

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ROBERT L. LILLY

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Appeal No. 1996-2626  
Application No. 08/286,046

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ON BRIEF

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Before WARREN, ROBINSON and TIMM, Administrative Patent Judges.  
ROBINSON, Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 18 and 20-24, which are all of the claims pending in the application.

Claims 18 and 20 are representative of the subject matter on appeal and are reproduced below:

18. A polymeric fiber containing anti-static agent, wherein the fiber is produced according to the method comprising:

- a) forming a nonaqueous dispersion of a pulverized polyoxyethylene alkylamine anti-static agent which is a solid waxy material at room temperature with a carrier;
- b) injecting the nonaqueous anti-static agent and carrier dispersion into a spinning extruder;
- c) adding fiber-forming polymer to the spinning extruder;
- d) heating together the anti-static agent and polymer to form a melt in the extruder;  
and
- e) extruding the melt to form a polymeric fiber containing anti-static agent.

20. The fiber of claim 18, wherein the anti-static agent is N, N-dipolyoxyethylene-N-2 hydroxyalkyl amine.

The references relied upon by the examiner are:

Burton	5,116,897	May 26, 1992
Burditt et al. (Burditt)	5,157,067	Oct. 20, 1992
Jones	5,236,645	Aug. 17, 1993

#### **Ground of Rejection**

Claims 18 and 20-24 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Jones, Burton and Burditt.

### **Background**

Applicant describes the invention, at pages 2-3 of the specification, as being directed to a method for incorporating an anti-static agent into a polymeric material in a spinning extruder and the product resulting from this method.

### **Discussion**

#### **Grouping of the claims**

At page 5 of the Appellant's Brief (Brief), appellant states that claim 20 does not stand or fall together with claims 18 and 21-24. Appellant has not separately argued the claims within the group which include 18 and 21-24. Therefore, in considering the issues presented in this appeal, we have separately considered claim 20 and have considered 18 as representative of claims 18 and 21-24. 37 C.F.R. §1.192(7)(1995).

#### **The rejection under 35 U.S.C. § 103**

#### **Claims 18 and 21-24:**

In setting forth the basis of this rejection, the examiner relies on Jones as describing  
(Answer, page 3)

a process for introducing additives into thermoplastic melt (see claims of Jones). One of the additives is an anti-static agent and one thermoplastic material is nylon 6 both of which are claimed in instant claim 18. Jones feeds the additive in an aqueous vehicle together with a dispersant into an extruder. These additives are essentially solids (see claim 13). Addition of a surfactant is also suggested (column 5, lines 32-36).

The examiner acknowledges that Jones "fails to specify the antistatic agent of instant claim 20 and rosin of instant claim 21." Id.

The examiner cites Burditt as disclosing (Answer, page 4)

liquid additive concentrate for incorporation into plastics. Such an additive is comprised of an organic rosin material, a surfactant and a colorant or other additive. This reference teaches rosin of instant claim 21.

The examiner cites Burton as disclosing anti-static agents useful in the preparation of polymeric fibers which fall within the scope of claim 18. Id.

The examiner then concludes that (id.)

it would have been obvious to a person of ordinary skill in the art to use the anti-static agent of Burton as an additive to prepare a concentrate of it (as taught by Burditt) with rosin and surfactant and then use this concentrate with nylon into (sic, in) the process of Jones to impart anti-static properties to the nylon fibers so produced by that process.

Claim 18, in product-by-process format, is directed to a polymeric fiber containing an anti-static agent. It is established law that even though the product of a product-by-process claim is defined at least in part by the recited process steps, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 965-66 (Fed. Cir. 1985). On the record before us, the examiner has established that, at the time of the invention, polymeric fibers containing anti-static agents were known (Jones and Burditt) and that polyoxyethylene alkylamine anti-static agents (Burton) were

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anti-static agents known for use in this type of polymeric product. Thus, the examiner has established that the claimed subject matter would have been prima facie obvious within the meaning of 35 U.S.C. § 103 at the time of the invention by appellant. Where, as here, a prima facie case of obviousness has been established, the burden of going forward shifts to the appellant. In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984), In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

Appellant argues that (Brief, page 8)

the references, whether taken alone or in combination, do not teach or suggest the presently claimed process . . . .

However, as we have previously stated, the process of preparing a product, even where the process has been demonstrated to be patentable, will not serve, standing alone, to render patentable a product which is old or obvious. See In re Wertheim, 541 F.2d 257, 271, 191 USPQ 90, 103 (CCPA 1976) ("[T]he patentability of the products defined by the claims, rather than the processes for making them, is what we must gauge in light of the prior art.").

