

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES F. HOOVER and PAUL D. SYBERT

Appeal No. 95-4199
Application No. 08/068,445¹

ON BRIEF

Before SOFOCLEOUS, PAK and WALTZ, Administrative Patent Judges.

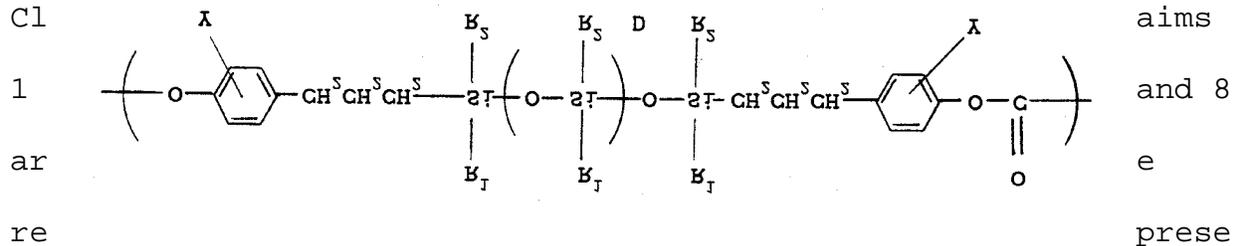
PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1 through 12, which are all of the claims pending in the application.

¹ Application for patent filed May 27, 1993.

The subject matter on appeal relates to thermoplastic terpolymers having particular polysiloxane, aromatic polyester and polycarbonate segments. See specification, page 1, lines 6-8. These terpolymers are said to exhibit "non-Newtonian melt viscosities, advantageous low temperature properties and resistance to solvents, chemicals, hydrolysis and to photodecomposition." See specification, page 1, lines 9-11.



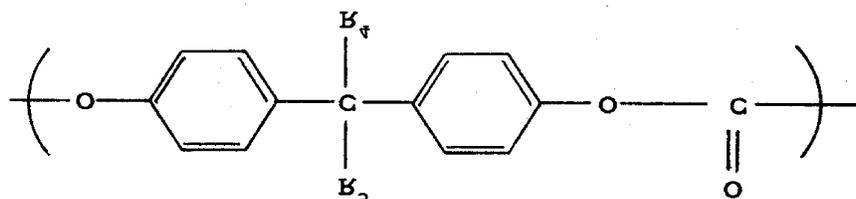
ntative of the subject matter on appeal and read as follows:

1. A thermoplastic terpolymer, which comprises:
 - (a) about 1 to about 50 weight percent of a repeating or recurring polysiloxane unit, based on the total weight of the terpolymer, of the formula:

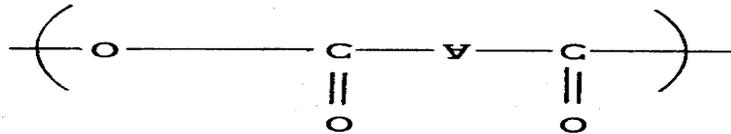
where R¹ and R² are each independently selected from hydrogen, hydrocarbyl, or halogen-substituted hydrocarbyl; D is an integer of from about 10 to about 120; and Y is hydrogen,

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alkyl or alkoxy; and (b) about 99 to about 50% by weight of the terpolymer of polycarbonate segments and aromatic polyester segments consisting essentially of from about 80 to about 10% by weight, relative to the total weight of the carbonate and aromatic ester segments in the terpolymer, of polycarbonate units of the formula:



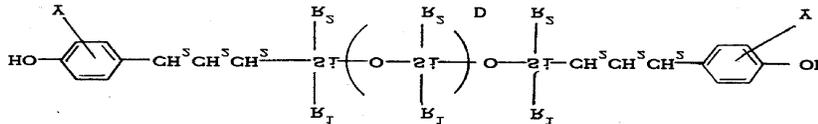
where R³ and R⁴ are each selected from hydrogen, hydrocarbyl or halogen-substituted hydrocarbyl; and from 20 to 90% by weight, relative to the total weight of the carbonate and aromatic ester segments in the terpolymer, of aromatic diester units of the formula:



where A is phenylene.

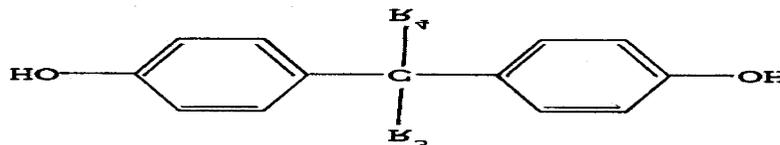
8. A process for the production of a terpolymer which comprises introducing phosgene into a stirred two phase mixture comprising:

(1) a siloxane, terminated by phenolic hydroxyls, of the structure



where R¹ and R² are selected from hydrogen, hydrocarbyl or halogen-substituted hydrocarbyl; where D is an integer of from about 10 to about 120; and Y is selected from hydrogen, hydrocarbyl, halogen-substituted hydrocarbyl and alkoxy,

(2)
 bisphenol
 structure

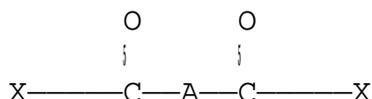


a
 , of the
 :

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where R³ and R⁴ are selected from hydrogen, hydrocarbyl and halogen-substituted hydrocarbyl; and

(3) an aromatic dicarboxylic acid halide having the structure



where A is phenylene and X is chloro or bromo, in the presence of sufficient aqueous alkali to maintain an alkaline pH and in the presence of a substantially water-immiscible solvent; and in the presence of

(4) an effective molecular modifying amount of a monohydric phenol.

The references of record relied upon by the examiner are:

Vaughn Jr.	3,419,634	Dec. 31, 1968
Schmidt et al. (Schmidt)	4,681,922	Jul. 21, 1987
Okamoto (Published European Patent Application)	0376052	Jul. 04, 1990

Claims 1 through 12 stand rejected under 35 U.S.C. § 103 as unpatentable over Schmidt in view of Okamoto and Vaughn Jr.

Having carefully considered the respective positions advanced by the appellants in the brief and the examiner in the answer, it is our conclusion that the above-noted rejection is not sustainable. In rejecting claims under 35 U.S.C. § 103 the examiner bears the initial burden of

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presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met does the burden of coming forward with evidence or argument shift to the applicants. Id. If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

With respect to product claims 1 through 7 and 12, the examiner takes the position that it would have been obvious to provide propylene-phenylene on the end of the polysiloxane segment of the polysiloxane/polyester (carbonate) block copolymer described in Schmidt inasmuch as the secondary references, such as Vaughn Jr., teach that "using a polysiloxane having a Si-C [C includes propylene-phenylene] linkage in a polysiloxane-polycarbonate copolymer yields a product which has improved hydrolytic stability." See Answer, page 4. Although we do not doubt that it would have been obvious to employ a silicon-propylene-phenylene linkage in a polysiloxane-polycarbonate

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copolymer, we do not agree that it would have been obvious to employ such linkage in the polysiloxane-polyester (carbonate) copolymer described in Schmidt. We find no evidence, and the examiner has not supplied any, that would have suggested the desirability of employing propylene-phenylene between polysiloxane and polyester. The examiner simply fails to supply sufficient facts to establish a prima facie case of obviousness within the meaning of 35 U.S.C. § 103.

With respect to process claims 8 through 11, the examiner asserts that "appellants' claimed method is conventional in the art for preparing polysiloxane-polycarbonate-polyester copolymers as can be seen in Example 4 of the Schmidt reference". See Answer, page 5. Rather than explaining why it would have been obvious to employ the claimed reactants, as well as produce the claimed terpolymers in the alleged "conventional" method, the examiner relies on In re Durden, 763 F.2d 1406, 226 USPQ 359 (Fed. Cir. 1985). Id. However, as held by In re Ochiai, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995), the use of per se rules is not condoned in applying the test for obviousness. Obviousness requires a factual analysis involving taking the claimed subject matter

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as a whole and comparing it to the prior art to determine whether the prior art as a whole would have suggested to one of ordinary skill in the art the claimed subject matter. The examiner, however, has not supplied any factual evidence that would have suggested the desirability of employing the claimed reactants, much less forming the claimed terpolymers.

Accordingly, the examiner has not satisfied his burden of presenting a prima facie case of obviousness within the meaning of 35 U.S.C. § 103.

In view of the foregoing, the decision of the examiner rejecting claims 1 through 12 is reversed.²

REVERSED

² We note that the subject matter of this appeal is related to that of Appeal No. 95-4228, Application 08/062,485, commonly assigned with a common inventor to this application. In Appeal No. 95-4228, the examiner relies on published International Application WO 80/00084 as the primary reference in rejecting the claims in Application 08/062,485. Upon return of this application, the examiner is advised to consider WO 80/00084 to determine whether it affects the patentability of the claims in this application. Published International Application WO 80/00084 is attached to this decision.

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MICHAEL SOFOCLEOUS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHUNG K. PAK)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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CKP/jrg

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Serial No. 08/068,445

Judge PAK

Judge WALTZ

Judge SOFOCLEOUS

Received: 25 Aug 98

Typed: 25 Aug 98

DECISION: REVERSED

Send Reference(s): Yes No
or Translation(s)

Panel Change: Yes No

3-Person Conf. Yes No

Remanded: Yes No

Brief or Heard

Group Art Unit: 1501

Index Sheet-2901 Rejection(s): _____

Acts 2: _____

Palm: _____

Mailed: Updated Monthly Disk: _____

Updated Monthly Report: _____