

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(2) is not binding precedent of the Board.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 HANS BAURIEDEL,
WOLFGANG KLAUCK, and GUENTER HENKE

Appeal No. 96-2505
Application 08/122,417¹

ON BRIEF

Before GARRIS, WEIFFENBACH, and WARREN, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

Appeal No. 96-2505
Application No. 08/122,417

This is a decision on an appeal from the final rejection of claims 25 through 64 which are all of the claims remaining in the application.

The subject matter on appeal relates to an aqueous polymer dispersion reactive resin component for a two-component reactive laminating adhesive system comprising OH-functional polyurethane prepolymers produced by a particular process. The process comprises reacting a polyol component and compounds containing at least two isocyanate-reactive groups with a stoichiometric excess of an isocyanate component comprised of at least 20% by weight tetramethyl xylylene diisocyanate to produce polyurethane prepolymers with remaining NCO groups followed by dispersing these prepolymers in water and at least partially reacting the remaining NCO groups of the prepolymers with aminoalcohols. This appealed subject matter is adequately illustrated by independent claim 25, a copy of which taken from the appellants' brief is appended to this decision.

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

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matter of the rejected claims or direct those skilled in the art to the subject matter without any need for picking, choosing and combining various disclosures not directly related to each other by the teachings of this reference. In re Arkley, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972). While Schwab unquestionably discloses individual elements of the here claimed invention, the element combination defined by the rejected claims would be achieved only by picking, choosing and combining various disclosures of the reference which are not directly related to each other.

For example, the examiner is outside the boundary of section 102 in proposing to select at least 20% by weight tetramethyl xylylene diisocyanate from the extensive number of diisocyanates envisioned by Schwab and dispersing the consequent prepolymer in water rather than a non-aqueous system for reaction with an aminoalcohol specifically. The examiner points to nothing, and we find nothing independently in the Schwab reference, which yields a combination of these specific disclosures to the exclusion of others in the absence of the aforementioned picking

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Under these circumstances, we cannot sustain the examiner's rejection under 35 U.S.C. § 102(b) of claims 25 through 53 and 55 through 58 as being anticipated by Schwab.

However, we agree with the examiner's conclusion that the subject matter defined by the appealed claims would have been obvious to one with ordinary skill in the art within the meaning of 35 U.S.C. § 103 over the applied prior art.

In this regard, we emphasize that an artisan with ordinary skill would have been led to use tetramethyl xylylene diisocyanates (e.g., see lines 26-27 in column 2) specifically for producing prepolymers and to disperse the prepolymers in water (e.g., see lines 53-56 in column 5) for reaction with aminoalcohol (e.g., see lines 35-51 in column 4) as required by appealed claim 25 in light of Schwab's disclosure of such features as viable mechanisms for obtaining his desired OH-functional polyurethane prepolymers. The appellants' arguments to the contrary are unpersuasive primarily because they do not correspond to the limitations of claim 25. For example, with regard to the appellants' arguments concerning the property of

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prepolymers thereof to possess such a property. Similarly, because this claim does not require the prepolymer to be dispersed in water before reaction with an aminoalcohol, the appellants' arguments regarding this feature are simply irrelevant.

We have carefully considered each of the arguments advanced by the appellants regarding the other claims on appeal. In some cases, the arguments are unconvincing because they are premised upon an incorrect test for obviousness. As an example, the adipic acid and/or phthalic acid feature of dependent claim 26 would have been suggested by Schwab (e.g., see lines 16 through 33 in column 3), and the appellants' remark that such components "are not explicitly stated [by Schwab] as preferred materials" (brief, page 22) has no apparent relevance to the section 103 issue under consideration. See Merck & Co. v. Biocraft Labs., 874 F.2d 804, 808, 10 USPQ2d 1843, 1846 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989).

In other cases, the arguments advanced by the appellants lack merit because they are plainly contrary to the express

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see lines 42-46 in column 2). This disclosure of the Schwab reference is in direct opposition to the appellants' argument bridging pages 22 and 23 of the brief.

Finally, in many cases, the appellants' arguments do not persuade us of patentability because we simply disagree with the appellants' nonobviousness conclusion. The appellants argue, for example, that "[c]laims 55 and 56 are patentable over the references of record since there is neither teaching nor suggestion to disperse the crosslinking agent in the prepolymer dispersion in a finely divided form" (brief, page 25). From our perspective, Schwab's teaching of crosslinking agents which are water dispersible (e.g., see lines 29-37 in column 6) would have suggested dispersing these compounds in finely divided form as required by claim 55. Analogously, we cannot agree with the appellants' patentability conclusion regarding claim 59 in light of Schwab's express teaching that his dispersions possess the property of intercoat adhesion (e.g., see lines 28-34 in column 7) whereby a primer coat and finish coat (which read on the here claimed substrates) are effectively bonded together via Schwab's

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In light of the foregoing, we will sustain the examiner's section 103 rejection of claims 25 through 64 as being unpatentable over Schwab in view of Long, Nagorski and Jacobs.

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

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| Bradley R. Garris |) | |
| Administrative Patent Judge |) | |
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| |) | |
| Cameron Weiffenbach |) | BOARD OF PATENT |
| Administrative Patent Judge |) | APPEALS AND |
| |) | INTERFERENCES |
| |) | |
| |) | |
| Charles F. Warren |) | |
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