

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EUGENE G. SOMMERFELD and FRANK L. SCHADT III

Appeal No. 95-3734
Application No. 08/043,620¹

ON BRIEF

Before WINTERS, OWENS and WEIMAR, Administrative Patent Judges.
WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 1 through 23, 40 through 42 and 99. Claims 24 through 39 and 46 through 98, which are the only other claims remaining in

¹ Application for patent filed April 7, 1993. According to appellants, this application is a continuation of Application No. 07/662,539, filed February 28, 1991, now abandoned; which is a continuation-in-part of Application No. 07/414,417, filed September 29, 1989, now abandoned; which is a continuation-in-part of Application No. 07/162,966, filed March 2, 1988, now abandoned.

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the application, stand withdrawn from further consideration by the examiner as directed to a non-elected invention.

THE INVENTION

The invention relates to a class of interpenetrating polymer networks which are dispersible in conventional coating solvents. According to appellants, such dispersions are useful in preparing protective and/or decorative film coatings and are particularly useful in photosensitive or imaging formulations such as photo resists, sodder masks, and the like.

Claims 1 and 99, which are illustrative of the subject matter on appeal, read as follows:

1. A composition of matter comprising an interpenetrating polymer network containing at least two polymer networks which
 - (a) are polymerized and/or crosslinked in the immediate presence of one another, and
 - (b) are dispersible in a solvent with the proviso that at least one of the polymer networks is formed by polymerization in a solvent and that one of the following takes place in formation of two polymer networks:
 - (i) the two polymer networks are formed sequentially wherein the second polymer network is formed in a solvent dispersion of the first formed polymer network, or
 - (ii) the two polymer networks are formed simultaneously or substantially simultaneously by independent and non-interfering mechanisms of polymerization. [Emphasis added].

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99. A composition of matter comprising an interpenetrating polymer network wherein:

- (a) at least two distinct polymer networks from [sic] the interpenetrating polymer network and
- (b) the interpenetrating polymer network is dispersible in a solvent. [Emphasis added].

THE REFERENCES

The prior art references relied on by the examiner are:

Skinner et al. (Skinner)	4,128,600	Dec. 5, 1978
Jones	4,235,972	Nov. 25, 1980
Simpson	4,361,676	Nov. 30, 1982
Wright et al. (Wright)	4,377,661	Mar. 22, 1983
Roemer et al. (Roemer)	4,396,476	Aug. 2, 1983
Arkles et al. (Arkles)	4,970,263	Nov. 13, 1990

THE REJECTIONS

Claims 1 through 23, 40 through 42 and 99 stand rejected under 35 U.S.C. § 102 as anticipated by or, in the alternative, under 35 U.S.C. § 103 as unpatentable over "Skinner, Arkles, applicants' disclosure (SPEC, pages 1, 2 (top)), Jones, Wright, Roemer and/or Simpson" (Examiner's Answer, page 3, second paragraph). Claims 1 through 23, 40 through 42 and 99 also stand rejected under 35 U.S.C. § 112, first and second paragraphs, "as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant

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regards as the invention" (Examiner's Answer, page 5, first paragraph).

DELIBERATIONS

Our deliberations in this matter have included evaluation and review of the following materials: (1) the instant specification, including all of the claims on appeal; (2) the Appeal Brief; (3) the Examiner's Answer; (4) the above-cited references relied on by the examiner; (5) the Sommerfeld Declaration executed November 18, 1992; (6) the Schadt Declaration executed December 2, 1992; (7) the Schadt Supplemental Declaration executed February 4, 1993; and (8) the Sperling Declaration executed December 22, 1993.

On consideration of the record, including the above-listed materials, we reverse the examiner's rejections.

DISCUSSION

In setting forth the prior art rejection of claims 1 through 23, 40 through 42, and 99, the examiner argues that the claimed and prior art products reasonably appear to be identical or substantially identical, or are produced by identical or substantially identical processes. Under these circumstances, the examiner argues, the Patent and Trademark Office (PTO) can require appellants to prove that the prior art products do not necessarily or inherently possess the characteristics of their

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claimed product. Specifically, according to the examiner, the PTO can require appellants to prove that the prior art products do not necessarily or inherently possess the physical property "dispersible in a solvent" recited in the appealed claims. With this line of reasoning, the examiner rejects all of the appealed claims concurrently for anticipation by inherency under 35 U.S.C. § 102 and for obviousness under 35 U.S.C. § 103. See In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977).

