

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte VALERIE J. BUJANOWSKI, SHEDRIC O. GLOVER,  
SUSAN V. PERZ, MARIS J. ZIEMELIS, GARY R. HOMAN  
and MICHAEL W. SKINNER

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Appeal No. 95-3933  
Application No. 08/063,206<sup>1</sup>

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ON BRIEF

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Before KIMLIN, JOHN D. SMITH and WALTZ, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-3, 23 and 26-29. Claims 5-13, 24 and 30-36 stand withdrawn from consideration. Claim 4, the only other claim remaining in the

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<sup>1</sup> Application for patent filed May 18, 1993.

Appeal No. 95-3933  
Application No. 08/063,206

present application, has been allowed by the examiner. Claim 1 is illustrative:

1. A method of making a vinylether functional siloxane, the method comprising the steps of:

(I) reacting:

(a) a silane having the formula  $R_xSi(OR^1)_{4-x}$ ;

(b) water; and

(c) an acidic condensation catalyst, wherein R is a monovalent hydrocarbon or halohydrocarbon radical having from 1 to 20 carbon atoms,  $R^1$  is a monovalent alkyl radical having from 1 to 8 carbon atoms, x has a value of from 0 to 3, with the proviso that the molar ratio of water to alkoxy radicals is less than 0.5;

(II) removing alcohol from the reaction mixture of (I);

(III) neutralizing the mixture of (II);

(IV) adding a vinyl ether compound having the formula  $HOR^2OCH=CH_2$  wherein  $R^2$  is a divalent hydrocarbon or halohydrocarbon radical having from 1 to 20 carbon atoms to the mixture of (III);

(V) adding a transesterification catalyst to the mixture of (IV);

(VI) removing volatiles from the mixture of (V).

The examiner relies upon the following references as evidence of obviousness:

Burzynski et al. (Burzynski)	4,539,232	Sep. 3, 1985
Brown et al. (Brown)	5,270,423	Dec. 14, 1993
		(filed Nov. 13, 1992)

Appeal No. 95-3933  
Application No. 08/063,206

Appellants' claimed invention is directed to a method of making a vinylether functional siloxane comprising the recited steps.

Appealed claims 1-3, 23 and 26-29 stand rejected under 35 U.S.C. § 103 as being unpatentable over Brown in view of Burzynski.

Upon careful review of the opposing arguments presented on appeal, we will not sustain the examiner's rejection.

The threshold issue on appeal is the effectiveness of appellants' affidavit under 37 CFR § 1.131, dated November 21, 1994, in removing Brown as a prior art reference. It is the examiner's position that the affidavit does not effectively remove Brown as a prior art reference because the affidavit shows a reduction to practice of claimed step (I) with alcohol as an additional reactant. According to the examiner, "[t]here is no evidence in the Affidavit that a method comprising a reaction of components a, b and c recited in step (I) of claim 1 without the addition of an alcohol was reduced to practice before the Brown et al[.] effective date" (page 7 of Answer).

The examiner's reasoning is not on sound legal footing because it is well settled that an applicant need prove priority of invention of only that portion of his claimed invention that

Appeal No. 95-3933  
Application No. 08/063,206

is disclosed, or rendered obvious, by the applied reference. In re Stempel, 241 F.2d 755, 759, 113 USPQ 77, 81 (CCPA 1957). In the present case, the examiner expressly acknowledges that "Brown et al[.] do not teach reacting an alkoxy silane with water in the presence of an acidic condensation catalayst [sic], as recited in step (I) of instant claim 1" (page 3 of Answer). Since the examiner relies on Brown for claimed steps (IV)-(VI), and makes no argument that the Rule 131 Affidavit does not show reduction to practice of claimed steps (IV)-(VI) prior to the effective date of Brown, it can be seen that the Affidavit establishes priority of invention for that portion of the presently claimed invention that is disclosed by Brown.

Also, based on the Burzynski disclosure, we find that claimed steps (I)-(III), not requiring alcohol as a reactant, would have been an obvious modification of the reaction shown in the Affidavit to one of ordinary skill in the art. In re Stempel, 241 F.2d at 759, 113 USPQ at 81; In re Clarke, 356 F.2d 987, 992, 148 USPQ 665, 670 (CCPA 1966).

Since we agree with appellants that the Rule 131 Affidavit of November 21, 1994, effectively removes the reference to Brown as prior art, it logically follows that we must reverse the examiner's rejection under 35 U.S.C. § 103 over Brown in view of Burzynski.

Appeal No. 95-3933  
Application No. 08/063,206

In conclusion, based on the foregoing, the examiner's  
decision rejecting the appealed claims is reversed.

REVERSED

EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
JOHN D. SMITH	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
THOMAS A. WALTZ	)	
Administrative Patent Judge	)	

Appeal No. 95-3933  
Application No. 08/063,206

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