

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(2) is not binding precedent of the Board.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. 46

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT J. STATZ

Appeal No. 95-4387
Application 08/021,741¹

ON BRIEF

Before KIMLIN, WEIFFENBACH and WARREN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

This is an appeal under 35 U.S.C. ' 134 from the decision of the examiner finally rejecting claim 27, the sole claim in the application.

We will not sustain the ground of rejection of the appealed claim under 35 U.S.C ' 103

over Ohmae et al. in view of Coran et al. and further in view of EP >139.^{2,3} It is well settled that

¹ Application for patent filed February 23, 1993. According to appellant, this application is a continuation-in-part of application 07/315,291, filed February 24, 1989, now abandoned, which is a continuation-in-part of application 07/193,630, filed May 13, 1988, now abandoned.

² The references relied on by the examiner with respect to the ground of rejection are listed at

in order to establish a *prima facie* case of obviousness, A[b]oth the suggestion and the reasonable expectation of success must be found in the prior art and not in applicant's disclosure.³ *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). Thus, a *prima facie* case of obviousness is established by showing some that objective teaching or suggestion in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in the art would have led that person to the claimed invention, including each and every limitation of the claim, without recourse to the teachings in appellant's disclosure. *See generally In re Oetiker*, 977 F.2d 1443, 1447-48, 24 USPQ2d 1443, 1446-47 (Fed. Cir. 1992) (Nies, J., concurring).

We have carefully considered the record before us in this appeal and conclude therefrom that the examiner has failed to make out a *prima facie* case of obviousness with respect to appealed claim 27. We cannot agree with the examiner that the combination of references provides evidence that one of ordinary skill in this art would have been motivated to employ less than 40 percent by weight of the thermoplastic copolyester resin in the adhesive resin compositions of Ohmae et al. in order to arrive at the invention set forth in claim 27, in view of the following teaching in this reference:

If the [thermoplastic copolyester resin] component (A) is less than 40% by weight and the components (B) [, an ethylene copolymer having at least one functional group selected from, *inter alia*, an epoxy group or a carboxylic acid group,] and (C) [, an optional component which is a thermoplastic resin other than the resin (A),] the *adhesion of the resulting composition to polar group-containing synthetic resins, particularly, a soft polyvinyl chloride resin, is seriously reduced; that is, the inherent characteristic of the component (A) is lost.* [Col. 5, lines 40-46; emphasis ours.]

Thus, one of ordinary skill in this art interested in adhesive resin compositions would not have looked to the teachings of Coran et al, which are directed to thermoplastic resin compositions, for motivation to employ a lesser amount of the thermoplastic copolyester resin, such as 30 weight percent as required by claim 27, in the adhesive resin compositions of Ohmae et al. because there would have been no reasonable expectation of successfully obtaining an adhesive resin composition in doing so. Even in view of the difference in the properties of the resin

page 2 of the answer. We refer to these references in our opinion by the name associated therewith by the examiner.

³ The examiner has withdrawn the grounds of rejection under ' 103 based on EP= 139 or Epstein in view of Coran et al. (answer, page 3).

compositions taught in these references, we further conclude that one of ordinary skill in this art would not have considered the teachings of Coran et al. with respect to the adhesive resin compositions of Ohmae et al. for two reasons. First, Ohmae et al. discloses that at least one of the functional groups of component (B) can be an epoxy group, which functional group is not disclosed in Coran et al. And, second, where the functional group of component (B) of Ohmae et al. is a carboxylic acid group, there is no indication in Ohmae et al. that the carboxylic acid groups are neutralized to any extent while they are completely neutralized in Coran et al. We also conclude that one of ordinary skill in the art would not have found the requisite motivation to adjust the amount of thermoplastic resin which may be present in the adhesive compositions of Ohmae et al. in the teachings of EP =139 because we find that, unlike Ohmae et al. and Coran et al., this reference does not disclose the use of a thermoplastic polyester resin in the crosslinkable polymer compositions taught therein (e.g., page 2, lines 20-30).

Accordingly, in view of the differences in the teachings of the applied references, we conclude that the combination of references would not have reasonably suggested the claimed invention to one of ordinary skill in this art. *In re Young*, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

The examiner's decision is reversed.

Reversed

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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