

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHEL GAY
and SYLVIE LAVAUT

Appeal No. 94-0825
Application 07/908,860¹

HEARD: AUGUST 5, 1997

Before WILLIAM F. SMITH, PAK and WALTZ, *Administrative Patent Judges*.

WALTZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 17 to 20. Claims 21 to 32, the only other claims in this application, stand withdrawn from

¹ Application for patent filed July 1, 1992. According to appellants, this application is a continuation of Application 07/475,279 filed February 5, 1990, now abandoned.

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consideration due to a requirement for restriction (see the brief, page 1, and 37 CFR § 1.142(b)).

The subject matter on appeal is drawn to siloxane compounds with a tetramethyl-piperidyl substituent (brief, pages 2-3, and appealed claim 17). As noted by appellants on page 4 of the brief, the claims stand or fall together. The subject matter on appeal is adequately represented by appealed claim 17, which is reproduced and attached to this decision as an Appendix.

The reference relied upon by the examiner is:

Nohr et al. (Nohr)	8932719-A	Oct. 19, 1989
(Australian) ²		

Claims 17 to 20 stand rejected under 35 U.S.C. § 102(g) as being anticipated by Australian Patent application 8932719-A, which claims priority to abandoned U.S. Patent Application Number 07/181,623.³ We reverse this rejection.

² Actually the Australian Patent application 8932719-A has never been put into this application record but the examiner has relied upon a Derwent Abstract of this Australian Patent application. The date of this abstract is not part of the record but is immaterial to our decision.

³ The final rejection also included a rejection of claims 17 to 20 under 35 U.S.C. § 102(a) over abandoned application number 07/181,623. This rejection was withdrawn by the examiner in the Advisory Action dated April 26, 1993.

OPINION

The following facts do not appear to be in dispute between the examiner and appellants: (1) the appealed claims have a priority date of February 3, 1989, since appellants have perfected their claim of priority with a certified translation of the French priority document; (2) the Australian Patent application was published on October 19, 1989; and (3) the Derwent abstract of the Australian Patent application indicates "priority" to abandoned U.S. Patent application 07/181,623 filed April 4, 1988 (see the brief, page 6).

The sole issue before us is whether it is proper for the examiner to reject claims under § 102(g) based upon a foreign application published after appellants' effective filing date that claims priority to an abandoned U.S. patent application filed prior to appellants' effective filing date (see the brief, page 4). We have carefully reviewed the appellants' arguments in the main and reply briefs and the examiner's position stated in the answer. However, it appears that this issue is directly on point with *Ex parte Smolka*⁴, a decision of an expanded panel of the Board of Appeals, which states, at page 234, "[I]t is our

⁴ 207 USPQ 232 (Bd. App. 1980), a copy of which is attached to this decision.

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view that under these circumstances, 35 U.S.C. 102(g) does not provide a proper basis for rejecting the claims on appeal."

These circumstances were the same as the rejection in this application, as detailed on page 235 of *Smolka*:

In the event that the Examiner's rejection is construed as being based upon a foreign patent publication which is relying for priority upon an abandoned United States application, the rejection would be clearly improper. The courts in such cases as *Monarch Marking System v. Dennison Mfg. Co.*, 92 F.2d 90, 34 USPQ 85 (6th Cir. 1937) and *Joseph Bancroft & Sons Co. v. Brewster Finishing Co., Inc.*, 113 F. Supp. 714, 98 USPQ 187 (D.N.J. 1953), *aff'd*, 210 F.2d 677, 100 USPQ 365 (3rd Cir. 1954), have long held that the foreign patent document and its prior abandoned United States counterpart application do not provide a proper basis for rejecting claims in an application filed prior to the publication date of the foreign document but subsequent to the filing date of the United States application.

Although the examiner's rejection under § 102(g) is improper in this application, there are references available under 35 U.S.C. § 102(e) for the examiner's consideration.⁵ Upon return of the application, the examiner should review these three patents and determine whether they adversely affect the patentability of the pending claims.

⁵ U.S. Patent Nos. 4,859,759, 4,920,168, and 4,923,914 have issued from related applications to abandoned application 07/181,623. All of these patents, copies of which accompany this decision, contain disclosure corresponding to that found in the abandoned application.

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For the foregoing reasons, the rejection of claims 17 to 20 under 35 U.S.C. § 102(g) as being anticipated by Australian Patent application 8932719-A, with priority claimed to abandoned U.S. Patent application 07/181,623, is reversed.

