

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte FRANZ GUEBITZ

---

Appeal No. 1998-3202  
Application No. 08/456,294

---

ON BRIEF

---

Before HANLON, WARREN, and TIMM, Administrative Patent Judges.

HANLON, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 involving claims 5 and 8. Claims 5-7 were finally rejected. However, subsequent to the final rejection, an amendment was filed canceling claims 6 and 7 and adding claim 8. Paper No. 16. That amendment was entered by the examiner. See Paper No. 17 (the proposed amendment will be entered upon filing a Notice of appeal and an appeal brief). Therefore, claims 5 and 8 are properly at issue in this appeal.

The claims on appeal are directed to a method for preparing a decorative surface appearance of a molded body. Claim 5 is illustrative and reads as follows:

5. A method for the preparation of a decorative surface appearance of a molded body manufactured from a polymer comprising polypropylene said method comprising the steps of adding to a mixture of:

- a) from 95 to 50% by weight of isotactic polypropylene or copolymers of propylene with up to 10% by weight of ethylene,
- b) from 5 to 50% by weight of ethylene-propylene-rubber copolymers which are compatible with polypropylene and
- c) from 10 to 50% by weight of reinforcing fillers

carbon fibers having a fiber length of from 0.5 to 18 mm in an amount from 0.3 to 3% by weight, calculated on total weight of the mixture of a) plus b) plus c), and shaping the mixture and the added carbon fibers to produce said molded body.

The sole issue in this appeal is whether the examiner properly rejected claims 5 and 8 under 35 U.S.C. § 103 as being unpatentable over Kishida et al.<sup>1</sup>

#### Discussion

According to appellant, the issue in this appeal is whether the teachings of Kishida render obvious the claimed range of carbon fibers. See Brief, p. 4.

Claim 5 is directed to a method for preparing a decorative surface appearance of a molded body manufactured from a polymer comprising polypropylene. The method includes the step of adding to a mixture of a) polypropylene or copolymers thereof, b) ethylene-propylene-rubber copolymers and c) from 10 to 50% reinforcing fillers, from 0.3 to 3% by weight, based on the total weight of a), b) and c), of carbon fibers having a fiber length of from 0.5 to 18 mm.

---

<sup>1</sup>U.S. Patent No. 4,720,516 granted on January 19, 1988, to Kishida et al. (hereinafter “Kishida”).

Appeal No. 1998-3202  
Application No. 08/456,294

According to the specification, reinforcing fillers include talc, chalk, glass fibers and glass beads.

See Specification, p. 4, lines 8-9.

Kishida discloses a method for preparing molded products from polyolefin resin compositions comprising a modified polyolefin and reinforcing materials. Examples of polyolefins used to prepare the modified polyolefin include polypropylene and ethylene/propylene/diene copolymer. The reinforcing materials disclosed in Kishida are of two types, fibrous materials and powdery materials. Fibrous materials include glass fibers and carbon fibers having a length of 5 mm or less, preferably 0.01 to 3 mm, and powdery materials include talc and calcium carbonate. According to Kishida, the reinforcing materials may be used singly or in combination in an amount of 5 to 80% by weight of the modified polyolefin. See col. 4, lines 3-20.

The examiner explains (Answer, pp. 3-4):

It is acknowledged that the amount of carbon fibers added to the claimed composition is not expressly disclosed in the reference. The instantly claimed amount is 0.3 to 3% by weight of the carbon fibers relative to the total weight of the composition. This patent teaches a minimum amount of 5 weight percent based on the modified polyolefin. The examiner maintains however that this amount is not simply the amount of the reinforcement fibrous materials of which the carbon fiber is preferred. When referring to the amount of the reinforcements utilized at column 4 line 18, it is clear that the reinforcement material is referring to the powdery reinforcement as well as the fibrous reinforcement. This is to say that the total amount of the combination of reinforcing materials is 5 weight percent and up. This is to say that one could incorporate 1, 2 or 3% of the carbon fibers as stated at column 4 line 3 in combination with higher amounts of the other reinforcements as stated at column 4 line 11 and thus arrive at a composition having greater than 5 weight percent of reinforcements and still having the instantly claimed amount of carbon fibers. The Examiner maintains that this interpretation is well within the scope of the reference and that absent a clear

Appeal No. 1998-3202  
Application No. 08/456,294

showing of unexpected results, the instantly claimed invention is rendered prima facie obvious.

We agree with the examiner that the teachings of Kishida reasonably suggest a range of carbon fibers which overlaps the range claimed. See In re Lamberti, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976) (a reference must be considered for all that it expressly teaches and fairly suggests to one of ordinary skill in the art). It is well-settled that where the difference between the claimed invention and the prior art is a range, the applicant must show that the particular range is critical. In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990); see also In re Malagari, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974) (claimed invention is rendered prima facie obvious by the teachings of a prior art reference that discloses a range that touches the range recited in the claim). Appellant has made no such showing in this case. Although appellant argues that the claimed range is critical, arguments in the brief do not take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965).

Finally, appellant argues that the claimed range would not have been obvious to one of ordinary skill in the art since the objectives of the invention disclosed in Kishida and the claimed invention are different. To the extent that the "objectives" are different, the motivation in the prior art need not be identical to that of appellant in order to establish obviousness under 35 U.S.C. § 103. In re Kemps, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 131 (Fed. Cir. 1996). That is, it is of no moment, in the rejection based on 35 U.S.C. § 103, that one of ordinary skill in the

Appeal No. 1998-3202  
Application No. 08/456,294

art would have chosen the claimed range of carbon fibers for a different reason than appellant.

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

|                             |   |                 |
|-----------------------------|---|-----------------|
| ADRIENE LEPIANE HANLON      | ) |                 |
| Administrative Patent Judge | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
|                             | ) | BOARD OF PATENT |
| CHARLES F. WARREN           | ) | APPEALS         |
| Administrative Patent Judge | ) | AND             |
|                             | ) | INTERFERENCES   |
|                             | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
| CATHERINE TIMM              | ) |                 |
| Administrative Patent Judge | ) |                 |

alh

Appeal No. 1998-3202  
Application No. 08/456,294

CONNOLLY AND HUTZ  
PO BOX 2207  
WILMINGTON, DE 19899