

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRIAN S. GLASBRENNER

Appeal No. 2001-0851
Application No. 09/042,735

ON BRIEF

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

DECISION ON APPEAL

This is a decision on an appeal which involves claims 19-22 and 24-40 which are all of the claims remaining in the application.

The subject matter on appeal relates to a method of laminating flexible packaging which comprises providing a laminating adhesive comprising an isocyanate composition. The isocyanate composition comprises the reaction product of a polymeric polyol (which in turn comprises the condensation product of an alkylene diol, a diol containing a pendant

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aliphatic chain and a dicarboxylic acid) with an NCO-terminated polyurethane prepolymer (which in turn comprises the reaction product of a polyether polyol and a polyisocyanate) wherein the polyol and polyurethane prepolymer are blended together to form a laminating adhesive having an initial viscosity less than about 25,000 mPa.s at 25°C+/-5°C.

The appealed subject matter also relates to a laminate, a package, a bond assembly and an article, each of which includes the aforementioned adhesive. Further details of this appealed subject matter are set forth in representative independent claim 19 which reads as follows:

19. A method of laminating flexible packaging comprising the steps of:

a) providing a laminating adhesive comprising an isocyanate composition comprising the reaction product of:

i) at least one polymeric polyol (part A) comprising the condensation product of:

1) at least one alkylene diol having a hydroxyl number in a range of from about 950 to about 1250; and

2) at least one diol containing a pendant aliphatic chain having a hydroxyl number in a range of from about 950 to about 1250; and

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3) at least one dicarboxylic acid; with
ii) at least one NCO-terminated polyurethane prepolymer (part B) comprising the reaction product of:

1) at least one polyether polyol; and

2) at least one polyisocyanate;

wherein the equivalence ratio of hydroxyl component (part A) to isocyanate component (part B) is in a range of from about 1:0:1:2 to about 1.0:1.6; and said parts are blended together to form a laminating adhesive having an initial viscosity less than about 25,000 mPa.s at 25 C [sic, 25°C] +/-5 C [sic, 5°C];

b) providing at least one first flexible substrate;

c) applying a layer of said adhesive to a surface of at least one portion of said first substrate;

d) contacting the adhesive coated surface portion of first substrate with at least a portion of the surface of a second substrate; and

e) allowing the said adhesive to bond the first and second substrate together.

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

Abraham et al. (Abraham)	3,915,935	Oct. 28, 1975
Gruenewaelder et al. (Gruenewaelder)	5,278,223	Jan. 11, 1994

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Claims 19-22 and 24-40 are rejected under the second paragraph of 35 U.S.C. § 112 for failing to particularly point out and distinctly claim the subject matter which the appellant regards as his invention.

Claims 19-22 and 24-40 also are rejected under 35 U.S.C. § 103(a) as being unpatentable over Abraham in view of Gruenewaelder.

Rather than reiterate the respective positions advocated by the appellant and by the examiner concerning the above noted rejections, we refer to the brief (filed April 25, 2000) and the "REPLY TO EXAMINER" (filed August 24, 2000) as well as to the answer (mailed November 21, 2000).

OPINION

For the reasons set forth below, we cannot sustain the rejections advanced by the examiner on this appeal.

In assessing the examiner's Section 112, second paragraph, rejection, the proper inquiry is whether the claims set out and circumscribe a particular area with a reasonable degree of precision and particularity. It is here where the definiteness of the language employed must be analyzed, not in a vacuum but, always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by

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one possessing an ordinary level of skill in the pertinent art. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Under this analysis, claims which appear indefinite when read in a vacuum may become quite definite when read in light of the specification disclosure or prior art teachings. Id., n.2.

This last mentioned point is particularly relevant to the issue under review. This is because, in our opinion, the examiner's finding of claim indefiniteness is improperly based upon an analysis of the appealed claims in a vacuum. It is clear to us that, when properly analyzed in light of the appellant's specification disclosure, these claims set out and circumscribe a particular area with a reasonable degree of precision as required by the second paragraph of Section 112. Id.

Specifically, the appealed claims are not rendered indefinite as the examiner believes merely because the two diol reactants recited in the independent claims are not mutually exclusive. Upon reading these claims in light of the appellant's specification disclosure (e.g., see specification pages 3 and 4), one with ordinary skill in this art would readily appreciate that the compounds encompassed by these respective diols may, but need not, be the same. For analogous reasons, claim 40 also complies with the second paragraph of Section 112 contrary to the

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examiner's viewpoint. That is, the disclosure, for example, on page 3 of the subject specification clarifies the alleged indefiniteness perceived by the examiner by revealing that the weight and polyol recitations in this dependent claim relate to part A of parent independent claim 19.

In light of the foregoing, we cannot sustain the examiner's Section 112, second paragraph rejection of all appealed claims.

We also cannot sustain the examiner's Section 103 rejection of all appealed claims as being unpatentable over Abraham in view of Gruenewaelder. Even assuming that it would have been obvious to combine the teachings of these references in the manner proposed by the examiner, the adhesive resulting from this combination would fail to possess the initial viscosity characteristic required by each of the independent claims on appeal. This is because, as correctly argued by the appellant, the applied references contain no teaching or suggestion of the here claimed viscosity characteristic.

In response to the appellant's argument, the examiner contends that "the use of the less viscous polyether polyol reactant [of Gruenewaelder] would have been expected to reduce the viscosity of the adhesive composition to levels which meet those claimed" and that "one of ordinary skill would have been

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able to tailor the desired initial viscosity of the adhesive [resulting from the aforementioned combination of Abraham and Gruenewaelder] through careful selection of polyols and prepolymers of suitable viscosity" (answer, page 7; emphasis added). The aforequoted contentions do not establish obviousness regarding the viscosity limitation claimed by the appellant. Relative to such an obviousness conclusion, the examiner's contentions are deficient in a number of respects.

In the first place, the examiner's contention that using Gruenewaelder's less viscous polyether polyol in Abraham's adhesive composition would reduce the viscosity to levels "which meet those claimed" is completely unsupported by the applied reference evidence. While some degree of viscosity reduction might have been expected, there is absolutely no basis in fact on the record before us for concluding that viscosity would have been reduced to the here claimed levels. Plainly, this contention is based on conjecture, speculation or assumption rather than fact, and it is well settled that a Section 103 rejection must rest on a factual basis rather than conjecture, speculation or

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assumption. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968), reh'g denied, 390 U.S. 1000 (1968).

Likewise, an obviousness conclusion is not supported by the examiner's contention that "one of ordinary skill would have been able to tailor the desired initial viscosity of the adhesive." That is, even if correct, the contention simply does not lead to a conclusion that the initial viscosity defined by the appealed claims would have been obvious to an artisan with ordinary skill. The mere fact that the initial viscosity of the adhesive could be modified by an artisan would not have made the modification obvious unless the prior art suggested the desirability of such a modification. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Here, the applied prior art contains no teaching or suggestion concerning the here claimed initial viscosity or the desirability thereof.

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For the reasons set forth above, we cannot sustain the
Section 112 or Section 103 rejections before us on this appeal.

The decision of the examiner is reversed.

REVERSED

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BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
THOMAS A. WALTZ)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JAMES T. MOORE)	
Administrative Patent Judge)	

BRG:hh

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