

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD T. GRAY, JOSEPH M.
OWENS and HARRISON S. KILLAM

Appeal No. 94-1058
Application 07/464,844¹

ON BRIEF

MAILED

APR 29 1996

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

Before KIMLIN, TURNER and WEIFFENBACH, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-5, 13 and 18. Claims 6-11, the other claims remaining in the present application, have been allowed by the examiner. Claim 1 is illustrative:

¹ Application for patent filed January 16, 1990.

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Upon careful consideration of the opposing arguments presented on appeal, we find that the Bernard reference fails to establish a prima facie case of anticipation/obviousness for the claimed subject matter. Accordingly, we will not sustain the examiner's rejection.

There is no dispute that Bernard discloses a polymeric composition which comprises three components in common with appellants' polymeric composition. For instance, both the compositions encompassed by the appealed claims and disclosed by Bernard comprise a major portion of an alkyl acrylate, a polar monomer such as acrylic acid, and a crosslinking multifunctional monomer. While the examiner recognizes that Bernard is silent with respect to the claimed properties of appellants' composition, such as swellability and resistance to alkaline detergent, the examiner believes there is sufficient correspondence between the claimed and referenced compositions to shift to appellants the burden of proving that the polymeric compositions of Bernard do not have the claimed properties.

It is well settled that when a claimed product appears to be substantially identical to a product disclosed by the prior art, the burden is on the applicant to prove that the product of the prior art does not necessarily or inherently possess characteristics or properties attributed to the claimed product. Under such circumstances, a rejection may be properly made under

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§ 102 or § 103. In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990); In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980); In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977). In the present case, however, we are not persuaded that the examiner has adequately demonstrated, in the first instance, the substantial identity between the polymeric compositions claimed and disclosed by Bernard. We say this because not only do the claimed and Bernard compositions have different utilities, appellants' as a protective polish and Bernard's as a pressure sensitive adhesive, but the relative amounts of the compositional components do not generally correspond. While the present specification discloses that the composition contains a polar monomer, such as acrylic acid, in an amount of 3-50%, Bernard's composition contains only up to about 2% of polar monomer. In addition, whereas appellants' composition comprises 0.15-12% of crosslinking monomer, Bernard discloses that the amount of crosslinking monomer should not exceed about 1%. Although the examiner relies upon the fact that both appellants and Bernard teach that the crosslinking monomer can be hexan-1,6-diol diacrylate, appellants correctly point out that their specification teaches and exemplifies that when a crosslinking monomer which has only one type of reactive functionality is selected, such as hexan-1,6-diol diacrylate, a greater amount of the crosslinking monomer is necessary to render the composition

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effectively swellable and resistant to alkaline detergent, e.g., about 5-8% (see the specification at the last full paragraph of page 8 and the paragraph bridging pages 8 and 9). Table 7 at page 27 of the specification exemplifies that a composition comprising 1.9% hexan-1,6-diol diacrylate has poor removability, whereas a composition comprising 7.6% of the same crosslinking monomer has excellent removability. Since Bernard teaches that hexane diol diacrylate is the preferred crosslinking monomer and that its amount should not exceed 1%, and Bernard also teaches the preparation of a pressure-sensitive adhesive with no more than 2% polar monomer, it cannot reasonably be said that the compositions of Bernard are inherently swellable and resistant to alkaline detergent.

Accordingly, based on the foregoing, the examiner's decision rejecting the appealed claims is reversed.

REVERSED

Edward C. Kimlin
EDWARD C. KIMLIN)
Administrative Patent Judge)

Vincent D. Turner
VINCENT D. TURNER)
Administrative Patent Judge)

Cameron Weiffenbach
CAMERON WEIFFENBACH)
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