

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 40

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEAN-PAUL BINDELLE

Appeal No. 95-3615
Application No. 08/003,401¹

HEARD: February 8, 1999

Before GARRIS, WALTZ and KRATZ, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the refusal of the examiner to allow claims 1 and 3 through 6 as amended subsequent to the final rejection. The only other claim remaining in the application, which is claim 13, stands allowed by the examiner.

¹ Application for patent filed January 12, 1993.

Appeal No. 95-3615
Application No. 08/003,401

The subject matter on appeal relates to a continuous process for removing residual monomer from an aqueous latex of a synthetic polymer. This appealed subject matter is adequately illustrated by independent claim 1 which reads as follows:

1. A continuous process for removing residual monomer from an aqueous latex of a synthetic polymer comprising:

treating said latex of a synthetic polymer containing residual monomer by passage through a heat exchanger comprising a closed chamber divided into two distinct superposed parts, an unobstructed upper part placed under reduced pressure and adapted to communicate with a plant for recovery of the residual monomer, and a lower part equipped with a partitioning bounding two separate extended and adjoining circuits, one of the circuits being traversed by the latex to be treated and being maintained in communication, via a top face extending over its entire path with the upper part of the chamber, and the other circuit, isolated from the upper part of the chamber, being traversed by a heat-transfer fluid maintained at a temperature of about 40 to 100°C, said latex to be treated and said heat-transfer fluid traversing their respective circuits in opposite directions, and

removing said residual monomer.

No references have been relied upon by the examiner in the rejection before us.

According to the examiner, "[c]laims 1 and 3-6 are rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is enabling only for claims limited to a process

Appeal No. 95-3615
Application No. 08/003,401

for removing residual monomer from an aqueous latex, wherein the aqueous latex comprises polyvinyl chloride, a vinyl chloride copolymer, a rubber polymer or well-known functional equivalents of these polymers. The claims are not enabled for any other synthetic polymer latex. Further clarification is required. See MPEP

§ 706.03(n) and 706.03(z)" (Answer, pages 2-3).

We cannot sustain this rejection.

We share the appellant's basic position that on the record of this appeal the examiner has failed to carry his burden of establishing a prima facie case that the disclosure of this application would not enable one with ordinary skill in the art to practice the here claimed invention without undue experimentation. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982). In this regard, we reiterate the appellant's point that many of the examiner's proffered reasons for doubting enablement are based upon speculation, some of which are patently erroneous, rather than evidence.

As for the examiner's concern that experimentation would be required to practice the process defined by the appealed

Appeal No. 95-3615
Application No. 08/003,401

claims, it is appropriate to emphasize that the test for undue experimentation vis à vis enablement is not merely quantitative since a considerable amount of experimentation is permissible, if it is merely routine or if the specification in question provides a reasonable amount of guidance. Ex parte Forman, 230 USPQ 546, 547 (Bd. Pat. App. & Int. 1986); cf., In re Brandstadter, 484 F.2d 1395, 1407, 179 USPQ 286, 294-295 (CCPA 1973). From our perspective, the record reflects that any experimentation required to practice the appellant's claimed invention would be routine rather than undue for an artisan with ordinary skill.

In making the rejection before us, the examiner in essence has attempted to limit the appellant to claims involving the specific materials disclosed in the subject specification. However, to provide effective incentives, claims must adequately protect inventors. To demand that the first to disclose shall limit his claims to what he has found will work or to materials which meet the guidelines specified for "preferred" materials in a process such as the one here involved would not serve the constitutional purpose of

Appeal No. 95-3615
Application No. 08/003,401

promoting progress in the useful arts. In re Goffe, 542 F.2d
564, 567, 191 USPQ 429, 431 (CCPA 1976).

In light of the foregoing, we cannot sustain the
examiner's § 112, first paragraph, rejection of claims 1 and 3
through 6.

Appeal No. 95-3615
Application No. 08/003,401

The decision of the examiner is reversed.

REVERSED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
THOMAS A. WALTZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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PETER F. KRATZ)	
Administrative Patent Judge)	

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Appeal No. 95-3615
Application No. 08/003,401

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