

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

*Ex parte* MICHAEL KAUSCH, KARL-HEINZ WOLF,  
WOLFGANG KLEIN and KONRAD SCHMITZ

---

Appeal No. 1997-0958  
Application 08/300,669

---

HEARD: February 8, 2000

---

Before JOHN D. SMITH, OWENS, and LIEBERMAN, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

*DECISION ON APPEAL*

This is an appeal from the examiner's final rejection of claims 10-18. Claims 19 and 20, which are the only other claims remaining in the application, stand withdrawn from consideration by the examiner as being directed toward a

Appeal No. 1997-0958  
Application 08/300,669

nonelected invention.

*THE INVENTION*

Appellants claim a process for producing elastane fibers from polyurea polyurethanes wherein recited amounts of a polydimethylsiloxane and an ethoxylated polydimethylsiloxane are added to the spinning solution before the solution is spun to form the fibers. Appellants state that these additives cause distinctly less streaking in dyed and finished textiles (specification, page 2, lines 18-30). Claim 10 is illustrative and reads as follows:

10. In the production of elastane fibers from polyurea polyurethane by dry spinning or wet spinning, removing the spinning solvent, finishing, optionally twisting a solution thereof to form filaments winding the spun filaments, the improvement which comprises adding to the spinning solution before spinning,

A) from 0.8 to 2% by weight of polydimethylsiloxane with a viscosity of 50 to 300 cSt and

B) from 0.2 to 0.6% by weight of ethoxylated polydimethylsiloxane with a viscosity of 20 to 150 cSt

(viscosities measured with a falling ball viscosimeter at 25EC) the percentages being based on the siloxane content of the final fiber, whereby fabrics formed of the resulting yarn exhibit reduced defects when dyed.

Appeal No. 1997-0958  
Application 08/300,669

*THE REFERENCES*

Chandler 1967 Koerner et al. (Koerner) 8, 1978	3,296,063 4,105,567	Jan. 3, Aug.
Hanzel et al. (Hanzel) 1981	4,296,174	Oct. 20,
Ejima et al. (Ejima) 1989	4,840,846	Jun. 20,
Schmalz 1991	5,045,387	Sep. 3,
Anderson et al. (Anderson) 1994	5,288,516	Feb. 22,

*THE REJECTIONS*

Claims 10-18 stand rejected under Hanzel, Ejima, Anderson or Chandler, in view of Schmalz and Koerner, and under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regard as the invention.

*OPINION*

We have carefully considered all of the arguments advanced by appellants and the examiner and agree with appellants that the aforementioned rejections are not well founded. Accordingly, we reverse these rejections.

*Rejection under 35 U.S.C. § 112, second paragraph*

Appeal No. 1997-0958  
Application 08/300,669

The relevant inquiry under 35 U.S.C. § 112, second paragraph, is whether the claim language, as it would have been interpreted by one of ordinary skill in the art in light of appellants' specification and the prior art, sets out and circumscribes a particular area with a reasonable degree of precision and particularity. See *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

The examiner argues that the phrase "dry spinning or wet spinning" is indefinite as to what is appellants' invention (answer, page 6). In what is apparently the examiner's explanation of the rejection, the examiner argues that "[t]he primary references to Hanzel et al, Anderson et al, Ejima et al, teach the well known process of spinning and heating to remove solvent, finishing and winding of polydimethylsiloxane to produce spandex fibers". See *id.* It is not clear from this argument why the examiner considers the claims, as they would have been interpreted by one of ordinary skill in the art in light of appellants' specification and the prior art, to fail to set out and circumscribe a particular area with a

Appeal No. 1997-0958  
Application 08/300,669

reasonable degree of precision and particularity, and the examiner provides no other argument in support of the rejection. Moreover, appellants define "dry spinning" and "wet spinning" (supplemental brief filed March 7, 1996), and the examiner does not challenge these definitions.

For the above reasons, we conclude that the examiner has not set forth a *prima facie* case of indefiniteness. We therefore reverse the rejection under 35 U.S.C. § 112, second paragraph.

*Rejection under 35 U.S.C. § 103*

Chandler, which appears to be the applied reference which is closest to appellants' claimed invention, discloses adding a mixture of polyamylsiloxane and polydimethylsiloxane to a spinning solution for making spandex fibers (col. 3, lines 38-42 and 60-64). The only applied reference which discloses ethoxylated polydimethylsiloxane is Schmalz, and in this reference, the ethoxylated polydimethylsiloxane is applied to the surfaces of polyolefin fibers to render them hydrophilic

(col. 1, lines 5-10; page 4, lines 56-62). The examiner has not explained, and it is not apparent, why the combined teachings of the applied references would have led one of ordinary skill in the art to use Schmalz's ethoxylated polydimethylsiloxane, which is a component of a composition used to render the surfaces of polyolefin fibers hydrophilic, in Chandler's composition which has the purpose of providing a lubricating finish to spandex fibers (col. 1, lines 12-15).

In the other applied references, polydimethylsiloxane is applied to the surfaces of fibers to form a lubricating finish thereon, and in all of the references except Hanzel the fibers are not spandex fibers. The examiner argues that because Schmalz discloses ethoxylated polydimethylsiloxane and Koerner teaches that it was known to add additional materials to spandex fibers before spinning a solution to form fibers, it would have been obvious to one of ordinary skill in the art to add ethoxylated polydimethylsiloxane to the additives in the primary references in order to impart desired characteristics to the products (answer, page 4). The examiner does not point out where Koerner discloses spandex fibers, and in the portion

Appeal No. 1997-0958  
Application 08/300,669

of the reference relied upon by the examiner (col. 12, lines 46-59) it appears that a solution is made for application to fibers as a surface finish. Also, the examiner does not explain why the applied references would have led one of ordinary skill in the art to apply to spandex fibers Schmalz's ethoxylated polydimethylsiloxane which is a component of a composition applied to polyolefin fibers to render the surfaces hydrophilic.

As indicated by the above discussion, the examiner used impermissible hindsight based on appellants' disclosure when rejecting appellants' claims as being obvious. See *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *In re Rothermel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960). Consequently, we do not sustain the rejection under 35 U.S.C. § 103.

#### DECISION

The rejections of claims 10-18 under 35 U.S.C. § 103 over Hanzel, Ejima, Anderson or Chandler, in view of Schmalz and Koerner, and under 35 U.S.C. § 112, second paragraph, are

Appeal No. 1997-0958  
Application 08/300,669

reversed.

*REVERSED*

JOHN D. SMITH	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
TERRY J. OWENS	)	)
Administrative Patent Judge	)	APPEALS AND
	)	)
	)	INTERFERENCES
	)	)
PAUL LIEBERMAN	)	)
Administrative Patent Judge	)	)

TJO/pgg  
Sprung Horn Kramer and Woods  
660 White Plains Road  
4th Floor  
Tarrytown, NY 10591-5144