

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(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte HARRO TRAUBEL,  
HANS-WERNER MULLER AND  
FRITZ NOVOTNY

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Appeal No. 96-0767  
Application 08/136,439<sup>1</sup>

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ON BRIEF

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Before RONALD H. SMITH, DOWNEY and HANLON, Administrative Patent  
Judges.

RONALD H. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims

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<sup>1</sup> Application for patent filed October 13, 1993. According to applicants, this application is a continuation-in-part of Application 07/865,429, filed April 9, 1992.

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7-11. Claims 1-6 have been canceled, and claim 12 has been withdrawn from consideration.

The subject matter is directed to an aqueous pigment preparation comprising an oligourethane formulating agent. Claim 7, the only independent claim, is illustrative of the appealed claims and reads as follows:

7. An aqueous pigment preparation comprising

(a) a formulating agent comprising an oligourethane having an average molecular weight range of from 5000 to 50,000 and containing

(1) no primary or secondary amino groups,

(2) 5 to 25% by weight, based on the oligourethane, of incorporated ethoxy groups, and

(3) anionic and cationic groups, wherein the quantity of anionic groups is from 0.2 to 0.8 mol per 1000 g of the oligourethane and the molar ratio of anionic to cationic groups is from 0.8 to 4,

wherein said oligourethane comprises a reaction product of a polyisocyanate; hydroxyl compounds, wherein at least one such hydroxyl compound is a dihydroxyl compound containing ionic groups; and an amino alcohol having tertiary nitrogen atoms;

(b) from 2 to 20 ml, per 100 gram of pigment preparation, of a pigment having a density of from 0.8 to 7 g/ml; and

© an aqueous phase containing up to 30% by weight of organic solvent.

The reference of record relied on by the examiner is:

Scriven et al. (Scriven)

4,147,679

April 3, 1979

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Appellants made no statement that the claims do not stand or fall together. 37 CFR § 1.192(c)(7). Accordingly, we will limit our consideration to claim 7.

Claim 7 stands rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Claims 7-11 stand rejected under 35 U.S.C. § 103 as obvious over Scriven. We have carefully considered the entire record, including the appellants' position as set forth in their briefs and the examiner's position as set forth in the answer, and we have decided that we will not sustain the rejections.

Claim 7 is rejected as indefinite by the examiner because the claim does not indicate whether the claimed "average molecular weight range" of 5000 to 50,000 for the oligourethane is a "number average, weight average, viscosity average, z average, etc." As noted by appellants, claims are not indefinite if they "set out and circumscribe a particular area with a reasonable degree of precision and particularity" and the definiteness of the language "must be analyzed—not in a vacuum, but always in the light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art." In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA

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1971). We agree with appellants that claim 7 describes the formulating agents with a reasonable degree of precision and particularity. We also agree with appellants that, for the reasons set forth in their briefs, one skilled in the art would readily understand that the term "average molecular weight" as used by appellants refers to number average molecular weight.

We have carefully reviewed the disclosure of Scriven, and we agree with appellants that Scriven does not disclose or suggest the claimed pigment preparations comprising the particular oligourethane formulating agent and 2 to 20 ml of pigment per 100 gram of pigment preparation. It is well established that for an invention to be obvious in view of a reference, something in the art taken as a whole, other than the applicant's disclosure, must suggest the invention. In re Dow Chem. Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1532 (Fed. Cir. 1988). The mere fact that the Scriven disclosure could be modified, using appellants' claim 7 as a guide, to provide the claimed oligourethane would not have made the claimed pigment preparations obvious under 35 U.S.C. § 103.

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The decision of the examiner is reversed.

Ronald H. Smith	)	
Administrative Patent Judge	)	
	)	
	)	
Mary F. Downey	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
Adriene Lepiane Hanlon	)	
Administrative Patent Judge	)	

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