

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTIAN WAMPRECHT
and MICHAEL SONNTAG

Appeal No. 1998-3113
Application No. 08/583,167

ON BRIEF

Before OWENS, LIEBERMAN, and TIMM, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 1-3. Claims 4 and 5, which are the only other claims remaining in the application, stand withdrawn from consideration by the examiner as being directed toward a nonelected invention.

THE INVENTION

The claimed invention is directed toward a specified polyester polyol composition. Claim 1 is illustrative:

1. A polyester polyol having a hydroxyl number of 60 to 400, which is the esterification product of
 - a) an alcohol component comprising
 - a1) one or more aliphatic or cycloaliphatic alcohols having at least 3 hydroxyl groups and 3 to 8 carbon atoms,
 - a2) optionally one or more aliphatic or cycloaliphatic alcohols having 2 hydroxyl groups and 2 to 18 carbon atoms and
 - a3) optionally one or more aliphatic or cycloaliphatic, saturated or unsaturated alcohols having one hydroxyl group and 1 to 18 carbon atoms,
 - with
 - b) a carboxylic acid component comprising
 - b1) itaconic acid, maleic acid, their anhydrides and/or fumaric acid,
 - b2) optionally one or more aliphatic or cycloaliphatic, saturated or unsaturated dicarboxylic acids having at least 2 carbon atoms and/or their anhydrides other than those set forth under b1) and
 - b3) optionally one or more aliphatic or cycloaliphatic, saturated or unsaturated monocarboxylic acids having 1 to 18 carbon atoms and/or their anhydrides,
- provided that component a3) is used in an amount of at least 10 mole%, based on the total moles of component a), or component b3) is used in an amount of at least 10 mole %, based on the total moles of component b).

THE REFERENCES

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Nodelman et al. (Nodelman) 1989	4,859,791	Aug. 22,
Wamprecht et al. (Wamprecht) 1995 (Canadian patent application)	2,138,310	Jun. 21,

THE REJECTION

Claims 1-3 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wamprecht in view of Nodelman.

OPINION

We affirm the aforementioned rejection. Because our rationale differs significantly from that of the examiner, we denominate the affirmance as involving a new ground of rejection under 37 CFR § 1.196(b).

The appellants state that the claims stand or fall together (brief, page 2). We therefore limit our discussion to one claim, i.e., claim 1, which is the sole independent claim. See *In re Ochiai*, 71 F.3d 1565, 1566 n.2, 37 USPQ2d 1127, 1129 n.2 (Fed. Cir. 1995); 37 CFR § 1.192(c)(7)(1995).

Nodelman discloses a polyester polyol which has a hydroxyl number of about 200 to 350 and is the esterification product of 1) an alcohol component which has a functionality of at least 3 and which can have a number of carbon atoms

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within the 3 to 8 range, and 2) a carboxylic acid component including, in an amount which should be at least about 50 wt%, an aromatic or a cycloaliphatic carboxylic acid, and optionally including acyclic carboxylic acids and anhydrides which can be maleic acid, maleic anhydride or fumaric acid (col. 2, lines 16-24 and 40-49; col. 2, line 60 - col. 3, line 3). The functionality can be controlled by including in the composition a monoalcohol or a monofunctional acid (col. 2, lines 57-59; col. 3, lines 4-6 and 29-33). The teaching that "[b]y varying the amounts and functionalities of the individual components, polyester polyols with virtually any theoretical average functionality may be obtained" (col. 3, lines 33-36) would have fairly suggested, to one of ordinary skill in the art, including in the composition any amount of monoalcohol or monofunctional acid needed to obtain the desired functionality, such as amounts of at least 10 mole%. Nodelman's disclosure of polyol A, wherein the monofunctional acid (2-ethylhexanoic acid) is present in an amount of 11.8 mole% of the acid and anhydride components, further would have fairly suggested, to one of ordinary skill in the art,

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including in the composition an amount of monofunctional acid which is greater than 10 mole%.

Accordingly, we conclude that the composition recited in the appellants' claim 1 would have been *prima facie* obvious to one of ordinary skill in the art at the time of the appellants' invention over Nodelman.¹

The appellants argue that one of ordinary skill in the art would not have used the teachings of Nodelman to modify Wamprecht's composition (brief, pages 3-4; reply brief, page 2). This argument is not persuasive because, as discussed above, the claimed invention would have been fairly suggested to one of ordinary skill in the art by Nodelman.

For the above reasons, we conclude that the claimed invention would have been obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103. Hence, we affirm the examiner's rejection. Because our rationale differs substantially from that advanced by the examiner, we denominate the affirmance as involving a new ground of rejection under

¹ A discussion of Wamprecht is not necessary to our decision.

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37 CFR § 1.196(b).

DECISION

The rejection of claims 1-3 under 35 U.S.C. § 103 over Wamprecht in view of Nodelman is affirmed. This affirmance is denominated as involving a new ground of rejection under 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR

§ 1.196(b) provides, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner

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(2) Request that the application be reheard
under § 1.197(b) by the Board of Patent Appeals and
Interferences upon the same record

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

AFFIRMED, 37 CFR § 1.196(b)

TERRY J. OWENS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
PAUL LIEBERMAN)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
CATHERINE TIMM)	
Administrative Patent Judge)	

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APJ OWENS

APJ

APJ KEYBOARD()

DECISION:

Prepared: August 15, 2002