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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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PAT.&T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PATRICK T. Mc GRAIL
and JEFFREY T. CARTER

Appeal No. 93-3982
Application 07/585,940[1]

ON BRIEF

Before GOLDSTEIN, JOHN SMITH and WEIFFENBACH, *Administrative Patent Judges*.

WEIFFENBACH, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from the examiner's final rejection of claims 1-5 and 10-18. The remaining claims in the case, claims 6-9,

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[1] Application 07/585,940, filed September 21, 1990.

have been withdrawn from consideration pursuant to a restriction requirement.

The claimed invention is a curable polymer composition. Claims 1 and 14 are illustrative of the invention:

1. A curable polymer composition comprising a phenol/formaldehyde thermosetting system and a polyarylsulphone comprising reactive epoxy groups.

14. A curable polymer composition comprising a phenol/formaldehyde thermosetting system, a polyarylsulphone comprising reactive epoxy groups and reinforcing fibres.

The reference of record relied upon by the examiner is:

McGrail et al. (European patent) EP 0 311 349 Apr. 12, 1989

Claims 1-5 and 10-18 stand rejected under 35 U.S.C. § 102(a) as being anticipated by the European patent.[2]

Appellants state in their appeal brief that all of the claims stand or fall together.

After careful consideration of the complete record, we agree with appellants that the prior art reference relied upon by the

[2]The examiner's final rejection of claims 1-5 and 10-18 was based on 35 U.S.C. § 102 (e). In their brief, appellants argued that the published European patent did not meet the requirements of 35 U.S.C. § 102(e). The examiner in his answer restated the rejection stating that the "rejection should in fact be a rejection ... under 35 U.S.C. 102(a)" (paragraph bridging pages 1 and 2 of the answer) and stated in paragraph 11 of his answer that "the original 102(e) rejection was incorrect." Appellants filed a reply brief and argued that the restatement of the rejection amounted to a new ground of rejection and that they should be permitted to reopen prosecution or in the alternative be granted a two month period of time within which to respond to the "new ground of rejection." In view of our reversal of the rejection under 35 U.S.C. § 102(a) and in view of appellants' arguments in their brief distinguishing European patent over the claimed invention, we find no need to remand this case to the examiner.

examiner does not anticipate the subject matter defined by the claims. Accordingly, we shall not sustain the examiner's rejection for essentially those reasons set forth on pages 3 and 4 of the appellants' brief. We add the following primarily for emphasis.

Anticipation is established when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984).

The European patent discloses a curable polymer composition comprising a mixture of a polyarylsulphone and a phenol/formaldehyde or epoxy thermosetting resin to which reinforcing fibers can be added. However, we do not see that the reference discloses that the polyarylsulphone has epoxy end groups. The reference discloses that the polyarylsulphone component contains end groups of formula -A-Y where A is a divalent hydrocarbon groups and Y is a group *reactive with epoxide groups*, such as OH, NH_2, NHR or SH where R is a hydrocarbon group containing up to 8 carbon atoms or Y is a group providing "other cross-linking reactivity especially epoxy, ... as in vinyl, allyl or maleimide."[3] The reference does not disclose or teach that Y

[3]Page 4, lines 5-10 of the European Patent.

could be an epoxy group as required in appellants' claims. While the patent provides examples of reacting the polyarylsulphone with an epoxy resin to form a new polymer composition, whether or not the reaction of the polyarylsulphone with an epoxy resin forms a polyarylsulphone with epoxy end groups is unclear. Even assuming that the new polymer is inherently a polyarylsulphone with epoxy end groups as argued by the examiner, there is no teaching in the patent of combining this new polymer with a phenol/formaldehyde thermosetting resin to form a curable polymer composition as required by appellants' claims.

For the foregoing reasons, we find that claims 1-5 and 10-18 are not anticipated by the European patent under 35 U.S.C. § 102(a). Accordingly, the decision of the examiner is reversed.

REVERSED

MELVIN GOLDSTEIN)
Administrative Patent Judge)
)
JOHN SMITH)
Administrative Patent Judge) BOARD OF PATENT APPEALS AND INTERFERENCES
)
CAMERON WEIFFENBACH)
Administrative Patent Judge)

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Cushman, Darby & Cushman
Eleventh Floor
1615 L Street, N.W.
Washington, DC 20036-5601