

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD LEVY

Appeal No. 2005-2667
Application 08/943,125

ON BRIEF:

Before PAK, WARREN and KRATZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

ORDER VACATING ORAL HEARING

On January 25, 2006, Mr. Craig R. Feinberg, a Program and Resources Administrator of the Board of Patent Appeals and Interferences, informed appellant's counsel, Mr. Robert J. Eichelburg, that the Merits Panel assigned to this application had decided to reverse the decision of the examiner. Mr. Feinberg further informed Mr. Eichelburg that therefore, the Oral Hearing scheduled for January 25, 2006, will be vacated.

Accordingly, as counsel was informed on January 25, 2006, it is ORDERED that the Oral Hearing scheduled for 1:00 PM on January 25, 2006, is *VACATED*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, and based on our review, find that we cannot sustain the rejection of appealed claims 43, 44, 49, 50, 55 and 56 under 35 U.S.C. § 102(b) as being anticipated by the Geursen et al. (Geursen) references

United States Patent 5,534,304 ('304 reference) and WO 93/18223 ('223 reference)¹, which are in the same patent family (answer, pages 3-5 and 6-7).^{2,3}

We refer to the answer and to the brief and reply brief for a complete exposition of the positions advanced by the examiner and appellant.

It is well settled that the examiner has the burden of making out a *prima facie* case of anticipation in the first instance by pointing out where each and every element of the claimed invention, arranged as required by the claim, is described identically in a single reference, either expressly or under the principles of inherency, in a manner sufficient to have placed a person of ordinary skill in the art in possession thereof. *See In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). Whether the teachings and inferences that one skilled in this art would have found in the disclosure of an applied reference would have placed this person in possession of the claimed invention, taking into account this person's own knowledge of the particular art, is a question of fact. *See generally, In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995), and cases cited therein (a reference anticipates the claimed method if the step that is not disclosed therein "is within the knowledge of the skilled artisan."); *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968) ("[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom."). While it is entirely appropriate to rely on another reference to clarify a fact in the anticipating reference, *see generally, In re Samour*, 571 F.2d 559, 562, 197 USPQ 1, 4 (CCPA 1978), the supporting reference must in fact accomplish that purpose.

The principal issue in this ground of rejection is whether the lubricating compositions

¹ The answer incorrectly identifies the '223 reference as "WO 93/18233."

² The examiner withdrew the ground of rejection of appealed claims 45 through 48, 51 through 54, 57 and 58 under 35 U.S.C. § 103(a) as being unpatentable over the Geursen et al. references further in view of the admitted prior art and Sayad et al., set forth in the Office action mailed May 24, 2002 (pages 5-7) and maintained in the Office action mailed December 18, 2003. The examiner objected to these claims as containing allowable subject matter but dependent on a rejected base claim (answer, page 2). We consider the ground of rejection under the judicially created doctrine of obviousness type double patenting below.

³ Claims 43 through 48 are all of the claims in the application. *See* page 2 and the appendix of the brief filed March 13, 2003, which we consider on appeal.

containing any “superabsorbent polymer which absorbs greater than about 100 times its weight in water” in the claimed method of lubricating a surface, encompassed claim 43, and the lubricating compositions containing any “superabsorbent polymer which absorbs greater than about 100 times its weight in water and is a polymer of acrylic acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof” in the claimed method of lubricating a surface, encompassed in the remainder of the rejected claims, would have been described to one skilled in this art within the meaning of § 102(b) by the Geursen references.

