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THE GOODYEAR TIRE & RUBBER COMPANY 200 Innovation Way AKRON, OH 44316-0001			LEE, DORIS L	
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pair_goodyear@firsttofile.com
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte NIHAT ALI ISITMAN, MANUELA POMPEI, and
GEORGES MARCEL VICTOR THIELEN

Appeal 2019-005210
Application 14/818,774
Technology Center 2800

BEFORE KAREN M. HASTINGS, JAMES C. HOUSEL, and
BRIAN D. RANGE, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ requests our review under 35 U.S.C. § 134(a) of the Examiner's decision rejecting claims 1, 3–9, 13–17, and 19 under 35 U.S.C. § 103 as unpatentable over the combined prior art of Sandstrom 084 (US 7,019,084 B2, issued March 28, 2006), Houjo (US 2010/0113703 A1, published May 6, 2010), and Sandstrom 869 (US 2010/0186869 A1,

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). “The Goodyear Tire & Rubber Company” is identified as the real party in interest (Appeal Br. 3).

published July 29, 2010), with evidence provided by Blok (US 2004/0069388 A1, published April 15, 2004).

We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

CLAIMED SUBJECT MATTER

Claim 1 is illustrative of the subject matter on appeal (emphasis added to highlight key disputed limitations):

1. A pneumatic tire having a tread comprising a vulcanizable rubber composition comprising, based on 100 parts by weight of elastomer (phr),

(A) from about 50 to about 90 phr of a solution polymerized styrene-butadiene rubber having a glass transition temperature (T_g) ranging from -65 °C to -55 °C, wherein the solution polymerized styrene-butadiene rubber is functionalized with an alkoxy silane group and at least one functional group selected from the group consisting of primary amines and thiols;

(B) from about 50 to about 10 phr of polybutadiene having a cis 1,4 content greater than 95 percent and a T_g ranging from -80 to -110 °C;

(C) from 30 to 80 phr of a combination of an oil and a terpene phenol resin having a T_g greater than 100 °C, *wherein the amount of the oil ranges from 5 to 30 phr and the amount of the terpene phenol ranges from 15 to 45 phr*; and

(D) from 50 to 160 phr of silica

(Appeal Br. 8 (Claims Appendix)).

Appellant relies upon the same arguments for all of the claims (Appeal Br. 4–6).

OPINION

Upon consideration of the evidence of record and each of Appellant's contentions as set forth in the Appeal Brief, we determine that Appellant has not identified reversible error in the Examiner's rejection (*See generally* Ans.). *In re Jung*, 637 F.3d 1356, 1365–66 (Fed. Cir. 2011) (explaining the Board's long-held practice of requiring Appellant(s) to identify the alleged error in the Examiner's rejection). We sustain the rejection for the reasons expressed by the Examiner in the Final Office Action and the Answer.

We add the following primarily for emphasis.

It has been established that “the [obviousness] analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007); *see also In re Fritch*, 972 F.2d 1260, 1264–65 (Fed. Cir. 1992) (a reference stands for all of the specific teachings thereof as well as the inferences one of ordinary skill in the art would have reasonably been expected to draw therefrom).

Appellant does not dispute the Examiner's findings based on the applied prior art. Appellant's arguments are focused on their belief that there is no reason to use the terpene phenol resin of Houjo's rubber tire composition in the rubber tire composition of Sandstrom 084 because the amount of oil used in Houjo is outside the claimed range of 5 to 50 phr (*See* Appeal Br. 5, 6). Appellant also argues that Houjo teaches away from the claimed invention (Appeal Br. 6).

Appellant's arguments are not persuasive of reversible error as they fail to consider the applied prior art as a whole and the inferences that one of

ordinary skill would have made. Here, as the Examiner aptly points out, Sandstrom 084 is relied upon to teach an amount of oil that overlaps the claimed amount (Ans. 4, relying on Sandstrom 084 col. 8, ll. 20–30).

The Examiner merely relied upon Houjo to exemplify that one could use a terpene to enhance the gripping performance and workability of a styrene-butadiene rubber tire composition (Ans. 4, relying on Houjo ¶¶ 31, 32).

Under the flexible inquiry set forth by the Supreme Court, the PTO must take account of the “inferences and creative steps,” or even routine steps, that an ordinary artisan would employ. *Ball Aerosol & Specialty Container, Inc. v. Ltd. Brands, Inc.*, 555 F.3d 984, 993 (Fed. Cir. 2009). One of ordinary skill would have readily inferred and appreciated from the applied prior art as a whole that a terpene phenol resin may be useful in any styrene-butadiene rubber tire composition. The use of such a component in the tire composition of Sandstrom 084, e.g., to improve gripping performance and workability of its rubber tire composition, would have been within the skill and creativity of one of ordinary skill in the art.

Likewise, Appellant’s argument that Houjo teaches away from use of its terpene phenol resin because it also teaches that the amount of oil used therein should preferably be at least 35 parts per mass (Appeal Br. 6) is not persuasive. Whether the prior art teaches away from the claimed invention is a question of fact. *In re Harris*, 409 F.3d 1339, 1341 (Fed. Cir. 2005). It is well established that a prior art reference must be considered in its entirety, i.e., as a whole, when determining if it would lead one of ordinary skill in the art away from the claimed invention. *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550 (Fed. Cir. 1983). One of ordinary skill

in the art would have readily appreciated that the terpene phenol resin of Houjo has advantages for its use in a rubber tire composition irrespective of the amount of oil used in the rubber tire composition. *Cf. In re Susi*, 440 F.2d 442, 446 n.3 (CCPA 1971) (Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments.); *Syntex (U.S.A.) LLC v. Apotex, Inc.*, 407 F.3d 1371, 1379–80 (Fed. Cir. 2005) (Even a “statement that a particular combination is not a preferred embodiment does not teach away absent clear discouragement of that combination.”). One of ordinary skill would have expected the known rubber tire component of a terpene phenol resin exemplified in Houjo to be a useful component in the known rubber tire composition of Sandstrom 084 which has an oil component amount within the claimed range.

On this record, Appellant has not sufficiently explained why the claimed subject matter is “more than the predictable use of prior art elements according to their established functions.” *KSR*, 550 U.S. at 417.

Accordingly, we sustain the Examiner’s rejection of independent claim 1, as well as all claims dependent thereon, noting that Appellant relies upon the arguments made for claim 1 for all the other claims (*See generally* Appeal Br.).

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed
1, 3-9, 13-17, 19	103	Sandstrom 084, Houjo, Sandstrom 869, Blok	1, 3-9, 13-17, 19	

TIME PERIOD FOR RESPONSE

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)(iv).

AFFIRMED