

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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.17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte GEORGE COMBS  
and KENNETH G. MCDANIEL

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Appeal No. 1999-2229  
Application 08/832,167

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ON BRIEF

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Before GARRIS, LIEBERMAN and TIMM, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

**DECISION ON APPEAL**

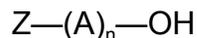
This is a decision on an appeal from the refusal of the examiner to allow claims 1-27, 30 and 31 as amended subsequent to the final rejection. These are all of the claims remaining in the application.

The subject matter on appeal relates to a composition which comprises an oleophilic polyoxyalkylene monoether of a particular structure and less than 6 mole percent, based on the amount of monoether, of alkoxyated unsaturates and/or less

than about 5 mole percent, based on the amount of monoether, of polyoxyalkylene diols. The appealed subject matter also relates to a method of using such a composition. This appealed subject matter is adequately illustrated by independent claim 13 which reads as follows:

13. A composition which comprises:

- (a) an oleophilic polyoxyalkylene monoether of the structure:



wherein A is an oxyalkylene group, Z is a hydrocarbyl residue selected from the group consisting of C<sub>4</sub>-C<sub>60</sub> alkyl, aryl, and aralkyl, and n, which is the average number of oxyalkylene groups, is within the range of about 2 to about 500; and

- (b) less than about 6 mole percent, based on the amount of monoether, of alkoxyated unsaturates.

The references set forth below are relied upon by the examiner as evidence of obviousness:

Manary	3,615,295	Oct. 26, 1971
Polss	3,901,665	Aug. 26, 1975

Under 35 USC § 103(a), claims 1-3, 5-20, 22, 24, 26, 30 and 31 are rejected as being unpatentable over Manary, and claims 1, 2, 4-18, 21, 23, 25, 27, 30 and 31 are rejected as being unpatentable over Polss.

Although the appealed claims including the independent claims vary widely in

scope and involve different categories of invention, the appellants affirmatively state that “[t]he claims on appeal shall stand or fall together” (Brief, page 3). Accordingly, in assessing the merits of the above noted rejections, we will focus upon independent composition claim 13 as representative of the claims involved in these rejections. See 37 CFR § 1.192(c)(7)(8) (1998) and Ex parte Schier, 21 USPQ2d 1016, 1018 (Bd. Pat. App. Int. 1991). Claim 13 has been selected as the representative claim because it is at least one of the broadest, if not the broadest, appealed claim.

We refer to the Brief and the Reply Brief and to the Answer for a complete exposition of the opposing viewpoints expressed by the appellants and by the examiner concerning the aforementioned rejections.

### **OPINION**

For the reasons set forth in the Answer and below, we will sustain each of the rejections before us on this appeal.

The issues pivotal for resolution of this appeal have been reasonably well crystallized on the subject appeal record. It is the examiner’s position that Manary or Polss would have suggested component (a) of the appellants’ claimed composition, and the appellants do not argue otherwise. However, the appellants vigorously disagree with the examiner’s determination that, since both Manary and Polss are silent regarding the presence of claim component (b), these prior art compositions must satisfy the claim requirement concerning this component (i.e., that the composition

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comprises less than about 6 mole percent alkoxyated unsaturates and/or less than about 5 mole percent polyoxyalkylene diols).

In this last mentioned regard, the appellants point out that both Manary and Polss teach that their compositions may be manufactured using conventional base-catalyzed methods. According to the appellants, such base-catalyzed methods will inherently and inevitably produce impurities in the form of the above noted unsaturates and diols at concentrations higher than permitted by the appealed claims. As support for this position, the appellants refer to their specification disclosure and to the several references attached to their Brief.

Initially, we emphasize that it is appropriate for the appellants to bear the burden of proving that the seemingly identical or substantially identical composition products of Manary or Polss do not actually possess the low-impurity characteristic of the here claimed composition product. The fairness of such a burden allocation is evidenced by the inability of the Patent and Trademark Office to manufacture products or to obtain and compare prior art products. See In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977).

We have carefully considered the evidence proffered by the appellants in support of their position. From our perspective, however, this evidence as a whole tends to support the examiner's view, namely, that the "compositions of Manary and

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Polss do not inevitably contain polyoxyalkylene diols and alkoxyated unsaturates in an amount greater than [sic, than] the claims [permit]" (Brief, page 5). Our reasons for this determination follow.

We cannot agree with the appellants that their position is supported by the subject specification disclosure. On the contrary, Table 1 on specification page 10 reflects that inventive monoether E of Example No. 5 included a quantity of C<sub>3</sub> olefin (i.e., alkoxyated unsaturates) within the here claimed range despite the fact that a KOH catalyst was used (i.e., the reaction was base-catalyzed in correspondence with the disclosures of Manary and Polss). Similarly, a number of the references attached to the appellants' Brief disclose methods of making monoethers of the type under consideration having reduced unsaturation via a base-catalyzed reaction. Specifically, base-catalyzed reactions which yield reduced unsaturation are disclosed in U.S. Patent No. 5,114,988 and U.S. Patent No. 5,114,619. While the other references attached to the appellants' Brief effect a reduction in unsaturation via other types of catalyst, they certainly do not negative the teachings of the aforementioned patents or otherwise support the appellants' sweeping proposition that all base-catalyzed reactions for making the monoethers under consideration will inherently and inevitably produce impurities at concentrations higher than permitted by the appealed claims.

In short, a number of the teachings proffered by the appellants as evidence supporting their position in fact militate against it by clearly evincing that the prior art

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includes a number of base-catalyzed reactions which yield the compositions under review having low levels of alkoxyated unsaturates as required by appealed independent claim 13. To this extent, the evidence proffered by the appellants vitiates their position that base-catalyzed reactions inherently and inevitably produce these unsaturates at quantities higher than permitted by the claim under consideration.<sup>1</sup>

Under the circumstances recounted above, it is our ultimate determination that the appellants have failed to carry their burden of proving that the respective compositions of Manary and Polss do not actually possess the low-impurity characteristic of the here claimed compositions. In re Best, 562 at 1255, 195 USPQ at 433-34. It follows that we will sustain each of the § 103 rejections advanced by the examiner on this appeal.

The decision of the examiner is affirmed.

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

**AFFIRMED**

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<sup>1</sup> Indeed, a number of the references attached to the appellants' Brief may anticipate or render obvious compositions of the type defined by appealed claim 13. This possibility should be considered by the appellants and the examiner in any further prosecution that may occur.

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