

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LARRY D. BOARDMAN and JOEL D. OXMAN

Appeal No. 95-0331
Application No. 07/626,904¹

ON BRIEF

Before JOHN D. SMITH, GARRIS and WARREN, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 2, 3, 5, 7-13, 15-17, 19, 20, 22, 24, 26-32, 34-36, 42, 43, 46-51, 56, 57, 59, 61-63 and 65-87². The only other claims

¹ Application for patent filed December 13, 1990.

² Notwithstanding the examiner's entry authorization (see Paper No. 21), the amendment filed September 12, 1994 (see

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remaining in the application, which are claims 52-55, have been allowed by the examiner.

The subject matter on appeal relates to a hydrosilation process and composition as well as to the products made thereby which involves a particular type of platinum catalyst and a particular type of free-radical photoinitiator. This appealed subject matter is adequately illustrated by independent claim 3, a copy of which taken from the appellants' Brief is appended to this decision.

The references relied upon by the examiner in the prior art rejections before us are:

Gruber 1977	4,017,652	Apr. 12,
McDowell 1979	4,169,167	Sep. 25,
Drahnak 1985	4,530,879	Jul. 23,
Eckberg 1986	4,587,137	May 6,

Paper No. 20) has not been physically entered.

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In support of her double patenting rejections, the examiner has also relied upon the claims of U.S. 4,916,169 (Boardman) and the claims of Application 07/627,009³.

All of the claims on appeal⁴ are rejected under the doctrine of obviousness-type double patenting over the claims of Boardman in view of Drahnak, Eckberg and McDowell.

All of the claims on appeal also are provisionally rejected under the doctrine of obviousness-type double patenting over the claims of the '009 application in view of Drahnak, Eckberg and McDowell.

All appealed claims except claims 10, 29, 78 and 84 are rejected under 35 U.S.C. § 103 as being unpatentable over Drahnak taken with Eckberg in view of McDowell or Gruber or alternatively in view of only McDowell.

³ The examiner's provisional rejection under the doctrine of obviousness-type double patenting over the claims of Application 07/626,905 has been nullified by the fact that this application is now abandoned.

⁴ We observe that dependent claim 62 does not appear to further restrict parent claim 24 as required by the fourth paragraph of 35 U.S.C. § 112. The appellants and the examiner should address and resolve this issue in any further prosecution that may occur.

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Finally, "[c]laims 10, 29, 78 and 84 are rejected under 35 U.S.C. § 103 as being unpatentable over Drahnak and Eckberg as applied to claims 9, 28, 77 and 83 above, and further in view of Boardman '169" (Answer, page 13).

As a preliminary matter, we point out that the appellants have stated that the appealed claims stand or fall together; see page 10 of the Brief.

OPINION

For the reasons which follow, we will sustain each of the above noted rejections except for the examiner's § 103 rejection of claims 10, 29, 78 and 84.

THE OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION

It is appropriate to initially address the appellants' argument that, "[a]ccording to In re Braat, 19 U.S.P.Q.2d 1289 (Fed. Cir. 1991), a 'two-way' determination is necessary in order to sustain a rejection for obviousness-type double patenting" (Brief, page 11). This is incorrect. In fact, under the circumstances of the case at bar, a "one-way" analysis is the proper test for assessing the merits of the

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subject rejection for the reasons fully detailed in In re Emert, 124 F.3d 1458, 44 USPQ2d 1149 (Fed. Cir. 1997).

Furthermore, the record before us on this appeal necessarily leads us to a "one-way" analysis of this rejection since the only arguments presented by the appellants concern a "one-way" as opposed to a "two-way" determination.

