

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD P. SQUILLER, JAMES W. ROSTHAUSER,
PETER H. MARKUSCH and TERRY A. POTTER

Appeal No. 1997-0140
Application No. 08/266,290¹

ON BRIEF

Before KIMLIN, JOHN D. SMITH and SPIEGEL, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-16, all the claims in the present application. Claim 1 is illustrative:

¹ Application for patent filed June 27, 1994.

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1. A storage stable, one-component polyurethane composition useful as a sealant or coating which cures at elevated temperature comprising

a) an isocyanate selected from

- (1) isocyanate terminated prepolymers formed from a polyisocyanate and a hydroxyl group containing compound having at least two hydroxyl groups and a molecular weight greater than 500 which prepolymers have been blocked with a phenol or oxime,
- (2) polyisocyanate adducts in which the free isocyanate groups have been blocked with a phenol or oxime, and
- (3) monomeric isocyanates which have been blocked with a phenol or oxime;

b) at least one compound selected from the group consisting of polyketimines having amino groups attached to secondary carbon atoms, polyenamines and oxazolidines;

and

c) a compound which generates water under the curing conditions

in which components a), b) and c) are used in amounts such that the equivalent ratio of a):b):c) is from about 1:0.1:0.3 to about 1:2:2.

The examiner relies upon the following references as evidence of obviousness:

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| Akiyama et al. (Akiyama) | 5,130,402 | Jul. 14, 1992 |
| Markusch et al. (Markusch) | 5,142,014 | Aug. 25, 1992 |

Appellants' claimed invention is directed to a one-component polyurethane composition that finds utility as a

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sealant or a coating. The composition comprises one of the recited isocyanates, at least one of polyketimines, polyenamines and oxazolidines, and a compound which generates water under curing conditions, such as internal organic salts, salts of organic amines and salts of organic acids.

Appealed claims 1, 3-5, 8-10, 12-14 and 16 stand rejected under 35 U.S.C. § 112, first paragraph, as being based upon a non-enabling disclosure. In addition, appealed claims 1-16 stand rejected under 35 U.S.C. § 103 as being obvious over Markusch in view Akiyama.

Upon careful consideration of the opposing arguments presented on appeal, we agree with appellants that the examiner's rejections are not sustainable. Accordingly, we will reverse the examiner's § 112 and § 103 rejections.

We consider first the examiner's rejection under 35 U.S.C. § 112, first paragraph. According to the examiner, "[t]he use of the phrase 'a compound which generates water' is rather vague and does not define with particularity the boundaries of Applicants' invention" (page 2 of office action of September 8, 1994).

In setting forth a rejection under 35 U.S.C. § 112, first paragraph, the examiner has the initial burden of establishing

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lack of enablement by compelling reasoning or objective evidence. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982); In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). In particular, the examiner must demonstrate that one of ordinary skill in the art, based on the teachings of the specification and state of the prior art, would not be able to practice the claimed invention without undue experimentation. In the present case, we find that appellants' specification and the prior art evidenced by Markusch, cited by the examiner, would sufficiently apprise one of ordinary skill in the art which compounds would qualify as those which generate water within the context of the claimed invention. It must be borne in mind that it is not a function of the claims to specifically exclude possible inoperable substances, and that the mere possibility that a composition claim embraces inoperable reactants does not render the claim unduly broad. See In re Dinh-Nguyen, 492 F.2d 856, 858-59, 181 USPQ 46, 48 (CCPA 1974); In re Kamal, 398 F.2d 867, 872, 158 USPQ 320, 324 (CCPA 1968).

We now turn to the examiner's rejection of the appealed claims under § 103 over the combined teachings of Markusch and Akiyama. The examiner recognizes that Markusch, who discloses

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a one-component polyurethane composition that is useful as a sealant, does not teach the inclusion of appellants' claimed component b), i.e., polyketimines, polyenamines and oxazolidines. While Akiyama discloses a polyurethane coating composition comprising appellants' component b) as a curative, we concur with appellants that the compositions of Markusch and Akiyama are not sufficiently similar to support the conclusion that it would have been prima facie obvious for one of ordinary skill in the art to incorporate the curatives of Akiyama in the polyurethane composition of Markusch. For one, the examiner has not pointed to any teaching in Markusch that any curative, in general, is an optional component of the composition. Markusch relies upon the specific reaction of a liquid blocked polyisocyanate with a solid polyamine internal salt. Akiyama, on the other hand, does not disclose a polyurethane composition comprising a solid polyamine internal salt but, rather, teaches the specific reaction of a particular blocked urethane prepolymer derived from TMXDI and the curatives, such as ketimines. In our view, impermissible hindsight is required to modify the polyurethane composition of Markusch by including the curative of Akiyama. While the examiner explains that the requisite motivation stems from

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lending enhanced curability and coating properties to the polyurethane of Markusch, the examiner has not established a factual basis for concluding that the curatives of Akiyama would be compatible with the polyamine internal salt-containing polyurethane composition of Markusch. The examiner has pointed to no teaching in Akiyama or any other prior art reference which explains how the curatives of Akiyama operate in the presence of a polyamine internal salt.

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is reversed.

REVERSED

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| EDWARD C. KIMLIN |) | |
| Administrative Patent Judge |) | |
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| JOHN D. SMITH |) | BOARD OF PATENT |
| Administrative Patent Judge |) | APPEALS AND |
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| CAROL A. SPIEGEL |) | |
| Administrative Patent Judge |) | |

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