

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HANSULRICH REISACHER, ANDREAS STOHR,
INGO KLOPP, and JUAN ANTONIO GONZALEZ GOMEZ

Appeal 2007-0499
Application 10/515,345
Technology Center 1700

Decided: September 20, 2007

Before EDWARD C. KIMLIN, CHUNG K. PAK, and PETER F. KRATZ,
Administrative Patent Judges.

KRATZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the Examiner's final rejection of claims 1- 20. We have jurisdiction pursuant to 35 U.S.C. §§ 6 and 134. An Oral Hearing was held on September 11, 2007.

Appellants' invention is directed to a solid pigment preparation, a process of producing same, and processes for using such a preparation. The preparation includes at least one pigment, one or more anionic surface-active agents, and optionally one or more non-ionic surface-active agents, each in a specified amount. The nonionic additive is based on polyethers. The anionic surface-active additive is based on specified acid phosphoric, phosphonic, sulfuric, and/or sulfonic esters or salts thereof with a requirement as to the weight percent of the phosphorous-containing additive when a mixture of phosphorous-containing and sulfur-containing additives are employed and a proviso requiring the employment of a phosphoric and/or phosphonic ester when no nonionic surface active additive is employed in the solid preparation. Appellants' solid pigment preparation is said to be comparable in color and dispersibility properties yet easier to handle and less complex in additive content than stabilized liquid coloring formulations customarily used in coatings, varnishes, emulsion paints, and printing inks (Specification 1). Claim 1 is illustrative and is reproduced below.

1. A solid pigment preparation comprising as essential constituents:
 - (A) from 60% to < 90%, by weight of the preparation, of at least one pigment,
 - (B) > 10% to 40%, by weight of the preparation, of at least one anionic surface- active additive, based on (1) acid phosphoric, phosphonic, sulfuric and/or sulfonic esters of polyalkylene oxides, (2) acid phosphoric, phosphonic, sulfuric and/or sulfonic esters of reaction products of alkylene oxides with aliphatic alcohols, (3) acid phosphoric, phosphonic, sulfuric and/or sulfonic esters of reaction products of alkylene oxides with phenol or naphthol, which may each be optionally alkyl

substituted, (4) acid phosphoric, phosphonic, sulfuric and/or sulfonic esters of reaction products of alkylene oxides with aliphatic or aromatic amines, (5) acid phosphoric, phosphonic, sulfuric and/or sulfonic esters of reaction products of alkylene oxides with aliphatic carboxylic acids or carboxamides, (6) salts of the esters (1) - (5), and wherein the fraction of the phosphorus-containing additive in a mixture of phosphorus- and sulfur-containing additives is not less than 50% by weight, and

(C) from 0% to < 30%, by weight of the preparation, of at least one nonionic surface-active additive based on polyethers,

with the proviso that component (B) is a phosphoric and/or phosphonic ester when the fraction of component (C) is 0% by weight.

The Examiner relies on the following prior art references as evidence in rejecting the appealed claims:

Gonzalez-Blanco	US 6,110,266	Aug. 29, 2000
Nyssen	US 6,646,023 B1	Nov. 11, 2003

In addition, the Examiner relies on the claims of the following copending application in an obviousness-type double patenting rejection:

Copending Application No. 10/501,343¹

Claims 1- 20 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-12 of copending Application No. 10/501,343. Claims 1-3, 5-8, and 11-20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Gonzales-Blanco. Claims 4, 9, and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gonzales-Blanco in view of Nyssen.

¹ This Appeal is related to Appeal No. 2007-2005 involving Application No. 10/501,343. A Board Decision affirming the Examiner's decision based only on a provisional obviousness-type double patenting ground of rejection presented by the Examiner was entered May 24, 2007.

We affirm the provisional obviousness-type double patenting rejection and reverse the anticipation and obviousness rejections. Our reasoning follows.

§ 102(b) Rejection

The Examiner contends that Gonzales-Blanco discloses pigment preparations, which anticipate appealed claims 1-3, 5-8, and 11-20 (Answer 5). Appellants contend that the preparation disclosed in Gonzales-Blanco does not meet the independent claim 1² requirements for a solid pigment preparation, the particular combinations of anionic with or without anionic surface-active additives required in appealed claim 1, and/or amounts thereof within the percentage ranges claimed.