Regarding these arguments, we discern no persuasive merit in the appellants' contention that, because the catalyst claimed by Boardman and the catalyst disclosed by Drahnak are dissimilar, it would not have been obvious to replace the former with the latter. In our view, it would have been obvious for one with ordinary skill in the art to replace the claimed catalyst of Boardman with the catalyst of Drahnak in order to obtain the disclosed advantages associated therewith (e.g., see lines 47 through 57 in column 2 and lines 53 through 61 in column 3). Moreover, there would have been a reasonable expectation that the replacement would have enjoyed success since Drahnak expressly discloses using his catalyst for effecting hydrosilation reactions of the type claimed by Boardman (as well as by the appellants). In re O'Farrell, 853 F.2d 894, 903-04, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988).

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Additionally, we agree with the examiner's conclusion that it would have been obvious for one with ordinary skill in the art to provide the process and composition claimed by Boardman with photoinitiators of the type taught by McDowell in view of Eckberg's teaching of using photoinitiators generally in hydrosilation reactions involving platinum catalysts. In this latter regard, we are mindful of the appellants' argument that McDowell contains no disclosure relating his photoinitiators to processes involving hydrosilation reactions and platinum catalysts. From our perspective, however, this deficiency of McDowell is supplied by Eckberg. That is, Eckberg's aforementioned teaching of using photoinitiators generally in hydrosilation reactions involving platinum catalyst would have led an artisan with ordinary skill to a reasonable expectation that the specific photoinitiators of McDowell (which correspond to those here claimed) would be successful in the catalytic hydrosilation processes and compositions claimed by Boardman.

For the above stated reasons, we will sustain the examiner's rejection of all the appealed claims under the

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obviousness-type double patenting doctrine over the claims of Boardman in view of Drahnak, Eckberg and McDowell.

THE PROVISIONAL OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION

The appellants' arguments against the merits of this rejection correspond to those previously discussed with respect to the obviousness-type double patenting rejection over the claims of Boardman. These arguments are unpersuasive for reasons analogous to those set forth previously. We also will sustain, therefore, the examiner's provisional rejection of all the appealed claims under the obviousness-type double patenting doctrine over the claims of the '009 application in view of Drahnak, Eckberg and McDowell.

THE § 103 REJECTIONS

Like the examiner, we conclude that it would have been obvious for an artisan with ordinary skill to use the hydrosilation catalyst of Drahnak in combination with a photoinitiator in accordance with Eckberg's teaching of using photoinitiators and catalysts together in a hydrosilation process or composition and to employ as a specific photoinitiator those of the type taught by McDowell or Gruber.

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As indicated earlier, the artisan would have been motivated to combine these prior art teachings in order to obtain the advantages taught by Drahnak to attend use of his catalyst as well as the advantages taught by Eckberg to attend use of a photoinitiator and catalyst together in the hydrosilation reactions under consideration. Further, the artisan would have had a reasonable expectation of successfully effecting such reactions using Drahnak's catalyst in light of patentee's explicit teachings with respect thereto and using the specific photoinitiators of McDowell or Gruber in light of Eckberg's teachings of employing photoinitiators generally in combination with platinum catalysts to effect hydrosilation reactions. O'Farrell, Id.

In addition to the unpersuasive arguments previously addressed, the appellants argue that the teachings of Drahnak and Eckberg are in conflict and thus not combinable. Specifically, the appellants point out that "the composition of Eckberg would be expected to react prematurely at room temperature because of the nature of the precious metal or precious metal-containing catalyst that Eckberg utilizes" whereas "[t]he catalyst of Drahnak ... would not be expected

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to activate a hydrosilation reaction at temperatures below about 50°C in the absence of actinic radiation" (Brief, page 21, emphasis in original). Contrary to the appellants' belief, their above quoted point militates for rather than against combining the teachings of Eckberg and Drahnak in the manner proposed. That is, an artisan would have been yet further motivated to use the catalyst of Drahnak rather than the catalyst of Eckberg in order to avoid the plainly undesirable premature reaction referred to by Eckberg.

