

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(2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

\_\_\_\_\_  
Ex parte DAVID J. DOUGHERTY

\_\_\_\_\_  
Appeal No. 96-3938  
Application 08/288,861<sup>1</sup>

\_\_\_\_\_  
ON BRIEF  
\_\_\_\_\_

Before JOHN D. SMITH, GARRIS, and WARREN, Administrative  
Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

\_\_\_\_\_  
<sup>1</sup> Application for patent filed August 11, 1994.

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Application No. 08/288,861

This is a decision on an appeal from the final rejection of claims 10 through 25 which are all of the claims remaining in the application.<sup>2</sup>

The subject matter on appeal relates to an adhesive composition comprising a block copolymer having at least two polymer blocks which comprise a vinyl aromatic hydrocarbon and at least one polymer block comprising a conjugated diene and comprises a vinyl aromatic hydrocarbon content of 25% to 60% by weight and a vinyl content of the conjugated diene portion of 30% to 70%. Additionally, the relationship between the aforementioned contents must satisfy a certain claim formula. This appealed subject matter is adequately illustrated by independent claim 10, a copy of which taken from the appellant's brief is appended to this decision.

The references relied upon by the examiner as evidence of obviousness are:

Minamizaki et al. (Minamizaki)	4,699,938	Oct. 13, 1987
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<sup>2</sup> Notwithstanding certain conflicting language therein, the last paragraph on page 1 of the appellant's brief is interpreted by this panel of the Board as reflecting that the appellant is advancing claims 10 through 25 on this appeal but concedes the propriety of the examiner's section 112, second paragraph, rejection of claim 20.

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Tang et al. (Tang)	4,717,749	Jan. 5, 1988
Diehl et al. (Diehl)	5,143,968	Sep. 1, 1992
Debier et al. (Debier)	5,300,582	Apr. 5, 1994
Kamiya (JP)	54-127930	Oct. 4, 1979

Claim 20 stands finally rejected under the second paragraph of 35 U.S.C. § 112 for failing to particularly point out and distinctly claim the subject matter which the appellant regards as his invention.<sup>3</sup>

Claims 10 through 25 stand rejected under the first paragraph of 35 U.S.C. § 112 as being based upon a nonenabling disclosure.

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<sup>3</sup> In his answer, the examiner has included claim 21 in this rejection on the grounds that this claim is a duplicate of claim 12. For a number of reasons, it is quite apparent that the inclusion of claim 21 in the above noted rejection was an inadvertent oversight on the examiner's part. This is because of the fact that claim 21 was not included in the rejection set forth in the final office action coupled with the fact that the examiner has explicitly stated that his answer "does not contain any new ground of rejection" (answer, page 5). Additionally, claim 21 is unquestionably not a duplicate of claim 12 since the dependencies of these claims differ. For these reasons, we consider the section 112, second paragraph, rejection before us on this appeal to not include claim 21 as reflected above.

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Finally, claims 10 through 25 also stand rejected under 35 U.S.C. § 103 as being unpatentable over Debier in view of Minamizaki, Tang, Diehl or Kamiya.

As reflected on page 3 of the brief, certain of the appealed claims have been separately grouped and argued, and these certain claims will be individually treated in our opinion which follows.

We refer to the brief and to the answer for a complete exposition of the differing viewpoints expressed by the appellant and the examiner concerning the above noted rejections.

#### OPINION

For the reasons which follow, we will sustain the examiner's section 112, second paragraph, rejection of claim 20 and his section 103 rejection of claims 10 through 25 but not the section 112, first paragraph, rejection of claims 10 through 25.

The section 112, second paragraph, rejection of claim 20 is hereby summarily affirmed in light of the appellant's concession of its propriety mentioned earlier in footnote 2.

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The examiner has rejected the appealed claims under the first paragraph of section 112 because lines 19 and 20 on specification page 12 disclose certain compounds which may be alternatively used for plasticizing oils as having a particular range of average molecular weights without specifying "whether the cited molecular weights are weight, number, viscosity or Z average molecular weights" (answer, page 3). However, the examiner has not explained, and we do not independently perceive, why this lack of specificity would prevent one with ordinary skill in this art from selecting and using without undue experimentation the aforementioned compounds as plasticizing oils in the here claimed composition. Even if this were not so, the appealed claims still would be enabled contrary to the examiner's view. This is because none of these claims is limited to the earlier mentioned compounds or molecular weights as a plasticizing oil for the here claimed composition.

