

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 18

MAILED

UNITED STATES PATENT AND TRADEMARK OFFICE

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PAT.&T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM L. O'BRIEN
and WILLIAM J. MERTZ

Appeal No. ~~94-03947~~
Application 07/460,422¹

ON BRIEF

Before KIMLIN, GARRIS and TURNER, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 10-12, 15, 18 and 21-26. Claims 1-9, 13, 14, 16, 17, 19 and 20, the other claims remaining in the present application, stand withdrawn from consideration pursuant to a restriction requirement. Claim 10 is illustrative:

¹ Application for patent filed January 3, 1990.

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Appealed claims 10-12, 15, 18 and 21-26 stand rejected under 35 U.S.C. 103 as being unpatentable over Mertz.

We have carefully reviewed the respective positions of appellants and the examiner. In so doing, we find that the disclosure of Mertz fails to establish a prima facie case of obviousness for the claimed subject matter. Accordingly, we will not sustain the examiner's rejection.

There is no dispute that the claimed liquid polyester has three properties or characteristics which are not shared by the polyester plasticizers of Mertz. Firstly, whereas Mertz discloses that the polyester is prepared by reacting the appropriate monomers with a terminating agent, such as an aliphatic saturated monofunctional alcohol having from 6 to 13 carbon atoms or an aliphatic saturated monocarboxylic acid having from about 6 to 13 carbon atoms, appellants' claimed polyester is "unterminated." As stated at page 7, lines 12 and 13 of the specification, the reaction mixture of the present invention "does not include a polymerization terminator." Secondly, whereas the claimed polyester has a weight average molecular weight of from about 3,000 to about 10,000, the polyesters of Mertz generally have average molecular weights in the range of 500 to about 2,000. In addition, the copolyesters of the reference have a hydroxyl value less than about 25, while the claimed polyester has a hydroxyl value of at least 25.

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Since Mertz provides no teaching, suggestion or even hint that the plasticizing polyesters can be untermiated, which untermiation results in the claimed higher hydroxyl value, we must concur with appellants that the only motivation for modifying Mertz in the manner proposed by the examiner emanates from appellants' own disclosure which, of course, amounts to the application of impermissible hindsight. In our view, appellants, in preparing their plasticizing liquid polyester, have proceeded contrary to the teachings of the prior art.

We also do not agree with the examiner that the referenced molecular weight of about 2,000 renders obvious the claimed lower limit of about 3,000. While it is generally a matter of prima facie obviousness for the skilled artisan to determine the optimum value of a parameter within a range disclosed by the prior art, it is generally not considered obvious for one of ordinary skill in the art to operate outside a range disclosed by the prior art. In re Sebek, 465 F.2d 904, 175 USPQ 93 (CCPA 1972). Also, while the claimed lower limit of at least 25 for the hydroxyl value does not, in itself, serve as an unobviousness distinction over the prior art upper limit of less than about 25, we find that the claimed invention, considered in its entirety, would not have been prima facie obvious over the Mertz disclosure.

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John E. Drach, Jr.
Law Dept.
Henkel Corporation
300 Brookside Avenue
Ambler, PA 19002