Finally, the appellants argue that both Drahnak and Eckberg are silent with respect to curing by visible radiation. This argument is unpersuasive because none of the independent claims on appeal requires curing by visible radiation and because the appealed claims stand or fall together as noted earlier in this decision. In any event, the argument lacks persuasive merit. While Drahnak may prefer use of ultraviolet radiation for curing, he discloses using actinic radiation generally (see lines 13 through 16 in column 9) and more specifically any radiation source emitting radiation below about 4000 Angstroms (see lines 20 and 21 in column 9), thereby suggesting the use of visible light.

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Further, patentee explicitly teaches using radiation having wavelengths of 3900 Angstroms (see line 46 in column 9), and a 3900 Angstrom wavelength is applicable to both the longest ultraviolet radiation wavelength and the shortest visible radiation wavelength (e.g., see Hackh's Chemical Dictionary, 3rd edition, page 716, copy attached).

Under these circumstances, we also will sustain the § 103 rejection of all appealed claims except for claims 10, 29, 78 and 84 as being unpatentable over Drahnak taken with Eckberg in view of McDowell or Gruber or in view of only McDowell.

However, we cannot sustain the examiner's § 103 rejection of claims 10, 29, 78 and 84 "as being unpatentable over Drahnak and Eckberg as applied to claims 9, 28, 77 and 83 above, and further in view of Boardman '169." On the record before us, the Boardman reference does not appear to be prior art, and the examiner has offered utterly no exposition in support of her implicitly-held contrary view. It follows that the examiner has failed to carry her initial burden of establishing a prima facie case of obviousness with respect to the claims under consideration.

SUMMARY

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We have sustained each of the rejections advanced on this appeal except for the § 103 rejection of claims 10, 29, 78 and 84.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

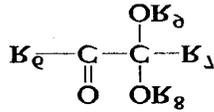
AFFIRMED

JOHN D. SMITH)	
Administrative Patent Judge))	
)	
)	
BRADLEY R. GARRIS)	BOARD OF PATENT
Administrative Patent Judge))	APPEALS AND
)	INTERFERENCES
)	
CHARLES F. WARREN)	
Administrative Patent Judge))	

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ΓΟΙΩΝΗΣ:

αν α-αίκετονη οτ αν α-κετοαίκετονη μάλινά τρε άνεταί
μπερετν αττ ερε-κατταί βροτομτττατοτ τσ α μονοκεταί οτ
καταττον τσ τμττταττεσ νβον εκβοαητε το ατττμττ κατταττον
απαοττμττ ατττμττ κατταττον αησν τμττ τρε μλκτοαττταττον
αυτ α ερε-κατταί βροτομτττατοτ τμττ τσ ατταττε οτ

μπεν εττμττ K₄ οτ K₂ τσ νοτ ατττ αττκευττ κατταί:
ποττ K₄ αυτ K₂ ατε ατττ αττκευττ κατταί αυτ πετμττ ονε
α
τεβρεσεντα αετο οτ ονε' πετμττ αετο οητλ μπεν
βοατττον μττμ κατταττε το τρε α-ποητετ βοατττον: αυτ
αττκευττ οτ ατττοαττκευττ κατταί πετμττ τμ α α- οτ α-
α οτ ε κτμττ ατττον ατταττε' τρε μπαττατταττεττ ποητ οτ τρε

μάλινά ττωμ ονε το εττμττεσ ατττον ατταττε' αυτ μλκτοαττε.
τμττετερε μττμ τρε μλκτοαττταττον καταττον' αττμπατταί άποητα
άποητα αππαττατταττεττ μττμ ονε οτ ποητε άποητα τμττ το νοτ
άποητα αοηταττμττ οτ μπαπαττατταττεττ αττλ άποητα αυτ αττλ
αησν τμττεβουαετταττλ τεβρεσεντα α μωμπετ αετταττεττ ττωμ τρε
τμττετερε μττμ τρε μλκτοαττταττον καταττον' K₁' K₈' αυτ K₉
άποητα αππαττατταττεττ μττμ ονε οτ ποητε άποητα τμττ το νοτ
μπερετν K₆ τεβρεσεντα αν μπαπαττατταττεττ αττλ άποητα οτ αν αττλ