The examiner takes the position that the Geursen references teach compositions which contain “a superabsorbent material” that is disclosed to be “capable of absorbing and holding a comparatively large quantity of water” which can be made from absorbent derivatives of polyacrylic acid including homo- and copolymers derived from acrylic acid and acrylamide (answer, page 3) (‘223 reference, page 6, ll. 5-32; ‘304 reference, col. 3, ll. 33-67). In the statement of the ground of rejection, the examiner does not identify any specific polymer disclosed *per se* in the Geursen references as meeting the subject claim limitations, but contends that

Geursen incorporates the teachings of Arroyo et al (Arroyo) EP 0,351,100^[4,5] that the [superabsorbent material] includes the ARIDALLTM polymers that are known to absorb greater than 100 times its weight in water. Appellant makes admission on record at page 21 to the bridging paragraph of pages 22-23 of the instant specification that conventional known [superabsorbent material] that absorbs greater than 100 times its weight in water of the Admitted Prior Art are the [superabsorbent material] used in the instant claims. Appellant makes admission on record at line 17 of [page 22] of the instant specification that the ARIDALLTM POLYMERS of the Admitted Prior Art of Arroyo is the [superabsorbent material] used in the instant claims. [Answer, page 4.]

Contrary to appellant’s contentions (brief, page 14; reply brief, page 2), the Geursen references teach that insoluble superabsorbent materials that can be used include those “mentioned in . . . [Arroyo]” which are described as “derived from an aqueous solution comprising an acrylate polymeric material which combines acrylic acid and sodium acrylate

⁴ European Patent Application published January 17, 1990.

⁵ We cannot find Arroyo in a PTO-892, a PTO-1449 or elsewhere in the official electronic file of the USPTO for this application. Thus, if the examiner cannot locate evidence in the official electronic file of the USPTO for this application that Arroyo was made of record, the examiner should make it of record.

functionalities and water” (‘223 reference, page 2, ll. 10-17, and page 6, ll. 9-11; ‘304 reference, col. 1, ll. 45-53, and col. 3, ll. 37-40). We find that Arroyo describes superabsorbent materials generally, including those based on polyacrylic acid and polyacrylonitrile, and discloses that “[t]he preferred superabsorbent material is AridallTM 1125F Superabsorbent Polymer available from the Chemdal Corporation,” and that “Aridall polymers are crosslinked acrylic polymers” (col. 5, l. 35, to col. 7, l. 1).

Appellant discloses in the written description in the specification that “[t]he superabsorbent polymer employed according to the invention, absorbs from about 25 to greater than 100 times its weight in water and comprises a polymer of acrylic acid, an acrylic ester, acrylonitrile or acrylamide, including co-polymers thereof or starch graft copolymers thereof or mixtures thereof, where the mixtures contain from 2 to about 3 or 4 superabsorbent polymers” (page 21, ll. 1-7). Appellant further discloses that the superabsorbent polymers include those listed in certain United States Patents as well as certain commercially available polymers (pages 21-23). Included among the latter is “AridallTM which are sodium or potassium polyacrylates that may be lightly cross-linked” (page 22, ll. 17-18).

Appellant argues in the brief that the “swelling value” disclosed in Geursen references includes “the relative water absorbency of the yarn or the yarn coated with the superabsorbent polymer composition,” and provides a supporting explanation based on the disclosure in Example I, including Table A, of the references for the contention that the same would not have disclosed “superabsorbent polymers that can absorb greater than about 100 times their weight in water” (brief, pages 6-10 and 12; *see* reply brief, page 6). The composition includes “Mirox W 45985” which is a superabsorbent polymer that “is a terpolymer of acrylamide, carboxyl groups- and sulfo groups-containing polymers” (‘223 reference, pages 15-17; ‘304 reference, cols. 8-9).

In response to appellant’s arguments in the brief, the examiner points to the disclosure in the Geursen references that “[d]epending on the nature of the substrate and the quantity and nature of the superabsorbent material applied thereto, the swelling values ranges from 50 to 700 or higher, more particularly from 100 to 700 or higher” (‘223 reference, page 2, ll. 10-17, and page 6, ll. 9-11; ‘304 reference, col. 7, ll. 2-6) (answer, page 6).

Appellant points out in the reply brief that “neither[the Geursen references] nor Arroyo claim that the ARIDALL™ 1125F disclosed in Arroyo can absorb greater than 100 times its weight in water,” and that this material is not disclosed in his specification (pages 3-4).

