

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte HEINZ-GERD SMOLKA,  
KLAUS LEHMANN, HANS HAWEL,  
DIETER SCHRAML AND KLAUS HORNFECK

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Appeal No. 96-3172  
Application 08/328,335<sup>1</sup>

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ON BRIEF

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Before SOFOCLEOUS, CAROFF and DOWNEY, Administrative Patent Judges.  
SOFOCLEOUS, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims  
9 to 12 and 14, all the claims remaining in the application.

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<sup>1</sup> Application for patent filed October 24, 1994.  
According to applicants, this application is a continuation of  
Application 08/142,646, filed October 25, 1993, now abandoned;  
which is a continuation of Application 07/848,993, filed April  
20, 1992, now abandoned.

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The subject matter on appeal is directed to a process of regenerating wastepaper containing printing ink.

Appellants acknowledge that claims 9 to 12 and 14 stand or fall together. Independent claim 9 reads as follows:

9. The process of regenerating wastepaper containing printing ink comprising the steps of;

(1) fiberizing said wastepaper in an aqueous alkaline deinking [sic, de-inking] solution containing no foam inhibitors and a deinking [sic] effective quantity of a deinking [sic] agent consisting of (a) a C<sub>6</sub>-C<sub>22</sub> carboxylic acid or resinic acid and (b) a C<sub>6</sub>-C<sub>22</sub> oxoalcohol alkoxyated with from about 2 to less than 6 moles of a C<sub>2</sub>-C<sub>4</sub> alkylene oxide to detach ink particles from said wastepaper, and (2) removing the detached ink particles from the deinking [sic] solution.

The references relied upon by the Examiner are:

Wood et al. (Wood 0933)	4,561,933	Dec. 31, 1985
Poppel et al. (Poppel)	4,586,982	May 6, 1986
Wood et al. (Wood 0558)	4,666,558	May 19, 1987
Togashi et al. (Togashi) (Japan Application) (Japan 30978)	59-30978	Feb. 18, 1984

Claims 9 to 12 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Japan 30978 or Poppel in view of Wood '933, further if necessary with Wood '558.

We cannot sustain this rejection.

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Both Japan 30978 and Poppel teach de-inking compositions comprising a fatty acid and an ethoxylated alcohol surfactant, but fail in anticipation of the claimed invention in that they do not use a C<sub>6</sub>-C<sub>22</sub> highly branched oxoalcohol alkoxyated with from about 2 to less than 6 moles of a C<sub>2</sub>-C<sub>4</sub> alkylene oxide. Wood '933 teaches a de-inking composition comprising an alkanol and an alkoxyated alcohol. The examiner urges that it would have been obvious for one of ordinary skill in this art to substitute the alkoxyated alcohols of Wood '933 for the ethoxylated alcohols of the primary references to arrive at appellants' claimed invention.

We agree with appellants that there is no objective teaching that would lead one skilled in the art to combine the relevant teachings of Wood '933 with those of the primary references. The de-inking compositions of the references are entirely different-- Japan 30978 and Poppel use a fatty acid in combination with an ethoxylated alcohol surfactant, whereas Wood '933 uses an alkanol in combination with an alkoxyated alcohol. There is no suggestion to substitute the particular alkoxyated alcohol of Wood '933 for the ethoxylated alcohols of the primary references. Even if the references were combined as suggested by the examiner, appellants' claimed process would not be obtained. Missing therefrom would be

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a highly branched oxoalcohol. Wood '933, column 3, lines 6 to 13, expresses a preference for linear (straight chain) C<sub>8</sub>-C<sub>16</sub> alcohols and further notes that his invention may be practiced with a secondary or tertiary alkanol. Such a secondary or tertiary C<sub>8</sub>-C<sub>16</sub> alcohol as taught by Wood '933 would not be highly branched. As noted by appellants on page 7 of their brief, oxoalcohols are made from petroleum feedstocks and consequently are branched alcohols which produced by conventional means result in the alcohol being 40% to 50% branched, as is evidenced by Exhibit B earlier submitted herein. As a result, oxoalcohols are substantially more branched than fatty alcohols and are different.

The decision of the examiner is reversed.

REVERSED

Michael Sofocleous	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
Marc L. Caroff	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES

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Mary F. Downey )  
Administrative Patent Judge )

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