

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGE A. PAPSIN, JR.

Appeal No. 2000-0346
Application No. 08/868,353

ON BRIEF

Before KIMLIN, GARRIS, and WALTZ, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1, 3-11 and 21-34, which are all of the claims remaining in the application.

The subject matter on appeal relates to a film laminating adhesive composition comprising a stable blend of at least one aqueous N-methylol-based polyacrylic dispersion and at least one polyalkyleneimine. The appealed subject matter also

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relates to a method for the preparation of (1) a film laminating adhesive composition of the type previously mentioned and (2) a bonded laminate obtained in using such a composition. This appealed subject matter is adequately illustrated by claims 1 and 32 which read as follows:

1. A film laminating adhesive composition comprising a stable blend of:
 - a) at least one aqueous N-methylol-based polyacrylic dispersion; and
 - b) at least one polyalkyleneimine.

32. A film laminating adhesive composition for preparing bonded laminates, said bonded laminates prepared by a method comprising the steps of:
 - a) coating a first flexible film with the adhesive according to Claim 21;
 - b) heating the coated flexible film to form a dried coated substrate; then
 - c) applying onto said substrate a second flexible film using heat and pressure.

The references set forth below are relied on by the examiner as evidence of obviousness:¹

De Long

4,082,882

Apr. 04, 1978

¹ On page 6 of the answer, the examiner refers to prior art (i.e., "(1) the Hart et al. reference cited and supplied by appellant in his Information Disclosure Statement . . . and (2) page 1, lines 16-17 of appellant[']s specification") in support of his obviousness conclusion but which has not been included in his statement of the rejection. Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection. See In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970) as well as the Manual of Patent Examining Procedure (MPEP) section 706.02 (j) (August 2001). We have not considered the aforementioned prior art in our assessment of the examiner's rejection since this prior art is not included in his statement of rejection.

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Druschke et al. (Druschke)	4,529,772	Jul. 16, 1985
Mirle et al. (Mirle)	5,500,470	Mar. 19, 1996
Wierer et al. (Wierer)	5,508,100	Apr. 16, 1996

Claims 32-33 stand rejected under the second paragraph of 35 U.S.C. § 112 for failing to particularly point out and distinctly claim the subject matter which the appellant regards as his invention.

All of the claims on appeal stand rejected under 35 U.S.C. § 103 as being unpatentable over (1) De Long in views of Wierer or Druschke or Mirle and (2) alternatively over Wierer or Druschke or Mirle in view of De Long.

We refer to the brief and reply brief and to the answer for a complete discussion of the opposing views expressed by the appellant and by the examiner regarding the above-noted rejections.

OPINION

We cannot sustain any of these rejections for the reasons set forth below.

Considering the section 112, second paragraph, rejection, the examiner expresses his position on page 4 of the answer in the following manner.

Specifically, the Examiner[']s position is that claim 32, while purporting to define an adhesive composition, rather instead constitutes an article by-process claim ie [sic] this claim is held/seen to be an improper hybrid in that the preamble thereof is inconsistent with the remainder of the claim, and it is unclear whether applicant[']s intent is to claim a composition or an article; further along this line, composition claims should not contain limitations drawn to (a) process steps, as in claim 32, or (b) substrate materials, as in claim 33 (which depends from claim 32).

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In response, appellant argues that claim 32 “is clearly directed to a film laminating adhesive composition where the components of the adhesive composition of claim 21 are selected for their suitability in the specified method for preparing bonded laminates” (brief, page 4). This argument (which the examiner has not specifically rebutted) has merit.

When viewed with this argument in mind, claim 32 (and claim 33 which depends therefrom) defines with adequate particularity, a film laminating adhesive composition which contains the ingredients of claim 21 that are suitable for preparing bonded laminates in accordance with the method steps recited in claim 32 (and correspondingly wherein the substrate of this method is selected from the group listed in dependent claim 33).

Under these circumstances, we cannot sustain the section 112, second paragraph, rejection of claims 32 and 33.

With respect to the alternative section 103 rejections, it is appropriate to reiterate the appellant’s point that De Long’s composition is utilized as an anti-fouling overcoat for watercraft structures whereas the compositions of Wierer or Druschke or Mirle are utilized as adhering or binding agents. Particularly in light of these disparate utilities, there would have been no suggestion, or a reasonable expectation of success, for combining the applied reference teachings in the manner proposed by the examiner. See In re O’ Farrell, 853 F.2d 894, 904, 7 USPQ2d 1673, 1680-1681 (Fed. Cir. 1988)

(obviousness under section 103 requires a suggestion for the proposed modification and

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a reasonable expectation that the proposed modification would be successful). That is, these references contain no suggestion, or reasonable expectation of success, for providing the composition of De Long with a N-methylol-based polyacrylic of the type disclosed in Wierer or Druschke or Mirle or alternatively for providing the composition of Wierer or Druschke or Mirle with a polyalkyleneimine of the type taught by De Long.

For the above stated reasons, we also cannot sustain any of the section 103 rejections advanced by the examiner in this appeal.

The decision of the examiner is reversed.

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
BRADLEY R. GARRIS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
)	
THOMAS A. WALTZ)	
Administrative Patent Judge)	

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