

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 DIETER BOECKH,
RALF OERENBERG, SOEREN HILDEBRANDT,
BERNHARD MOHR, HOLGER SCHOEPKE,
REINHOLD J. LEYRER, and JUERGEN HUFF

Appeal No. 2006-1065
Application No. 10/296,231

ON BRIEF

Before KIMLIN, WARREN, and FRANKLIN, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION

This is an appeal from the final rejection of claims 11-31. Claim 11 is illustrative:

11. A composition for the treatment of hard surfaces, which comprises

(a) 0.05 to 40% by weight of cationically modified, particulate, hydrophobic polymers, the surface of which has been cationically modified by coating with cationic polymers, and the particle size of which is 10 nm to 100 µm, wherein the particulate hydrophobic polymers contain no active substance entrapped therein, distributed throughout, absorbed or adsorbed,

(b) 0 to 20% by weight of at least one water-soluble salt of Ca, Mg, Al, Zn and/or 0.01 to 30% by weight of at least one cationic surfactant and/or 0.01 to 15% by weight of at least one cationic polymer,

(c) 0 to 80% by weight of at least one additive, selected from the group consisting of acids, bases, inorganic builders, organic cobuilders, further surfactants, polymeric color transfer inhibitors, polymeric antiredeposition agents,

soil release polymers, enzymes, complexing agents, corrosion inhibitors, waxes, silicone oils, light protection agents, dyes, solvents, hydrotropes, thickeners and alkanolamines, and

(d) water to make up 100% by weight.

The examiner does not rely upon prior art in the rejection of the appealed claims.

Appellants' claimed invention is directed to a composition comprising a cationically modified, particulate, hydrophobic polymer, water, up to 20% of at least one of the recited water-soluble salts, and up to 80% of various additives. A number of claims on appeal recite the negative limitation that "the particulate hydrophobic polymers contain no active substance entrapped therein, distributed throughout, absorbed or adsorbed."

Appealed claims 11-14, 17, and 20-31 stand rejected under 35 U.S.C. § 112, first paragraph, description requirement. Claims 11-21 stand rejected under the judicially-created doctrine of obviousness-type double patenting over claims of U.S. Patent No. 6,908,490. Also, claims 11-31 stand rejected under the judicially-created doctrine of obviousness-type double patenting over claims of U.S. Patent No. 6,911,054.¹

Appellants have not separately argued any particular claim on appeal. Accordingly, the groups of claims separately rejected by the examiner stand or fall together.

We have thoroughly reviewed each of appellants' arguments for patentability. However, we find that the examiner's rejections are well-founded and in accord with current patent jurisprudence. Accordingly, we will sustain the examiner's rejections.

¹ The examiner has withdrawn the rejection of claims 15, 16, 18, and 19 under 35 U.S.C. § 112, first paragraph (see page 3 of Answer).

We consider first the examiner's rejection under § 112, first paragraph, description requirement. We agree with the examiner that the original specification fails to provide descriptive support for the claim recitation "the particulate hydrophobic polymers contain no active substance entrapped therein, distributed throughout, absorbed or adsorbed." As appreciated by appellants, whether the claim recitation has original descriptive support in the specification is a question of fact. In the present case, we are in agreement with the examiner that the facts do not support appellants' contention that they had possession, at the time of filing the present application, of the concept that the claimed polymers contain no active substance entrapped therein, distributed throughout, absorbed or adsorbed. In re Anderson, 471 F.2d 1237, 1244, 176 USPQ 331, 336 (CCPA 1973).

Our review of the original specification finds no indication that appellants reasonably conveyed to one of ordinary skill in the art that they possessed the inventive concept that the disclosed polymers have no association with active substances. Appellants rely upon the citation of U.S. Patent No. 5,476,660 at page 1 of the present specification, lines 35-42 for evidence that they consider their polymers to be different from the carrier particles of the cited patent. However, the specification reference to U.S. Patent No. 5,476,660 simply describes the prior art use of polymeric retention agents having active substances embedded therein, but the specification provides absolutely no disclosure that the present invention involves a departure from using the polymeric particles as carrier particles. Indeed, it is just as, if not more so, reasonable to conclude that the polymeric particles of the present invention are intended to be employed as such carrier particles.

Appellants also maintain that “[t]he composition described at page 20, lines 19-37 can consist of 0.05–40% by weight of the above-discussed cationically modified, particulate, hydrophobic polymers and 99.95–60% by weight of water [which] is further evidence of possession of such particulate polymers containing no active substance contained therein (page 2 of Reply Brief, penultimate paragraph). We find this argument unconvincing because the relevant section of the original specification broadly describes a large class of compositions that may comprise as much as 80% of a wide variety of customary additives and as much as 20% of various salts, in addition to the particulate polymers and water. The fact that it is possible for one of ordinary skill in the art to ferret out from this extensive class of polymers those which have no active substance entrapped therein, distributed throughout, absorbed or adsorbed falls far short, in our view, of a description of the claimed invention within the meaning of § 112, first paragraph. This is particularly so since appellants have failed to define the compounds and materials which fall within the penumbra of the recited “active substance.”

Appellants also cite case law in support of their position (see page 10 of principal brief). However, the precedential value of prior cases regarding the issue at hand is extremely limited since each case must be decided based on its own particular set of facts. In re Edwards, 568 F.2d 1349, 196 USPQ 465 (CCPA 1978). Here, we are convinced that appellants’ claimed negative limitation introduces a new concept that was not reasonably conveyed to one of ordinary skill in the art at the time of filing the present application. Ex parte Grasselli, 231 USPQ 393 (Bd. App. 1983) (The express exclusion of certain elements in the claim implies the permissible inclusion of all other elements and materials not expressly excluded).

Appellants have not contested the examiner's double patenting rejections but "will file a Terminal Disclaimer" over each of these patents upon the indication of otherwise allowable subject matter" (page 3 of Reply Brief, penultimate paragraph).

In conclusion, based on the foregoing, the examiner's decision of rejecting the appealed claims 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

Edward C. Kimlin)
Administrative Patent Judge)
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) BOARD OF PATENT
Charles F. Warren)
Administrative Patent Judge) APPEALS AND
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) INTERFERENCES
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Beverly A. Franklin)
Administrative Patent Judge)

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