

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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PATRICK KAPPLER,
JEAN L. PERILLON and CATHERINE SAVARY

Appeal No. 1998-3162
Application 08/453,149

HEARD: November 7, 2001

Before WARREN, KRATZ and PAWLIKOWSKI, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellants, in the brief,¹ and based on our review, find that we cannot sustain either of the rejections of appealed claims 1, 2, 5 through 7 and 10 through 12,² under 35 U.S.C. § 103 as being unpatentable over Mohri et al. (Mohri).³ We agree with appellants that the examiner has failed to make out a *prima facie* case of obviousness.

¹ We have considered the brief filed November 17, 2001 (Paper No. 17).

² See the amendments of July 23, 1996 (Paper No. 9), and specification, pages 28-30. Claims 3 and 4 are also of record and have been withdrawn by the examiner under 37 CFR § 1.142(b).

³ Answer, pages 3-5.

A *prima facie* case of obviousness is established by showing that some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in the art would have led that person to the claimed invention as a whole, including each and every limitation of the claims, without recourse to the teachings in appellants' disclosure. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996) (“When obviousness is based on a particular prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. [Citation omitted.] This suggestion or motivation need not be expressly stated. [Citation omitted.]”); *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed. Cir. 1988).

It is readily apparent that the plain language of appealed claim 1, when considered in light of the written description in the specification as interpreted by one of ordinary skill in this art, *see, e.g., In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997), simply requires that the hydroxylated fluorinated copolymer must be prepared solely from one member of each of the three stated groups of monomers. It is readily apparent from Mohri that the fluorine containing copolymers disclosed therein must be prepared from at least one member of each of four groups of monomers, wherein *none* of the members of two of the required groups are among those specified in the monomer groups of appealed claim 1. Thus, in routinely preparing the copolymers of Mohri, one of ordinary skill in this art could have selected certain members of two required groups which fall within the monomers required in appealed claim 1 for purposes of copolymerizing the same with monomers selected from each of the other two required groups.

The examiner's position appears to be that even though Mohri is “silent” with respect to hydroxylated fluorinated copolymers as required by appealed claim 1, “one having ordinary skill in the art would have found it obvious to cull, from the disclosure of [Mohri] the precisely defined copolymer including a combination of tetrafluoroethylene (a) and trifluoroethylene (b), alone, and further in

combination with an acrylic copolymer since the combination of individually disclosed ingredients for their stated purpose is authorized per *In re Jansen* [525 F.2d 1059, 187 USPQ 743 (CCPA 1975)] and with the understanding that [Mohri] gives express authorization to blend the fluorine-containing copolymer with other acrylic resins . . . and with a reasonable expectancy of success” (answer, page 4).

There is no support in *Jansen* for this proposition. Indeed, as appellants point out (brief, IX.B.1.), there is no authority which supports the proposition that one of ordinary skill in this art could have obviously arrived at a claimed chemical compound by simply choosing less than all of the starting materials taught to be necessary by the reference to prepare the compound disclosed therein even in the absence of evidence that there is an objective teaching, suggestion or motivation in the prior art to do so. Here, no such evidence is of record. See *In re Jones*, 958 F.2d 347, 349-51, 21 USPQ2d 1941, 1943-44 (Fed. Cir. 1992) (“Conspicuously missing from this record is any *evidence*, other than the PTO’s speculation (if it be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modifications of the prior art salts necessary to arrive at the claimed . . . salt.”); *In re Dillon*, 919 F.2d 688, 692-93, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990)(*in banc*) (“This court . . . reaffirms that structural similarity between claimed and prior art subject matter, proved by combining references or otherwise, where the prior art gives reason or motivation to make the claimed compositions, creates a *prima facie* case of obviousness, and that the burden (and opportunity) then falls on an applicant to rebut that *prima facie* case.”); *In re Grabiak*, 769 F.2d 729, 731-32, 226 USPQ 870, 872 (Fed. Cir. 1985) (“[W]e have concluded that generalizations should be avoided insofar as specific chemical structures are alleged to be *prima facie* obvious one from the other. . . . [I]n the case before us there must be adequate support in the prior art for the ester/thioester change in structure, in order to complete the PTO’s *prima facie* case and shift the burden of going forward to the applicant.”); *In re Payne*, 606 F.2d 303, 315, 203 USPQ 245, 254-55 (CCPA 1979) (“An obviousness rejection based on similarity in chemical structure and function entails the motivation of one skilled in the art to make a claimed compound, in the expectation that compounds similar in structure will have similar properties.”).

Therefore, it is clear that the examiner has resorted to hindsight gained from appellants’ specification and claims in order to reach the conclusion that the claimed invention was *prima facie*

obviousness over Mohri, which is an inappropriate standard of obviousness under 35 U.S.C. § 103(a). *See generally, Rouffet, supra* (“hindsight” is inferred when the specific understanding or principal within the knowledge of one of ordinary skill in the art leading to the modification of the prior art in order to arrive at appellant’s claimed invention has not been explained); *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983) (“To imbue one of ordinary skill in the art with knowledge of the invention . . . when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to . . . hindsight . . . wherein that which only the inventor taught is used against its teacher.”).

The examiner’s decision is reversed.

Reversed

CHARLES F. WARREN)	
Administrative Patent Judge)	
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PETER F. KRATZ)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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BEVERLY A. PAWLIKOWSKI)	
Administrative Patent Judge)	

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