

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. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANCIS G. BOMO,
RONALD A. SWOR and JAMES M. WATSON

Appeal No. 2001-1231
Application No. 08/976,371

ON BRIEF

Before PAK, WALTZ, and PAWLIKOWSKI, **Administrative Patent Judges**.
WALTZ, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 7 through 17, 20 through 22, and 25 through 34, which are the only claims pending in this application.¹ We have jurisdiction pursuant to 35 U.S.C. § 134.

¹ The minor amendment dated Jun. 27, 2000, Paper No. 26, amending claims 25 and 29, was entered by the examiner (Brief, page 2; see Paper No. 27 (erroneously numbered as Paper No. 19), dated Aug. 29, 2000, ¶19).

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According to appellants, the invention is directed to a carbon black and a rubber composition including this carbon black, where the carbon black results in improved treadwear and tear resistance (Brief, pages 2-3).² Appellants state that the claims do not stand or fall together but should be grouped as in each rejection (Brief, page 5). Appellants do not set forth any specific, substantive reasons for the separate patentability of any individual claim (see the Brief in its entirety). Accordingly, pursuant to the provisions of 37 CFR § 1.192(c)(7) (1997), we select one claim (i.e., independent claim 7) from each grouping and decide the grounds of rejection in this appeal on the basis of claim 7 alone. Of course, we consider claim 14 in the rejection under the first paragraph of section 112 and claim 27 in the rejection under 35 U.S.C. § 103(a) separately since each of these claims is the only claim in a rejection.

Illustrative independent claim 7 is reproduced below:

7. A carbon black, suitable for use in the fabrication of tire tread rubber, comprising:

a. a carbon black particle size of between about 16.0 nm and about 19.0 nm;

²All reference to the Brief is to the Second Substitute Brief dated Sep. 19, 2000, Paper No. 28.

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b. said carbon black having a dibutylphthalate [sic, dibutylphthalate] absorption value of between about 100 cc/100g to about 115 cc/100g;

c. said carbon black further comprising a weight percentage of ellipsoidal aggregates greater than about 14.

The examiner has relied upon the following references as support for the rejections on appeal:

Warner et al. (Warner)	3,959,008	May 25, 1976
Wideman et al. (Wideman)	4,929,280	May 29, 1990
Wolff et al. (Wolff)	5,159,009	Oct. 27, 1992

Claim 14 stands rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the original specification in such a way as to reasonably convey to one skilled in the art that appellants, at the time the application was filed, had possession of the invention as now claimed (Answer, page 2). Claims 7-11 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as unpatentable over Warner (Answer, page 3). Claims 7-17, 20-22, 25, 26 and 28-34 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under

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35 U.S.C. § 103(a) as unpatentable over Wideman (*id.*). Claim 27 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Wideman in view of Wolff (Answer, page 4).

We *affirm* the examiner's rejections of claim 14 under the first paragraph of section 112 and claims 7-11 under sections 102(b) or 103(a) over Warner essentially for the reasons set forth in the Answer and those stated below. We *reverse* the examiner's rejections under sections 102(b) or 103(a) over Wideman and under section 103(a) over Wideman in view of Wolff for reasons which follow. Accordingly, the decision of the examiner is affirmed-in-part.

OPINION

A. *The Rejection under 35 U.S.C. § 112, ¶1*

The initial burden of establishing unpatentability, on any ground, rests with the examiner. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In a rejection based on the written description requirement of the first paragraph of 35 U.S.C. § 112, the examiner can meet this burden by establishing that the claimed subject matter in

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question is completely outside the scope of any embodiments in the original disclosure. See *In re Alton*, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996). Then the burden of proof is shifted to appellants to show, by evidence, reasoning, or argument, that the original disclosure reasonably conveyed to one of ordinary skill in the art that appellants were in possession of the subject matter in question. See *Alton*, *supra*.

The examiner finds that claim 14, part e, recites that the average aggregate branches are "less than about 11.5." (Answer, page 2). The examiner finds no support for this range anywhere in the original disclosure, merely finding a single data point of 11.2 (*id.*, citing page 19 of the specification). Therefore we determine that the examiner has met the initial burden of proof. See *Alton*, *supra*.

