

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. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte
KARL JOSEF KUHN,
WOLFGANG WEHNER,
and ROLF DREWES

Appeal No. 2001-0899
Application No. 08/799,174

ON BRIEF

Before PAK, LIEBERMAN and JEFFREY T. SMITH, 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 2 through 12 and 14 through 16, which are all the claims pending in this application.

THE INVENTION

The invention is directed to a halogen containing polymer or a recycle thereof. Two stabilizers are added to the polymer. The first stabilizer is an alkali metal zeolite. The second stabilizer is an organic zinc compound, an aluminum compound or a rare earth compound. Additional limitations are described in the following illustrative claim.

THE CLAIM

Claim 16 is illustrative of appellants' invention and is reproduced below.

16. A composition, comprising
- (a) a halogen-containing polymer or a recycle thereof;
 - (b) at least one zeolite in the form of alkali metal zeolite, with the exception of zeolite A, $\text{Na}_{12}\text{Al}_2\text{Si}_2\text{O}_8 \cdot 27 \text{H}_2\text{O}$ and clinoptilolite $\text{Na}_6\text{Al}_6\text{Si}_3\text{O}_{72} \cdot 2\text{H}_2\text{O}$, and at least one organic zinc, aluminum or rare earth compound.

THE REFERENCES OF RECORD

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

Baldyga	4,000,100	Dec. 28, 1976
Kashiwase et al.	4,371,656	Feb. 1, 1983

THE REJECTION

Claims 2 through 12 and 14 through 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Baldyga and Kashiwase.

OPINION

We have carefully considered all of the arguments advanced by the appellants and the examiner and agree with the appellants for the reasons set forth in the Brief and those herein that the rejection of record is not well founded. Accordingly, we reverse the rejection.

The Rejection Under § 103(a)

"[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." See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The examiner relies upon a combination of two references to reject the claimed subject matter and establish a prima facie case of obviousness. It is the examiner's position that

Baldyga relates the use of inactivated Na zeolites with a conventional organotin or zinc carboxylate stabilizer in the thermal stabilization of PVC resins (columns 3-4). According to Kashiwase (col. 1, lines 39 et seq.) the inactivated state means water is yet bound and in Baldyga's instance the water content is said to be 18 to 25%.

Kashiwase also relates that such Na zeolites are less effective as a component of a stabilizer system but are rendered more effective if most of the Na is cation exchanged for a Group II or IV A metal (col. 2, line 16 et seq.). It is quite evident from these teachings that alkali zeolites whether partially ion exchanged or not are not useful per se as a preservative but must be used with a primary stabilizer of which the organotin compounds are disclosed as eminently suitable by Kashiwase et al.

See the Office action mailed February 26, 1998, paper No. 11 for the statement of rejection relied upon by the examiner in the Answer. See also Answer page 3. We disagree with the examiner's position.

We find that Baldyga is directed to the stabilization of polyvinyl chloride resins. See column 1 lines 6-7. We find that the addition of unactivated Zeolite A or unactivated naturally occurring molecular sieves in combination with conventional organometallic stabilizers increases the thermal and ultraviolet light stability of a polyvinyl chloride resin. See column 2, lines 39-49. We find the particular zeolites utilized fall exclusively within the scope of Zeolite A and naturally occurring molecular sieves which are natural zeolites.

See column 3, lines 30-51. No zeolites other than zeolite A types are disclosed by Baldyga. Moreover, there is no assertion by the examiner that the molecular sieves disclosed in Baldyga are in the form of an alkali metal zeolite as required by the claimed subject matter. To the contrary, however, the appellants have stated, "that all of those naturally occurring molecular sieves are calcium zeolites." See Reply Brief, page 2. We further find that conventional organo-zinc stabilizers are disclosed among a large group of stabilizers disclosed by Baldyga. See column 3, lines 64 and 67, column 4, lines 7 and 8.

The secondary reference to Kashiwase discusses the primary reference in column 1, lines 44-46 and is directed to an improvement in the performance of the stabilizer by substituting Group II or Group IV A metal salts in place of Group I metal ions present in the zeolites. See column 2, lines 16-27. Among the zeolites preferred zeolite A remains one of the particularly preferred zeolites. See column 2, lines 52-54. We find that the amount of residual Group I metal ion remaining is less than 10% and preferably less than 5%. See column 3, lines 24-32.

The examiner has given no reason or suggestion to combine the references. Nonetheless even if we considered Kashiwase to be an improvement over Baldyga and substituted the Group II or IV metal ions for those present in the primary reference, we would obtain a composition preferably constituting zeolite A substituted with multivalent ion in combination with stabilizers including zinc.

Based upon the above considerations, even if the examiner was correct in combining

Baldyga and Kashiwase in the manner described in the Answer, and the Office action incorporated therein, the omission of a zeolite in the form of alkali metal, as required by the claimed subject matter would result in a composition created that would, in any event, fall short of the invention defined by the claimed subject matter, as the aforesaid claimed subject matter requires features that cannot be achieved by combining the references. 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.

As we have determined that the examiner has not established a prima facie case of obviousness, it is not necessary for us to consider the evidence of record submitted under 37 CFR § 1.132.

DECISION

The rejection of claims 2 through 12 and 14 through 16 under 35 U.S.C. § 103(a) as being unpatentable over Baldyga in view of Kashiwase is reversed.

The decision of the examiner is reversed.

REVERSED

CHUNG K. PAK
Administrative Patent Judge

PAUL LIEBERMAN
Administrative Patent Judge

JEFFREY T. SMITH

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