

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte KOLAZI S. NARAYANAN

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Appeal No. 96-2665  
Application 07/975,811<sup>1</sup>

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ON BRIEF

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Before KIMLIN, WARREN and OWENS, Administrative Patent Judges.  
KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 10, 15, 17, 18, 20-26, 28-40 and 45-51, all the claims remaining in the present application.<sup>2</sup> A copy of illustrative claim 45 is appended to this decision.

The examiner has not applied prior art in the rejection of the appealed claims.

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<sup>1</sup> Application for patent filed November 13, 1992.

<sup>2</sup> Claim 27 was cancelled by appellant in Amendment B, filed March 14, 1994 (Paper No. 7).

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Appellant's claimed invention is directed to compositions that provide stable microemulsions in aqueous medium that are used to coat a film on a substrate. The resultant film exhibits water fastness even though the film-forming composition is aqueous based. According to appellant, the claimed compositions are particularly useful for coating agriculturally active ingredients, such as herbicides. The compositions of the present invention comprise a long chain alkylpyrrolidone of the recited formula, an anionic surfactant, and a film-forming water insoluble graft polymer of N-vinylpyrrolidone and an "-olefin.

Appealed claims 10, 15, 17, 18, 20-26, 28-40 and 45-51 stand rejected under 35 U.S.C. § 112, second paragraph. In addition, claims 10, 15, 17, 18, 20-26, 28-40 and 45-51 stand rejected under 35 U.S.C. § 112, first paragraph, as being based upon a specification that fails to provide an adequate written description of the invention.

We have carefully reviewed the respective positions advanced by appellant and the examiner. In so doing, we find that the examiner's rejections are not sustainable.

We consider first the examiner's rejection of the appealed claims under 35 U.S.C. § 112, second paragraph. According to the

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examiner, the claim language "relative amounts" is vague.<sup>3</sup> The examiner queries whether appellant intends 99.9% polymer and 99.9% bicarbonate to achieve a rainfast condition and a solid, respectively (page 3 of Supplemental Answer, first paragraph). However, it is well settled that claim language is not to be read in a vacuum but in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983); In re Kroekel, 504 F.2d 1143, 1146, 183 USPQ 610, 612 (CCPA 1974); In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). In the present case, we agree with appellant that when the claim language "relative amounts" is read in light of the specification, one of ordinary skill in the art would understand that, depending upon the specific components utilized, the relative amounts of the recited components is that which produces the stated result, i.e., a rainfast microemulsion (claim 45) and a clear liquid (claim 46). As noted by appellant, page 7 of the specification, second paragraph, describes preferable ranges in percent for each of the claimed components. We agree with appellant that only routine experimentation would be required of

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<sup>3</sup> We note that claim 46 does not contain the language "relative amounts."

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the skilled artisan to determine the amounts of specific components to produce a rainfast microemulsion and clear liquid.

We now turn to the examiner's rejection of the appealed claims under 35 U.S.C. § 112, first paragraph. According to the examiner, the present specification does not completely specify which of the two monomers makes up the backbone of the graft polymer, and which of the monomers is grafted onto the backbone.

The first paragraph of § 112 requires the specification to contain a written description of the invention in such a way as to enable one of ordinary skill in the art to which it pertains to make and use the invention. When criticizing the adequacy of a specification description, the examiner has the initial burden of establishing, by compelling reasoning or objective evidence, that one of ordinary skill in the art would be unable to practice the claimed invention. 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 our view, the examiner has not satisfied this initial burden.

Appellant's specification, at page 7, first paragraph, describes three separate, commercially-available graft polymers in terms of the type of monomers used, as well as their amounts. Faced with this disclosure, it is incumbent upon the examiner to demonstrate that one of ordinary skill in the art would be unable

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to ascertain the type of graft polymers employed by appellant, whether it be a vinyl pyrrolidone grafted onto an olefin backbone, vice versa, or both. This the examiner has not done. On the other hand, appellant presents the reasonable argument that one cannot specifically say which monomer forms the backbone once the polymer is formed, and what is important to understand is that the claimed graft polymer is not a linear polymer containing two different monomers. The examiner has not refuted appellant's reasoning and, in any event, it is axiomatic that an applicant need not comprehend the scientific principles (in this case, precise chemical structure) on which the practical effectiveness of the invention rests. Fromson v. Advanced Offset Plate, 720 F.2d 1565, 1570, 219 USPQ 1137, 1140(Fed. Cir. 1983).

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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	)	
	)	
CHARLES F. WARREN	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
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	)	
TERRY J. OWENS	)	
Administrative Patent Judge	)	

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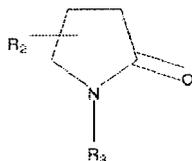
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APPENDIX

45. A composition comprising:

a. a long chain alkylpyrrolidone having the formula:



wherein R<sub>2</sub> is hydrogen or alkyl having from 6 to 14 carbon atoms and R<sub>3</sub> is alkyl having from 6 to 14 carbon atoms with the proviso that at least one of R<sub>2</sub> and R<sub>3</sub> must contain at least 6 carbon atoms and the sum of the carbon atoms in R<sub>2</sub> and R<sub>3</sub> cannot exceed 14.;

- b. an anionic surfactant other than the long-chain alkylpyrrolidone;
- c. a film-forming water insoluble graft polymer from 20 to 80% of N-vinylpyrrolidone and from 80 to 20% of an "-olefin, the latter monomer containing up to 20 carbon atoms; and
- d. an agriculturally active chemical;

the relative amounts of the components being such that the composition forms a rainfast microemulsion or emulsion when added to water.