

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MAHENDRA K. SHARMA

Appeal No. 1997-2376
Application 08/199,863¹

ON BRIEF

Before PAK, OWENS and WALTZ, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's refusal to allow

¹ Application for patent filed February 22, 1994. According to the appellant, the application is a division of Application 07/956,532, filed October 5, 1992, now U.S. Patent No. 5,300,256, issued April 5, 1994; which is a division of Application 07/513,389, filed April 23, 1990, now U.S. Patent No. 5,153,029, issued October 6, 1992; which is a continuation-in-part of Application 07/392,759, filed August 11, 1989, now U.S. Patent No. 5,204,022, issued April 20, 1993.

Appeal No. 1997-2376
Application 08/199,863

claims 49, 50, 53 and 54 as amended after final rejection.
These are all of the claims remaining in the application.

THE INVENTION

Appellant claims a method for applying meltable polymer additives such as antioxidants, thermal stabilizers, colorants, lubricants, mold release agents, and antistatic agents to polymer particles. Claim 49 is illustrative and reads as follows:

49. A method for treating polymer particles with a dispersion in water of one or more meltable polymer additives said method comprising

contacting with an aqueous medium under conditions of agitation for a time to efficiently wet with water and form a dispersion the composition comprising:

i) one or more water insoluble, meltable polymer additives, wherein substantially all of said polymer additives have a particle size of less than about 40 Fm,

ii) at least one surfactant having a low hydrophobic-lipophobic balance value less than 9, wherein said surfactant is adsorbed on the surface of said water insoluble, meltable polymer additive particles, and

iii) at least one surfactant having a high hydrophobic-lipophobic balance value of greater than 9,

wherein said composition is in powder form having a particle size of about 5.0 to about 1000.0 Fm and contains about 2.0 to

Appeal No. 1997-2376
Application 08/199,863

about 40.0 weight % of encapsulated water based on the total of said composition; and

contacting the dispersion with polymer particles.

THE REFERENCES

| | | |
|----------------------|-----------|---------------|
| Hyche et al. (Hyche) | 4,880,470 | Nov. 14, 1989 |
| Sharma | 5,204,022 | Apr. 20, 1993 |

THE REJECTIONS

Claims 49, 50, 53 and 54 stand rejected as follows: under the judicially created doctrine of obviousness-type double patenting over claims 1-47 of Sharma, and under 35 U.S.C. § 103 over Hyche.

OPINION

We have carefully considered all of the arguments advanced by appellant and the examiner and agree with appellant that the aforementioned rejections are not well founded. Accordingly, we reverse these rejections.

We need to address only claim 49, which is appellant's sole independent claim.

Obviousness-type double patenting rejection

Appellant's claim 49 requires, *inter alia*, that the

Appeal No. 1997-2376
Application 08/199,863

composition has a particle size of about 5.0 to about 1000.0 Fm and contains about 2.0 to about 40.0 wt% of encapsulated water based on the total of the composition. The examiner has not pointed out, and it is not apparent, where these limitations are found in any claim of Sharma.

The examiner argues that even if appellant's claimed invention is not an obvious variant over the claims of Sharma, appellant's claimed invention would have been obvious over the claims of Sharma coupled with Sharma's disclosure (answer, page 4). In support of this argument the examiner relies upon *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). The examiner, however, does not explain, and it is not apparent, why *Schneller* supports the examiner's position.

When an examiner makes an obviousness-type double patenting rejection, the examiner may use the patent's specification as a dictionary to determine the meaning of terms in the patent's claims. See *In re Vogel*, 422 F.2d 438, 441, 164 USPQ 619, 621-22 (CCPA 1970). The disclosure of the patent, however, may not be used as though it were prior art. See *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972

Appeal No. 1997-2376
Application 08/199,863

F.2d 1272, 1281, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992).

Because the examiner has not explained why a method which includes appellant's claim limitations noted above would have been fairly suggested to one of ordinary skill in the art by any claim of Sharma, the examiner has not carried the burden of establishing a *prima facie* case of obviousness-type double patenting. Consequently, we reverse the obviousness-type double patenting rejection.

Rejection under 35 U.S.C. § 103

As correctly pointed out by the examiner (answer, page 6), Hyche does not disclose the requirements in appellant's claim 49 of a polymer additive particle size of less than about 40 Fm, at least one surfactant having a hydrophobic-lipophobic balance (HLB) value of less than 9, and a composition which is in powder form, has a particle size of about 5.0 to about 1000.0 Fm, and contains about 2.0 to about 40.0 wt% of encapsulated water based on the total of the composition.

