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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LAU S. YANG, GANGFENG CAI, JEFFREY M. MCFARLAND, and JEFFREY A. KLANG

Appeal No. 1998-2646
Application No. 08/685,365

ON BRIEF

Before GARRIS, LIEBERMAN, and TIMM, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1, 2, 4-6, 8, 13 and 14. The only other claims remaining in the application, which are claims 9, 11, 12 and 15 stand withdrawn from further consideration by the Examiner.

The subject matter on appeal relates to a composition comprising a miscible resin blend of an epoxy-extended polyetherester resin prepared by a particular process which

includes the use of an insertion catalyst and one or more polymer resins selected from a specified group which includes vinyl ester resins. This appealed subject matter is adequately illustrated by independent claim 1 which reads as follows:

1. A composition comprising a miscible resin blend of:

(a) an epoxy-extended polyetherester resin prepared by

(1) reacting a polyether polyol with a dicarboxylic acid, an anhydride, or a diol diester in the presence of an insertion catalyst to produce an acid-terminated polyetherester resin; and

(2) reacting the acid-terminated polyetherester resin with an epoxy compound to produce the epoxy-extended polyetherester resin; and

(b) one or more polymer resins selected from the group consisting of vinyl esters, isophthalate resins, orthophthalate resins, dicyclopentadiene (DCPD) resins, bisphenol A resins, propylene glycol-maleate resins, and chlorendic anhydride resins.

The references relied upon by the Examiner as evidence of obviousness are:

Craigie	4,336,344	June 22, 1982
Stahl et al. (Stahl)	5,196,482	Mar. 23, 1993
Yang et al. (Yang)	5,436,314	July 25, 1995
Bertsch (European Patent Application)	580,114	Jan. 26, 1994

According to the Examiner's statement of rejection on page 3 of the answer, claims 1, 2, 4[1]-6, 8, 13 and 14[2] are rejected under 35 U.S.C. § 103 as being unpatentable over Stahl or Craigie in view of Yang and the EPA reference.

We refer to the brief and reply brief and to the answer for a complete exposition of the opposing viewpoints expressed by the Appellants and by the Examiner concerning the above noted rejection.

OPINION

As correctly indicated by the Appellants in their brief, obviousness cannot be established by combining the teachings

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[1] As indicated by the Appellants on page 2 of the brief, claim 4 is informal in that it depends from now canceled claim 3. This informality should be corrected in any further prosecution that may occur.

[2] Claims 13 and 14 were not included in the Examiner's statement of this rejection as set forth in the final office action. Apparently, in preparing the answer, the Examiner came to realize that these claims depend from elected independent claims 1 and 6 rather than non-elected independent claim 9 and therefore added claims 13 and 14 to the statement of rejection which appears on page 3 of the answer. The Examiner's actions regarding these last mentioned claims are harmless particularly in light of our disposition of this appeal.

of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). In the case before us on this appeal, as also correctly indicated by the Appellants in their brief, the applied prior art contains no teaching, suggestion or incentive for combining the applied reference teachings in the manner proposed by the Examiner.

More specifically, nothing in the applied references supports the Examiner's proposal to modify the insertion produced polyetherester resin of Yang by adding thereto an epoxy-terminated reactive liquid polymer of a type used in the EPA reference for toughening unsaturated polyetherester resins and

then substituting this modified polyetherester resin for the polyetherester resin of Stahl's composition or for the unsaturated polyester of Craigie's composition in order to thereby obtain a composition readable on appealed claim 1. Contrary to the Examiner's apparent belief, the toughness characteristic described in the EPA reference would not have motivated an artisan to combine the various reference

teachings in the proposed manner previously discussed. This is because the applied references do not support the Examiner's implicit proposition that such a characteristic would have been desirable in the ultimate compositions under consideration or that the achievement of such a characteristic (even if presumed to be desirable) would have been reasonably expected to be successful. In re O'Farrell, 853 F.2d 894, 903-904, 7 USPQ2d 1673, 1680-1681 Fed Cir. 1988).

The Examiner's rationale in support of his conclusion of obviousness contains additional infirmities as more fully detailed in the brief. However, we see little point in expounding upon these additional infirmities. Suffice it to say that we share the Appellants' viewpoint that the rejection before us is based upon impermissible hindsight derived from the Appellants' own disclosure (W. L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)), rather than some teaching, suggestion or incentive derived from the applied prior art (ACS Hospital Systems, Inc. v. Montefiore Hospital, id.).

Under these circumstances, we cannot sustain the Examiner's § 103 rejection of claims 1, 2, 4-6, 8, 13 and 14 as being unpatentable over Stahl or Craigie in view of Yang and the EPA reference.

The decision of the Examiner is reversed.

REVERSED

BRADLEY R. GARRIS Administrative Patent Judge	)	
PAUL LIEBERMAN Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
CATHERINE TIMM Administrative Patent Judge	)	

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