

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MICHAEL K. GEORGES,  
TOYOFUMI INOUE, GORDON K. HAMER,  
PETER M. KAZMAIER, and RICHARD P.N. VEREGIN

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Appeal No. 1997-4345  
Application No. 08/292,670

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ON BRIEF

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Before GARRIS, OWENS, and WALTZ, Administrative Patent Judges.  
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1 through 9 which are all of the claims pending in the application.

Appeal No. 1997-4345  
Application No. 08/292,670

The subject matter on appeal relates to a polymer having terminal end groups derived from stable free radical compounds wherein these end groups are covalently bonded stable free radical groups. This appealed subject matter is adequately illustrated by independent claim 1 which reads as follows:

1. A polymer having groups located at the ends of the polymer chain which groups are derived from stable free radical compounds, wherein the polymer is of the formula:



wherein SFR represents a covalently bonded stable free radical group and R represents a polymer chain including a thermoplastic resin.

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

Tong et al. (Tong)	5,034,485	Jul. 23, 1991
Georges et al. (Georges)	5,322,912	Jun. 21, 1994

Claims 1 through 9 are rejected under the first and second paragraphs of 35 U.S.C. § 112 "as the claimed invention is not described in such full, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention" (answer, page 4).

Appeal No. 1997-4345  
Application No. 08/292,670

Claims 1 through 4, 6, 8 and 9 are rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103 as being obvious over Tong.

Finally, claims 1 through 9 are rejected under 35 U.S.C. § 103 as being unpatentable over Georges.

#### OPINION

None of the rejections before us on this appeal can be sustained.

With regard to the examiner's section 112 rejection, we do not perceive the appealed claims to be offensive to any of the requirements set forth in the first and second paragraphs of this statute. More significantly, the examiner's comments regarding this rejection plainly are inadequate to carry his initial burden of establishing a prima facie case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Indeed, these comments are purely conclusory and lack any explanation of reasonable specificity as to why the appealed claims are

Appeal No. 1997-4345  
Application No. 08/292,670

considered to not particularly point out and distinctly claim the appellants' invention as required by the second paragraph of section 112 or to not be enabled by the subject specification in accordance with the first paragraph of section 112.

As a consequence of the foregoing, we cannot sustain the examiner's rejection of claims 1 through 9 under the first and second paragraphs of 35 U.S.C. § 112.

In the brief and reply brief, the appellants argue that the applied prior art does not teach and would not have suggested the here claimed polymer having at the ends of the polymer chain covalently bonded stable free radical groups which are thermally labile and reversibly attachable, thereby allowing the insertion of additional monomer components into and consequent extension of the polymeric chain (e.g., see the paragraph bridging pages 5 and 6 of the brief). The independent claim on appeal does not expressly recite that the stable free radical groups possess the aforementioned thermally labile and reversibly attachable characteristic. Nevertheless, it is reasonable and consistent with the subject specification to interpret the independent claim as requiring

Appeal No. 1997-4345  
Application No. 08/292,670

that the stable free radical groups encompassed thereby must possess this characteristic. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

Particularly as so interpreted, the appealed claims cannot be regarded as anticipated by or obvious over the applied prior art as correctly argued by the appellants. This is because neither Tong nor Georges contains any teaching or suggestion that the groups located at the ends of the polymer chains disclosed in these references are thermally labile, reversibly attachable, covalently bonded stable free radical groups of the type under consideration. Moreover, the crosslinking scheme disclosed by Tong with respect to his polymer chain militates against the examiner's position that patentee's end groups correspond to those required by the appealed claims.

It appears to be the examiner's view (e.g., see the supplemental examiner's answer mailed June 28, 1996) that the appellants should be required to submit evidence which shows that the here claimed polymers are indeed different from those of Tong or Georges as argued in their briefs. As previously explained, however, it is the examiner's initial burden of

Appeal No. 1997-4345  
Application No. 08/292,670

presenting a prima facie case of unpatentability. In re Oetiker, 977 F.2d at 1445, 24 USPQ2d at 1444. Here, the examiner has presented no evidence or even rationale to support the proposition that the prior art teaches or would have suggested polymers having end groups which are thermally labile, reversibly attachable, covalently bonded stable free radical groups as required by the claims before us.

For the above stated reasons, we cannot sustain the examiner's section 102 or section 103 rejection of claims 1 through 4, 6, 8 and 9 over Tong or his section 103 rejection of claims 1 through 9 over Georges.

Appeal No. 1997-4345  
Application No. 08/292,670

The decision of the examiner is reversed.

REVERSED

	Bradley R. Garris	)	
	Administrative Patent Judge	)	
		)	
		)	
		)	
	Terry J. Owens	)	BOARD OF
PATENT		)	
	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
		)	
	Thomas A. Waltz	)	
	Administrative Patent Judge	)	

BRG:tdl

Appeal No. 1997-4345  
Application No. 08/292,670

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