

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte RUDOLPH KLIMA, JOHN KRASNIEWSKI  
and JOSE M. RODRIGUEZ

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Appeal No. 96-3069  
Application No. 08/206,231<sup>1</sup>

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ON BRIEF

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

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

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<sup>1</sup> Application for patent filed March 2, 1994. According to appellants, this application is a continuation of Application No. 07/941,021, filed September 4, 1992, now abandoned.

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This is an appeal from the final rejection of claims 6-9 and 11-20, all the claims remaining in the present application. Claims 6 and 14 are illustrative:

6. An aqueous-based paper or paper board coating composition consisting essentially of a pigment, a binder, and a lubricant additive selected from the group consisting of a polyoxyalkylene mono- and di-ester of phosphoric acid, a polyoxyalkylene mono- and di-ester of a phosphoric acid salt, and a mixture thereof.

14. The process of applying an aqueous-based coating composition consisting essentially of a pigment and a binder to a rapidly moving paper or paper board web consisting of contacting said web with a lubricant additive selected from the group consisting of a polyoxyalkylene mono- and di-ester of phosphoric acid, a polyoxyalkylene mono- and di-ester of a phosphoric acid salt, and a mixture thereof.

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

Woodward	4,183,766	Jan. 15, 1980
Yoshioka et al. (Echuca)	4,717,452	Jan. 5, 1988
Nikoloff et al. (Nikoloff)	4,766,015	Aug. 23, 1988

Appellants' claimed invention is directed to an aqueous-based composition for coating paper or paper board consisting essentially of a pigment, a binder and a polyoxyalkylene phosphate ester. The polyoxyalkylene phosphate ester is employed as a lubricant. Appealed claim 14 is directed to a

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process of applying the composition to a rapidly moving paper or paper board web.

Appealed claims 6-9, 11 and 14-19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Woodward. Claims 12, 13 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Woodward in view of Nikoloff. In addition, claims 14, 16, 19 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Yoshioka. Also, claims 13 and 20 stand rejected under 35 U.S.C. § 112, second paragraph.

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

We consider first the examiner's rejections of claims 6-9, 11 and 14-19 over Woodward, and claims 12, 13 and 20 over Woodward in view of Nikoloff. The sole argument raised by appellants in opposition to this rejection is that "Woodward fails to teach, suggest or motivate the use of the claimed polyoxyalkylene (alkoxylated) mono- and di-esters of phosphoric acid in a paper coating composition, or its use as a lubricant therein" (page 4 of Brief). According to appellants, "alkoxylated esters of phosphoric acid are not

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disclosed or suggested" (page 4 of Brief). Notwithstanding the examiner's argument to the contrary, we agree with appellants that Woodward does not teach or suggest the claimed polyoxyalkylene mono- and di-esters of phosphoric acid. The product of the reaction set forth at column 3 of Woodward is a mono-oxyalkene ester of phosphoric acid, in contrast to the reaction depicted at page 4 of appellants' specification.

We will also not sustain the examiner's § 103 rejection of claims 14, 16, 19 and 20 over Yoshioka because, as urged by appellants, Yoshioka does not teach or suggest the claimed process of contacting a rapidly moving paper or paper board web with a polyoxyalkylene phosphate ester. Rather, Yoshioka discloses incorporating a polyalkylene phosphate ester as a sizing agent in a composition for making paper. The examiner has not responded to this argument of appellants at page 6 of the Answer. Furthermore, the examiner has not pointed out where Yoshioka teaches or suggests the claimed requirement of applying an aqueous-based coating composition consisting essentially of a pigment and a binder to moving paper.

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We will also not sustain the examiner's rejection under 35 U.S.C. § 112, second paragraph. Appellants have cited ANIONIC SURFACTANTS, Part II, 509 (Warner M. Linfield ed., Marcel Dekker, Inc., New York 1976) for scientific evidence that rebuts the examiner's position that "the second oxygen atom in the structure  $(CH_2-CH_2-O)_n-O-$  should be deleted" (page 5 of Answer). Contrary to the examiner's statement at page 7 of the Answer that phosphate esters must contain the ester moiety depicted therein, the publication cited by appellants characterizes compounds according to appellants' structural formula as "Polyoxyalkylene Phosphate Esters."

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

REVERSED

EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
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JOHN D. SMITH	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
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CAMERON WEIFFENBACH )  
Administrative Patent Judge )

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