

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(2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLI-KURT GRIES

Appeal No. 1998-2134
Application 08/585,217¹

HEARD: March 22, 2001

Before KIMLIN, PAK, and WALTZ, Administrative Patent Judges.
PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134
from the examiner's refusal to allow claims 1 through 9, 11
through 13, 16 and 17 in the above-identified application.

¹ Application for patent filed January 11, 1996.

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Claims 10, 14 and 15 were indicated to "be allowable if rewritten in independent form, including all of the limitations of the base claim and any intervening claims."

See Answer, page 2. Claims 1 and 17 are representative of the subject matter on appeal and read as follows:

1. A photocurable elastomeric mixture comprising:
 - a) an amphiphilic elastomeric binder or a mixture of such binders,
 - b) a free-radical-polymerizable compound which is compatible with the binder and which has at least one terminally ethylenically unsaturated group and a boiling point at normal pressure of over 100°C and
 - c) a compound or a combination of compounds which is capable of initiating the polymerization of the compound (b) on exposure to actinic light,

wherein the elastomeric binder is a block copolymer made up of the segments A, B and C, where

A is a hydrophobic soft polymer block having a glass transition temperature of below -30°C,

B is a hydrophobic hard polymer block having a glass transition temperature of over +30°C,

C is a polar polymer block which is made up of heterocyclic compounds which can be polymerized by anionic ring opening.

17. A photocurable recording material as claimed

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Morton, *Rubber Technology*, Third Ed., published by Van Nostrand Reinhold Company, (1987), pp. 464-481.

The appealed claims stand rejected as follows⁴:

1) Claim 7 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention;

2) Claims 1 through 9, 11 through 13 and 16 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of DuPont, Hsieh and Wright; and

3) Claims 1 through 9, 11 through 13, 16 and 17 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Garmong, Hsieh and Wright.

As a preliminary matter, we observe that appellant takes the position that the objection to the specification set forth by the examiner under 35 U.S.C. § 132 is erroneous. See Brief, pages 7 and 8. As correctly stated by the examiner (Answer, page 2), this argument is not appropriate in the present case since appellant's remedy regarding the objection to the specification at issue is through a petition to the

⁴ Subsequent to the final Office action dated Feb. 5, 1997 (Paper No. 9), the examiner has withdrawn the rejection of claims 16 and 17 under 35 U.S.C. § 112, first paragraph, as lacking an enabling disclosure for the subject matter claimed.

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Director of the U.S. Patent and Trademark Office and not appeal to the Board.

We reverse the examiner's rejection of claim 7 under 35 U.S.C. § 112, second paragraph as being indefinite for the reasons articulated by appellant in his Brief and Reply Brief. As the court stated in *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971), the determination of whether the claims of an application satisfy the requirements of the second paragraph of Section 112 is

merely to determine whether the claims do, in fact, set out and circumscribe a particular area with a **reasonable** degree of precision and particularity. It is here where the definiteness of language employed must be analyzed -- not in a vacuum, but always in light of the teachings of the **prior art** and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. [Emphasis ours; footnote omitted.]

Here, the examiner criticizes the use of the terminology "M_p" but has not supplied any basis to doubt the evidence and argument submitted by appellant in his Reply Brief⁵.

We affirm the examiner's decision rejecting all of the

⁵ The examiner has approved entry of appellant's Reply Brief containing new arguments and supporting evidence.

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appealed claims under 35 U.S.C. § 103 for the findings of fact and conclusions set forth at pages 5 through 22 of the Answer. We add the following for emphasis and completeness.

At the outset, we note that appellant has grouped the claims on appeal as follows (Brief, page 6):

Group I - Claims 1 through 9, 11 through 13 and 16; and

Group II - Claim 17.

Therefore, we need only consider the propriety of the examiner's § 103 rejections based on claims 1 and 17 consistent with 37 CFR § 1.192(c)(7) (1995).

Appellant does not dispute the examiner's finding that both DuPont and Garmong describe a photocurable elastomeric composition comprising a generic elastomeric block copolymer **binder** inclusive of the claimed elastomeric block copolymer binder, the claimed free-radical-polymerizable compound and the claimed polymerization initiator. Compare Answer, pages 5-6, 8-9, 12-13 and 19-20 with Brief and Reply Brief in their entirety. However, both the examiner and appellant agree that neither DuPont nor Garmong specifically mentions the claimed

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binder. See Answer, pages 6 and 9 and Brief and Reply Brief in their entirety.

