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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SHUN WAN, DAKE SHEN, YAMING NIU, and YING XI¹

Appeal 2015-006482
Application 13/593,024
Technology Center 1700

Before BRADLEY R. GARRIS, LINDA M. GAUDETTE, and
JEFFREY W. ABRAHAM, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134, Appellants appeal from the Examiner's decision rejecting claims 1–4, 6–10, 12–18, 20–24, and 26–30 under 35 U.S.C. § 103(a) as unpatentable over Wan et al. (WO 2012/058821 A1, published May 10, 2012, with SABIC INNOVATIVE PLASTICS IP B.V. listed as Applicant for all designated States except US) (“Sabic”). We have jurisdiction under 35 U.S.C. § 6.

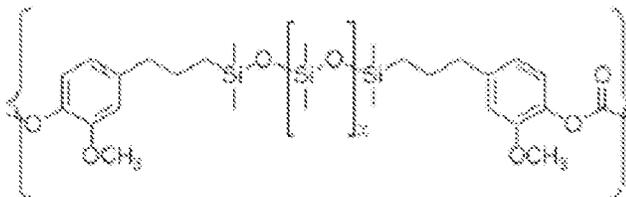
¹ SABIC Global Technologies B.V. is identified as the real party in interest. App. Br. 1.

We AFFIRM.

Appellants claim a polycarbonate composition comprising various amounts of a polycarbonate component, a polysiloxane-polycarbonate block copolymer, an impact modifier, an anti-dripping agent, a flame retardant, and one or more additional additives wherein the composition exhibits a certain notched Izod impact strength and a certain UL-94 flammability rating (i.e., a rating of V0 as measured on a flame bar having a thickness of about 0.60 mm) (independent claims 1 and 9). Appellants also claim a method for the manufacture of such a polycarbonate composition (independent claims 15 and 23).

A copy of representative claim 1, taken from the Claims Appendix of the Appeal Brief, appears below.

1. A polycarbonate composition comprising:
 - (a) from 20 to 80 weight percent of a first polycarbonate component;
 - (b) from greater than 0 to 25 weight percent of a polysiloxane-polycarbonate block copolymer comprising a polycarbonate block derived from bisphenol A and a diorganopolysiloxane block of the general formula (I):



wherein “x” is an integer from 40 to 60 and wherein the organopolysiloxane block is randomly distributed in a Bisphenol-A polycarbonate block copolymer such that the siloxane content within the polysiloxane-polycarbonate block copolymer is about 20% and the weight average molecular weight of the polysiloxane-polycarbonate block copolymer is from 29,000 to 31,000 daltons using Bisphenol-A polycarbonate absolute molecular weight standards;

- (c) from greater than 0 to 5 weight percent of an impact modifier;

(d) from greater than 0 to 5 weight percent of an anti-dripping agent;
(e) from greater than 0 to 25 weight percent of a flame retardant; and
(f) balance of one or more additional polymer composition additives;
wherein the polycarbonate composition exhibits a notched Izod impact strength greater than 400 J/m as measured according to American Society for Testing and Materials (ASTM) D256 as measured on a bar having a thickness of about 3.2 mm and wherein the composition exhibits a UL-94 flammability rating of V0 as measured on a flame bar having a thickness of about 0.60 mm.

Appellants do not present separate arguments specifically directed to the dependent claims under rejection (App. Br. 7–13). Therefore, the dependent claims will stand or fall with their parent independent claims of which claim 1 is representative.

We will sustain the § 103 rejection for the reasons given in the prior Office Actions and particularly in the Answer. The following comments are added for emphasis and completeness.

Concerning the prior Final Office Actions of July 23, 2014 and of June 25, 2014, Appellants argue “[t]here is no specific citation to the cited art or any articulation of how specific aspects of the cited art would teach or suggest *all* the limitations of Appellants’ claims” (App. Br. 8). In response to the Answer which provides the aforementioned specificity, Appellants argue that the Answer includes new rationales which should be disregarded by the Board in resolving this appeal (Reply Br. 2).

