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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL
AND APPEAL BOARD

Ex parte CHARLES J. WILLARD, STEPHANE ROCHARD,
MICHAEL J. VENTURINI, DOREEN C. BECKER, and
SHAHJAHAN KAZI

Appeal 2011-004411
Application 10/995,756
Technology Center 1700

Before PETER F. KRATZ, BEVERLY A. FRANKLIN, and
JAMES C. HOUSEL, *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's
rejection of claims 1-20. We have jurisdiction under 35 U.S.C. § 6.

STATEMENT OF THE CASE

Claim 1, 8, 9, 12, and 13 are representative of the subject matter on
appeal and is set forth below:

1. A composition comprising substantially spherical particles, said particles comprising:

- (a) about 60 to about 80 weight percent pearlescent pigment;
- (b) greater than 20 weight percent to about 38 weight percent wax;
and
- (c) about 2 to about 6 weight percent surfactant.

8. The composition of claim 1 wherein said surfactant (c) is selected from the group consisting of poly(oxy-1,2-ethanediyl), α -(9Z)-9-octadecenyl- ω -hydroxy-(9CI) and a mixture of C12-14 secondary ethoxylated alcohols.

9. A masterbatch precursor comprising said composition of claim 1.

12. A method of making the composition of claim 1 comprising the steps of:

combining pearlescent pigment and emulsion comprising wax, surfactant, and water;

and

spray drying said combination to form said composition comprising substantially spherical particles.

13. A method of increasing throughput rate in an extruder comprising the steps of:

(a) combining polymer and a composition comprising substantially spherical particles; and

(b) extruding said combination to form a masterbatch, wherein said substantially spherical particles comprise:

(i) about 60 to about 80 weight percent pearlescent pigment;

(ii) greater than 20 weight percent to about 38 weight percent wax;

and

(iii) about 2 to about 6 weight percent surfactant.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Rohr	US 7,029,818 B2	Apr. 18, 2006
Scheibelhoffer	US 5,670,561	Sep. 23, 1997
Lucey	US 5,306,739	Apr. 26, 1994

THE REJECTION

Claims 1-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Rohr in view of Scheibelhoffer and Lucey.

ANALYSIS

As an initial matter, Appellants have not presented separate arguments for all of the rejected claims. Rather, Appellants' arguments are principally directed to independent claims 1, 12, and 13, and dependent claims 8, 9, and 20. Any claim not separately argued will stand or fall with its respective independent claim. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Claim 1

Appellants argue that their claims are directed to a masterbatch precursor for introducing pearlescent pigment into a masterbatch composition by extrusion, whereas Rohr is directed to colorants for use in electrophotographic toners and developers, powder coating material, and inkjet inks. Br. 10-12. Appellants submit that therefore Rohr is not analogous art. Br. 11. However, such arguments are unconvincing because the limitations argued by Appellants are not set forth in claim 1. Limitations not appearing in the claims cannot be relied upon for patentability. *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982).

Appellants also argue that their claimed subject matter includes effect pigments such as a pearlescent effect pigment. Br. 10-11. However, the Examiner correctly finds that Rohr teaches use of pearlescent pigments. Ans. 2. Rohr, col. 4, l. 12.

Appellants argue that Rohr does not teach an amount of surfactant of “about 2 to about 6 weight percent” as recited in claim 1. Br. 12. The Examiner acknowledges that Rohr teaches use of a surfactant, but is silent as to the amount of surfactant. Ans. 2. Rohr, col. 5, ll. 55-67. Therein, Rohr indicates that “optimum wetting” of the pigment surface can be influenced by the addition of a surfactant. The Examiner also relies upon Scheibelhoffer for teaching the addition of a surfactant to pigment concentrates in amounts as claimed by Appellants. Ans. 3, Scheibelhoffer, col. 8, ll. 10-14.

Implicit in the Examiner’s position is that the amount of pigment is a result effective variable, and therefore obvious, as demonstrated by Rohr. As discussed, *supra*, Rohr indicates that the wetting of the pigment surface

can be affected by use of a surfactant. Hence, we agree with the Examiner's position in this regard. Optimization of a variable recognized in the prior art to be a result effective variable is the type of routine step ordinarily within the skill in the art and, therefore, supportive of a conclusion of obviousness. *In re Boesch*, 617 F.2d 272, 276 (CCPA 1980). We thus are not convinced by Appellants' arguments as set forth on pages 15-18 of their Brief.

It is true that a routine variable change sometimes causes an unexpected effect. In such a situation, the claimed subject matter will be unobvious under the law if Appellants present a showing of criticality of the range for unexpected beneficial results. *See In re Boesch*, 617 F.2d 272, 276 (CCPA 1980); *see also In re Woodruff*, 919 F.2d 1575, 1578 (Fed. Cir. 1990); *In re Aller*, 220 F.2d at 456 (CCPA 1955).