Appellant states that “an internet search” did not “find” this material (*id.*, page 3).

On this record, we agree with appellant that the examiner has not identified any evidence in the Geursen references and Arroyo which support the ground of rejection. In order to factually support the ground of rejection, the examiner must establish as a matter of fact that at least one superabsorbent material in the references met the subject claim limitations in the appealed claims. This cannot be accomplished by combining a disclosed general range of absorbent values of superabsorbent materials which overlaps the claimed absorbent range of “greater than about 100 times its weight in water,” with a particular superabsorbent material, and especially since there is no disclosure in any of the references or in appellant’s specification which would place the particular species within the claimed absorbent range, either expressly or under the principles of inherency. *See Titanium Metals Corp. of Am. v. Banner*, 778 F.2d 775, 780, 227 USPQ 773, 777 (Fed. Cir. 1985) (“[A]nticipation under § 102 can be found only when the reference discloses exactly what is claimed.”). Therefore, the examiner has not established a *prima facie* case of anticipation under 35 U.S.C. § 102(b) as a matter of fact and accordingly, we reverse this ground of rejection.

Other Issues

Upon further consideration of the appealed claims by the examiner subsequent to the disposition of this appeal, the examiner should consider whether the Geursen references alone (see, e.g., Geursen ‘223, page 5, l. 19, to page 6, l. 32, and page 12, l. 18, to page 13, l. 3), or together with appellant’s admissions in the specification (page 21, l. 1, to page 23, l. 4), which suggest that superabsorbent materials that absorb greater than about 100 times their weight in water were known, affect the patentability of the claimed invention under 35 U.S.C. § 103(a).

REMAND TO THE EXAMINER

We remand the application to the examiner for consideration and explanation of issues raised by the record. 37 CFR §1.41.50(a)(1) (2005); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 2, May 2004; 1200-29 – 1200-30).

The examiner provisionally rejected appealed claims 43 through 57⁶ under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 72 through 86 of then copending application 08/943,123 (answer, pages 5-60). This application has since matured into United States Patent 6,734,147 ('147 patent), issued May 11, 2004.

Appellant filed a terminal disclaimer along with the reply brief on December 8, 2003, "to overcome the double patenting rejection" (reply brief, page 9). The examiner acknowledged that the terminal disclaimer "is proper and has been entered into the file," but did not state the status of the ground of rejection in view thereof in the communication mailed February 27, 2004.

Accordingly, the examiner is required to take appropriate action consistent with current examining practice and procedure to determine whether the terminal disclaimer overcomes the ground of rejection, and if not, to state the ground of rejection based on the appealed claims vis-à-vis the claims of the '147 patent, setting forth the status of appealed claim 58 in this respect, with a view toward placing this application in condition for decision on appeal with respect to the issues presented.

This remand is made for the purpose of directing the examiner to further consider the ground of rejection. Accordingly, if the examiner submits a supplemental answer to the Board in response to this remand, "appellant must within two months from the date of the supplemental examiner's answer exercise one of" the two options set forth in 37 CFR §1.41.50(a)(2) (2005), "in order to avoid *sua sponte* dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding," as provided in this rule.

We hereby remand this application to the examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

⁶ The examiner did not include appealed claim 58 in this ground of rejection (answer, page 5; Office action mailed May 24, 2002, page 7; Office action mailed December 18, 2003, page 3), and thus this claim stands unrejected on appeal.

Reversed

Remanded

CHUNG K. PAK Administrative Patent Judge))))))
CHARLES F. WARREN Administrative Patent Judge) BOARD OF PATENT) APPEALS AND) INTERFERENCES))
PETER F. KRATZ Administrative Patent Judge))

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The Law Offices of Robert J. Eichelburg
HODAFEL Building, Suite 200
196 Action Road
Annapolis, MD 21403