To remedy this deficiency, the examiner relies on the disclosures of Hsieh and Wright. See Answer, pages 6-7 and 9-10. Appellant does not dispute the examiner's finding that both Hsieh and Wright describe the claimed block copolymer binder. Compare Answer, pages 6-7 and 9-10 with Brief and Reply Brief in their entirety. Rather, appellant argues that Hsieh and Wright do not provide a sufficient suggestion to employ their block copolymer as the block copolymer binder of DuPont or Garmong. See Brief, pages 12-14 and 20-21 and Reply Brief, page 2-3 and 5-7.

In so arguing, appellant fails to take into consideration the collective teachings of the applied prior art references. When the applied prior art references, not just Hsieh and Wright, are considered as a whole, we agree with the examiner that there is a sufficient suggestion to arrive at the claimed subject matter. Specifically, we agree with the examiner's finding that both DuPont and Garmong set the criteria for

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employing the type of elastomeric block copolymers as the binder for their photocurable compositions. See Answer, pages 12-13 and 19-20. We also agree with the examiner's finding that both Hsieh and Wright teach elastomeric block copolymers which meet such criteria. See Answer, pages 13 and 20. Further, we agree with the examiner's finding that both Hsieh and Wright teach that their elastomeric block copolymers impart desired and advantageous properties, including ozone resistant properties. See, e.g., Answer, pages 6 and 7.

Given these advantages and the compatibility of the elastomeric block copolymers described in Hsieh and Wright in the photocurable compositions of DuPont or Garmong, we agree with the examiner that it would have been *prima facie* obvious to employ

Hsieh's or Wright's elastomeric block copolymers as the binder of the photocurable compositions of the type described in DuPont and Garmong. Appellant's reliance on Morton does not negate the teachings of DuPont and Garmong, which indicate

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usefulness of the elastomeric block copolymers of the type described in Hsieh and Wright as the binder of their photocurable compositions. We also note that the claims on appeal, like the disclosure of DuPont or Garmon, recite a large number of elastomeric block copolymers as a binder for the claimed photocurable composition. See, e.g., specification, pages 5 and 6.

As a rebuttal to the *prima facie* case of obviousness, appellant relies on the Gries declaration to demonstrate that the claimed subject matter imparts unexpected results. We are not convinced that appellant has carried his burden of proof. *In re Mayne*, 104 F.3d 1339, 1344, 41 USPQ2d 1451, 1456 (Fed. Cir. 1997)(the burden is on appellant to show why the evidence he relied on is unexpected); *In re Klosak*, 455 F.2d 1077, 1080, 173 USPQ 14, 16 (CCPA 1972) (the burden of proving unexpected results rests on the party who assert them); *In re Heyna*, 360 F.2d 222,

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228, 149 USPQ 692, 697 (CCPA 1966)(it is incumbent on
appellant

to submit clear and convincing evidence that the claimed
subject matter in fact exhibits unexpected results).

First, we note that it is not enough that the results for
appellant's invention and a supposed closest prior art
invention are different. Appellant must demonstrate that they
are unexpectedly different. *See, e.g., In re Geisler*, 116
F.3d 1465, 1469-70, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997);
Klosak, 455 F.2d at 1080, 173 USPQ at 16. In spite of the
examiner's finding at pages 15 and 16 of the Answer, including
the explicit teachings of Hsieh and Wright, appellant has not
supplied any evidence to establish that the extent of the
improvement obtained in the declaration is unexpected.

Secondly, appellant has not demonstrated that the showing
in the declaration is reasonably commensurate in scope with
the protection sought by the appealed claims. While the
showing in the declaration is limited to a few photocurable
compositions containing a limited number of elastomeric block
copolymers, the claims are not so limited. Appellant's own

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specification, which

is not limited to specifically described compositions, lists potentially thousands or millions of compositions embraced by the

the appealed claims. See pages 5-12. The examiner's finding at page 16 of the Answer regarding the effect of different percentages of the monomers in elastomeric block copolymers and appellant's own argument and evidence regarding the unpredictable nature of elastomeric block copolymers in a photocurable composition demonstrate that the showing applicable to a few compositions cannot be extended to the thousands or millions of compositions covered by the appealed claims.

Under these circumstances, we agree with the examiner that the evidence of obviousness, on balance, outweighs the evidence of nonobviousness proffered by appellant. Accordingly, we affirm the examiner's decision rejecting all of the appealed claims under 35 U.S.C. § 103 over the applied

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prior art.

In summary:

- 1) the examiner's § 112 rejection is reversed; and
- 2) the examiner's § 103 rejections are affirmed.

Therefore, 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

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHUNG K. PAK)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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THOMAS A. WALTZ)
Administrative Patent Judge)

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