

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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte E. CHRIS HORNAMAN

Appeal No. 2004-1178
Application No. 09/655,899

HEARD: December 10, 2003

Before KRATZ, JEFFREY T. SMITH and PAWLIKOWSKI, , *Administrative Patent Judges*.

JEFFREY T. SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals the decision of the Primary Examiner finally rejecting claims 1 to 12, all of the pending claims. We have jurisdiction under 35 U.S.C. § 134.¹

¹ In rendering this decision, we have considered Appellant's arguments presented in the Brief filed March 3, 2003 and the Reply Brief filed June 12, 2003.

BACKGROUND

Appellant's invention relates to a flexible setting type joint compound and the method of producing flexible joints. Claims 1 and 7, which are representative of the claimed invention, appear below:

1. A flexible setting joint compound comprising, for each 100 parts by weight calcium sulfate hemihydrate:

- 2 to 20 parts by weight (solids) of an emulsion polymer having a T_g of less than about -40°C
- 26 to 44 parts by weight total water;
- 0 to 20 parts by weight inert filler;
- 0 to 5 parts by weight additional surfactant; and
- 0 to 5 parts by weight of an accelerator.

7. A method for producing flexible joints comprising:

a) supplying a first planar substrate having a first edge;

b) abutting a second edge of a second planar substrate against said first edge of the first planar substrate, thereby forming a joint;

c) applying a setting hydraulic joint compound to the joint, said joint compound comprising, for each 100 parts by weight calcium sulfate hemihydrate:

- 2 to 20 parts by weight (solids) of an emulsion polymer having a T_g of less than about -40°C ;
- 26 to 44 parts by weight total water;
- 0 to 20 parts by weight inert filler;
- 0 to 5 parts by weight additional surfactant; and
- 0 to 5 parts by weight of an accelerator.

CITED PRIOR ART

As evidence of unpatentability, the Examiner relies on the following references:

Williams	3,947,398	Mar. 30, 1976
Terada et al. (Terada)	4,092,409	Aug. 16, 1977
Babcock et al. (Babcock '365)	4,746,365	May 24, 1988
Babcock et al. (Babcock '018)	4,849,018	Jul. 18, 1989
Patel (Patel '797)	5,653,797	Aug. 5, 1997
Patel (Patel '786)	5,779,786	Jul. 14, 1998
Takiyama, et al (JP'456)	JP-62-57456	Mar. 13, 1987

The Examiner rejected claims 1 to 12 under 35 U.S.C. § 102(b) as anticipated by or in the alternative under 35 U.S.C. § 103(a) as obvious over Williams, Terada, Babcock '018, Babcock '365, Patel '797, Patel '786 or JP'456. (Answer p. 4).

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellant concerning the above-noted rejections, we refer to the Answer and the Briefs. We will limit our discussion to claims 1 and 7 which are the only independent claims.

OPINION

The subject matter of claim 1 is directed to a flexible joint compound that comprises, *inter alia*, for each 100 parts by weight of calcium sulfate hemihydrate, 2 to 20 parts by weight of an emulsion polymer having a T_g of less than about -40°C and 26 to 44 parts by weight total water. The subject matter of claim 7 is directed to a method of producing flexible joints comprising applying a joint compound that comprises, *inter alia*, for each 100 parts by weight of calcium sulfate hemihydrate, 2 to 20 parts by weight of an emulsion polymer having a T_g of less than about -40°C and 26 to 44 parts by weight total water.

The Examiner's position is that each of the cited prior art references anticipates the subject matter of claims 1 and 7. (Answer, page 4.) We cannot agree.

"To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); *accord Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 1047, 34 USPQ2d 1565, 1567 (Fed. Cir. 1995). In addition, the prior art reference must disclose the limitations of the claimed invention "without any need for picking,

Appeal No. 2004-1178
Application No. 09/655,899

choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference." *In re Arkley*, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972); *cf. In re Schaumann*, 572 F.2d 312, 315, 316, 197 USPQ 5, 8, 9 (CCPA 1978)(holding that "the disclosure of a chemical genus...constitute[s] a description of a specific compound" within the meaning of §102 where the specific compound falls within a genus of a "very limited number of compounds.").

Here, it is our judgment that the Examiner has engaged in "picking, and choosing" in order to arrive at a conclusion of anticipation. In this regard, we note that the cited prior art describes compositions that comprise calcium sulfate hemihydrate, an emulsion polymer and water. However, in order for Appellant's invention to be anticipated by each of the cited references, the Examiner must identify, in each reference, disclosure that would have led a person of ordinary skill in the art to a polymer having a T_g of less than about -40°C . None of the cited references describes the necessity to limit the polymer's T_g to less than about -40°C . Consequently, for a person of ordinary skill in the art to arrive at a polymer having a T_g of less than about -40°C , one must select from the expansive list of suitable monomers disclosed in each reference.

Appeal No. 2004-1178
Application No. 09/655,899

Accordingly, because Williams, Terada, Babcock '018, Babcock '365, Patel '797, Patel '786 and JP'456, each individually, do not describe each and every limitation of the appealed claims with sufficient specificity, we cannot uphold the Examiner's rejections under 35 U.S.C. § 102.

The Examiner's rejections under § 103 fails for the same reasons presented above. Specifically, each reference must have disclosure that would have led a person of ordinary skill in the art to a polymer having a T_g of less than about -40°C . The Examiner has not provided motivation for selecting the proper combination of monomers, from each of the cited references, to produce a polymer having a T_g of less than about -40°C . The mere fact that the proper combination of monomers could have been selected from the references as proposed by the Examiner is not sufficient to establish a *prima facie* case of obviousness. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The Examiner has not adequately provided an explanation why the cited prior art would have suggested to one of ordinary skill in the art the desirability of forming a joint compound that comprises an emulsion polymer having a T_g of less than about -40°C .

Appeal No. 2004-1178
Application No. 09/655,899

Since we reverse for the lack of the presentation of a *prima facie* case of obviousness by the Examiner, we need not reach the issue of the sufficiency of the rebuttal evidence presented in the specification. See *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987).

CONCLUSION

The rejections claims 1 to 12 under 35 U.S.C. § 102(b) as anticipated by or in the alternative under 35 U.S.C. § 103(a) as obvious over Williams, Terada, Babcock '018, Babcock '365, Patel '797, Patel '786 or JP' 456 are reversed.

Appeal No. 2004-1178
Application No. 09/655,899

Based on our consideration of the totality of the record before us, we conclude that we cannot uphold the rejections of the claims presented on this record.

REVERSED

PETER F. KRATZ
Administrative Patent Judge

JEFFREY T. SMITH
Administrative Patent Judge

BEVERLY A. PAWLIKOWSKI
Administrative Patent Judge

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Appeal No. 2004-1178
Application No. 09/655,899

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