

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ALAN W. KOHR  
and  
KARL J. HARTMAN

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Appeal No. 2001-0127  
Application No. 09/121,636

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ON BRIEF

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Before WARREN, TIMM, and DELMENDO, Administrative Patent Judges.  
DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 through 10, which are all of the claims pending in the above-identified application.<sup>1</sup>

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<sup>1</sup> In reply to the final Office action of Aug. 13, 1999 (paper 7), the appellants submitted an amendment under 37 CFR § 1.116 (1981) on Nov. 17, 1999 (paper 8), proposing changes to claim 1. The examiner indicated in the advisory action of Nov. 23, 1999 (paper 9) that the amendment will be entered for

The subject matter on appeal relates to a polymer composition (claims 1-5) and to a "method for improving the burnish response of a floor polish composition" comprising using the polymer composition in the floor polish composition (claims 6-10). Further details of this appealed subject matter are recited in illustrative claims 1 and 6 reproduced below:

1. A polymer composition comprising an aqueous suspension or dispersion of a water insoluble polymer of ethylenically unsaturated monomers, said polymer having a Tg of at least 35°C and comprising 25% to 65% by weight units of isobutyl methacrylate (IBMA) and butyl methacrylate (BMA) and 3% to 50% by weight units of at least one acidic monomer.

6. A method for improving the burnish response of a floor polish composition, which method comprises using in the floor polish composition an aqueous suspension or dispersion of a water-insoluble polymer of ethylenically unsaturated monomers, said polymer having a Tg of at least 35°C and comprising 25% to 65% by weight units of IBMA and BMA, and 3% to 50% by weight units of at least one acidic monomer.

The examiner relies on the following prior art reference as evidence of unpatentability:

Anton et al.	5,798,426	Aug. 25, 1998
(Anton)	(effective filing date May 10, 1996)	

Claims 1 through 10 on appeal stand rejected under 35 U.S.C. § 103(a) as unpatentable over Anton. (Final Office

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purposes of this appeal. We note, however, that the amendment has not been clerically entered.

action, pages 2-3; examiner's answer of Apr. 10, 2000, paper 12, pages 2-7.)

We affirm this rejection for the reasons well stated in the examiner's answer. Nevertheless, we add the following comments for emphasis.<sup>2</sup>

As the examiner correctly found (answer, pages 2-3), Anton describes an acrylic polymer having a Tg of 21-43°C and containing 30-60% by weight of butyl methacrylate, 20% by weight of acetoacetoxy ethyl methacrylate, and 10% by weight of acrylic acid. (Column 1, line 33 to column 2, line 56; column 3, line 52 to column 4, line 32; column 4, lines 61-63; Example 4.) According to Anton, the polymer may be dispersed in water. (Column 2, lines 39-56.) Anton also teaches that isobutyl methacrylate and butyl methacrylate are interchangeable monomers and suggests that mixtures of ethylenically unsaturated monomers may be used to provide a polymer having the requisite Tg. (Column 3, lines 19-46).

Based on Anton's teachings as a whole, we share the examiner's view that one of ordinary skill in the art would have

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<sup>2</sup> The appellants submit that "claims 1-5 stand or fall as a group independently from claims 6-10" (appeal brief, p. 5) and present arguments in support of these two claim groupings. We therefore confine our discussion to representative claims 1 and 6 for purposes of deciding this appeal, with claims 2-5 standing

found it prima facie obvious to formulate an aqueous composition comprising an acrylic polymer having the claimed Tg and containing 10-40% by weight of methyl methacrylate, 30-60% by weight of butyl methacrylate and isobutyl methacrylate (e.g., 59% butyl methacrylate and 1% isobutyl methacrylate), 20% by weight of acetoacetoxy ethyl methacrylate, and 10% by weight of acrylic acid, thus arriving at a composition encompassed by appealed claim 1. The motivation or suggestion to modify Anton's disclosed acrylic polymer to include both butyl methacrylate and isobutyl methacrylate comes from the express teachings of the same reference as a whole, which suggests that mixtures of monomers may be used. In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991) (citing In re Dow Chemical Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988)).

Moreover, one of ordinary skill in the art would have found, prima facie, the requisite teaching, motivation, or suggestion to combine butyl methacrylate with isobutyl methacrylate, each of which is taught in Anton to be useful for the same purpose, in order to form a third monomer mixture to be

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or falling together with claim 1 and claims 7-10 standing or falling together with claim 6. 37 CFR § 1.192(c)(7) (1997).

