and independent claim 7, including the admitted prior art, do not alleviate the deficiencies of Viksne discussed above.

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In conclusion, based on the foregoing, the examiner's
decision rejecting the appealed claims is reversed.

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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CHUNG K. PAK)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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)	
PETER F. KRATZ)	
Administrative Patent Judge)	

ECK:clm

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Brooks & Kushman
1000 Town Center
22nd Floor
Southfield, MI 48075