

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID ELTON BIDSTRUP
and
LESLIE MITCHELL BLAIR

Appeal No. 2002-1190
Application No. 09/023,470

ON BRIEF

Before KIMLIN, WALTZ and MOORE, Administrative Patent Judges.
KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 and 4-11. Claims 12-14 have been deemed allowable by the examiner.

Claim 1 is illustrative:

1. A process for stabilizing and whitening melt-fabricable fluoropolymer resin having total unstable fraction of no more than 0.3%, comprising melt extruding said resin in the presence of alkali metal nitrate to obtain fluoropolymer resin having improved color and/or stability, said resin being free of boron nitride.

Appeal No. 2002-1190
Application No. 09/023,470

The examiner does not rely upon prior art in the rejection of the appealed claims.

Appellants' claimed invention is directed to a method for stabilizing and whitening a melt-fabricable fluoropolymer resin having no more than 0.3% of total unstable fraction. The method entails incorporating an alkali metal nitrate in the resin before it is extruded, with the proviso that the resin is "free of boron nitride" (claim 1).

Appealed claims 1 and 4-11 stand rejected under 35 U.S.C. § 112, first paragraph, description requirement.¹

Appellants submit at page 4 of the Brief that "[c]laims 1 and 4-11 stand or fall together with respect to issues 1 and 2" (second paragraph). Since appellants' issue 1 concerns the § 112, first paragraph rejection, all the appealed claims stand or fall together with claim 1.

We have thoroughly reviewed each of appellants' arguments for patentability. However, we are in complete agreement with the examiner that appellants' specification, as originally filed, does not provide descriptive support for the claimed subject matter within the meaning of § 112, first paragraph. Accordingly, we will sustain the examiner's rejection.

¹ The examiner has withdrawn the rejections based on prior art (see page 3 of Answer).

Appeal No. 2002-1190
Application No. 09/023,470

As recognized by appellants, the relevant inquiry is whether the original specification reasonably conveys to one of ordinary skill in the art that appellants had in their possession the concept of what is presently claimed. In re Anderson, 471 F.2d 1237, 1244, 176 USPQ 331, 336 (CCPA 1973). In particular, although appellants acknowledge that the claim language "said resin being free of boron nitride" is not disclosed in the specification, the dispositive issue on appeal is whether appellants' original specification would reasonably convey to one of ordinary skill in the art that the fluoropolymer resin comprising alkali metal nitrate is free of boron nitride before extrusion.

Like the examiner, we find nothing in the original specification or the present record which indicates that appellants conveyed the concept of processing only fluoropolymer resins that are free of boron nitride. On the contrary, appellants indicate in their Brief that one of the contemplated utilities for their extruded resin is wire insulation, and Buckmaster, of record, discloses that it was known in the art that foamed fluoropolymer resins are used for wire insulation because of a lower dielectric constant, and that "boron nitride is attractive because it is thermally stable, chemically inert, has excellent electrical properties . . . is white and has low

Appeal No. 2002-1190
Application No. 09/023,470

toxicity" (column 1, lines 31-35). Accordingly, absent evidence to the contrary, we find it reasonable to conclude that one of ordinary skill in the art would have understood the present invention to be inclusive of compositions comprising the known boron nitride as a nucleating agent. We are not persuaded by appellants' argument that because one of the purposes of the present invention is not to form bubbles during extrusion, "the presence of boron nitride would be inimical to Applicants' process" (page 5 of Brief, first paragraph). Manifestly, there is a clear distinction between the formation of unwanted, random bubbles and deliberate homogenous foaming. As noted by the examiner, there is no disclosure or suggestion in the present specification that foaming the extruded fluoropolymer is inimical to appellants' invention.

Appellants cite Ex parte Parks, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Int. 1993) as legal support for the propriety of the claimed negative limitation in the absence of its disclosure in the specification. However, unlike in Parks, there is no declaration evidence of record which establishes that one of ordinary skill in the art would have recognized that the claimed extrusion process must be conducted on a fluoropolymer resin that is free of boron nitride (see Parks at page 1236, last paragraph). It is well settled that appellants' arguments in the

Appeal No. 2002-1190
Application No. 09/023,470

Brief cannot take the place of objective evidence. In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974).

Concerning appellants' reference to "the practice in the European Patent Office" (page 6 of Brief, penultimate paragraph), such practice has no bearing on proceedings before this Board.

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

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

AFFIRMED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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THOMAS A. WALTZ)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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JAMES T. MOORE)	
Administrative Patent Judge)	

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Appeal No. 2002-1190
Application No. 09/023,470

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