

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW T. GRAHAM
and DON L. STEVENS

Appeal No. 94-3846
Application 07/891,376¹

ON BRIEF

Before GARRIS, PAK, and OWENS, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed May 29, 1992.

This is a decision on an appeal from the final rejection of claims 1 through 11 which are all of the claims in the application.

The subject matter on appeal relates to a process for preparing a fluid absorbent polymer which comprises isolating polymer particles having hydrophobic surfaces from the organic phase in which they were formed and coating the polymer particles with a hydrophilic material in the absence of an organic solvent so as to render the polymer surface hydrophilic. Further details of this appealed subject matter are set forth in illustrative claim 1 which reads as follows:

1. In a process for preparing a fluid absorbent polymer wherein an ethylenically unsaturated monomer mixture is dispersed as droplets in an inert organic phase containing a hydrophobic suspending agent, such droplets being polymerized to form polymer particles whereupon a portion of the hydrophobic suspending agent remains on the surface of the polymer rendering the polymer surface hydrophobic, the improvement comprising isolating the polymer particles from the organic phase and coating the polymer particles with a hydrophilic material in the absence of an organic solvent, such as to render the polymer surface hydrophilic.

The references relied upon by the examiner's evidence of obviousness are:

Yamasaki et al. (Yamasaki)	4,459,396	Jul. 10, 1984
Yasui et al. (Yasui)	4,799,911	Mar. 5, 1991

Claims 1 through 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Yasui alone or further in view of Yamasaki.

Having carefully studied the record before us, it is our determination that neither of the above noted rejections can be sustained. Our reasons are set forth below.

The examiner points out that “[t]he polymer [of Yasui] is the product of emulsion or suspension or polymerization methods” and that “[e]mulsion polymerization includes oil-in-water and water-in-oil arrangements, [wherein] the later [sic, latter] constitutes [the] claimed ‘dispersed [as] droplets in an inert organic phase’” (Answer, page 3). It is the examiner’s implicit position that the emulsion polymerization generally referred to by Yasui would include “water-in-oil arrangements” that would necessarily produce polymer particles having a hydrophobic surface as required by the appealed claims. However, the Yasui patent contains utterly no disclosure of a hydrophobic surface or of a hydrophobic suspending agent which results in the aforementioned hydrophobic surface as recited in the appellants’ claims. It is, therefore, clear that the examiner’s above noted position is improperly based upon conjecture, speculation, or assumptions rather than a factual basis as required by § 103. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

The examiner’s rejection is further deficient with respect to his position concerning the claim 1 step of “coating the polymer particles with a hydrophilic material in the absence of an organic solvent, such as to render the polymer surface hydrophilic.” Specifically, the examiner seems to equate this claimed step with Yasui’s

step of treating his polymer agglomerates with an organic liquid. While the examiner acknowledges that “[t]he reference is silent regarding the resultant rendering of the polymer surface hydrophilic, . . . [he contends that Yasui’s treatment] would be presumed to yield the same results [as appellants’ claimed step]” (Answer, page 4). According to the examiner, this is because “[a]mong the list of treatment liquids [disclosed by Yasui] are alcohols and polyhydric alcohols (polyols), . . . [and such] alcohols constitute a preferred embodiment of the claimed hydrophilic material” (Answer, page 4).

In essence, it is the examiner’s position that the here claimed step of coating with a hydrophilic material would be inherently practiced by patentee’s step of treating his agglomerates with organic liquids if alcohols and polyhydric alcohols are selected for use as such liquids. Particularly since Yasui contains no disclosure of the hydrophilic feature of the appealed claims, it is apparent to us that the examiner has formulated this aspect of his rejection using the appellants’ own disclosure as a guide based upon a retrospective view of inherency by urging that at least some of patentee’s organic liquids constitute hydrophilic materials and therefore would inherently render the polymer surface hydrophilic. W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) (impermissible hindsight arises where that which only the inventor has taught is

used against its teacher); In re Newell, 891 F.2d 899, 901, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989)(retrospective view of inherency is no substitute for some teaching or suggestion which supports the selection and use of the various elements in the claimed combination).

For the above stated reasons, it is clear to us that the examiner's § 103 rejection of claims 1 through 11 based on Yasui cannot be sustained. Moreover, since the deficiencies of this reference are not supplied by Yamasaki (and the examiner does not contend otherwise), we also cannot sustain the § 103 rejection of claims 1 through 11 as being unpatentable over Yasui in view of Yamasaki.

The decision of the examiner is reversed.

REVERSED

Bradley R. Garris)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
Chung K. Pak)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
Terry J. Owens)	
Administrative Patent Judge)	

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