

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD J. WOO

Appeal No. 95-3989
Application No. 07/956,107¹

ON BRIEF

Before KIMLIN, PAK and OWENS, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed October 2, 1992. According to appellant, this application is a division of Application No. 07/727,472, filed July 9, 1991, now U.S. Patent No. 5,176,943, issued January 5, 1993.

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This is an appeal from the final rejection of claims 1-12, all the claims remaining in the present application.

Claim 1 is illustrative:

1. An antistatic composition, comprising:

(a) 100 parts by weight of, ethylenically unsaturated, nonfluorinated copolymerizable, radiation curable monomers;

(b) from 0.5 to 5.0 parts by weight of a nonionic perfluoro surfactant; and

(c) from 0.5 to 5.0 parts by weight of an ionic perfluoro surfactant.

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

Keough	4,623,594	Nov. 18, 1986
Sato et al. (Sato) (Japanese Kokai publication)	57-42741	Mar. 10, 1982
Yamamoto et al. (Yamamoto) (Japanese Kokai publication)	64-46739	Feb. 21, 1989

It is evident from illustrative claim 1 that appellant's claimed invention is directed to an antistatic composition comprising an ethylenically unsaturated, nonfluorinated, copolymerizable, radiation curable monomer, a nonionic perfluoro surfactant and an ionic perfluoro surfactant. According to appellant, the claimed composition can be cured

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with radiation to form an abrasion-resistant, transparent, stable antistatic coating for optical recording media.

Appealed claims 1-12 stand rejected under 35 U.S.C. § 112, second paragraph. The appealed claims also stand rejected under 35 U.S.C. § 112, first paragraph. In addition, appealed claims 1-12 stand rejected under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 35 U.S.C. § 103 as being unpatentable over either Sato or Yamamoto. Finally, claims 1-12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sato, Yamamoto and Keough.

Upon careful consideration of the opposing arguments presented on appeal, we find that none of the examiner's rejections are sustainable.

We consider first the rejection of the appealed claims under 35 U.S.C. § 112, second paragraph. According to the examiner, the claims are indefinite because "[t]he term 'monomer' is not clearly distinctive of the term 'prepolymer' as used and disclosed by applicant (specification, page 9)" (page 5 of Answer).

In making a rejection under 35 U.S.C. § 112, second paragraph, it is incumbent upon the examiner in the first

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instance to establish with objective evidence or compelling scientific reasoning that one of ordinary skill in the art would not understand the meaning and scope of the criticized language when such language is read in light of the specification and state of the prior art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). Appellant's specification, at page 9, line 1, expressly teaches that it is preferable that substantially all of the prepolymers are monomeric in form, and, at page 8, lines 24-27, the specification teaches that ethylenically unsaturated compounds having acrylic, methacrylic, vinyl and allyl functional groups are exemplary of such prepolymers. In light of this disclosure the examiner has not established on this record that one of ordinary skill in the art would have difficulty in understanding which monomers having acrylic, methacrylic, vinyl and allyl groups would be suitable as copolymerizable, radiation curable monomers. Also, the examiner has not explained why one of ordinary skill in the art would not be guided in this determination by the materials identified by trade name in the specification examples. The fact that the

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examiner considers the materials of the applied references to be within the scope of the claims is irrelevant to the definiteness of the claim term "monomer." (See page 5 of Answer.)

The examiner's rejection of the appealed claims under 35 U.S.C. § 112, first paragraph, is similarly flawed. The examiner states "[t]here is no disclosure of material under the designation 'monomer' or 'prepolymer' sufficient to give the specific guidance necessary to make and use the composition invention of this application" (page 5 of Answer). Again, the examiner has the initial burden of establishing departures from requirements of § 112, first paragraph, such as lack of enablement, by compelling reasoning or objective evidence. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982); In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). In the present case, the examiner has not satisfied his burden of demonstrating that the aforementioned descriptions at pages 8 and 9 of the present specification, as well as in the examples, would not describe the claimed monomers to one of ordinary skill in the art or enable such an artisan to practice the claimed invention

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without undue experimentation. In particular, we are in substantial agreement with the position advanced by appellant at page 15 of the Brief.

We now turn to the rejection of the appealed claims under 35 U.S.C. § 102/§ 103 over Sato. Although there is no dispute that Sato discloses the claimed nonionic perfluoro surfactant and ionic perfluoro surfactant in a polymeric composition, we agree with appellant that Sato does not describe, within the meaning of § 102, or render obvious under § 103, the presently claimed radiation curable monomer. Sato expressly discloses at page 2 of the translation that the invention relates to plastic compositions wherein "plastics" is defined as "natural and synthetic elastomers, plastomers, and heat-curing resins." At page 6 of the translation, second paragraph, the reference lists specific plastics. We find no factual basis for the examiner's position that the generic term "plastics" includes materials which are known as monomers. Compositions that are molded by heat-curing are normally thermosetting polymers. Also, all the working examples of Sato treat a polymerized, cured sample with the surfactants. The examiner has not explained why it would have been obvious for one of ordinary

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skill in the art to depart from the teachings of Sato and add the surfactants to an uncured monomer composition, as required by the appealed claims.

We will also not sustain the examiner's § 102/§ 103 rejection of the appealed claims over Yamamoto. Yamamoto discloses a radiation curable composition that may contain a wide variety of curable components, including monomers. The composition of Yamamoto also includes a fluoric surfactant that can be ionic, nonionic and amphoteric. The referenced composition also includes a defoaming agent that can be selected from alcohols, fatty acids, fatty acid esters, polypropylene or polyethylene glycols, amines, amides, ethers, phosphoric acid esters, metal soaps, silicone oils and surfactants which contain perfluoroalkyl groups and phosphorus atoms. According to appellant, the surfactant which serves as the defoaming agent can be either ionic or nonionic. Consequently, although it is possible to select from the Yamamoto disclosure a radiation curable component, a fluoric surfactant and a defoaming agent that meets the requirements of the appealed claims, we agree with appellant that Yamamoto would have provided no guidance to one of ordinary skill in

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the art to formulate the claimed composition. In our view, one of ordinary skill in the art would have arrived at the claimed composition only by serendipity, rather than from the requisite suggestion by the prior art. Accordingly, we find no description of the claimed invention in support of the examiner's rejection under § 102, and we further find that the claimed invention would not have been obvious to one of ordinary skill in the art within the meaning of § 103.

Finally, we concur with appellant that the appealed claims would not have been obvious over the combined teachings of Sato, Yamamoto and Keough. The examiner states at page 4 of the Answer that Keough discloses formulations employing a mixture of ionic and nonionic surfactants. However, like appellant, we find no such disclosure in the reference. Furthermore, Keough does not disclose or suggest perfluoro antistatic agents and, therefore, Keough would have provided no teaching or suggestion of substituting a monomer in the polymeric formulation of Sato which comprises a mixture of ionic and nonionic perfluoro antistatic agents. In addition, the antistatic agents of Keough are reactive with the electron radiation curable prepolymer, whereas appellant submits that

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the perfluoro surfactants of Sato and Yamamoto are not electron beam reactive. We note that the examiner has not rebutted this argument of appellant.

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

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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CHUNG K. PAK)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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TERRY J. OWENS)	
Administrative Patent Judge)	

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3M Office of Intellectual Property
Counsel
P.O. Box 33427
St. Paul, MN 55133-3427