

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

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(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRUCE MULHOLLAND

Appeal No. 95-0244
Application 08/035,832¹

ON BRIEF

Before RONALD H. SMITH, SOFOCLEOUS and WARREN, Administrative
Patent Judges.

RONALD H. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1,
3, 5, 7-10, 12, 14 and 16-22. Claims 2, 4, 6, 11, 13 and 15
have been canceled, and claims 23 and 24 have been allowed.

¹ Application for patent filed March 23, 1993. According to applicant,
this application is a continuation of 07/812,594, filed December 23, 1991,
now abandoned.

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The subject matter of the appealed claims relates to a composition consisting of a polymeric acetal and zinc oxide which is suitable for use in the preparation of a plumbing fixture and to the method for producing a shaped article suitable for use as a plumbing fixture. Claims 1 and 10 are illustrative of the appealed claims and read as follows:

1. A composition suitable for use in the preparation of a plumbing fixture, consisting of a polymeric acetal and zinc oxide in an amount from about 1 to about 20% by weight, wherein the fixture exhibits resistance to the build-up and adhesion of mineral deposits.

10. A method for producing a shaped article suitable for use as a plumbing fixture which exhibits resistance to the build-up and adhesion of mineral deposition, consisting essentially of the steps of: (a) making a blend consisting of polymeric acetal and from about 1 to about 20% by weight of zinc oxide; and (b) shaping said blend to form a shaped article.

Appellant made no statement that the claims do not stand or fall together. 37 CFR § 1.192(c)(7). Accordingly, we will limit our consideration to claim 1 in considering the examiner's rejection of the appealed claims.

The reference relied on by the examiner is:

Reske et al. (Reske) 4,517,319 May 14,
1985

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Claims 1, 3, 5, 7-10, 12, 14 and 16-22 stand rejected under 35 U.S.C. § 103 as obvious over Reske. We have carefully considered the entire record, including appellant's position as set forth in his brief and the examiner's position as set forth in the answer, and we have decided that we will affirm the examiner's rejection. Appealed claim 1 is limited to a composition consisting of a polymeric acetal and 1 to 20% zinc oxide. As noted by the examiner, Reske discloses a molding composition which consists essentially of a polyoxymethylene (polymeric acetal), a polyurethane and a filler (column 1, lines 5-7 and 36-40). As set forth in appealed claim 7, the claimed polymeric acetal may be an "oxymethylene homopolymer" which is equivalent to Reske's polyoxymethylene. Reske discloses that a disadvantage of the polyoxymethylene is "a low impact strength" (column 1, lines 11-14). The disadvantage is overcome by including the polyurethane and filler. Accordingly, as noted by the examiner, the compatible polyurethane is an "impact modifier." Reske discloses further that the filler may be zinc oxide (column 6, lines 22-28), and in claim 8 Reske specifically claims a composition wherein the filler is zinc

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oxide. The filler is preferably 1 to 30% by weight of the total mixture (column 7, lines 22-27). Further, Reske discloses in column 8, lines 12-22 that the composition may be processed to form shaped articles such as "pipes and tubes", which are well known plumbing fixtures.

We agree with the examiner that the composition of appealed claim 1 consisting of a polymeric acetal and zinc oxide would have been prima facie obvious to one of ordinary skill in the art in view of the noted teachings of Reske. Appellant urges that the claimed invention is not obvious because Reske discloses some twenty fillers and in examples 17 and 18 prefers titanium dioxide and silicon dioxide. We disagree, and point out that Reske specifically discloses and in claim 8 claims the use of zinc oxide as the filler. Nor is it necessary for Reske to teach or appreciate the property of resistance to mineral adhesion because the mere discovery that the claimed composition possesses a property not disclosed in the prior art does not alone defeat the prima facie case of obviousness. In re Dillon, 919 F.2d 688, 693, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990)(en banc), cert. denied, 500 U.S. 904 (1991).

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Appellant also urges that the appealed claims eliminate "an essential feature of Reske et al, i.e., polyurethane." The argument is not persuasive because it is well settled that the omission of an element, i.e., polyurethane, and its intended function, as an impact modifier, is prima facie obvious if the remaining elements perform the same function as before. Cf. In re Karlson, 311 F.2d 581, 584, 136 USPQ 184, 186 (CCPA 1963). There is no evidence in the record to indicate that the elimination of the polyurethane would have any effect on the composition other than the elimination of its function as an impact modifier.

Appellant urges that the declaration submitted under Rule 132 is sufficient to overcome the rejection under 35 U.S.C. § 103. However, we note that appellant's declaration does not compare the claimed composition to the closest prior art composition of Reske, i.e., Reske's claim 8 which includes polyoxymethylene, polyurethane and zinc oxide. Further, in view of the fact that Reske specifically discloses and claims the use of zinc oxide and polyoxymethylene compositions, we agree with the examiner that the evidence of obviousness outweighs the evidence submitted in the declaration, and the

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declaration does not overcome the prima facie case of obviousness.

The decision of the examiner 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

	RONALD H. SMITH)	
	Administrative Patent Judge)	
)	
)	
	MICHAEL SOFOCLEOUS)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
	CHARLES F. WARREN)	
	Administrative Patent Judge)	

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