

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRIAN CLARK

Appeal No. 2000-1980
Application No. 08/476,980¹

ON BRIEF

Before WILLIAM F. SMITH, ROBINSON, and ADAMS, Administrative Patent Judges.
ROBINSON, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 6, 7, 27 - 29 and 31. Claims 14 -24, 30, 32, and 33 stand withdrawn from consideration by the examiner and are not before us on appeal.²

¹ This application is directed to subject matter which is closely related to the subject matter claimed in Application No. 08/436,086, filed May 8, 1995, which is the subject of Appeal No. 1998-2196, currently before the Board. We have considered the two appeals together.

² There appears to be some confusion as to the claims currently pending in this application. The Brief at page 2 indicates that claims 1, 6, 7, 27 - 29 and 31 remaining pending. The examiner does not disagree. (Answer, page 1). However, claims 14 - 24, 30, 32, and 33 were withdrawn from consideration by the examiner in the Office action of July 21, 1997 (Paper No. 14) and we find no indication in this record that these claims have been canceled.

Appeal No. 2000-1980
Application No. 08/476,980

Claim 1 is illustrative of the subject matter on appeal and read as follows:

1. An article comprising a surface functionalized polyaryl addition polymer having at least about 5% of the aryl groups in said polyaryl addition polymer to a depth of 100A, as determined by ESCA substituted with a functionalized nitrogen-containing group, with the remaining aryl groups substantially unsubstituted with said functionalized nitrogen-containing group.

The references relied upon by the examiner are:

Kenyon et al. (Kenyon)	3,981,775	Sep. 21, 1976
Janata	4,151,049	Apr. 24, 1979
Okrongly	4,933,410	Jun. 12, 1990
Clark	5,484,852	Jan. 16, 1996

Grounds of Rejection

Claims 1, 6, 7, 27 - 29 and 31 stand rejected under 35 U.S.C. § 102(b) or, alternatively, under 35 U.S.C. § 103. As evidence of anticipation/obviousness, the examiner relies upon Kenyon and Janata.

Claims 1, 6, 7, and 31 stand rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 10, 11, and 12 of U.S. Patent 4,933,410 or of claims 1, 2, 3, and 4 of U.S. Patent 5,484,852.

We reverse the rejections for the reasons which follow.

Discussion

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims and to the respective positions articulated by the appellant and the examiner. We make reference to the Examiner's Answer of November

Appeal No. 2000-1980
Application No. 08/476,980

16, 1998 (Paper No. 24) for the examiner's reasoning in support of the rejections and to the appellant's Appeal Brief filed August 13, 1998 (Paper No. 23) for the appellant's arguments thereagainst.

The rejections under 35 U.S.C. § 102(b) or 103

Anticipation requires the disclosure, in a single prior art reference, of each element of the claim under consideration. W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). In considering Kenyon and Janata, we agree with the appellant that neither reference describes an article of the type presently claimed. Kenyon describes grafting p-nitro styrene or p-nitrophenylacrylate to a polyaryl polymeric material (col. 1, lines 43-45). However, Kenyon does not substitute the aryl groups present in the polymer chain. Similarly, Janata grafts the hydrocarbon chain into the polymer article described. This process, also, does not reasonably appear to result in an article wherein at least a portion of the aryl groups present in the polyaryl polymer are substituted with a nitrogen containing group. Thus, we conclude that neither Kenyon nor Janata explicitly or implicitly describe a substance which would anticipate the presently claimed article.

The examiner presents no analysis which would indicate how Kenyon or Janata would have made obvious the presently claimed article. Therefore, we reverse these rejections of claims 1, 6, 7, 27 - 29 and 31.

The rejections under 35 U.S.C. § 101

The examiner has rejected claims 1, 6, 7, and 31 under 35 U.S.C. § 101 as claiming the same invention as claimed in claims 10, 11, and 12 of U. S. Patent 4,933, 410 to Okrongly and claims 1, 2, 3, and 4 of U.S. Patent 5,484,852 to Clark. With respect to Okrongly, the examiner urges that "[t]he 'polystyrene surface' of [the] patent does not distinguish over [the] 'article' of present claims and/its surface." (Answer, page 3). As to Clark, the examiner urges that "[t]he polar groups recited in patent includes the nitrogen-containing group in claimed subject matter." (Answer, page 4). As noted by appellant, "[s]tatutory double patenting requires that the claims be directed to the same invention." (Brief, page 6-7). In re Vogel, 422 F.2d 438, 441, 164 USPQ 619, 621 (CCPA 1970). Claims 10, 11, and 12 of Okrongly do not require that the article have "at least 5% of the aryl groups in said polyaryl addition polymer to a depth of 100D . . . substituted with a functionalized nitrogen-containing group." (Appealed Claim 1). Thus, the claims of Okrongly are not directed to the same invention as appealed claims 1, 6, 7, and 31. Claims 1 - 4 of Clark require that the aryl group be substituted with "a polar group." Appealed claim 1 requires the aryl groups of the polyaryl addition polymer to be substituted with an "nitrogen-containing group." While there may be overlap in the defined substituents, the claim limitation relating to this substituent are not the same as indicated by appellant's discussion at page 7 of the Appeal Brief.

Thus, claims 1, 6, 7, and 31 are not directed to the same invention as claimed in either Okrongly or Clark. Therefore, the rejection of these claims under 35 U.S.C. § 101 is reversed.

Other Issues

Should further prosecution occur in this application we would urge the examiner to step back and consider, anew, the present claims in light of both Okrongly and Clark. While we have determined that the claims of these patents are not directed to the identical invention as presently claimed in this application, we recognize the possibility of overlap as to the subject matter encompassed by these two patents and the claims before us. We would, thus, urge the examiner to evaluate the facts of this application with a view to determine whether a rejection under the judicially-created doctrine of obviousness-type double patenting may be appropriate. (See In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); Georgia-Pacific Corp. v. United States Gypsum Co., 195 F.3d 1322, 52 USPQ2d 1590 (Fed. Cir. 1999); and In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985)). The examiner should, in the first instance, consider the record as a whole to determine whether such a rejection is appropriate in this case. We note, for example, the extensive restriction requirements which occurred in the instant application as well as in the application which resulted in the issuance of Clark ('852). We do not have available the file record for Application No. 08/330,207 which issued as Okrongly ('410). Thus, we leave it to the examiner to evaluate the record of all three applications and determine if there is a reasonable basis for questioning the patentability of the claims in this application. Should the examiner determine that there is a basis for rejecting the claims of this application under the judicially created doctrine of

Appeal No. 2000-1980
Application No. 08/476,980

obviousness-type double patenting, the examiner should issue an appropriate Office action setting forth the basis for such a rejection and provide appellant with the appropriate opportunity to respond thereto.

Summary

The examiner's determination that the claims pending in this application are unpatentable under 35 U.S.C. § 102(b) or, alternatively, under 35 U.S.C. § 103, is reversed. The examiner's determination that the claims pending in this application are unpatentable under 35 U.S.C. § 101 is reversed.

AFFIRMED

WILLIAM F. SMITH)
Administrative Patent Judge)
)
)
) BOARD OF PATENT
DOUGLAS W. ROBINSON)) APPEALS AND
Administrative Patent Judge)
) INTERFERENCES
)
DONALD E. ADAMS)
Administrative Patent Judge)

MORRISON & FOERSTER
SUITE 5500
2000 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20006-1888

Appeal No. 2000-1980
Application No. 08/476,980

DWR/jlb