

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(2) is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT D. LUNDBERG,
DENNIS G. PEIFFER and ROBERT R. PHILLIPS

Appeal No. 1996-3000
Application 08/304,105¹

ON BRIEF

Before GARRIS, WARREN and LIEBERMAN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner refusing to allow claims 1 through 4, 6 through 9 and 11 through 16 as amended subsequent to the final rejection, which amendment further cancelled claims 5 and 10.^{2,3}

¹ Application for patent filed September 9, 1994.

² See the amendment of April 26, 1995 (Paper No. 6). We observe that while claim 10 was canceled in this amendment, the dependency of both claims 12 and 13 was changed to newly canceled claim 10 from pending claim 11 which depends on cancelled claim 10. Appealed claims 14 and 15 depend on claim 13 and thus are included in this error. We further observe that claim 7 was amended to include

We have carefully considered the record before us, and based thereon, find that we cannot sustain the ground of rejection of the appealed claims under 35 U.S.C. § 103 as being unpatentable over Agarwal et al.⁴ Each of the appealed claims involves a plasticized thermoplastic sulfonated polymer emulsion which contains a plasticizer, selected from a specified group, that is characterized as, *inter alia*, “substantially insoluble in the water phase of the emulsion” as this phrase is defined by appellants in their specification (page 4). *In re Morris*, 127 F.3d 1048, 1055-56, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997). The examiner has expressly “acknowledged that appellants’ specifically claimed plasticizers are not disclosed in this reference” (answer, page 2) and states that “a plasticizer is *generically* called for by” Agarwal et al. (*id.*, page 3, emphasis supplied; see also page 4, lines 3-5). Thus, the examiner reasons that because the “instantly claimed plasticizers are the most conventionally incorporated plasticizers known to be used in thermoplastic elastomers” it would have been *prima facie* obvious to “incorporate a conventionally known plasticizer for thermoplastic elastomers” as a plasticizer is “generically” suggested in Agarwal et al. Appellants submit that the reference fails to suggest the claimed invention because, *inter alia*, the claimed “emulsion includes a specified list of plasticizers, *none* of which are *ionic* preferential plasticizers” as disclosed in Agarwal et al. (emphasis supplied), and that “one with ordinary skill in this art would not substitute . . . a non-ionic plasticizer for an ionic plasticizer” (brief,⁵ page 3; see also page 4).

We must agree with appellants that the examiner has failed to establish a *prima facie* case of obviousness. We find that the sole suggestion in Agarwal et al. to use a plasticizer in the emulsion-type adhesive compositions taught therein appears at col. 2, lines 22-24, wherein it is stated that “to the compositions can be optionally added an *ionic* preferential plasticizer” (emphasis supplied). The examiner has not provided any evidence or scientific explanation on this record why one of ordinary

the plasticizers of claim 11. For purposes of judicial economy, we have considered appealed claims 11 through 15 as depending on claim 7 on which they ultimately depended when claim 10 was pending.

³ The copy of the appealed claims appended to the brief is in error because claim 8 is not included therein.

⁴ Agarwal et al. is listed at page 2 of the answer.

⁵ We refer in our opinion to the brief filed on August 7, 1995 (Paper No. 11).

skill in the art would have found in the specific disclosure of “ionic preferential plasticizer” in Agarwal et al. both the suggestion and reasonable expectation of success to replace the same with the plasticizers specified in the appealed claims. Thus, it is manifest that the only direction to appellants’ claimed invention as a whole on the record before us is supplied by appellants’ own specification.

The examiner’s decision is reversed.

Reversed

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| BRADLEY R. GARRIS |) | |
| Administrative Patent Judge |) | |
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| CHARLES F. WARREN |) | BOARD OF PATENT |
| Administrative Patent Judge |) | APPEALS AND |
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| |) | |
| |) | |
| PAUL LIEBERMAN |) | |
| Administrative Patent Judge |) | |

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