

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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* SHELBY F. THAMES  
and ZHIGIANG A. HE

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Appeal No. 1998-1304  
Application 08/444,534

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ON BRIEF

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

WARREN, *Administrative Patent Judge*.

*Decision on Appeal and Opinion*

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellants, in the brief, and based on our review, find that we cannot sustain either of the rejections of appealed claims 1 and 12-16<sup>1</sup> under 35 U.S.C. § 102(b) and under 35 U.S.C. § 103(a) as, respectively, anticipated by and obvious over Garratt et al.

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<sup>1</sup> The grounds of rejection include appealed claims 15 and 16. See the examiner's supplemental answer of March 29, 2001 (Paper No. 23) in response to the remand by the board of January 9, 2001 (Paper No. 22). The appealed claims are set forth in the specification (pages 17 and 19). The examiner withdrew the rejection of appealed claim 2, stating that it would be allowed if submitted in independent

(Garratt).<sup>2</sup> For the reasons pointed out by appellants in the brief, the examiner has failed to make out a *prima facie* case of anticipation and of obviousness. We add the following for emphasis.

The dispositive consideration in this appeal is the interpretation to be made of appealed claim 1. We find that, when considered in light of the written description in the specification as interpreted by one of ordinary skill in this art, *see, e.g., In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997), the plain language of appealed claim 1 specifies that the claimed composition comprise at least “acrylated chlorinated rubber containing acrylic ester functional groups,” that is, “an acrylated, chlorinated rubber containing *acrylic* functionality.” We note that claim 1 was first amended to so read, but appellants further amended the claim to recite “acrylic ester functionality” in the amendment of July 1, 1996 (Paper No. 16) in order to comply with the examiner’s view that if “used as a functional group, the term acrylic must be accompanied by the terms ‘acid’ and ‘ester’” (Paper No. 15; page 4). It is further clear from the specification that, contrary to the examiner’s position (Paper No. 17, unnumbered page 3, third full paragraph), the “acrylic functionality” can be obtained by the reaction of an acid halide, e.g., acryloyl chloride, with the hydroxy compound chlorinated hydroxyrubber, which is, of course, a classic textbook synthesis for carboxylic acid esters. Thus, it appears that the “acrylic functionality” based on these components would be the  $-O-CO-CH=CH_2$  moiety, linked to the rubber through the ester linkage. Indeed, the examiner has allowed claim 2 (*see above* note 1) drawn to such a rubber in product-by-process format which specifies the two starting materials we used above to demonstrate what we find to be in appellants’ written description, but has

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form (answer, page 4). The remaining claims of record, claims 3 through 11 and 17 through 19 stand allowed.

<sup>2</sup> The examiner stated that the grounds of rejection were set forth in the “prior Office action, Paper No. 17” (answer, page 3) That Office action, mailed September 9, 1996, states that the grounds of rejection were set forth in “the Office action dated March 28, 1996” (Paper No. 15). While the “ground of rejection” advanced on appeal is not found in the same “*single* prior action,” See Manual of Patent Examining Procedure (MPEP) § 1208 (6th ed., Rev. 3, July 1997; 1200-15), we have been able to determine the examiner’s position and it is apparent that appellants have not been placed at a disadvantage, and thus we decide this appeal rather than remand the application to the examiner on this basis.

not explained why appealed claim 1 would have a broader interpretation with respect to “acrylic ester functionality.”

In comparing claim 1 as we have interpreted it above with the teachings of Garratt, it is clear that the examiner has indeed confused “mixtures” with “molecules” as argued by appellants in their brief. In the reference, the resin *mixture* containing a chlorinated natural or synthetic rubber and ethyl acrylate monomer upon curing by radiation induced free radical polymerization provides a product useful as a coating, and it is not apparent on this record that this product is a “rubber” *molecule* falling within claim 1, as appellants point out in the brief.

Thus, to the extent that a *prima facie* case of anticipation and obviousness had been made out by the examiner over Garratt in Paper No. 15, the factual arguments by appellants in rebuttal shifted the burden back to the examiner to again establish the factual underpinning of a *prima facie* case under § 102(b) and § 103(a) in order to maintain the grounds of rejection. *See, e.g., In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Spada*, 911 F.2d 705, 707 n.3, 15 USPQ2d 1655, 1657 n.3 (Fed. Cir. 1990). The examiner’s mere conclusion that the “resulting composition [of Garratt] must contain acrylate or acrylic acid ester functionality,” unsupported by any evidence or scientific reasoning, does not carry the burden.

The examiner’s decision is reversed.

*Reversed*

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

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PETER F. KRATZ )  
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