

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KARIN BERGSTROM
and
PER-ERIK HELLBERG

Appeal No. 2002-1001
Application No. 09/202,906

ON BRIEF

Before GARRIS, DELMENDO, and MOORE, Administrative Patent Judges.

DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 (2002) from the examiner's final rejection of claim 3 in the above-identified application. Claims 1, 2, and 4 through 9, which are the only other pending claims, have been allowed. (Examiner's answer mailed Oct. 19, 2001, paper 18, page 2.)

Appeal No. 2002-1001
Application No. 09/202,906

N.I. Nikitin, The Chemistry of Cellulose and Wood 62-71 (J. Schmorak trans., Israel Program for Scientific Translations, Ltd. 1966).

Leo Mandelkern, An Introduction to Macromolecules 18-27 (Springer-Verlag New York Inc. 2d. ed. 1983).

Paul C. Hiemenz, Polymer Chemistry: The Basic Concepts 34-43 (Marcel-Dekker, Inc. 1984).

Joel R. Fried, Polymer Science and Technology 16-18 (Prentice Hall PTR 1995).

The appellants rely on the following reference in support of their arguments:

Aldrich Handbook of Fine Chemicals and Laboratory Equipment F12, 786 (n.d.) (Aldrich).

Claim 3 on appeal stands rejected under 35 U.S.C. § 112, second paragraph, as indefinite. (Answer, pages 3-8.)

We affirm.

The appellants do not dispute the examiner's finding, based on substantial evidence in the form of the relied upon prior art, that the weight average molecular weight (M_w) value and the number average molecular weight (M_n) value for the here claimed polymer differ significantly. Nor do they contest the examiner's determination that molecular weight values would be meaningless to one skilled in the relevant art and would thus render a claim reciting them indefinite, unless the particular type of molecular weight characterization (i.e., weight average M_w or number average M_n) is sufficiently indicated in the claim

or in the accompanying specification. Rather, the appellants' principal argument in this appeal is that one skilled in the relevant art would understand from reading the present specification that the recited molecular weight values are M_w values. (Appeal brief filed Jun. 29, 2001, paper 16, page 3; reply brief filed Jan. 24, 2002, paper 19, pages 1-4.) In support of their position, the appellants refer us to the description of Examples 1 and 2 in the specification.

We find the appellants' position to be without merit. The appellants are correct in pointing out (appeal brief, page 3) that polypropylene glycol having an unspecified average molecular weight of 400 is used in the examples of the present specification as a starting material in the synthesis of the claimed polymer. (Specification, page 5, lines 8-11.) The appellants are also correct in stating that Aldrich quantifies the M_w of a commercial polyethylene glycol identified by Aldrich catalog number 20,239-8 as 400. However, these facts are woefully insufficient to establish that the molecular weight value recited in the specification examples for polypropylene glycol is an M_w value, much less establish that the values recited for the claimed polymer are M_w values. To begin, polypropylene glycol is not the same as polyethylene glycol.

Hence, the M_w of Aldrich's polyethylene glycol is irrelevant to the facts of this case.¹ Additionally, the appellants do not identify any evidence in the specification or elsewhere to establish that the polypropylene glycol used in the specification examples was purchased from Aldrich and that the molecular weight information was obtained from Aldrich. Contrary to their counsel's unsupported allegation (appeal brief, page 3), the appellants have failed to identify any evidence in the specification or elsewhere to establish that one skilled in the relevant art would have understood the molecular weight values reported in the specification as M_w values.

The appellants also contend that the use of the term "mole" in conjunction with the term "average molecular weight" in the examples (specification, page 5, lines 8-9) "clearly conveys to one of ordinary skill in the art that weight average molecular weight is meant by [the] appellants." (Appeal brief, page 4.) However, the appellants have failed to present any persuasive scientific reasoning or sufficient evidence to support this position.

¹ It is interesting to note that Aldrich Handbook of Fine Chemicals and Laboratory Equipment 1387-88, T827 (2000-01), copy attached, reports the molecular weights of its commercial polypropylene glycols in terms of M_n . This undercuts the appellants' argument that the molecular weight value reported for the polypropylene glycol in the specification examples is M_w .

The appellants argue that the molecular weight of the claimed polymer was analyzed using gel permeation chromatography (GPC) by comparing the orthoester-based polymers with polypropylene glycol of known M_w and that, therefore, the recited molecular weight values are M_w values. (Appeal brief, page 4.) Again, however, the appellants have failed to identify any evidence in the specification or elsewhere to support this argument. On this point, it is well settled that mere lawyer's arguments and conclusory statements, which are unsupported by factual evidence, are entitled to little probative value. In re Geisler, 116 F.3d 1465, 1470, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997); In re De Blauwe, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978); In re Lindner, 457 F.2d 506, 508-09, 173 USPQ 356, 358 (CCPA 1972).

The appellants urge: "[N]umber average molecular weight is not mentioned anywhere in appellants' specification." (Appeal brief, page 5.) We note, however, that the appellants have not identified any portion of the specification that mentions weight average molecular weight. Accordingly, it is our judgment that one skilled in the relevant art would not understand what type of molecular weight values are intended and, therefore, would be unable to ascertain the scope of appealed claim 3.

Appeal No. 2002-1001
Application No. 09/202,906

For the reasons well stated in the answer, we affirm the examiner's rejection under 35 U.S.C. § 112, second paragraph, of appealed claim 3 as indefinite.

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

Bradley R. Garris)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
Romulo H. Delmendo)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
)	
James T. Moore)	
Administrative Patent Judge)	

RHD/kis

Appeal No. 2002-1001
Application No. 09/202,906

RALPH J. MANCINI
AKZO NOBEL INC
PATENT & TRADEMARK DEPARTMENT
7 LIVINGSTON AVE
DOBBS FERRY NY 10522-3408