Appellants submit that the preliminary amendment adding the subject matter in question incorrectly stated the support for the amendment was on page 20 of the specification, but argue that the proper support is found on page 19 of the specification (Brief, page 5). However, appellants do not cite any specific lines of page 19 nor refer to any specific average aggregate branch values

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on page 19. As correctly found by the examiner, the only value for "average aggregate branches" for appellants' carbon black on page 19 of the specification is 11.2 (under the column for C.B.A.). Appellants have failed to explain why this single value would have reasonably conveyed to one of ordinary skill in this art that appellants had possession of the subject matter in question, namely the range of "less than about 11.5." Therefore we determine that appellants have not met their burden of proof.

For the foregoing reasons and those set forth in the Answer, we determine that the examiner has established a *prima facie* case of unpatentability which has not been sufficiently rebutted by appellants. Accordingly, we affirm the examiner's rejection of claim 14 under the first paragraph of 35 U.S.C. § 112.

B. The Rejection over Warner

The examiner finds that Warner teaches carbon blacks with a particle size of 15 nanometers (nm) or more and a DBP value of 120 or less (Answer, page 3). The examiner admits that Warner does not teach "all the claimed properties" but submits that since Warner teaches the claimed surface area and size, the "substructure" appears to be the same as that claimed (*id.*). The

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examiner states that since the product of the prior art appears to be identical or substantially identical to that claimed, the burden of proof has shifted to appellants to show a difference between the claimed products and those of Warner (*id.*).

Appellants agree with the examiner that Warner discloses carbon blacks with the same surface area and particle size as the claimed carbon black but argues that the burden has not been shifted to appellants since the examiner admits that Warner does not teach all the claimed properties (Brief, pages 5 and 7). This argument is not persuasive since claim 7 on appeal only requires *three* properties for the claimed carbon black, namely particle size, DBP absorption value, and weight percentage of ellipsoidal aggregates (see claim 7 on appeal). Appellants do not contest that Warner discloses *two* of the three claimed properties (see the Brief, pages 5 and 7).³ With regard to the property not mentioned by Warner (wt. % ellipsoidal aggregates), we note that carbon black having a low particle size and low DBP absorption value, as disclosed by Warner and claimed by

³ Appellants also agree that the "inventive carbon black" has the same surface area (less than 450 m²/g) as the carbon blacks of Warner, although this property is not recited in the claims on appeal (Brief, page 7; see also the Declaration, page 3).

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appellants, has a reduced structure which may be produced by use of potassium compounds in the formation of the carbon black (see Warner, col. 12, ll. 1-5, and the specification, page 17, ll. 4-10). Therefore we determine that the amount of low structure ellipsoidal aggregates⁴ of Warner would have reasonably appeared to be the same or substantially the same as the claimed amount. Accordingly, we determine that the burden of proof has shifted to appellants to submit convincing evidence or arguments to show that the claimed products are different than those of the prior art. See *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

Appellants assert that they have met the burden of proof by submitting the Declaration under 37 CFR § 1.132 by Ronald A. Swor dated Feb. 12, 1998 (hereafter the "Swor Declaration"; see the Brief, pages 6-10). We determine that the evidence submitted as the Swor Declaration and appellants' arguments are not persuasive for reasons stated in the Answer (pages 4-5) and those reasons set forth below.

⁴ As disclosed by appellants on page 9, ll. 20-25, of the specification, four shape categories are defined for carbon black aggregates, including low structure ellipsoidal aggregates.

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The Swor Declaration does not contain a comparison with the closest prior art (i.e., the carbon black of Warner). See *In re Burckel*, 592 F.2d 1175, 1179, 201 USPQ 67, 71 (CCPA 1979). The Swor Declaration has no explanation for the lack of comparison with Warner. However, appellants, in footnote 1 on pages 6-7 of the Brief, explain that a comparison with Warner "was impossible since applicants understand and believe that the specific carbon black products disclosed by the cited patents are not commercially available and cannot be made by applicants since the necessary starting materials are not available to applicants." There is no declaration by appellants attesting to these facts nor any *specific* explanation why the products of Warner cannot be made or obtained. Furthermore there is no evidence set forth by appellants as to what attempts were made to repeat the process of Warner or to obtain the starting materials of the Warner process.