Appellants’ arguments lack persuasive merit. The fundamental rationale of the rejections presented in the prior Office Actions is that Sabic would have suggested a polycarbonate composition falling within the scope of claim 1 and that such composition, being identical to the claim 1 composition, inherently would possess the claim 1 properties including the recited flammability rating of V0 (*see, e.g.*, the first Office Action (dated

July 12, 2013), 2–3 and the Final Office Action (dated June 25, 2014), 2). We emphasize that Appellants do not expressly contend that these rejections lack sufficient information to enable them to judge the propriety of continuing with prosecution.² In any event, if upon their receipt these rejections were considered inadequately specific, Appellants should have filed at that time a petition requesting that the rejections be withdrawn and reinstated with the necessary specificity.

Appellants further argue that “the Examiner has not begun to explain how the functional properties recited in the pending claims are *necessarily* present in the cited art compositions, or the natural result of the combination of elements explicitly disclosed by the cited art” (App. Br. 10 (citing *Par Pharm., Inc. v. TWi Pharms., Inc.*, 773 F.3d 1186, 1195–96 (Fed. Cir. 2014))).

The record reveals that the compositions of Sabic are disclosed as having the notched Izod impact strength recited in claim 1 and a flammability rating of V0 albeit as measured on a sample thickness of 1.5 mm rather than 0.60 mm as claimed (Ans. 7–8 (citing Sabic ¶¶ 80–81)). We agree with the Examiner that the composition suggested by Sabic inherently would possess a rating of V0 for the claimed 0.60 mm thickness as well as Sabic’s 1.5 mm thickness because this composition is otherwise identical to the claim 1 composition (*see, e.g., id.* at 8). As correctly explained by the Examiner, where the claimed and prior art products are identical or substantially identical, the PTO can require an applicant to prove that the

² We also emphasize that such a contention would be undermined by the fact that the current application and Sabic list a common inventor thereby evincing Appellants’ familiarity with this reference.

prior art products do not necessarily or inherently possess the characteristics of the claimed product (*id.* at 12 (quoting *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977))).

In an attempt to satisfy their burden of proof, Appellants point out that Sabic's compositions require a polyester content greater than 12 wt% (App. Br. 11)³ and argue that Sabic's "reference examples" . . . indicate[] that such a V0 rating is not achieved, even at 1.5 mm, when the polyester content is higher, *e.g.*, at 15 wt% and 20 wt%" (*id.* at 12 (citing Sabic ¶¶ 95–96 and Table 4)).

The Examiner considers Appellants' argument to be unpersuasive because the "reference examples" referred to by Appellants do not include all the components required by Sabic such that these "reference examples" are not a comparison to Sabic's compositions (Ans. 16–17). Appellants agree that the "reference examples" in Table 4 of Sabic do not include all the required components of Sabic's compositions (Reply Br. 3) but contend Table 4 "nonetheless is evidence that the addition of flammable components, such as polyester, would typically negatively affect flame performance" (*id.*).

The deficiency of Appellants' contention is that it is not embellished by any explanation why the evidence of Table 4 should be considered applicable to the compositions of Sabic. On the other hand, the record before us reflects that the results shown in Table 4 are not applicable to

³ Appellants also correctly point out that a prior Office Action contained an erroneous finding that Sabic requires only 5% polyester (*id.* at 12). However, this error is harmless because it does not alter the fundamental issue of whether the composition suggested by Sabic inherently would possess the claimed V0 rating for a 0.60 mm sample thickness.

Sabic's compositions. As Appellants themselves correctly state, Table 4 shows "a V0 rating is not achieved, even at 1.5 mm, when the polyester content is higher" (App. Br. 12 (emphasis added)). In contrast, the compositions of Sabic, which have this higher polyester content, are expressly disclosed as achieving such a V0 rating for a 1.5 mm sample thickness (Sabic ¶¶ 80–81). Under these circumstances, the proof offered by Appellants fails to show harmful error in the Examiner's determination that the composition suggested by Sabic not only would possess the expressly disclosed V0 rating for a 1.5 mm thickness but also would possess inherently the claimed V0 rating for a 0.60 mm thickness.

For the reasons stated above and given by the Examiner, particularly in the Answer, we sustain the § 103 rejection of the appealed claims as unpatentable over Sabic.

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 C.F.R. § 1.136(a).

AFFIRMED