

**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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WOOD E. HUNTER, KEVIN W. FREDERICK  
and RANDY J. LOEFFLER

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Appeal No. 1997-1604  
Application No. 08/273,688<sup>1</sup>

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ON BRIEF

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Before KIMLIN, GARRIS and WARREN, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

**DECISION ON APPEAL**

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<sup>1</sup> Application for patent filed July 12, 1994. According to appellants, this application is a continuation of Application No. 07/993,800 filed December 21, 1992, now abandoned.

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This is a decision on an appeal from the final rejection of claims 1 through 18 which are all of the claims remaining in the application.

The subject matter on appeal relates to a method for preparing a pourable, concentrated polymer/emulsifying surfactant/hydrophobic liquid composition by removing some portion of hydrophobic liquid from a starting composition in a first centrifuge, thereby producing the aforementioned pourable composition. The subject matter also relates to the pourable composition itself. This subject matter is adequately illustrated by independent method claims 1 and 17 and independent composition claims 12 and 18. A copy of these claims taken from the appellants' brief is appended to this decision.

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

Krijnen et al. (Krijnen) 7, 1989	4,803,264	Feb.
Mallya et al. (Mallya) 1990	4,944,888	Jul. 31,
Scanley 1992	5,155,156	Oct. 13,

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Kirk-Othmer, Concise Encyclopedia of Chemical Technology, John Wiley & Sons, New York (1985) p. 235.

Claims 15 and 16 stand rejected under the first paragraph of 35 U.S.C. § 112 as being based upon a disclosure which would not enable one with ordinary skill in the art to practice the here claimed invention.

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Claims 1 through 5, 7 through 16 and 18 stand rejected under 35 U.S.C. § 102(e) as being anticipated by or alternatively under 35 U.S.C. § 103 as being unpatentable over Scanley.

Claims 1 through 18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or alternatively under 35 U.S.C. § 103 as being unpatentable over Mallya.

Claims 1 through 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mallya in view of Kirk-Othmer.

Finally, claim 17 stands rejected under 35 U.S.C. § 103 as being unpatentable over Krijnen.

We refer to the Brief and to the Answer for an exposition of the viewpoints expressed by the appellants and the examiner concerning each of the above noted rejections.

#### OPINION

Our study of the arguments, evidence and issues advanced on this appeal with respect to the rejections before us leads to the conclusion that we can sustain only the Section 102 and Section 103 rejections over Scanley of composition claims 12 through 14 and 18. Our reasons follow.

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Concerning the Section 112, first paragraph, rejection, the examiner's nonenablement position relates to the claim 15 phrase "settling or compaction stabilizer" (and correspondingly to the acronym "LMA/MAA" on page 36 of the subject specification) as well as to the claim 16 phrase "inverting surfactant." As explained by the appellants in their Brief, however, the aforequoted recitation criticized in the rejection under review would not prevent one ordinarily skilled in this art from practicing the here claimed invention as the examiner seems to believe. Indeed, the criticized terms are common in this art as reflected by, for example, the Scanley and Mallya references applied by the examiner in the rejections discussed below.

It follows that the examiner's Section 112, first paragraph, rejection of claims 15 and 16 cannot be sustained.

The Section 102 and Section 103 rejections over Scanley of method claims 1 through 11 and 15 through 17 also cannot be sustained. Each of these claims requires the step of removing some portion of hydrophobic liquid from a starting composition in a first centrifuge, thereby producing a pourable concentrated polymer/emulsifying surfactant/hydrophobic liquid

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composition. While Scanley removes hydrophobic liquid from a starting composition via physical separation steps such as centrifugation and filtration, the resulting product is essentially a cake of polymer particles (e.g., see lines 15-57 in column 8 and example I in column 10). Such a cake cannot be regarded as the here claimed pourable concentrated polymer/emulsifying surfactant/hydrophobic liquid composition. As a consequence, the step of Scanley's method in which hydrophobic liquid is removed, for example, via a centrifuge does not produce a pourable concentrated composition as required by the method claims under review.

The Section 102 and Section 103 rejections over Scanley of composition claims 12 through 14 and 18 stand under different footing. This is because, although these claims contain process recitation, the determination of claim patentability depends upon the composition itself. In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985).

With the foregoing in mind, we point out that Scanley's aforementioned cake of polymer particles is redispersed in a

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second oil to produce a finished composition (e.g., again see lines 55-57 in column 8). Moreover, patentee's finished composition would contain concentrations of water and polymer solids which are within the corresponding ranges defined by the appellants' composition claims (e.g., see the paragraph bridging columns 5 and 6 and lines 13-59 in column 6 of the patent). The correspondence between Scanley's finished composition and the here claimed composition (e.g., with respect to ingredients and concentrations) evinces that Scanley's composition also possesses the pourability and viscosity characteristics of the here claimed composition<sup>2</sup>.