The Swor Declaration states that the oxygen levels of the carbon blacks of Warner are clearly different than those of the present product, with levels of 6.5-16.5% for Warner and less than about 2% for the present product (Declaration, page 3;

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Brief, pages 7-8). However, the declarant and appellants never state a source for these oxygen level values. Furthermore, as discussed in the Answer, oxygen level values are not recited or required in claim 7 on appeal.

The Swor Declaration also states that the carbon black of Warner differs significantly from the invention product in being very porous in nature, as judged by the difference between the NSA and STSA levels (Declaration, page 4; Brief, page 8). Again we note that there is no data or reference to any data in Warner supporting this statement, nor is this property recited in the claims on appeal.

We note that the last comparison in the Declaration with Raven 5250 (pages 5-6) is also not a comparison with the closest prior art, nor has the declarant given any reasons why this comparison is relevant to the rejection on appeal.

Finally, the comparisons set forth in the Declaration are limited to one specific carbon black of the invention, with a specified particle size of 17.4 nm, nitrogen surface area of 125 m²/g, and a DBPA value of 107 cc/100g (Declaration, page 6),

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while the claims are not so limited. An effective comparison of the claimed product with the prior art must be commensurate in scope with the claims sought to be patented. See *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980).

For the foregoing reasons and those stated in the Answer, we determine that the examiner has established a *prima facie* case of unpatentability in view of the reference evidence, which has not been sufficiently rebutted by appellants. Accordingly, we affirm the examiner's rejection of claims 7-11 under 35 U.S.C. § 102(b)/§ 103(a) over Warner.

C. The Rejections involving Wideman

The examiner finds that Wideman teaches SAF carbon black, which has the claimed size by definition, and also carbon black having the claimed area with butadiene rubber (Answer, page 3). From these findings, the examiner states that the product of Wideman is substantially the same product as claimed and the burden of proof has shifted to appellants (*id.*).

The error in the examiner's rejection, as we see it, is as follows. Wideman discloses SAF carbon black, from a list of several main types of carbon blacks, with a particle size of

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about 19 nm, with the teaching that any of these types of carbon black may be used in the invention (see col. 2, ll. 10-24). In Examples 1-8 at col. 5, l. 51-col. 6, l. 8, Wideman discloses the preparation of oxo carbon blacks from four types of carbon black (A through D), two of which have DBP values within the scope of the claims. Although the examiner has not advanced any specific explanation or even cited the lines relied upon in Wideman (Answer, page 3), it is apparent that the examiner is attempting to combine the particle size of SAF carbon black with the DBP values of carbon blacks A and D of the examples. However, the examiner has not set forth any reasoning or explanation as to why the disclosures set forth above from Wideman would amount to a description of the claimed product under section 102(b), or why the claimed subject matter would have been obvious to one of ordinary skill in this art from these teachings of Wideman. In other words, the examiner has not stated any reasoning or explanation as to why one carbon black would have possessed the properties of the separate carbon blacks disclosed by the Wideman reference.

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Wolff was applied by the examiner in the rejection of claim 27 on appeal for the teaching of mixing carbon blacks with oil-extended rubbers (Answer, page 4; see Wolff, col. 3, ll. 7-31). Accordingly, Wolff does not remedy the deficiencies noted above in Wideman.

For the foregoing reasons, we determine that the examiner has failed to establish a *prima facie* case of unpatentability over the reference evidence. Therefore the examiner's rejections including Wideman as a sole or primary reference are reversed.

D. Summary

The rejection of claim 14 under 35 U.S.C. § 112, first paragraph, is affirmed. The rejections of claims 7-11 under 35 U.S.C. § 102(b)/§ 103(a) over Warner are affirmed.

The rejections of claims 7-17, 20-22, 25, 26 and 28-34 under 35 U.S.C. § 102(b)/§ 103(a) over Wideman are reversed. The rejection of claim 27 under 35 U.S.C. § 103(a) over Wideman in view of Wolff is reversed.

The decision of the examiner is affirmed-in-part.

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

AFFIRMED-IN-PART

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Administrative Patent Judge)	
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THOMAS A. WALTZ)	APPEALS AND
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