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used for the very same purpose. In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

The appellants argue that one of ordinary skill in the art would have been led away from using isobutyl methacrylate, either alone or in combination with butyl methacrylate, because it is not recited in any claim of the Anton patent and it is not one of the preferred monomers as described in the reference at column 3, lines 47-51. (Appeal brief, pages 6-8.) This argument has no merit. All of the disclosures of a prior art reference, including non-preferred embodiments, must be considered for what they fairly teach one of ordinary skill in the art. Merck & Co. Inc. v. Biocraft Labs. Inc., 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989); In re Fracalossi, 681 F.2d 792, 794 n.1, 215 USPQ 569, 570 n.1 (CCPA 1982); In re Lamberti, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976); In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966).

The appellants argue that Anton does not teach combining butyl methacrylate and isobutyl methacrylate and "using the resulting polymer in a method to achieve surprising performance improvements in floor polishes." (Appeal brief, page 8.) On this point, however, we are in complete agreement with the examiner's analysis at pages 5-6 of the answer.

The appellants urge that "[t]he results presented in Table 1 of the present application clearly indicate unexpected surprising properties of polishes comprising the copolymers of the present invention." (Appeal brief, page 8; see also reply brief filed Jun 27, 2000, paper 14, page 3.) We disagree.

Table 1 (specification, page 15) reports "Floor Test Data" for four different polymers, namely Polymers A, B, C, and D. Polymer A is said to contain 45% by weight of isobutyl methacrylate, 45% by weight of styrene, and 10% by weight of methacrylic acid; Polymer B is said to contain 10% by weight of isobutyl methacrylate, 35% by weight of butyl methacrylate, 45% by weight of styrene, and 10% by weight of methacrylic acid; Polymer C is said to contain 34% by weight of isobutyl methacrylate, 30% by weight of styrene, 26% by weight of methyl methacrylate, and 10% by weight of methacrylic acid; and Polymer D is said to contain 20% by weight of isobutyl methacrylate, 25% by weight of butyl methacrylate, 45% by weight of styrene, and 10% by weight of methacrylic acid. (Specification, page 10.) Thus, Polymers B and D are polymers within the scope of the appealed claims, while Polymers A and C are outside the scope of the appealed claims.

The relied upon evidence, however, lacks a comparison of the claimed invention against the closest prior art, which is an aqueous composition comprising an acrylic polymer having a Tg of 21-43°C and containing 30-60% by weight of butyl methacrylate, 20% by weight of acetoacetoxy ethyl methacrylate, and 10% by weight of acrylic acid. In re Baxter Travenol Labs, 952 F.2d 388, 392, 21 USPQ 1281, 1285 (Fed. Cir. 1991) ("[R]esults must be shown to be unexpected compared with the closest prior art.").

Furthermore, the relied upon evidence is not commensurate in scope with the claims. In re Kulling, 897 F.2d 1147, 1149, 14 USPQ2d 1056, 1058 (Fed. Cir. 1990) ("'[O]bjective evidence of nonobviousness must be commensurate in scope with the claims.'"; (quoting In re Lindner, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972)); In re Dill, 604 F.2d 1356, 1361, 202 USPQ 805, 808 (CCPA 1979) ("The evidence presented to rebut a prima facie case of obviousness must be commensurate in scope with the claims to which it pertains.").

In this regard, Polymers B and D are limited to those containing 10 or 20% by weight of isobutyl methacrylate, 25 or 35% by weight of butyl methacrylate, 45% by weight of styrene, and 10% by weight of methacrylic acid. By contrast, appealed

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claim 1 is significantly broader in scope. For example, the appellants' relied upon evidence does not include a showing that a polymer having a Tg of 35-43°C and containing 10-40% by weight of methyl methacrylate, 30-59% of butyl methacrylate, 1% of isobutyl methacrylate, 20% by weight of acetoacetoxy ethyl methacrylate, and 10% by weight of acrylic acid would provide results that are comparable to those reported for Polymers B and D.

For these reasons and those set forth in the answer, we affirm the examiner's rejection under 35 U.S.C. § 103(a) of all the appealed claims as unpatentable over Anton.

The decision of the examiner is affirmed.

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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

Charles F. Warren	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
Catherine Timm	)	
Administrative Patent Judge	)	APPEALS AND
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	)	INTERFERENCES
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Romulo H. Delmendo	)	
Administrative Patent Judge	)	

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