REVERSED

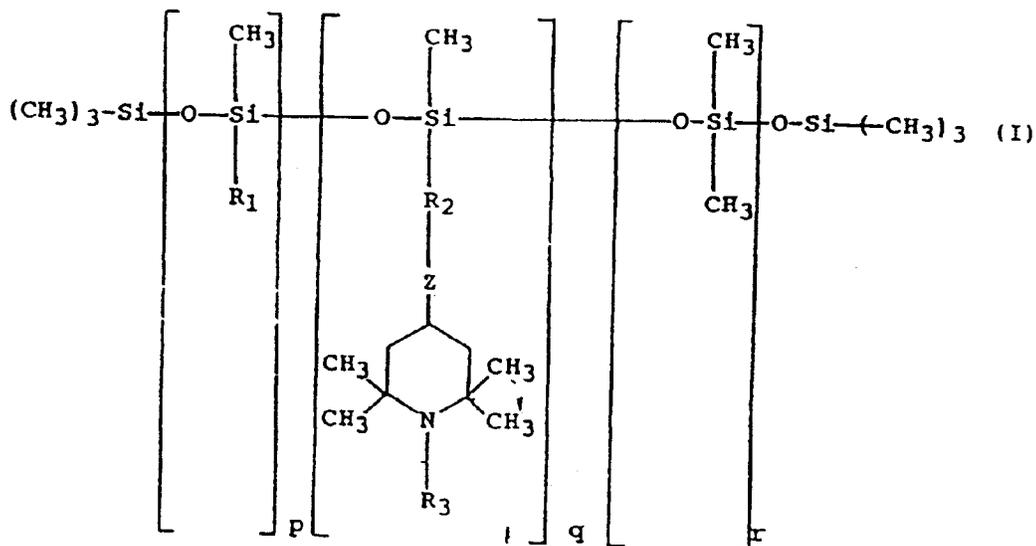
WILLIAM F. SMITH)	
Administrative Patent Judge)	
)	
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)	
CHUNG K. PAK)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS
)	AND
)	INTERFERENCES
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APPENDIX

17. A compound having the formula (I):



in which p and r are numbers equal to or greater than 0; q is a number greater than 0; the sum of $p + r + q$ is greater than or equal to 5; R_1 is a linear or branched chain alkyl radical having more than 4 carbon atoms, a radical of the formula $-(CH_2)_n-COO-R_4$ in which n is a number ranging from 5 to 20 and R_4 is an alkyl radical having from 1 to 12 carbon atoms; or a radical of the formula $-(CH_2)_m-OR_5$ in which m is a number ranging from 3 to 10 and R_5 is a hydrogen atom, an ethylene oxide chain, a propylene oxide chain or an acyl radical having from 2 to 12 carbon atoms; R_2 is a linear or branched chain alkylene radical having from 2 to 18 carbon atoms, an

alkylene-carbonyl radical, the linear or branched chain alkylene moiety of said alkylene-carbonyl radical having from 2 to 20 carbon atoms, an alkylene-cyclohexylene radical, the linear or branched chain alkylene moiety of said alkylene-cyclohexylene radical having from 2 to 12 carbon atoms and the cyclohexylene moiety contains an -OH group and optionally one or two alkyl radicals having from 1 to 4 carbon atoms, a radical of the formula $-R_6-O-R_7-$ in which the radicals R_6 and R_7 , which may be identical or different, are each an alkylene radical having from 1 to 12 carbon atoms, a radical of the formula $-R_6-O-R_7-$ in which the radicals R_6 and R_7 , which may be identical or different, are each an alkylene radical having from 1 to 12 carbon atoms and either or both are substituted by one or two OH groups, a radical of the formulae $-R_6-COO-R_7-$ or $-R_6-OCO-R_7-$ in which the radicals R_6 and R_7 , which may be identical or different, are each an alkylene radical having from 1 to 12 carbon atoms or a radical of the formula $-R_6-O-R_7-O-CO-R_8-$ in which R_6 , R_7 and R_8 , which may be identical or different, are each an alkylene radical having from 2 to 12 carbon atoms and the radical R_7 is substituted by a hydroxyl group; R_3 is a hydrogen atom or a linear or branched chain alkyl radical having from 1 to 12 carbon atoms; and Z is -O- or $-NR_8-$ wherein R_8 has the definition of R_3 .

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