

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 ROLF ALBACH, MICHAEL BROCKELT,
JUAN CIRUJEDA-RANZENBERGER

Appeal No. 2006-1676
Application No. 10/384,882

ON BRIEF

Before KIMLIN, GARRIS and PAK, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal, which involves claims 1-4.
We REVERSE.

The subject matter of this application is generally directed to polyol formulations based on aromatic aminopolyols and flame-resistant rigid foams produced therefrom (Specification, page 1, lines 9-10).

Further details regarding this subject matter are set forth in representative independent claims 1 and 2 which read as follows:

1. A rigid polyurethane foam obtained by reacting
 - a) an isocyanate group-containing component, with
 - b) a component having a flashpoint according to DIN EN 22719 below 55°C, comprising
 - b1) at least one substance which is inert toward an isocyanate, does not have an ozone-destroying effect, and has a boiling point below 100°C,
 - b2) a reaction product of at least one compound having an aromatic ring, at least one aldehyde or ketone and at least one primary or secondary amine,
 - b3) optionally, at least one isocyanate-reactive component which contains polyester groups,
 - b4) optionally, at least one compound which is capable of reacting with the isocyanate and does not correspond to component b2 or b3, and
 - b5) optionally, at least one additive required for the production of a foam.

2. A polyol formulation having a flash point to [sic, according to] DIN EN 22719 below 55°C, comprising
 - b1) at least one substance which is inert toward an isocyanate, does not have an ozone-destroying effect, and has a boiling point below 100°C,
 - b2) a reaction product of at least one compound having an aromatic ring, at least one aldehyde or ketone and at least one primary or secondary amine,
 - b3) optionally, at least one isocyanate-reactive component which contains polyester groups,
 - b4) optionally, at least one compound which is capable of reacting with the isocyanate and does not correspond to component b2 or b3, and
 - b5) optionally, one or more additives required for the production of foams.

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The references set forth below are relied upon by the Examiner as evidence of anticipation:

Molina et al. (Molina)	6,281,393	Aug. 28, 2001
Brennan et al. (Brennan)	4,485,195	Nov. 27, 1984

Claims 1-4 are rejected under 35 U.S.C. § 102(e) as being unpatentable over Molina.¹

Claims 1-2 are rejected under 35 U.S.C. § 102(b) as being unpatentable over Brennan.

Rather than reiterate the respective positions advocated by the Appellants and by the Examiner concerning this rejection, we refer to the brief and reply brief and to the answer respectively for a complete exposition thereof.

OPINION

For the reasons provided below, neither of the § 102 rejections can be sustained.

During examination claim language is given its broadest reasonable interpretation that is consistent with the specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). Additionally, a specification is examined for whatever enlightenment by way of definitions or

¹The examiner rejected claims 1-4 under 35 U.S.C. § 102(e), however, it appears that the rejection should have been made under 35 U.S.C. § 102(b). The U.S. filing date for Appellants' application is March 10, 2003 and the publication date of the Molina patent is August 28, 2001, which is more than one year before Appellants' filing date.

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otherwise it may provide to construing claim language. Id. When interpreting a claim, the specification is usually the single best guide to the meaning of disputed claim language. Phillips v. AWH Corp., 415 F.3d 1303, 1315, 1321, 75 USPQ2d 1321, 1327, 1332 (Fed. Cir. 2005), cert. denied sub nom., 126 S. Ct. 1332 (2006). However, when reading a claim in light of its specification, limitations from the specification must not be imported into the claim. Id. Phillips v. AWH Corp., 415 F.3d at 1323, 75 USPQ2d at 1334. A careful reading of a specification will usually indicate whether applicants are setting out specific examples for the purpose of enabling his invention or if applicant instead intends for his claims and his embodiments in the specification to be strictly coextensive. Id. (citing SciMed Life Sys. v. Advanced Cardiovascular Sys., 242 F.3d 1337, 1341, 58 USPQ2d 1059, 1062-63 (Fed. Cir. 2001)). Also, where applicants have disclaimed or disavowed scope of claim coverage, by using words or expressions of manifest exclusion or restriction in the specification, representing a clear disavowal of claim scope, such language will be used in interpreting the claim scope. Id. Phillips v. AWH Corporation, 415 F.3d at 1319, 75 USPQ2d at 1331 (citing Texas Digital v. Telegenix, 308 F.3d 1193, 1204, 64 USPQ2d 1812, 1819 (Fed. Cir. 2002)). The court in

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SciMed concisely stated this claim interpretation principle as follows:

Where the specification makes clear that the invention does not include a particular feature, that feature is deemed to be outside the reach of the claims of the patent, even though the language of the claims, read without reference to the specification, might be considered broad enough to encompass the feature in question. SciMed Life Sys. v. Advance Cardiovascular Sys., 242 F.3d at 1341, 58 USPQ2d at 1062-63.

