

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte SATISH KUMAR GAGGAR and FUH-SHENG CHEN

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Appeal No. 1999-2488  
Application No. 08/841,027

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ON BRIEF

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Before KIMLIN, GARRIS, and PAWLIKOWSKI, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claim 10 and from the refusal of the examiner to allow claims 2-7<sup>1</sup> and 9 as amended subsequent to the final rejection. These are all of the claims remaining in the application.

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<sup>1</sup>We observe that the phrase "said vinyl aromatic-vinyl cyanide rigid copolymer" in claim 6 lacks strict antecedent basis and apparently should read --said vinyl aromatic-unsaturated nitrile rigid resin--. This informality is deserving of correction in any further prosecution that may occur.

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The subject matter on appeal relates to a method for improving heat/humidity aging resistance of a flame retardant thermoplastic composition. Further details of this appealed subject matter are set forth in representative independent claim 9 which reads as follows:

9. A method for improving heat/humidity aging resistance of a flame retardant thermoplastic composition, comprising the steps of:

- (a) providing an aromatic polycarbonate resin present at a level of from 60 to 90 percent by weight based on the total weight of the composition,
- (b) providing a vinyl aromatic-unsaturated nitrile-diene rubber graft copolymer present at a level of from 8 to 15 percent by weight based on the total weight of the composition,
- (c) providing a vinyl aromatic-unsaturated nitrile rigid resin present at a level of from 1 to 10 percent by weight based on the total weight of the composition,
- (d) providing a phosphate present at a level of from 3 to 15 percent by weight based on the total weight of the composition; and
- (e) providing a tetrafluoroethylene polymer present at a level of from 0.05 to 2.0 percent by weight based on the total weight of the composition, wherein said diene rubber of said graft copolymer is present at a level of from 6 to 12 percent by weight based on the total weight of the composition whereby said composition retains about 80% of the original Izod impact strength after one week aging at 63 °C at 100% relative humidity.

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The references set forth below are relied upon by the examiner as evidence of obviousness:

Buyisch et al. (Buyisch)	4,883,835	Nov. 28, 1989
Gosens et al. (Gosens)	5,204,394	Apr. 20, 1993
Yang et al. (Yang)	5,643,981	Jul. 1, 1997
		(filed Nov. 1, 1994)

All of the claims on appeal are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yang, Gosens and Buyisch.<sup>2</sup>

We refer to the brief and to the answer (as well as to the first office action mailed August 11, 1997 as paper no. 11 to which the answer refers) for a complete exposition of the opposing viewpoints expressed by the appellants and by the examiner concerning the above noted rejection.

#### OPINION

For the reasons which follow, we will sustain this rejection.

On page 6 of the brief, the appellants state that "[t]he following table illustrates the compositions disclosed by the prior art references cited against the instant invention, comparing the prior art compositions to the inventive

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<sup>2</sup>As indicated by the appellants on page 7 of the brief, "the claims [on appeal] all stand or fall together." Accordingly in assessing the merits of the above noted rejection, we will focus primarily on independent claim 9 since, in most respects, it is the broadest claim on appeal.

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composition.” Consistent with the representations made in this table, the appellants then go on to argue that the applied references contain no teaching or suggestion to remove the diphosphate fire retardant or the low molecular weight halogen containing fire retardant of the Yang and Buysch compositions respectively in order to thereby obtain their inventive composition wherein only one fire retardant component, namely, a monophosphate fire retardant, is used. These arguments are unpersuasive.

This is because, contrary to the appellants’ apparent belief, the subject matter on appeal simply is not limited in the manner argued in the brief. Specifically, neither of the appealed independent claims excludes diphosphate fire retardant or low molecular weight halogen containing fire retardant or limits the recited composition to only one fire retardant component as implicitly presupposed by the appellants’ arguments. In this regard, we emphasize that the appealed independent claims 9 and 10 employ the term “comprising” which permits the inclusion of other steps, elements or materials such as the aforementioned diphosphate fire retardant and low molecular weight halogen containing fire retardant. In re Baxter, 656 F.2d 679, 686, 210 USPQ 795, 802 (CCPA 1981).

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Moreover, it is appropriate to clarify certain incorrect findings of fact made by the appellants in presenting their above noted arguments. First, neither of the independent claims on appeal (or for that matter any of the dependent claims on appeal) requires that the phosphate component of the composition recited in the here claimed method constitute a monophosphate fire retardant as the appellants seem to believe. Additionally, the appellants are clearly incorrect in stating that Gosens' composition does not include a copolymeric resin of the type here claimed (i.e., the resin recited in step (c) of the independent claims). This resin is unambiguously disclosed as a component of Gosens' composition in lines 1-29 of column 4.

Finally, the appellants present the following argument on page 11 of the brief:

The Examiner's statement that "[a]ll of applicants claim limitations are met" is erroneous because of Appellants' clause reciting "whereby said composition retains about 80% of the original Izod impact strength after one week aging at 63 °C at 100% relative humidity (Appendix, claim 9)." None of the cited prior art suggests or recites this condition.

Initially, it is appropriate to point out that appealed independent claim 10 contains no recitation concerning such a "condition." In any event, as correctly indicated by the examiner, the respective compositions of Yang and Buysch

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contain each of the ingredients defined by independent claim 9 in concentrations which encompass or overlap the claim 9 concentrations. Therefore, the composition products defined by appealed claim 9 and disclosed by Yang or Buysch appear to be identical or substantially identical.

Where, as here, the claimed and prior art products are identical or substantially identical, the Patent and Trademark Office can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. Whether the rejection is based on "inherency" under 35 U.S.C. § 102, on "prima facie obviousness" under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the inability of the Patent and Trademark Office to manufacture products or to obtain and compare prior art products. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977).

The record before us contains no proof of any kind that the composition products of Yang and Buysch respectively do not necessarily or inherently possess the appealed claim 9 characteristic or "condition" under consideration. On the other hand, it is reasonable to believe that the prior art compositions necessarily and inherently contain the same

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characteristics as the here claimed compositions in light of the  
aforementioned ingredient/concentration commonalities. Under  
these circumstances, the appellants' mere argument to the  
contrary must be considered unpersuasive. Id.

For the above stated reasons, we hereby sustain the  
examiner's Section 103 rejection of all appealed claims as being  
unpatentable over Yang, Gosens and Buysch.

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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

EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
BRADLEY R. GARRIS	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
BEVERLY A. PAWLIKOWSKI	)	
Administrative Patent Judge	)	

BRG:hh

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