Appellant additionally argues that the references fail to disclose the use of the polyoxyethylene alkylamine anti-static agent of claim 18 (Brief, page 8). We do not agree. We read claim 18 to require the use of an anti-static agent generically designated as a "polyoxyethylene alkylamine". That claim 18 is generic is evidenced by claim 20, which depends therefrom and is directed to a subgenus or specie of the anti-static agent of claim

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18. A reasonable reading of claim 18 in light of the specification would indicate that the polyoxyethylene polyoxypropylene alkylamine of Burton is encompassed by the generic language of the claim. This is supported by page 5 of the specification, which indicates that the anti-static agent of Burton is a preferred anti-static agent useful in the claimed product. Also, we find no description in the specification of anti-static agents useful in the invention which could reasonably be read to exclude the anti-static agents described at page 5 of the specification from that called for by the claim.

Appellant, alternatively, argues that any prima facie case of obviousness is refuted by the examples of the specification (Brief, page 9). We have considered the evidence at pages 9-18 of the specification, to determine whether it demonstrates unexpected results for the product or products claimed. We note, initially, that the data is limited to the use of specific anti-static agents, in specific amounts, in combination with a single type of polymeric material. Therefore, the evidence, at the outset, is not commensurate in scope with the claimed subject matter as it related to components and relative amounts of each. It is well settled that a showing of unexpected results must be commensurate in scope with the scope of the claims. See In re Kulling, 897 F.2d 1147, 1149, 14 USPQ2d 1056, 1058 (Fed. Cir. 1990); In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

Further, Examples 1 and 2 of the specification seek to compare polymeric products which have anti-static agents present therein with polymeric products which lack an anti-

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static agent. In our opinion, this does not represent a comparison of the claimed product with the closest prior art, which disclose and suggest the use of anti-static agents in this type of polymeric product. To the extent that appellant would argue that the evidence of Tables 4-8 serves to compare the anti-static agent with other anti-static agents, we note that the only other anti-static agent for which data is presented is identified only as "Anti-static agent #2 is made by BASF Corp. Wyandotte Michigan and is identified with the code ES-7776" (Specification, pages 14-18). This limited information provides no indication as to the nature of this anti-static agent and thus precludes the use of this data to compare the claimed anti-static agents with those of the prior art relied upon by the examiner. Thus, we do not find the evidence sufficient to overcome the prima facie case of obviousness established on the present record.

When all of the evidence and argument are considered anew, we find, on balance, the evidence and argument presented by the appellant, taken as a whole, fail to outweigh the evidence of obviousness established by the prior art. See Newell Cos. v. Kenney Mfg. Co., 864 F.2d 757, 768, 9 USPQ2d 1417, 1426 (Fed. Cir. 1988) and In re Beattie, 974 F.2d 1309, 1313, 24 USPQ2d 1040, 1043 (Fed. Cir. 1992).

Thus, on the record before us, the examiner has established a prima facie case of obviousness within the meaning of 35 U.S.C. § 103, which appellant has not overcome

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either by argument or evidence. Therefore, we affirm the rejection of claims 18 and 21-24 under 35 U.S.C. § 103 over the combination of Jones, Burton and Burditt.

**Claim 20:**

Appellant has separately argued that claim 20 is patentable over Jones, Burton and Burditt since the references do not disclose the particular N,N-dipolyoxyethylene-N-2-hydroxyamine anti-static agent required by claim 20. While the examiner has cited Burton as disclosing the anti-static agent of claim 20, our review of this reference, as well as Jones and Burditt, does not disclose a N,N-dipolyoxyethylene-N-2-hydroxyamine useful as an anti-static agent. The examiner offers no other evidence which would reasonably indicate that the anti-static agent of claim 20 was known at the time of the invention. Thus, the examiner's rejection of this claim is fatally defective since it does not properly account for and establish the obviousness of the subject matter as a whole. Where 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). Therefore the rejection of claim 20 under 35 U.S.C. § 103 is reversed.

**SUMMARY:**

The rejection of claims 18 and 21-24 under 35 U.S.C. § 103 is affirmed. The rejection of claim 20 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in connection with this appeal

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may be extended under 37 C.F.R. § 1.136(a).

**AFFIRMED-IN-PART**

CHARLES F. WARREN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
DOUGLAS W. ROBINSON	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
CATHERINE TIMM	)	
Administrative Patent Judge	)	

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