

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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRIEDEMANN ROUS

Appeal No. 1999-1073
Application No. 08/819,239

ON BRIEF

Before GARRIS, PAK, and KRATZ, Administrative Patent Judges.
PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 3 through 7 and 15 through 20, which are all of the claims pending in the above-identified application.

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Claim 1 is representative of the subject matter on appeal and reads as follows:

1. A nonflammable halogen-free mixture for manufacturing electrical cables with increased heat resistance, the mixture comprising:

a copolymer selected from the group of copolymers consisting of a polypropylene block copolymer and a polypropylene random block copolymer;

a salt of a metal selected from the group consisting of Group II, IIa and IIb metals of the periodic system, wherein the metal salt in the mixture is in the range of 1 to 15 parts per 100 parts of copolymer;

a metal hydroxide, wherein the metal hydroxide in the mixture is in the range of 30 to 180 parts of copolymer; and

a silicone material selected from the group consisting of silicone oil, silicone rubber, and combinations thereof, wherein the silicon material in the mixture is in the range of 0.3 to 20 parts per 100 parts copolymer.

The prior art references relied upon by the examiner are:

Harbourne et al. (Harbourne)	4,722,858	Feb. 2, 1988
Dokurno et al. (Dokurno)	4,847,317	Jul. 11, 1989
Keogh	5,104,920	Apr. 14, 1992
Jow et al. (Jow)	5,482,990	Jan. 9, 1996

(Filed Jan. 17, 1995)

The appealed claims stand rejected as follows:

1) Claims 1, 3 through 7 and 16 under 35 U.S.C. § 103 as unpatentable over Keogh; and

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2) Claims 1, 3 through 7 and 15 through 20 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Keogh, Jow, Dokurno and Harbourne.

We have carefully reviewed the claims, specification and applied prior art, including all of the arguments advanced by both the examiner and appellant in support of their respective positions. This review leads us to conclude that the examiner's § 103 rejections are not well founded. Accordingly, we reverse the examiner's § 103 rejections. Our reasons for this determination follow.

Under Section 103, "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 other words, the burden of producing a factual basis to support a *prima facie* case of obviousness rests on the examiner. *In re Warner*, 379, F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967).

In the present case, the examiner has not demonstrated that the applied prior art references, either individually or in

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combination, teach or would have suggested the employment of the claimed polypropylene block copolymer or polypropylene random block copolymer in the nonflammable halogen-free composition described in Keogh. As correctly pointed by appellant (e.g., Brief, pages 7, 9, 10 and 11), the examiner recognizes that the applied prior art does not teach the claimed polypropylene block copolymer or polypropylene random block copolymer. To remedy this deficiency, the examiner asserts (Answer, pages 4 and 5) that:

Keogh relates the same flame retardant systems's application in ethylene copolymers with propylene. Since applicant has not deigned to reveal with any degree of specificity what the comonomer(s) of his propylene block or random block copolymers are [,] they should be presumed to be those which are ordinarily employed in making propylene copolymers such as Keogh utilizes. Applicant has not pointed out any properties inherent in the makeup of the instant propylene block copolymers that would tend to detract from using the same preservatives as ordinarily used in the nonblock form of the copolymer[.] The fact that Keogh relates that alternatively polymers as diverse as polycarbonate, polyesters, and polyurethanes or diolefin derived polymers are also made flameproofed, signifies the absence of criticality in the spatial configuration of the hydrocarbon radicals in the polymers' chains as a factor in predicting amenability to flameproofing.

In so asserting, the examiner has improperly shifted the burden to appellant without first establishing a *prima facie* case of

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obviousness. In other words, the examiner has not provided any evidence to demonstrate that it would have been *prima facie* obvious to employ the claimed polypropylene block copolymer or polypropylene random block copolymer in the nonflammable halogen-free composition described in Keogh. The examiner simply has not referred to any evidence to show that it is known to use the claimed polypropylene block copolymer or polypropylene random block copolymer in forming a nonflammable halogen-free composition.

Under these circumstances, we are constrained to agree with appellant that the examiner has not established a *prima facie* case of obviousness regarding the claimed subject matter within the meaning of 35 U.S.C. § 103. Accordingly, we reverse all the aforementioned § 103 rejections.

REVERSED

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BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
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)	INTERFERENCES
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Letty

JUDGE PAK

APPEAL NO. 1999-1073

APPLICATION NO. 08/819,239

APJ PAK

APJ KRATZ

APJ GARRIS

DECISION: **REVERSED**

PREPARED: Oct 1, 2002

OB/HD

PALM

ACTS 2

DISK (FOIA)

REPORT

BOOK