On this record, however, the examiner has not established that any of the above-cited prior art references or the publications referenced in the specification, page 1, do, in fact, disclose products which reasonably appear to be identical or substantially identical to the claimed products. On the contrary, it would appear that conventional interpenetrating polymer networks of the prior art cannot be dispersed in solvents because extensive network formation far beyond the gel point leads to an interpenetrating polymer network which has substantially infinite molecular weight and which is considered to extend throughout the volume of the polymerized material (specification, page 7, lines 22 through 28). In contrast, the claimed compositions are dispersible in a solvent. They are prepared, for example, by incorporating just sufficient crosslinking precursor so that polymerization terminates before

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or near, i.e., substantially at, the gel point (specification, page 17, lines 6 through 9).

In short, the examiner has not adduced sufficient evidence to support a conclusion that the claimed and prior art products reasonably appear to be identical or substantially identical. The examiner has not established that the claimed and prior art products are produced by identical or substantially identical processes. Accordingly, the PTO cannot here require appellants "to prove that the prior art products do not necessarily or inherently possess the characteristics of [their] claimed product." In re Best, 562 F.2d at 1255, 195 USPQ at 433. On this record, the examiner has not established a prima facie case of anticipation under 35 U.S.C. § 102 or obviousness under 35 U.S.C. § 103, and the burden of persuasion has not shifted to the appellants to rebut any such prima facie case. We therefore find it unnecessary to discuss the Sommerfeld Declaration executed November 18, 1992; the Schadt Declaration executed December 2, 1992; or the Sperling Declaration executed December 22, 1993; all designed to rebut a prima facie case of unpatentability under 35 U.S.C. § 102 or 35 U.S.C. § 103.

The prior art rejection is reversed.

We next consider the rejection of claims 1 through 23, 40 through 42, and 99 under 35 U.S.C. § 112, first and second

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paragraphs. Having carefully reviewed the examiner's statement of this rejection, we find no argument, evidence, or reasoning which would serve to support a conclusion that the appealed claims do not particularly point out and distinctly claim the subject matter which appellants regard as their invention. Accordingly, we summarily reverse the rejection to the extent that it is predicated on 35 U.S.C. § 112, second paragraph.

Respecting the first paragraph of 35 U.S.C. § 112, the examiner focuses on the issue of enablement and whether the scope of protection sought is supported and justified by the specification disclosure. In this regard, our reviewing court has made it clear that the PTO must substantiate its rejection for lack of enablement with reasons. As stated in In re Armbruster, 512 F.2d 676, 677-78, 185 USPQ 152, 153 (CCPA 1975), quoting from In re Marzocchi, 169 USPQ 367, 369-70 (CCPA 1971):

[I]t is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement.

Here, according to the examiner, the specification lacks adequate guidelines enabling any person skilled in the art to make and use the claimed invention throughout its scope. The examiner does not, however, explain why he doubts the truth or accuracy of any

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statement in the supporting disclosure or back up assertions of his own with acceptable evidence or reasoning inconsistent with the contested statement. In re Armbruster, 512 F.2d at 677-78, 185 USPQ at 153.

We have carefully reviewed the specification, which contains an exhaustive disclosure pertaining to the claimed interpenetrating polymer network. The specification discloses, inter alia, the monomeric precursors, including crosslinking precursors, and the amounts of those precursors required to make the claimed products. The specification further discloses the process and process conditions necessary for preparing the claimed interpenetrating polymer network, the physical properties possessed by the claimed interpenetrating polymer network, and applications of the claimed interpenetrating polymer network, for example, photoresist applications. Finally, the specification includes thirteen working examples. All in all, we have no doubt that the specification imparts sufficient information and guidelines enabling any person skilled in the art to make and use the claimed invention throughout its scope. We therefore reverse the non-prior art rejection, to the extent that it is predicated on 35 U.S.C. § 112, first paragraph.

Where, as here, the examiner has not established a prima facie case of lack of enablement under 35 U.S.C. § 112, first

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paragraph, or of indefiniteness under 35 U.S.C. § 112, second paragraph, we find it unnecessary to discuss the Supplemental Schadt Declaration executed February 4, 1993. That declaration was offered to rebut any such prima facie case.

The examiner's decision rejecting claims 1 through 23, 40 through 42, and 99 on prior art and non-prior art grounds is reversed.

REVERSED

SHERMAN D. WINTERS)	
Administrative Patent Judge)	
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TERRY J. OWENS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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ELIZABETH C. WEIMAR)	
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