UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte RAYMOND SELTZER,
DAVID DEVORE, GLEN T. CUNKLE, CYRIL HEITNER,
JOHN A. SCHMIDT, PETER F. MCGARRY,
JEAN-PIERRE WOLF, and RANDALL B. NELSON

Appeal No. 2006-2666
Application No. 10/140,531
Technology Center 1700

Decided: May 30, 2007

Before EDWARD C. KIMLIN, CHARLES F. WARREN, and JEFFREY T. SMITH, Administrative Patent Judges.

SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from a final rejection of claims 44-54. We have jurisdiction under 35 U.S.C. § 6

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The present invention relates to a process of preventing the loss of brightness and for enhancing resistance to yellowing of pulp or paper. According to Appellants, the pulp or paper compositions have reduced loss of brightness and enhanced resistance to yellowing by virtue of the composition comprising certain hindered amine derivatives (Br. 7). Representative claim 44, as presented in Appellants' Brief, is reproduced below:

> 44. A process for preventing the loss of brightness and for enhancing resistance to yellowing of pulp or paper which comprises
>
> treating said pulp or paper with an effective stabilizing amounts of hydroxylamine compound of formula I, II or III or hydroxylamine salt of formula IA, IIA or IIIA
>
> $$R_1R_2N\text{-}OH \quad (I)$$
> $$(T_1SCH_2)(T_2SCH_2)N\text{-}OH \quad (II)$$
> $$(E_1COCH_2CH_2)(E_2COCH_2CH_2)N\text{-}OH \quad (III)$$
>
> $$(R_1R_2NH\text{-}OH)_h^+ (X^-)_j \quad (IA)$$
> $$[(T_1SCH_2)(T_2SCH_2)NH\text{-}OH]_h^+ (X^-)_j \quad (IIA)$$
> $$[(E_1COCH_2CH_2)(E_2COCH_2CH_2)NH\text{-}OH]_h^+ (X^-)_j \quad (IIIA)$$
>
> where
>
> $R_1$and R_2 are independently alkyl of 1 to 18 carbon atoms, alkyl of 1 to 18 carbon atoms substituted by a hydroxyl group; or benzyl;
>
> $T_1$and T_2 are independently alkyl of 1 to 4 carbon atoms, phenyl, 3, 5-di-tert-butyl-4-hydroxy-phenyl, benzyl or - CH_2COOH;
>
> $E_1$and E_2 are independently $-OE_3$, $-NHE_3$ or $-NE_3E_4$ where E_3 and E_4 are independently hydrogen, alkyl of 1 to 4 carbon atoms or said alkyl substituted by one hydroxyl group;

X is an inorganic or organic anion; and

the total charge of cations h is equal to the total charge of anions j.

The Examiner relies on the following references in rejecting the appealed claims:

Seltzer	US 5,051,511	Sept. 24, 1991
Rodgers	US 5,459,222	Oct. 17, 1995

Claims 44 to 54 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Seltzer and Rodgers. (Answer 3-5). We affirm the rejection.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellants regarding the above-noted rejection, we make reference to the Answer (mailed April 13, 2006) for the Examiner's reasoning in support of the rejection, and to the Brief (filed April 3, 2006) for the Appellants' arguments thereagainst.

OPINION

Upon careful review of the respective positions advanced by Appellants and the Examiner, we Affirm for the reasons advanced by the Examiner and add the following primarily for emphasis.

Appellants argue that polyurethane and polyester coatings are unknown as paper coatings and that there is no motivation provided to combine the two references in order to solve the present problem (Br. 10). Appellants also present a

Declaration under Rule 132 by Mr. David Vidal, which states that polyurethane and polyester coatings are unknown as paper coatings.[1] (Br. 10).

Appellants' argument and Declaration are not persuasive. Rodgers discloses polyurethane and polyester coatings are known as paper coatings. (Rodgers, col. 8, ll. 29-47). The statement of the declarant is limited to the disclosure of the three documents cited in the Declaration. The cited documents do not include the Rodgers reference cited in the rejection of the claims. (See Declaration 2). Appellants have not presented a Declaration that discusses the disclosure of the Rodgers reference.

Appellants argue, in view of the Declaration, that those skilled in the art would not combine Seltzer and Rodgers because polyurethane or polyester coatings were unknown as paper coatings at the time of filing the present invention and at the time of filing there was no motivation for one skilled in the art to combine the teachings of Seltzer and Rodgers regarding paper (Br. 11).

Contrary to Appellants' arguments, it would have been obvious to combine the teachings of Seltzer and Rodgers for the reasons stated by the Examiner (Answer 4-5). Seltzer discloses hindered amine light stabilizers which combine low basicity with a peroxy group in the same molecule. According to Seltzer, col. 1, ll. 57 to 64, the "light stabilizing hindered amine moiety becomes substantially chemically bonded to the substrate and becomes concomitantly resistant to migration, exudation, leaching, sublimation, volatilization or any process which is prone to remove an additive physically from the substrate it is supposed to

[1] The Declaration was signed on January 21, 2002.

protect." Seltzer also discloses that suitable stabilizers include N,N-diethylhydroxylamine (Seltzer, col. 12, l. 66) for stablizing polymers comprising polyurethanes and polyesters. (Seltzer, col. 8, ll, 12-17 and, 30-47). Rodgers discloses polyester and polyurethane compositions suitable for coating pulp and paper. (Rodgers, col. 8, ll. 29-47). Thus, a person of ordinary skill in the art would have reasonably expected that the light stabilizer of Seltzer would have been an effective additive to the paper and pulp coating composition of Rodgers for the light stabilizing properties.

Appellants argue that picking and choosing is required to arrive at the claimed invention because Seltzer only very generically mentions the possible co-use of hydroxylamine stabilizers among a long list of other potential stabilizers and Seltzer also only generically mentions polyesters and polyurethanes among a whole host of polymer substrates (Br. 11).

This argument is not persuasive because a person of ordinary skill in the art would have reasonably expected that the invention disclosed by Seltzer would have been suitable for the embodiments disclosed therein. Specifically, Seltzer discloses that the stabilizer is suitable for use with polyesters and polyurethanes. The Appellants have not directed us to evidence that the described hydroxylamine stabilizers would not perform as disclosed by Seltzer.

We note that Appellants have not relied upon evidence of unexpected results to rebut the Examiner's obviousness determination.

CONCLUSION

Based on our consideration of the totality of the record before us, having evaluated the prima facie case of obviousness in view of Appellants' arguments

and evidence, we conclude that the subject matter of claims 44 to 54 would have been obvious to a person of ordinary skill in the art from the combined teachings of the cited prior art. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Accordingly, the Examiner's rejection under 35 U.S.C. § 103 is affirmed.

TIME FOR TAKING ACTION

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(iv).

AFFIRMED

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