

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MARK K. RUSSELL and DAVID R. BATTISTE

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Appeal No. 2001-2048  
Application 09/357,257

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ON BRIEF

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Before WARREN, OWENS, and KRATZ, *Administrative Patent Judges*.  
OWENS, *Administrative Patent Judge*.

*DECISION ON APPEAL*

This appeal is from the final rejection of claims 1-20, which are all of the claims in the application.

*THE INVENTION*

The appellants claim a process for making a degradation resistant polyolefin composition, and claim a degradation

Appeal No. 2001-2048  
Application 09/357,257

resistant polyolefin composition made by the process. Claim 17, directed toward the composition, is illustrative:

17. A polyolefin composition having high resistance to degradation, said composition formed by combining components comprising at least one polyolefin component produced from a transition metal halide catalyst, bis(2,4-dicumylphenyl)pentaerythritol diphosphite, triisopropanolamine, a hydrotalcite component, and at least one phenol component.

*THE REFERENCES*

Miyata	4,675,356	Jun. 23, 1987
Stevenson et al. (Stevenson)	5,438,086	Aug. 1, 1995
Rotzinger et al. (Rotzinger)	5,955,522	Sep. 21, 1999
	(effective filing date	Jun. 24, 1996)

G.J. Klender et al. (Klender), "Further Studies on the Effects of Additives on Phenolic Antioxidant - Induced Color and Its Prevention in Polyolefins", ANTEC Conference, Baton Rouge, Louisiana, 1985, at 225-45.

*THE REJECTION*

Claims 1-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of Stevenson, Rotzinger, Miyata and Klender.

*OPINION*

We reverse the aforementioned rejection.

Each of the appellants' independent claims requires that five components are used to make a polyolefin composition: 1) a polyolefin produced using a transition metal halide catalyst,

Appeal No. 2001-2048  
Application 09/357,257

2) bis(2,4-dicumylphenyl)pentaerythritol diphosphite,  
3) triisopropanolamine, 4) a hydrotalcite, and 5) at least one  
phenol.

The examiner has not pointed out where the applied references disclose or would have fairly suggested, to one of ordinary skill in the art, using bis(2,4-dicumylphenyl)-pentaerythritol diphosphite in combination with triisopropanolamine to make a polyolefin composition. Stevenson discloses using trialkanolamine in the preparation of bis(2,4-dicumylphenyl)pentaerythritol diphosphite to increase the yield of that diphosphite (col. 15, lines 17-20), but does not indicate that any of the trialkanolamine is present in the diphosphite used to make Stevenson's polyolefin composition.

The examiner points out that the appellants disclose in their specification (page 16, lines 2-9) that bis(2,4-dicumylphenyl)pentaerythritol diphosphite was commercially available as Doverphos<sup>®</sup> S-9228T, and that a blend of this diphosphite and triisopropanolamine was commercially available as Doverphos<sup>®</sup> S-9228T (answer, page 6). The examiner argues that the fact that bis(2,4-dicumylphenyl)pentaerythritol diphosphite and triisopropanolamine are sold as a blend indicates that they are to be used together and that one of ordinary skill in the art

would not separate out the triisopropanolamine before using the diphosphite (answer, page 7). Because bis(2,4-dicumylphenyl)-pentaerythritol diphosphite has not been disclosed as having any utility other than stabilizing polymers, the examiner argues, it is plausible to presume that the triisopropanolamine is innocuous with respect to both bis(2,4-dicumylphenyl)pentaerythritol diphosphite and polymers (answer, page 6). The examiner argues that any benefit of the triisopropanolamine observed by the appellants is merely an inherent characteristic of the commercially available bis(2,4-dicumylphenyl)pentaerythritol diphosphite/triisopropanolamine blend (answer, pages 6-7).

The examiner's arguments are directed toward whether one of ordinary skill in the art would have had a reasonable expectation of success in using the commercially available bis(2,4-dicumylphenyl)pentaerythritol diphosphite/triisopropanolamine blend in the polyolefin compositions of the applied prior art. To establish a *prima facie* case of obviousness, however, the examiner also must explain how the applied prior art would have provided one of ordinary skill in the art with a motivation to use this blend as proposed by the examiner. See *In re Vaeck*, 947

Appeal No. 2001-2048  
Application 09/357,257

F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988).

Stevenson, which is the only applied reference which discloses bis(2,4-dicumylphenyl)pentaerythritol diphosphate, does not disclose use of this diphosphate in combination with triisopropanolamine. The examiner has not provided any evidence of a known function of the triisopropanolamine in the commercially available bis(2,4-dicumylphenyl)pentaerythritol diphosphate/triisopropanolamine blend which would have led one of ordinary skill in the art to use the blend instead of Stevenson's diphosphate when making the polyolefin compositions of the applied prior art. Nor has the examiner provided any other reason why the applied prior art would have led one of ordinary skill in the art to select the blend rather than the diphosphate to make the polyolefin compositions of the applied prior art.

The examiner argues that the appellants, as representative of those of ordinary skill in the art, concede by their comparative examples that there had to have been recognition in the art by the manufacturer of Doverphos<sup>®</sup> S-9228T and those who previously used it, that triisopropanolamine would increase the hydrolytic stability of Stevenson's bis(2,4-dicumylphenyl)-

Appeal No. 2001-2048  
Application 09/357,257

pentaerythritol diphosphite (answer, pages 7-8). This argument is not well taken because the examiner has not established that the information in the appellants' comparative examples is prior art.

The record, therefore, indicates that the motivation relied upon by the examiner for using a bis(2,4-dicumylphenyl)-pentaerythritol diphosphite/triisopropanolamine blend to make the polyolefin compositions of the applied prior art comes from the appellants' disclosure of their invention in the specification rather than coming from the applied prior art. Consequently, the record indicates that the examiner used impermissible hindsight when rejecting the claims. See *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *In re Rothermel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960). Accordingly, we reverse the examiner's rejection.

Appeal No. 2001-2048  
Application 09/357,257

*DECISION*

The rejection of claims 1-20 under 35 U.S.C. § 103 over the combined teachings of Stevenson, Rotzinger, Miyata and Klender is reversed.

*REVERSED*

CHARLES F. WARREN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
TERRY J. OWENS	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
PETER F. KRATZ	)	
Administrative Patent Judge	)	

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Appeal No. 2001-2048  
Application 09/357,257

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