Therefore, the principal issue before us with respect to the Examiner's anticipation rejection is: Whether the Examiner has established that Gonzales-Blanco describes a pigment preparation having all of the above-argued features; that is, the preparation is solid and includes at least one pigment and anionic surface-active additives with or without non-ionic surface-active additives of the kind claimed and in the amounts claimed. We answer that questioning in the negative. Thus, we reverse the Examiner's anticipation rejection.

Here, the Examiner has not identified where in Gonzales-Blanco an anticipatory description of a solid pigment *preparation* that includes all of the above-identified claim features is provided. At best, the Examiner maintains that "this reference does not explicitly disclose that Patentees'

² Rejected claims 2-4, 9 and 10 depend from claim 1. Method claims 5-8 and 11-20 require a process for forming the preparation of claim 1 or a process for pigmenting with the claim 1 preparation.

pigment preparations are either solid or liquid" while further asserting that "[a]lthough the reference may allude to 'further evidence that the preparations are in liquid form', as argued by Appellants, the reference does not clearly indicate that the preparations cannot be in any other form" (Answer 8). Also, *see* Br. 5. The Examiner does not furnish a persuasive basis for a determination that an implicit description of a solid pigment preparation, as here claimed, can be derived from Gonzales-Blanco.

In this regard, the factual determination of anticipation requires the disclosure in a single reference of every element of the claimed invention. *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). Moreover, the Examiner has not established that Gonzales-Blanco describes a pigment preparation that falls within the scope of appealed claim 1 with regard to the surface active component requirements thereof. While picking and choosing from among several optional surfactants and selecting an amount thereof from those suggested by the broad disclosure and ranges of dispersants disclosed by Gonzales-Blanco may have been obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103(a), such selection is not permissible in the context of an anticipation rejection. *See In re Arkley*, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972).

On this record, even if the Examiner could have established that Gonzales-Blanco (col. 8, ll. 26-32) describes a solid pigment/dispersant intermediate preparation, as an option, in forming the final pigment preparation, such would not have saved the Examiner's anticipation rejection because of the above-noted picking and choosing of the surface-active additive(s) and amounts thereof relative to the pigment component

that is required in order to arrive at subject matter on which independent appealed claim 1 would read.

Accordingly, we reverse the anticipation rejection before us.

Turning to the Examiner's obviousness rejection of claims 4, 9, and 11, the Examiner relies on Gonzales-Blanco for the reasons set forth in the anticipation rejection. The Examiner does not otherwise explain why one of ordinary skill in the art would have found Gonzales-Blanco teaches or suggests a pigment preparation corresponding to the independent claim 1 features as required by reference in claims 4, 9, and 11. Nor has the Examiner proffered any other logical reason for such a modification so as to arrive at these required features of rejected claims 4, 9, and 11. Given our determination above, respecting the lack of anticipation by Gonzales-Blanco, we are constrained to reverse the Examiner's rejection of dependent claims 4, 9, and 11, on this record, inasmuch as the obviousness rejection is premised on that erroneous anticipation determination of the Examiner. See the "Other Issue" section below.

Concerning the provisional obviousness-type double patenting rejection, Appellants argue the rejected claims as a group. Thus, we select claim 1 as the representative claim on which we shall decide this appeal as to this ground of rejection. Appellants contend that the claims of copending Application No. 10/501,343 do not suggest that the anionic surface active additive component is present in an amount above the 10 weight percent minimum for the anionic surface active additive component (B) of representative claim 1 and meeting the fractional proviso of representative claim 1. The Examiner, on the other hand, basically maintains that the weight percent range of anionic surface active additive required by

representative claim 1 essentially abuts the 10 weight percent upper end point of the range of weight percent for the anionic surface-active additive recited in claim 1 of the copending application. Given the adjacency of the here-claimed range and that in the copending application claim 1, the Examiner asserts that representative claim 1 is *prima facie* obvious over the claims of the copending application.