For these reasons, we can not sustain the examiner's section 112, first paragraph, rejection of claims 10 through 25 for lack of enablement.

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As indicated earlier, however, we will sustain the examiner's section 103 rejection of claims 10 through 25 since, in our view, Debier would have suggested an adhesive composition of the type defined by these claims.

In support of his contrary view, the appellant argues that "[t]he claimed adhesive compositions of the present invention have been claimed as displaying a range of criticality of  $75 \leq [S] + [V] \leq 100$  undemonstrated in the prior art, particularly the Debier . . . patent" (brief, page 5). This argument is unpersuasive. Rather than attempt to interpret the appellant's meaning in his use of the term "undemonstrated", we simply point out that the test for obviousness is what the reference teachings would have suggested to those of ordinary skill in the art. In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In this regard, it is significant that the content concentrations defined by the independent claims on appeal are disclosed by Debier (e.g., see claims 1 and 3 of the patent). Moreover, patentee's 35% styrene content and his 45% butadiene content satisfy the formula set forth in these appealed independent claims notwithstanding the appellant's apparent belief to the

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contrary. These circumstances lead us to conclude that the content and formula features defined by the appellant's independent claims at least would have been suggested by Debier. Ex parte Lee, 31 USPQ2d 1105, 1106-1107 (Bd. Pat. App. & Int. 1993).

The appellant also argues that he "has presented clearly novel compositions in the adhesive compositions having a vinyl aromatic hydrocarbon content [S] of the instant block copolymers of 35% to 50% (claim 19), and of 40% to 50% (claims 11 [sic, 12] and 21)" (brief, page 6). From our perspective, the 35% content of claim 19 is not novel and certainly not nonobvious in light of Debier's aforementioned disclosure. Ex parte Lee, id. Further, while the 40% content of claims 12 and 21 may be novel, it is our view that such a content would have been suggested by Debier's teaching of "about 35%" (again see patent claim 1), and the appellant's brief contains no reasonably specific arguments to the contrary.

Finally, it is argued by the appellant that "the claimed block copolymer of the present invention is necessarily linear in claim 17 and branched in claim 18, unlike the clearly

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radial block polymer used in the Debier . . . patent" (brief, page 6). However, Debier generically discloses block copolymers of the type under consideration and, for this reason alone, would have suggested linear as well as branched copolymers specifically, and again the appellant's brief contains no reasonably specific arguments to the contrary. More significantly with respect to appealed claim 18, Debier explicitly discloses branched block copolymers in Illustrative Embodiment 1 as correctly noted by the examiner in his answer.

Under the circumstances recounted above, it is appropriate that we sustain the examiner's section 103 rejection of claims 10 through 25 as being unpatentable over Debier in view of Minamizaki, Tang, Diehl or Kamiya.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

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PATENT

John D. Smith	)	
Administrative Patent Judge	)	
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Bradley R. Garris	)	BOARD OF
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
Charles F. Warren	)	
Administrative Patent Judge	)	

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D A Thomas  
Deputy General Counsel  
Bridgestone Firestone Inc.  
1200 Firestone Parkway  
Akron, OH 44317

APPENDIX

- (e) 0 to 10% of a compatible wax;
- (d) 0.5% to 5.2% of a stabilizer; and
- (c) 10% to 40% of a plasticizing oil;
- (b) 50% to 80% of a compatible tackifying resin;

$$V \leq [Z] + [A] \leq 100;$$

V-Vinyl content of the conjugated diene portion [A] satisfies the formula:

- (iii) the relationship between said vinyl aromatic hydrocarbon content [Z] and said
- (ii) a vinyl content of the conjugated diene portion [A] of 30% to 70%; and
- (i) a vinyl aromatic hydrocarbon content [Z] of 52% to 90% by weight;

block comprising a conjugated diene, and comprises:

least two polymer blocks comprising a vinyl aromatic hydrocarbon and at least one polymer

- (a) 10% to 20% of a block copolymer, wherein said block copolymer comprises at

10. An adhesive composition comprising: