

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte VIRGINIA C. MARHEVKA

---

Appeal No. 1996-1716  
Application No. 08/344,532<sup>1</sup>

---

ON BRIEF

---

Before PAK, WALTZ, and KRATZ, Administrative Patent Judges.

WALTZ, Administrative Patent Judge.

**DECISION ON APPEAL**

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 through 4 and 7. The remaining claims in this application are claims 5, 6 and 8

---

<sup>1</sup> Application for patent filed November 23, 1994. According to appellants, the application is a continuation of Application No. 08/082,609, filed June 24, 1993, now abandoned.

Appeal No. 1996-1716  
Application No. 08/344,532

through 12, which stand withdrawn from consideration by the examiner (Answer, page 1).

According to appellant, the invention is directed to an epoxy adhesive composition comprising a major amount of an epoxy resin and an oligomeric polyester, where the polyester is produced by the reaction of specific types of dicarboxylic acid and polyol (Brief, page 7). Appealed claim 1 is illustrative of the subject matter on appeal and a reproduction of this claim is attached as an Appendix to this decision.

The examiner has relied upon the following references as evidence of obviousness:

Aharoni	4,336,343	Jun. 22, 1982
Koleske	4,707,535	Nov. 17, 1987
Nishikawa et al. (Nishikawa)	4,933,252	Jun. 12, 1990
Blount	5,034,423	Jul. 23, 1991
Tominaga et al. (Tominaga)	5,218,018	Jun. 8, 1993
Tanaka et al. (Tanaka) (Published Japanese Kokai) <sup>2</sup>	62-195678	Aug. 28, 1987

Claims 1-4 and 7 stand rejected under 35 U.S.C. § 112, first paragraph, "as the specification, as originally filed,

---

<sup>2</sup>Our consideration of this reference relies on the English translation of this document which has been made of record.

Appeal No. 1996-1716  
Application No. 08/344,532

does not provide support for the invention as is now claimed."  
(Final rejection dated Feb. 2, 1995, Paper No. 8, page 2).<sup>3</sup>  
Claims 1-4 and 7 stand rejected under 35 U.S.C. § 103 as  
unpatentable over Koleske and Blount and Tominaga in view of  
Nishikawa and Tanaka and Aharoni (Answer, page 3). We reverse  
the examiner's rejections for reasons which follow.

#### OPINION

##### *A. The Rejection under 35 U.S.C. § 112, First Paragraph*

The examiner submits that there is no support for the  
claimed epoxy resin being present in a "major amount," stating  
that the only amounts of epoxy resin in the originally filed  
disclosure are the specific amounts found in the examples and  
that these specific amounts do not provide support for the

---

<sup>3</sup>The Answer does not contain this rejection under the  
first paragraph of § 112 (see page 3). However, we consider  
this to be an inadvertent error on the part of the examiner  
since the Answer on page 3 does contain the objection to the  
specification under  
§ 112, first paragraph, but does not repeat the rejection as  
stated in the final rejection dated Feb. 2, 1995, Paper No. 8,  
page 2. The basis for this objection in the Answer is the  
same basis as stated in the final rejection for the rejection  
of claims 1-4 and 7 under § 112, first paragraph.  
Accordingly, for purposes of this appeal, we will review the  
rejection of claims 1-4 and 7 under § 112, first paragraph,  
for "lack of support," i.e., failure to comply with the  
written description requirement.

Appeal No. 1996-1716  
Application No. 08/344,532

broader term "major amount" (Final rejection, page 2, and the Answer, page 3).

Appellant argues that the examples in the specification "all detail compositions which may be said to comprise a 'major amount' of an epoxy resin" (Brief, page 10). Appellant further argues that the disclosure in the original specification at page 9, lines 1-8, of the range of hydroxy:epoxy ratios for the claimed compositions clearly supports the phrase "major amount" (*Id.*).

The initial burden of establishing a rejection for failing to meet the description requirement of § 112, first paragraph, must be carried by the examiner. *In re Alton*, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996). An *ipsis verbis* disclosure is not necessary to satisfy the written description requirement of § 112. Appellant must convey with reasonable clarity to those skilled in the art that, as of the filing date, appellant was in possession of the invention as now claimed. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991); *In re Edwards*, 568 F.2d 1349, 1351-52, 196 USPQ 465, 467 (CCPA

Appeal No. 1996-1716  
Application No. 08/344,532

1978). The invention as now claimed recites the contested phrase "major amount" with regard to the epoxy resin (see component (a) in claim 1 on appeal). Accordingly, we must interpret the scope of this contested phrase to determine if the original disclosure reasonably conveyed to the artisan that appellant was in possession of the invention as now claimed. As stated by our reviewing court in *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997):

...the PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definition or otherwise that may be afforded by the written description contained in the applicant's specification.

The phrase "major amount" was not present in the originally filed disclosure but was added to claim 1 during prosecution.<sup>4</sup> Therefore, there is no definition of "major amount" in the original disclosure or elsewhere in this record. Giving the phrase "major amount" its meaning in

---

<sup>4</sup>See the amendment dated May 16, 1994, Paper No. 4, filed in parent Application No. 08/082,609.

Appeal No. 1996-1716  
Application No. 08/344,532

ordinary usage, we find that "major amount" means an amount that is "greater in number, quantity, or extent."<sup>5</sup>

All of the examples in the originally filed disclosure (see pages 18-22 and 24-28) show the epoxy resin component in an amount that is greater than any other component (either in parts, weight %, or volume %). Accordingly, we determine that this originally filed disclosure conveys with reasonable clarity to those of ordinary skill in the art that appellant, as of the filing date, was in possession of the invention as now claimed, i.e., that the epoxy resin component was present in the adhesive composition in a "major amount."

For the foregoing reasons, the rejection of claims 1-4 and 7 under the first paragraph of 35 U.S.C. § 112 is reversed.

*B. The Rejection under 35 U.S.C. § 103*

As admitted by the examiner, the primary references (Koleske, Blount, and Tominaga) do not recite the particular alkyl-substituted dicarboxylic acid reactant that forms the polyester of appealed claim 1 (Answer, page 4, see the Brief,

---

<sup>5</sup>See *Webster's Third New International Dictionary*, p. 1363, G. & C. Merriam Company, Springfield, Mass., 1971.

Appeal No. 1996-1716  
Application No. 08/344,532

page 10, second paragraph). To remedy this failing, the examiner applies the secondary references (Nishikawa, Tanaka, and Aharoni) to "teach the preparation of hydroxyl-functional polyesters utilizing a dicarboxylic acid with an appended alkyl group such as octadecylsuccinic [sic, octadecylsuccinic] acid." (Answer, page 5). The examiner reiterates that the secondary "references are relied upon merely to teach the conventional use of such a dicarboxylic acid in the formation of a hydroxyl-functional polyester" (Answer, page 6).

We determine that the examiner has failed to present evidence of a suggestion, teaching or motivation to combine the references as proposed. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); *In re Rouffet*, 149 F.3d 1350, 1356, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998).

Whether the evidence of a teaching or suggestion to combine comes from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved, the showing of evidence must be clear and particular. *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. The primary references are directed to adhesive compositions

Appeal No. 1996-1716  
Application No. 08/344,532

(Koleske, column 2, lines 54-58; Blount, column 10, lines 41-46) and coating (paint) compositions (Tominaga, column 2, lines 46-61). The secondary references are directed to electrophotographic developers (Nishikawa, column 3, lines 66-68; Tanaka, page 2) and a molding composition (Aharoni, column 1, lines 8-11). The examiner has not presented evidence of any teaching, suggestion or motivation to use the alkyl-substituted dicarboxylic acids of the secondary references in place of the dicarboxylic acids of the primary references. The examiner has pointed to Tanaka as "ascribing properties such as good fluidity and high glass transition temperature to an alkyl group-appended succinic acid," properties which are "desirable" in the hydroxyl-functional polyesters of the primary references (Answer, page 6, also see page 5 of the Answer). However, the examiner has not supported this statement by pointing to where Tanaka specifically ascribes these desirable properties to only the "alkyl group-appended succinic acid," where the primary references disclose the desirability of such properties, and why one of ordinary skill in the art would have made the proposed modification when Tanaka is directed to electrophotographic developer

Appeal No. 1996-1716  
Application No. 08/344,532

compositions and the primary references are directed to epoxy adhesives and coating compositions.

For the foregoing reasons, we determine that the examiner has not established a *prima facie* case of obviousness in view of the reference evidence. Accordingly, the rejection of claims 1-4 and 7 under 35 U.S.C. § 103 is reversed.

*C. Summary*

The rejection of claims 1-4 and 7 under the first paragraph of 35 U.S.C. § 112 for lack of support is reversed. The rejection of claims 1-4 and 7 under 35 U.S.C. § 103 as unpatentable over Koleske and Blount and Tominaga in view of Nishikawa and Tanaka and Aharoni is reversed.

The decision of the examiner is reversed.

**REVERSED**

Appeal No. 1996-1716  
Application No. 08/344,532

CHUNG K. PAK	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
THOMAS A. WALTZ	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
PETER F. KRATZ	)	
Administrative Patent Judge	)	

lp

Appeal No. 1996-1716  
Application No. 08/344,532

3M OFFICE OF INTELLECTUAL PROPERTY  
COUNSEL  
PO BOX 33427  
ST PAUL MN 55133-3427

Appeal No. 1996-1716  
Application No. 08/344,532

APPENDIX

1. An epoxy adhesive composition comprising:

(a) a major amount of an epoxy resin having an average epoxide functionality of greater than one;

(b) an oligomeric polyester which is, on average, terminated by at least two hydroxyl groups and which is the reaction product of starting materials comprising:

(i) a dicarboxylic acid, a dicarboxylic acid derivative or a mixture of one or more of the foregoing, each comprising a moiety linking the carboxyl groups thereof separating the carboxyl groups by about one to about ten carbon atoms and each further comprising an appended alkyl group comprising about eight to about thirty carbon atoms; and

(ii) an aliphatic polyol, a cycloaliphatic polyol, an alkanol substituted arene polyol, or a mixture of one or more of the foregoing, the polyol comprising from about three to about ten carbon atoms and at least two hydroxy groups being primary or secondary;  
and

(c) a catalytically effective amount of an acid catalyst.

***Leticia***

Appeal No. 1996-1716  
Application No. 08/344,532

APJ WALTZ

APJ KRATZ

APJ PAK

DECISION: REVERSED  
Send Reference(s): Yes No  
or Translation (s)  
Panel Change: Yes No  
Index Sheet-2901 Rejection(s):  
Prepared: June 16, 2000

Draft                  Final

3 MEM. CONF.    Y                  N

OB/HD                  GAU

PALM /ACTS 2/BOOK  
DISK(FOIA)/REPORT