Therefore, the issue before us with respect to this rejection is: Whether Appellants have identified reversible error in the Examiner's provisional obviousness-type double patenting rejection? We answer that question in the negative and we affirm the Examiner's obviousness- type double patenting rejection, on this record.

In obviousness-type double patenting rejections, the analysis and issues involved correspond to those encountered in § 103(a) obviousness determinations, albeit the applied claims of the copending application or patent involved, are not required to be prior art to the rejected claims. *See In re Longi*, 759 F.2d 887, 892 n.4, 225 USPQ 645, 648 n.4 (Fed. Cir. 1985). In this regard, it is our view that the use of a slightly higher amount of anionic surface-active additive than expressly disclosed and embraced by claim 1 of the copending application would have been well within the ordinary skill of an artisan seeking to determine the result effectiveness and workability of employing differing amounts of this component in the pigment formulation.³ When the difference between the claimed invention

³ Appellants refer to the proviso of appealed claim 1 as a difference that is not suggested (Br. 6 and 7). However, the claim 1 proviso is not operational when some surface active additive is present in the preparation, as in claim 1 of the copending application. Appellants do not argue the other compositional requirements of component B of appealed claim 1 as

and the prior art is a range or value of a particular variable, then a prima facie rejection is properly established when the difference in range or value is minor. *Hayes Int'l. Inc. v. Jessup Steel Co.*, 8 F.3d 1573, 1577 n.3, 28 USPQ2d 1652, 1655 n.3 (Fed. Cir. 1993).

After all, skill and not the converse is expected of an ordinarily skilled artisan. *In re Sovish*, 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985). Moreover, we are bound to consider the disclosure of each reference for what it fairly teaches one of ordinary skill in the art, including not only the specific teachings, but also the inferences which one of ordinary skill in the art would reasonably have been expected to draw therefrom. See *In re Boe*, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966); and *In re Preda*, 401 F.2d 825, 826-27, 159 USPQ 342, 344 (CCPA 1968). This reasoning also applies in establishing the obviousness of the representative appealed claim 1 over claim 1 of the copending application based on the adjacent ranges at issue in the obviousness-type double patenting rejection here. Hence, we agree with the Examiner that Appellants' appealed claims represent obvious variations of the claims of copending Application No. 10/501,343, which prima facie case has not been persuasively rebutted by Appellants. Consequently, we affirm the Examiner's provisional obviousness-type double patenting rejection, on this record.

OTHER ISSUE

In the event of further prosecution of the subject matter of this application before the Examiner in this or a continuing application, the

representing an unobvious difference over the claims of the copending application. Arguments not made in the Briefs are considered to be waived. See 37 C.F.R. § 41.37(c)(vii) (2006).

Examiner should consider whether or not one of ordinary skill in the art would have found a suggestion based on selections from the teachings of Gonzalez-Blanco, with or without other references, to make a solid pigment preparation corresponding to the claim 1 solid pigment preparation, as an intermediate or final product, in a manner so as to render the claim 1 subject matter *prima facie* obvious. If so, the Examiner should consider introducing an obviousness rejection of claim 1 over Gonzalez-Blanco alone or, in combination with any other references the Examiner may be aware of that would support such a rejection, during any such continued prosecution explaining in detail the reasons/rationale in support of any such rejection. Further, if such an obviousness rejection is introduced, the Examiner should determine whether or not such an obviousness rejection should be extended to any of the other pending claims. In this regard, we observe that whether or not the claim 1 subject matter would have been obvious within the meaning of § 103(a) over Gonzalez-Blanco was not developed by the Examiner on this record as an issue for resolution in this appeal.

CONCLUSION

The decision of the Examiner to reject claims 1-20 as standing provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-12 of copending Application No. 10/501,343 is affirmed. The Examiner's decision to reject claims 1-3, 5-8, and 11-20 under 35 U.S.C. § 102(b) as being anticipated by Gonzales-Blanco and the rejection of claims 4, 9, and 10 under 35 U.S.C. § 103(a) as being unpatentable over Gonzales-Blanco in view of Nyssen is reversed.

Appeal 2007-0499
Application 10/515,345

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

clj

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