

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JÜRGEN MEIXNER,
WOLFGANG FISCHER,
and
JOSEF PEDAIN

Appeal No. 1997-3013
Application No. 08/383,328

ON BRIEF

Before KIMLIN, Administrative Patent Judge, McKELVEY, Senior Administrative Patent Judge, and DELMENDO, Administrative Patent Judge.

DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL UNDER 35 U.S.C. § 134

Upon consideration of the record, it is:

ORDERED that the examiner's rejection of claims

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1 through 4 and 9 through 12¹ as being unpatentable under 35
U.S.C. § 103 over:

- (1) Noll et al., U.S. Patent 4,485,226 (1984),
- (2) German Patent Application 3,819,627 (1989), or
- (3) German Patent Application 4,021,109 (1992),

is reversed.

The claims on appeal, in particular independent claims 1 and 9, recite that component "A)" of the UV-curable coating composition is prepared by using, as "A2)," "an polyisocyanate component comprising an aliphatic polyisocyanate which contains isocyanurate groups, is based on 1,6-diisocyanatohexane and has an NCO content of 22 to 23.5 wt% and a viscosity at 23EC of 800 to 1400 mPa·s" (emphasis added). On page 7 of the appeal brief filed on November 25, 1996, the appellants argue that "[t]his low viscosity polyisocyanate is not taught by any of the three applied [prior art] references."

The examiner has not responded to this argument. Nor do we find anything in the record to indicate that the examiner

¹ Claims 13 through 16, the only other claims remaining in the application, have been allowed (Paper 12, advisory action, item 3).

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has properly established that one of ordinary skill in the art would have found it obvious, in view of the applied prior art, to arrive at the appellants' claimed subject matter by using the recited polyisocyanate A2) having the claimed viscosity to prepare component A). Under these circumstances, we hold that the examiner has not carried his burden of establishing a prima facie of obviousness within the meaning of 35 U.S.C. § 103. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984).

The decision of the examiner is reversed.

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
FRED E. McKELVEY)	APPEALS
Senior Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
ROMULO H. DELMENDO)	

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Administrative Patent Judge)

RHD:hh

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