

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte REDONDO E. GRIZANTE, ANTONIO ZAPO
and LUCA CASTELLANI

Appeal No. 96-1076
Application No. 07/961,160¹

ON BRIEF

Before GARRIS, WEIFFENBACH and WALTZ, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 13 through 16. The only other claims in the application, which are claims 1 through 12 and 17 through 20, stand withdrawn from further consideration by the examiner as

¹ Application for patent filed October 15, 1992.

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being directed to a nonelected invention or a nonelected species.

The subject matter on appeal relates to a cable coating formed by a polymeric mixture of a first thermoplastic polymer which consists of an aromatic polyester of isophthalic and terephthalic acid with bisphenol A and a second thermoplastic polymer consisting of an elastomeric polyether-ester block copolymer having particular Shore D hardness and Vicat softening point characteristics. The mixture possesses an ultimate elongation not lower than 50%. This appealed subject matter is adequately illustrated by independent claim 13 which reads as follows:

13. A cable coating formed by a polymeric mixture characterized in that it comprises from from [sic] 50 to 80 parts (w/w) of a first thermoplastic polymer which is amorphous, highly resistant to flames and combustion, and consists of an aromatic polyester of isophthalic and terephthalic acid with bisphenol A, and from about 20 to 50 parts (w/w) of at least a second thermoplastic polymer consisting of an elastomeric polyether-ester block copolymer, having a Shore D hardness greater than 50 and a Vicat softening point greater than 170°C, said mixture having an ultimate elongation not lower than 50% when the amount of the second polymer is the lowest one and a higher ultimate elongation as the amount of said second polymer increases.

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The references relied upon by the examiner as evidence of obviousness are:

Cella et al. (Cella)	4,690,997	Sep. 1, 1987
Penneck 1989 (PCT Application)	WO 89/00756	Jan. 26,

Claims 13 through 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Penneck taken with Cella².

We refer to the Brief and Reply Brief and to the Answer for a complete exposition of the opposing viewpoints expressed by the appellants and the examiner concerning the above noted rejection.

OPINION

We will sustain this rejection.

We agree with the examiner's ultimate conclusion that the coatings claimed by the appellants are indistinguishable from the coatings disclosed by Penneck.

² The appealed claims will stand or fall together; see page 5 of the Brief.

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In support of their contrary view, the appellants argue that the appealed claims are directed to polymeric mixtures which do not encompass the cross-linked polymer material of Penneck. This argument is unpersuasive for a number of reasons.

In the first place, the independent claim language "coating formed by a polymeric mixture" does not distinguish over a polymeric mixture which is ultimately cross-linked into a coating as in the Penneck reference. In this regard, we are mindful of the appellants' argument that "it is clear from the specification that appellants' claimed mixture is an end product which is not to be cross-linked" (Reply Brief, page 2). From our perspective, however, the subject specification militates against this argument by expressly disclosing that the polymeric mixtures may undergo "some structural modification" (see Specification page 7, second full paragraph).

Secondly, even if the appealed claims excluded a condition wherein the first and second thermoplastic polymers are cross-linked with each other, these claims still would not distinguish over the subject matter disclosed by Penneck.

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This is because the aromatic polymer and the aliphatic polymer of Penneck (which correspond to the here claimed first and second thermoplastic polymers) need not be cross-linked with each other as the appellants seem to believe. As correctly indicated by the examiner, Penneck expressly discloses in the last paragraph on page 17 of the reference that "the aliphatic polymer may be highly crosslinked [i.e., with itself] while the aromatic polymer remains substantially uncrosslinked". Concerning this matter, it is appropriate to emphasize the appellants do not even allege that the appealed claims exclude an embodiment wherein one of the here claimed thermoplastic polymers has been cross-linked with itself.

The appellants additionally seem to argue that Penneck contains no teaching or suggestion of an elongation not lower than 50% as required by the claims on appeal. This is clearly incorrect. Penneck expressly discloses that his "polymeric material ... will preferably have an elongation to break of at least 50% and especially at least 100%" (see the last sentence in the first full paragraph on page 16).

Finally, the appellants point out that the Penneck reference contains no teaching or suggestion of the here

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claimed Shore D hardness or Vicat softening point values. While the examiner acknowledges this point, she notes that "the polyetheresters taught at the bottom of page 13 through page 14 [of the Penneck reference] encompass the polyetheresters specified in the claims" (Answer, page 4), and the appellants do not contend otherwise. Since Penneck's polyether-esters include those claimed by the appellants, it is reasonable to believe that these polyether-esters possess the here claimed Shore D hardness and Vicat softening point values and concomitantly reasonable to require that the appellants prove the contrary. Whether the rejection is based on "inherency" under 35 U.S.C. § 102, on "prima facie obviousness" under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same and its fairness is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art products. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-434 (CCPA 1977). On this record, the appellants have not carried their burden of showing that

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Penneck's polyether-esters and the characteristics possessed thereby differ from those here claimed³.

For the above stated reasons, we will sustain the examiner's § 103 rejection of claims 13 through 16 as being unpatentable over Penneck taken with Cella.

The decision of the examiner is affirmed.

³ It is appropriate to clarify that Shore D hardness and Vicat softening point should be regarded as characteristics of the here claimed second thermoplastic polymer rather than "result effective variables" of the process by which these polymers are made as the appellants seem to imply (e.g., see the paragraph bridging pages 3 and 4 of the Reply Brief).

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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

	BRADLEY R. GARRIS)	
	Administrative Patent Judge))	
)	
)	
	CAMERON WEIFFENBACH)	BOARD OF
PATENT	Administrative Patent Judge))	APPEALS AND
)	INTERFERENCES
)	
	THOMAS A. WALTZ)	
	Administrative Patent Judge))	

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