In the instant case, Appellants rely upon the Declaration of Steven Goldsmith as rebuttal evidence, as well as additional argument, including reference to data in their Specification. Br. 18-23. Absent from this evidence is a comparison made with the closest prior art, as the Examiner points out on page 3 of the Answer. Each comparative example discussed by Appellants in either their arguments with reference to data in their Specification, or in the Declaration of Steven Goldsmith, is not a comparative example representative of the closest prior art because there is no comparison made with an example having a surfactant. Rohr is the closest prior art, and teaches a surfactant, and thus a comparison must be made with an example from Rohr. "[W]hen unexpected results are used as evidence of nonobviousness, the results must be shown to be unexpected compared with the closest prior art." *Kao Corp. v. Unilever U.S., Inc.*, 441 F.3d 963, 970 (Fed. Cir. 2006) *quoting In Re Baxter Travenol Labs.*, 952

F.2d 388, 392 (Fed. Cir. 1991). As a general guideline, the closest prior art is the reference that has the most claim limitations in common with the invention, bearing in mind the relative importance of particular limitations. *In re Merchant*, 575 F.2d 865, 868 (CCPA 1978). As such, we are unconvinced by such argument/Declaration.

In the Reply Brief, Appellants argue that Rohr does not teach the claimed wax range. But, this is not correct because the Examiner correctly finds that Rohr teaches the claimed wax range. Ans. 3. Rohr, claims 2 and 6. See also Rohr, col. 5, ll. 4-7. Appellants then argue that they have demonstrated the criticality of the claimed wax range and the presence of a surfactant. Reply B. 4-5. However, as stated, *supra*, because a comparison has not been made with the closest prior art, we are not convinced by such argument.

In view of the above, we agree with the Examiner's rejection of claim 1.

Claim 8

Claim 8 recites that the surfactant (c) of claim 1 is selected from the group consisting of poly(oxy-1,2-ethanediyl), α -(9Z)-9-octadecenyl- ω -hydroxy-(9CI) and a mixture of C12-14 secondary ethoxylated alcohols.

The Examiner's position is that:

The specific surfactants recited in instant claims 8 and 20 are not seen as distinguishing over the teachings of prior art. Applicants' specification demonstrates that these surfactants were known and commercially available at the time the invention was made. Additionally, the reference to Lucey teaches the known use of the ethanediyl species in polymer compositions.

Ans. 3.

Appellants' Specification discloses that the kinds of surfactants recited in claim 8 are most preferred. Spec. p. 8, ll. 1-14. It is not proper for the Examiner to rely upon such teachings in the Specification and take the position that just because these kinds of surfactants are known in the art, it would have been obvious to use them in the manner done by Appellants. That is, the Examiner's reliance upon Appellants' Specification in this regard is improper because the Examiner relies on information gleaned solely from Appellants' Specification. MPEP § 2142 states that "impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art". "Any judgement on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and **does not include knowledge gleaned only from applicant's disclosure** [emphasis added], such a reconstruction is proper" (MPEP § 2145(X)(A), quoting *In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971)).

The Examiner then relies upon Lucey as evidence that the ethanediyl species in polymer compositions was known in the art. However, the Examiner provides no reasoned rationale as to why it would have been obvious to have incorporated the type of surfactant of Lucey into Rohr.

Ans. 3. Establishing a prima facie case of obviousness of an invention comprising a combination of known elements requires "an apparent reason to combine the known elements in the fashion claimed." *KSR Int'l. Co. v.*

Teleflex Inc., 550 U.S. 398, 418 (2007). In the instant case, the Examiner has failed to provide an apparent reason.

In view of the above, we therefore reverse the rejection of claim 8 and claim 20.

Claims 9 and 13

Claim 9 is directed to a masterbatch precursor comprising the composition of claim 1.

Claim 13 is directed to a method including “extruding said combination to form a masterbatch”.

Appellants argue that their claims are directed to a masterbatch precursor for introducing pearlescent pigment into a masterbatch composition by extrusion, whereas Rohr is directed to colorants for use in electrophotographic toners and developers, powder coating material, and inkjet inks. Appellants submit that therefore Rohr is not analogous art. Br. 10-11.

However, the Examiner correctly finds that Rohr teaches spherical, wax-coated pearlescent pigment granules suitable for masterbatch applications. Ans. 3. Rohr indicates that the granules are free-flowing and “hence readily meterable” and claim 12 recites a masterbatch. Rohr, col. 3, ll. 49-51, and claim 12. We add that Rohr discusses “extrusion” and “masterbatch”. Rohr, col., 12. ll. 4-27. We thus are in agreement with the Examiner’s conclusion of obviousness regarding claims 9 and 13.

Claim 12

Claim 12 is directed to “a method of making the composition of claim 1 comprising the steps of combining pearlescent pigment and emulsion comprising wax, surfactant, and water; and spray drying said combination to form said composition comprising substantially spherical particles.”

Appellants argue that Rohr fails to teach preparing a composition using an emulsion comprising wax, surfactant and water. Br. 12. However, the Examples in Rohr teach that the pigment is dispersed in water followed by addition of isobutanol and polyethylene wax. This teaching, combined with the teaching, discussed, supra, that a surfactant can be used to improve wetting, suggests Appellants’ claimed method as set forth in claim 12. We thus agree with the Examiner’s conclusion of obviousness with regard to claim 12.

CONCLUSIONS OF LAW AND DECISION

The rejection of claims 1-7 and 9-19 is affirmed.

The rejection of claims 8 and 20 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1).

AFFIRMED-IN-PART

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