Under these circumstances, it is fair to require that the appellants prove Scanley's composition does not actually possess the aforementioned characteristics. The fairness of so allocating the burden of proof lies in the inability of the Patent and Trademark Office to manufacture and compare the compositions under consideration. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-434 (CCPA 1977).

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<sup>2</sup> That patentee's composition possesses such characteristics as pourability is also evinced by the disclosure of applying fluid handling techniques to these compositions at lines 46-49 in column 6.

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On this record, the appellants have proffered no evidence that Scanley's finished compositions do not possess the pourability and viscosity characteristics defined by their composition claims. It is appropriate, therefore, to sustain the Section 102 and Section 103 rejections over Scanley of these composition claims 12 through 14 and 18.

On the other hand, the Section 102 and Section 103 rejections based upon Mallya as the primary reference cannot be sustained. This is because the applied prior art contains no teaching or suggestion of the polymer solids concentrations required by appealed claims 1 through 16 and 18<sup>3</sup>. Further, Mallya contains no teaching or suggestion of the specific method defined by appealed claim 17 including step b thereof.

For the above stated reasons, we cannot sustain the examiner's Section 102 or Section 103 rejections of claims 1 through 14 over Mallya alone or further in view of Kirk-Othmer

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<sup>3</sup> The examiner's apparent belief (see the first full paragraph on page 15 of the Answer) that Mallya discloses such concentrations at column 6, lines 9-18, is clearly erroneous. The percentages referred to in this disclosure relate to adhesive coating not polymer solids.

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nor the corresponding rejections of claims 15 through 18 over Mallya alone.

Finally, the Section 103 rejection of claim 17 over Krijnen also cannot be sustained. This reference, like Mallya, contains no teaching or suggestion of the specific method defined by appealed claim 17 including step b thereof.

The decision of the examiner is affirmed-in-part.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

**AFFIRMED-IN-PART**

EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
BRADLEY R. GARRIS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
CHARLES F. WARREN	)	
Administrative Patent Judge	)	

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**APPENDIX**

1. A method for preparing a pourable, concentrated polymer/emulsifying surfactant/hydrophobic liquid composition from a starting dehydrated polymer/emulsifying surfactant/hydrophobic liquid composition, which method consists essentially of removing some portion of hydrophobic liquid from said starting dehydrated polymer/emulsifying surfactant/hydrophobic liquid composition in a first centrifuge, thereby producing a pourable concentrated polymer/emulsifying surfactant/hydrophobic liquid composition and a first centrifuge raffinate, wherein said polymer is a water soluble polymer prepared from one or more ethylenically unsaturated monomers and wherein said pourable concentrated polymer/emulsifying surfactant/hydrophobic liquid composition contains less than about 5%, by weight, water and greater than about 60%, by weight, polymer solids.

12. A pourable concentrated polymer/emulsifying surfactant/hydrophobic liquid composition prepared by a method consisting essentially of removing some portion of hydrophobic liquid from a starting dehydrated polymer/emulsifying surfactant/hydrophobic liquid composition in a first centrifuge, thereby producing said pourable concentrated polymer/emulsifying surfactant/hydrophobic liquid composition and a first centrifuge raffinate, where said polymer is a water soluble polymer prepared from one or more ethylenically unsaturated monomers and wherein said pourable concentrated polymer/emulsifying surfactant/hydrophobic liquid composition contains less than about 5%, by weight, water and greater than about 60%, by weight, polymer solids.

17. A method for preparing a pourable, concentrated polymer/emulsifying surfactant/hydrophobic liquid composition from a starting dehydrated polymer/emulsifying

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surfactant/hydrophobic liquid composition, which method comprises: a) removing some portion of hydrophobic liquid from said starting dehydrated polymer/emulsifying surfactant/hydrophobic liquid composition in a first centrifuge, thereby producing a pourable concentrated polymer/emulsifying surfactant/hydrophobic liquid composition and a first centrifuge raffinate; and b) centrifuging said first centrifuge raffinate in a second centrifuge to capture additional polymer solids.

18. A viscous, pourable polymer emulsifying surfactant/hydrophobic liquid composition having a viscosity of about 300 cps to 25,000 cps and containing greater than about 60% polymer solids and less than about 5% water prepared by centrifuging a starting dehydrated polymer/emulsifying surfactant/hydrophobic liquid composition, wherein said polymer is a water soluble polymer prepared from one or more ethlenically unsaturated monomers.

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