

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DUNCAN HYWEL-EVANS

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Appeal No. 2000-1180  
Application No. 09/000,028

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ON BRIEF

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Before WINTERS, PAWLIKOWSKI and POTEATE, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

#### **DECISION ON APPEAL**

This is a decision on an appeal from the final rejection of claims 1-22, which are all the claims pending in the application.

The subject matter on appeal is represented by claim 1, set forth below:

1. A cross linkable polyester resin composition suitable for use with a reinforcing element for reinforcing rock and other structures, said composition comprising:

(a) from 10 to 45% of a crosslinkable unsaturated polyester resin,

(b) from 40 to 90% of a filler and

(c) from 1 to 15% of an ethylenically unsaturated monomer copolymerisable with the polyester, the percentages being by

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weight based on the total weight of (a), (b) and (c), the composition being solid at 20°C but permitting insertion and rotation of a reinforcing element to cause mixing of the composition with a crosslinking catalyst to cold cure to form a hard mass.

The references relied upon by the examiner as evidence of unpatentability are:

|                                     |           |               |
|-------------------------------------|-----------|---------------|
| Schmank                             | 3,962,162 | June 8, 1976  |
| Kennedy-Skipton et al.<br>(Skipton) | 4,251,430 | Feb. 17, 1981 |
| Simmons et al. (Simmons)            | 4,616,050 | Oct. 7, 1986  |
| Van Gasse et al. (Van Gasse)        | 5,212,234 | May 18, 1993  |

Claims 1-21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Schmank, Skipton, Simmons or Van Gasse.

Claims 1-22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Schmank, Skipton, Simmons, or Van Gasse.

#### **OPINION**

For the reasons set forth in the brief, reply brief, and below, we reverse each of the above-noted rejections.

We note that the initial burden of presenting a prima facie case of unpatentability on any ground rests with the examiner. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

The examiner's position is that while the references of Schmank, Skipton, Simmons, or Van Gasse do not explicitly disclose that the compositions are solid compositions, because these references each disclose a composition comprising a

polyester resin, filler, and a monomer, these references each disclose a composition that is inherently a solid at room temperature (20°C). (answer, pages 5-6). Alternatively, the examiner states it would have been obvious to formulate solid compositions because "it would be within the skill of one in the art to select suitable percentages . . . to achieve a solid composition". (answer, page 4). The examiner's position also is that each of the references does not indicate that the disclosed composition is cold curable, however, the examiner asserts that appellant's claims do not require such subject matter. (answer, page 7).

Appellant argues that in fact each of the references does not disclose a composition that is solid at 20°C. (pages 8-16 of the brief and the declaration of Leslie Cheriton). For example, appellant states that Simmons, at column 5, lines 18-20, discloses a gel time of one minute, suggesting that the composition cannot be a solid. (brief, page 13). Appellant states that Schmank discloses that the compositions are flowable at 20 to 40°C. (brief, pages 13-14). Appellant states that Skipton's examples are pastes. (brief, page 13).

In response, the examiner, oddly enough, asserts that because Schmank discloses that the composition is flowable at 40°C, the composition is therefore a solid at temperatures less than 40°C. We disagree with the examiner's interpretation of Schmank in this regard. See for example, column 2, lines 62-68 of Schmank. The examiner does not address the other aforementioned points raised by appellant in connection with the Skipton and Simmons references. (answer, pages 5-7).

Furthermore, the examiner does not recognize the aspect of appellant's claimed invention regarding "a cold cure

crosslinkable polyester resin composition". This is explicitly recited, for example, in claim 9 at lines 3-4. We agree with appellant's remarks made on page 10 of the brief, that this recitation concerning cold cure cannot be ignored.

Additionally, we refer to the case of In re Lee, 277 F.3d 1338, 1445, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002). In this case, the court stressed the import of articulating and making of record knowledge negating patentability. Here, other than the conclusionary statements provided by the examiner that each of the references disclose a composition that inherently is a solid at 20°C, and that is inherently cold curable, and that inherently qualifies as a shaped article, the examiner provides no factual support for his conclusions in this regard.

With regard to the 35 U.S.C. § 103 rejection, we reiterate that with respect to obviousness, the examiner has the initial burden of factually supporting any prima facie conclusion of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Here, on page 4 of the answer, the examiner does not explain why one of ordinary skill in the art would have been motivated to modify each of the applied references to arrive at appellant's specifically claimed composition. The examiner simply states that it would be within the skill of one in the art to select suitable percentages of the three ingredients to achieve a solid composition in these references. We find such an explanation insufficient to support a prima facie case of obviousness, and we again refer to the case of In re Lee, 277 F.3d 1338, 1445, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002).

In view of the above, we reverse each of the rejections of record.

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**CONCLUSION**

Each of the rejections is reversed.

**REVERSED**

|                             |   |                 |
|-----------------------------|---|-----------------|
| Sherman D. Winters          | ) |                 |
| Administrative Patent Judge | ) |                 |
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| Beverly A. Pawlikowski      | ) | BOARD OF PATENT |
| Administrative Patent Judge | ) | APPEALS AND     |
|                             | ) | INTERFERENCES   |
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| Linda R. Poteate            | ) |                 |
| Administrative Patent Judge | ) |                 |

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