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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte HERBERT FISCHER, WINFRIED EMMERLING,
THOMAS MOELLER, HERMANN ONUSSEIT, WERNER HALLER,
BERNHARD SCHOETTMER, BERNHARD HERLFTERKAMP,
DIETER FEUSTEL, KLAUS FRIEDRICH,
HARTMUT BUESCHING and NORBERT HUEBNER

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Appeal No. 1998-3118
Application No. 08/ 448,543

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ON BRIEF

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Before GARRIS, WALTZ and JEFFREY SMITH , **Administrative Patent Judges**.

GARRIS, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 13-25, 27, 30, 31, 33-38, 40-44, 50, 51, 65-73 and 75-78. These are all of the claims remaining in the application.

The subject matter on appeal relates to a composition, and to various methods of using the composition, comprising a nonionic polyurethane consisting essentially of

specified groups including residues of tetramethylxylene diisocyanate. This appealed

subject matter is adequately illustrated by independent claim 13 which reads as follows:

13. A composition of matter comprising a nonionic polyurethane consisting essentially of the groups

(a) $O\text{-}(CH_2CH_2O\text{-})_n$;

(b) -CONH X NHCO-; and

(c) 0 to 40% by weight -O-Y-O- groups based on the weight of (a) + (c)

wherein Y is a hydrophobic moiety selected from the group consisting of $(\text{-}CH_2\text{-}CH(CH_3)\text{- }O)_mCH_2\text{-}CH\text{-}(CH_3)$; $(\text{-}CH_2CH(C_2H_5)\text{--}O)_m\text{ -}CH_2\text{-}CH(C_2H_5)\text{-}$, $(\text{-}CH_2\text{-}CH_2\text{-}CH_2\text{-}CH_2O)_m\text{-}CH_2\text{-}CH_2.\text{-}CH_2CH_2$, alkylene groups having from 2 to 44 carbon atoms and cycloalkylene groups having from 6 to 44 carbon atoms, wherein X is a m-tetramethylxylene residue, n is a number of from 8 to 500 and m is a number of from 8 to 500 wherein said nonionic polyurethane has a weight average molecular weight of at least 10,000 and forms a homogeneous mixture with water, said mixture having a specific viscosity of at least 0.4 when said nonionic polyurethane is present at 1 % by weight of said mixture and when said mixture is at 20°C.

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

Windemuth et al. (Windemuth)	2,948,691	Aug. 09, 1960
Stewart	3,539,482	Nov. 10, 1970
Wolff (Translation copy attached)	DE 1 127 082	Apr. 05, 1962
Dekker et al. (Dekker)	EP 0 497 404	Oct. 05, 1992

All of the appealed claims are rejected under 35 U.S.C. § 103 as being unpatentable over Windemuth in view of Stewart, Wolff and Dekker.

We refer to the brief and reply brief and to the answer for a thorough discussion of the opposing viewpoints expressed by the appellants and by the examiner concerning the above-noted rejection.

OPINION

This rejection cannot be sustained.

In order to establish obviousness within the meaning of 35 U.S.C. § 103, the applied references must contain a suggestion to modify the prior art in such a manner as to result in the claimed invention and must contain evidence supporting a reasonable expectation that the modification in question would be successful. In re O' Farrell 853 F.2d 894, 903, 7 USPQ2d 1673, 1680-1681 (Fed. Cir. 1988).

According to the examiner "[i]t would have been obvious to use TMXDI [i.e., tetramethylxylene diisocyanate] in Windemuth's polyurethane because Dekker teaches this as a way to make a more flexible and adhesive polymer (see Table on page

10)" (answer page 4). This obviousness conclusion is not well founded.

As properly indicated by the appellants, Dekker's teaching regarding tetramethylxylene diisocyanate (TMXDI) is limited to the preparation of nonionic polyurethane dispersions. That is, the polyurethanes of Dekker are dispersible rather than soluble in water and therefore cannot be regarded as capable of forming "a homogeneous mixture with water" as required by the independent claims on appeal. Viewed from this perspective, Dekker's teaching is not compatible with the teaching of Windemuth concerning water soluble polyurethanes (i.e., polyurethanes capable of forming "a homogeneous mixture with water").

Under these circumstances we do not perceive the requisite suggestion "to use [Dekker's] TMXDI in Windemuth's polyurethane" so as to thereby obtain a polyurethane composition of the type here claimed. This is because, as discussed above, the water dispersible versus water soluble teachings of these references are simply incompatible with one another. Analogously, these references would not have provided the requisite reasonable expectation that combining them in the manner proposed by the examiner would be successful *vis à vis* the production of nonionic polyurethane of the type under consideration (i.e., a nonionic polyurethane which forms a homogeneous mixture with water).

These deficiencies of Windemuth and Dekker are not supplied by the other applied references. It follows that the rejection before us must be based upon the unwitting application of impermissible hindsight wherein that which only the inventor has taught is used against its teacher. W.L. Gore & Assoc. V. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). As a consequence, it is clear that we cannot sustain the examiner's § 103 rejection of the appealed claims as being unpatentable over Windemuth in view of Stewart, Wolff and Dekker.

The decision of the examiner is reversed.

REVERSED

BRADLEY R. GARRIS Administrative Patent Judge	)
THOMAS A. WALTZ Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
JEFFREY T. SMITH Administrative Patent Judge	)

/vsh

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