Appellants argue in their brief that both Molina and Brennan use an alkoxyated Mannich base (limitation b2 in the claims) to form their foams, whereas Appellants use non-alkoxyated Mannich bases. (Brief at pages 4). Appellants indicate that Molina and Brennan teach that the reaction product of a compound having an aromatic ring, an aldehyde or ketone, and a primary or secondary amine is further reacted with either ethylene oxide or propylene oxide to alkoxyate it, and thereby forming what is known as a Mannich polyol. It is the Mannich polyol, Appellants state, which is used to form Molina's Brennan's foam. Moreover, Appellants in their reply brief state that the Examiner's claim construction, which interprets the b2 reaction product to include alkoxyated Mannich bases, is contrary to the express disclosure in their specification at page 3, lines 11-19. Appellants also cite to the comparative

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examples in their specification, which compare their invention with the prior art Mannich polyol formed foams, as evidence of intended claim scope for the claimed b2 reaction product. (Reply Brief at page 2).

We are persuaded by Appellants' arguments and evidence that their specification includes a clear disclaimer of using alkoxyated Mannich bases such that the broadest reasonable interpretation consistent with the specification would not encompass prior art using such alkoxyated Mannich bases. The "Summary of the Invention" section of Appellants' specification states that non-alkoxyated Mannich bases are used by Appellants to produce foams having more favorable flame propagation properties than foams produced using Mannich polyols (i.e., alkoxyated Mannich bases). (Specification at page 3, lines 11-15). Also, the specification states that using non-alkoxyated Mannich bases yield better compatibility with the blowing agent, than do alkoxyated Mannich bases. (Specification at page 3, lines 17-19). Moreover, Appellants' comparative examples in the table on page 9 of the specification demonstrate that using non-alkoxyated Mannich bases (Examples 1-4) yield compositions with completely dissolved blowing agent and better flame propagation properties, than a composition made with an alkoxyated Mannich

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base (Example V2). From the foregoing written description in the specification, we find that Appellants manifestly and unequivocally disavow that the claimed b2 reaction product includes alkoxyated Mannich bases.

The Examiner in his answer states that the non-alkoxyated Mannich base limitation argued by Appellants in their brief is not present in the claims. The Examiner also states that the claims only require that the b2 reaction product be formed from a compound containing an aromatic ring, an aldehyde or ketone, and a primary or secondary amine. However, the Examiner's broadest interpretation of the claim language must be reasonable and consistent with what Appellants have disclosed in their specification. See In re Morris, 127 F.3d at 1054, 44 USPQ2d at 1027. Moreover, here Appellants have made clear that alkoxyated Mannich bases are not part of their invention, so such alkoxyated Mannich bases are outside of their invention, even though their claims read without reference to their specification may be considered broad enough to encompass alkoxyated Mannich bases. See SciMed Life Sys. v. Advance Cardiovascular Sys., 242 F.3d at 1341, 58 USPQ2d at 1062-63. In view of Appellants' clear disclaimer of using alkoxyated Mannich bases with their foam or polyol composition, the

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Examiner's broad interpretation of the claimed b2 reaction product is neither reasonable nor consistent with the specification. Appellants' specification clearly sets forth that their invention does not include foams formed by or polyols containing alkoxyated Mannich bases.

The strongest indication that the Examiner's interpretation of the b2 reaction product is not reasonable or consistent with Appellants' specification is that it is directly opposite to Appellants' expressly stated claim scope in their specification. A person reading the claims in light of the specification would reasonably and necessarily determine that alkoxyated Mannich bases are not within the scope of Appellants' claims. Accordingly, the Examiner's claim interpretation cannot be regarded as proper.

In summary, we find that Appellants have clearly disclaimed using alkoxyated Mannich bases as the b2 reaction product in their claimed invention. With such a unequivocal disclaimer, the Examiner's claim interpretation that element b2 of Appellants' appealed claims would include alkoxyated Mannich bases is directly opposite to the clear meaning stated by Appellants, and thus is in error. See SciMed Life Sys. v.

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Advance Cardiovascular Sys., 242 F.3d at 1341, 58 USPQ2d at
1062-63.

The decision of the examiner is reversed.

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
BRADLEY R. GARRIS)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
CHUNG K. PAK)	
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BRG/mpc/sld

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