The examiner argues (answer, pages 6-7) that

Appeal No. 1997-2376
Application 08/199,863

Hyche discloses use of various surfactants which include an ethoxylated linear alcohol governed by an HLB value of 15.4 and, as operable equivalent, other commercially available emulsifiers which include SWS-211, ethoxylated stearyl alcohol, etc. as being operable within the scope of the method disclosed at col. 2, lines [sic, lines] 32+ which includes water encapsulated at a content of about 40 wt.%, therefore it would have been obvious to the skilled artisan to use a mixture of surfactants including the disclosed ethoxylated stearyl alcohol in combination with any of the disclosed commercially available surfactants, based on their recognized equivalency, in the method disclosed at col. 2, lines 32+ with a reasonable expectation of success.

This argument is based upon an incorrect reading of the reference. Hyche discloses that surfactants and emulsifiers such as Tergitol 15-S-15, which is an ethoxylated linear alcohol surfactant and has an HLB value of 15.4, can be used. This is the only such surfactant disclosed in the reference. Hyche states that the SWS-211 is an anti-foam agent and, contrary to the examiner's assertion, does not indicate that it is an equivalent to the surfactant (col. 4, lines 5-6). Also, Hyche does not disclose an HLB value of this material. The examiner, therefore, has not provided evidence which discloses use of a surfactant having an HLB greater than 9 in combination with a surfactant having an HLB less than 9 or

Appeal No. 1997-2376
Application 08/199,863

which would have fairly suggested this combination to one of ordinary skill in the art.

As for the examiner's argument regarding encapsulated water, Hyché teaches that water is used in the method of making the composition (col. 2, lines 36-52). Hyché, however, does not disclose that the product is in powder form and has about 2 to about 40 wt% of encapsulated water as required by appellant's claim 49.

The examiner argues that since Hyché does not disclose any particle sizes, he would have fairly suggested to one of ordinary skill in the art that any particle size would be useful in his method (answer, page 7). In order for a *prima facie* case of obviousness of appellant's claimed invention to be established, the prior art must be such that it would have provided one of ordinary skill in the art with both a suggestion to carry out appellant's claimed process and a reasonable expectation of success in doing so. See *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). "Both the suggestion and the expectation of success must be founded in the prior art, not in the

Appeal No. 1997-2376
Application 08/199,863

applicant's disclosure." *Id.* The mere possibility that the prior art could be modified such that appellants' process is carried out is not a sufficient basis for a *prima facie* case of obviousness. See *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996); *In re Ochiai*, 71 F.3d 1565, 1570, 37 USPQ2d 1127, 1131 (Fed. Cir. 1995). The examiner has not established that Hyché would have fairly suggested, to one of ordinary skill in the art, forming a composition in the form of a powder having a particle size within appellant's recited range. The motivation relied upon by the examiner comes solely from the description of appellant's invention in the specification. Thus, the examiner used impermissible hindsight when rejecting the claims. See *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *In re Rothermel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960).

The examiner argues that appellant has not demonstrated the criticality of use of his surfactant combination and

Appeal No. 1997-2376
Application 08/199,863

particle sizes (answer, page 7). This argument is not well taken because the examiner has the initial burden of establishing a *prima facie* case of obviousness. See *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). Only when a *prima facie* case of obviousness has been established does appellant have the burden of rebutting it by presenting objective evidence of non-obviousness. See *Piasecki*, 745 F.2d at 1472, 223 USPQ at 788; *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 882 (CCPA 1981). A final determination regarding obviousness is then reached by starting anew and evaluating the rebuttal evidence along with the evidence upon which the conclusion of *prima facie* obviousness was based. See *Rinehart*, 531 F.2d at 1052, 189 USPQ at 147. Because, for the above reasons, the examiner has not established a *prima facie* case of obviousness, appellant need not provide such rebuttal evidence.

Appeal No. 1997-2376
Application 08/199,863

DECISION

The rejections of claims 49, 50, 53 and 54 under the judicially created doctrine of obviousness-type double patenting over claims 1-47 of Sharma, and under 35 U.S.C. § 103 over Hyche, are reversed.

REVERSED

| | | |
|-----------------------------|---|-----------------|
| CHUNG K. PAK |) | |
| Administrative Patent Judge |) | |
| |) | |
| |) | |
| |) | BOARD OF PATENT |
| TERRY J. OWENS |) |) |
| Administrative Patent Judge |) | APPEALS AND |
| |) | |
| |) | INTERFERENCES |
| |) | |
| THOMAS A. WALTZ |) | |
| Administrative Patent Judge |) | |

Appeal No. 1997-2376
Application 08/199,863

TJO/pgg
Jonathan D. Wood
Eastman Chemical Company
P.O. Box 511
Kingsport, TN 37662-5075