

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER M. KAZMAIER,
MICHAEL K. GEORGES, RICHARD P.N. VEREGIN, BARKEV KEOSHKERIAN,
GORDON K. HAMER, KAREN A. MOFFAT, and MARKO SABAN

Appeal No. 1998-3264
Application No. 08/345,371

ON BRIEF

Before GARRIS, OWENS, and WALTZ, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the refusal of the examiner to allow claims 1 through 3, 5, 6, 8, 10, 11, 14, 16 through 18, 20, 22 and 23 as amended subsequent to the final

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rejection. The only other claims pending in the application, which are claims 7, 9, 13, 19 and 21, stand withdrawn from further consideration by the examiner.

The subject matter on appeal relates to a free radical polymerization process for the preparation of a thermoplastic resin which comprises forming a nitroxide stable free radical agent from a precursor material in a reaction vessel, introducing a free radical initiator and at least one polymerizable monomer compound into said reactor vessel and heating the resulting mixture in said vessel to form the thermoplastic resin. This appealed subject matter is adequately illustrated by independent claim 23 which reads as follows:

23. A free radical polymerization process for the preparation of a thermoplastic resin, comprising:

(a) forming a nitroxide stable free radical agent from a precursor material in a reactor vessel;

(b) introducing a free radical initiator and at least one polymerizable monomer compound into said reactor vessel; and

(c) heating a mixture comprised of said stable free radical initiator, said nitroxide stable free radical agent, and said at least one polymerizable monomer compound in said reactor vessel to form a thermoplastic resin.

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The reference set forth below is the sole reference applied by the examiner in the rejections before us:

Georges et al. (Georges)	5,322,912	Jun. 21,
1994		

As expressed on page 4 of the answer, "[c]laims 1, 2, 6, 8, 10, 11, 14, 16-18, 20, 22, 23 [are] rejected under 35 U.S.C.

§ 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention."

As expressed on page 3 of the answer, "[c]laims 1-6 [sic], 8, 10-12 [sic], 14-18 [sic], 20, 22 [are] rejected under 35 U.S.C. § 102(a) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Georges."¹

¹Plainly, the examiner has inaptly listed the claims included in his above noted prior art rejection. For purposes of completeness in our disposition of this appeal, we will assume that the prior art rejection has been applied against all of the claims on appeal.

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We refer to the several briefs and answers respectively for a complete exposition of the opposing viewpoints expressed by the appellants and the examiner concerning the above noted rejections.

OPINION

We cannot sustain any of the rejections advanced by the examiner on this appeal.

It is well settled that the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In each of the rejections under consideration, the examiner has failed to carry his initial burden of presenting the requisite prima facie case.

Concerning the section 112, second paragraph, rejection, the comments made by the examiner in his answer regarding a section 112 position have no discernible relationship at all to the issue of claim particularity and distinctness. It is clear, therefore, that the examiner has not even attempted much less succeeded in carrying his initial burden with

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respect to this rejection. As a consequence, the examiner's section 112, second paragraph, rejection cannot be sustained.

As for the section 112, first paragraph, rejection, the answer contains comments that are at least related to the issue of nonenablement. These comments, however, amount to nothing more than an allegation of nonenablement without any reasons in support thereof. Because a rejection for lack of enablement must be substantiated with reasons (In re Armbruster, 512 F.2d 676, 677-78, 185 USPQ 152, 153 (CCPA 1975)), the examiner's section 112, first paragraph, rejection also cannot be sustained.

Finally, the examiner's section 102 and section 103 rejections of the appealed claims as being unpatentable over Georges cannot be sustained. This is because, as correctly indicated by the appellants in their briefs, the applied reference simply does not contain any teaching or suggestion of forming a nitroxide stable free radical agent from a precursor material in a reaction vessel as required in step (a) in combination with introducing ingredients into said reactor vessel in accordance with step (b) and heating the ingredients in said reactor vessel in accordance with step (c)

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as required by each of the independent claims on appeal. In the absence of such a teaching or suggestion, it is apparent that the Georges reference is evidentially inadequate to establish a prima facie case of anticipation as well as obviousness.²

The decision of the examiner is reversed.

REVERSED

	Bradley R. Garris)	
	Administrative Patent Judge)	
)	
)	
)	
	Terry J. Owens)	BOARD OF
PATENT)	
	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES

²In the supplemental examiner's answer mailed April 25, 1997 (Paper No. 14), the examiner has referred to prior art other than the Georges reference in an apparent attempt to further support his anticipation and obviousness conclusions. Without question, this attempt by the examiner was wholly inappropriate. Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). In our assessment of the examiner's section 102 and section 103 rejections, we have not considered the prior art referred to in the aforementioned supplemental examiner's answer because it has not been positively included in the examiner's statement of these rejections.

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Thomas A. Waltz
Administrative Patent Judge

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BRG:tdl

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OLIFF & BERRIDGE
P.O. Box 19928
Alexandria, VA 22320