

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANK HOLTRUP, TANJA SCHONSTETTER
AND HEIDI GRUNDNER

Appeal No. 2002-2217
Application 09/549,016

ON BRIEF

Before KIMLIN, OWENS and POTEATE, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

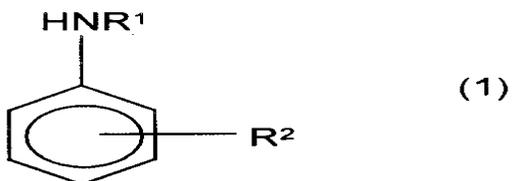
DECISION ON APPEAL

This appeal is from the final rejection of claims 1-3. Claim 4, which is the only other claim in the application, stands allowed.

THE INVENTION

The appellants' claimed invention is directed toward a resin obtainable by reacting of a specified substituted aniline with an aldehyde and an alkylene oxide. Claim 1 is illustrative:

1. A resin obtainable from a compound of the formula 1



in which the substituents R^2 and HNR^1 can be in the ortho, meta or para position relative to one another, and

R^1 has the same meaning as R^2 , or has the meaning $-COR^2$, where R^1 is independent of R^2 ,

R^2 is C_1-C_{30} -alkyl, C_2-C_{30} -alkenyl, C_6-C_{18} -aryl, C_7-C_{30} -alkyl-aryl, by the steps, which can be carried out in any order, of

A) reaction with an aldehyde of the formula 2

R^3-CHO (2),

wherein R^3 is H, C_1-C_{30} -alkyl, C_2-C_{30} -alkenyl, C_6-C_{18} -aryl or C_7-C_{30} -alkylaryl, and

B) alkoxylation with a C_2-C_4 -alkylene oxide in molar excess, such that the resulting alkoxyate has a degree of alkoxylation of from 1 to 100 alkylene oxide units per $-NH$ group,

and the resin has a molecular weight of from 250 to 100,000 units.

THE REFERENCE

Cox

3,245,924

Apr. 12, 1966

Appeal No. 2002-2217
Application 09/549,016

THE REJECTION

Claims 1-3 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cox.

OPINION

We affirm the aforementioned rejection.

The appellants state that the claims stand or fall together (brief, page 3). We therefore limit our discussion to one claim, i.e., claim 1, which is the sole independent claim. See *In re Ochiai*, 71 F.3d 1565, 1566 n.2, 37 USPQ2d 1127, 1129 n.2 (Fed. Cir. 1995); 37 CFR § 1.192(c) (7) (1997).

Cox discloses a resin obtained by reacting an alkyl-substituted aniline (formula 1 in the appellants' claim 1) with formaldehyde (component A in the appellants' claim 1) and phenol, and reacting this product with a vicinal epoxide, the preferred vicinal epoxide being an alkylene oxide (component B in the appellants' claim 1) such as ethylene oxide, 1,2-epoxypropane, and the epoxybutanes (col. 2, lines 36-58; col. 3, lines 58-60 and 65-67; col. 19, lines 39-55). The formaldehyde and alkylene oxide react with the amino group of the alkyl-substituted aniline (col. 2, lines 38-41; col. 5, lines 35-43). "The polyols can have oxyalkylene chains which average from about 1.0, and lower, to about 30, and higher, oxyalkylene units per reactive hydrogen

Appeal No. 2002-2217
Application 09/549,016

atoms contained in the phenol-aromatic amine-aldehyde condensation product. (The reactive hydrogens are the phenolic hydroxyl hydrogens and the aromatic amino hydrogens.)" (col. 6, lines 4-10). In the examples, molecular weights of the resin, before reaction with the alkylene oxide, include values above 250 (up to 551) (tables I and III).

Cox, therefore, would have fairly suggested, to one of ordinary skill in the art, a resin falling within the scope of the appellants' claim 1.

The appellants argue that Cox is nonanalogous art because the resin is for use in making polyurethane foams, whereas the appellants' resin is to be used as a crude oil emulsion breaker (brief, pages 4-6). The test of whether a reference is from an analogous art is first, whether it is within the field of the inventor's endeavor, and second, if it is not, whether it is reasonably pertinent to the particular problem with which the inventor was involved. See *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). The field of endeavor of the claimed invention is, broadly, resins, which the field to which Cox is directed.

The appellants argue that Cox does not teach that the resin disclosed therein can be used to break crude oil emulsions (brief, page 8). This argument is not persuasive because the appellants' claim 1 does not require that the resin is capable of breaking crude oil emulsions.

The appellants argue that one of ordinary skill in the art would not replace amino substituents on Cox's substituted aniline with alkyl substituents (brief, pages 8-9). This argument is not well taken because Cox discloses not only amino-substituted anilines, but also alkyl-substituted anilines (col. 3, lines 59-60 and 65-67; col. 19, lines 39-55).

The appellants argue that Cox does not disclose a homogeneous resin obtainable from a compound having formula 1 of the appellants' claim 1 (brief, page 10). We are not persuaded by this argument because that claim does not exclude reacting the compound of formula 1 with an additional compound other than components A and B.

The appellants argue that 1) Cox discloses a phenol-containing composition, 2) the objective of the appellants' invention is to eliminate phenols, and 3) there is no OH group in formula 1 of the appellants' claim 1 (brief, pages 5 and 9; reply brief, page 3). The appellants' claim 1, however, merely

Appeal No. 2002-2217
Application 09/549,016

requires that the resin is obtainable by reacting the compound of formula 1 with components A and B. As discussed above, Cox would have fairly suggested such a resin to one of ordinary skill in the art. The appellants' resin, as claimed, does not exclude phenol groups. To read the appellants' claim 1 as proposed by the appellants would require reading a limitation from the specification into the claim, which is improper. See *In re Prater*, 415 F.2d 1393, 1405, 162 USPQ 541, 551 (CCPA 1969).

For the above reasons we conclude that the appellants' claimed invention would have been obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103.

Appeal No. 2002-2217
Application 09/549,016

DECISION

The rejection of claims 1-3 under 35 U.S.C. § 103 over Cox 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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EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
TERRY J. OWENS)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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LINDA R. POTEATE)	
Administrative Patent Judge)	

Appeal No. 2002-2217
Application 09/549,016

CLARIANT CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
4000 MONROE ROAD
CHARLOTTE, NC 28205

TJO:cae