

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not binding precedent of the Board.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 WAYNE P. MILLER,
STEWART C. ANDERSON
AND MICHAEL J. DOCHNIAK

Appeal 2007-1688
Application 10/222,617
Technology Center 1700

Decided: July 30, 2007

Before EDWARD C. KIMLIN, BRADLEY R. GARRIS, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the final rejection of claims 1-10 and 13-21. We have jurisdiction under 35 U.S.C. § 6.

We REVERSE.

The subject matter on appeal relates to an aqueous composition comprising an aqueous hydroxy functional, carboxy functional polymer which comprises the reaction product of certain types of hydroxyl functional and carboxylic acid monomers. Further details of this subject matter are set forth in representative independent claim 1 which reads as follows:

1. An aqueous composition comprising
 - a) aqueous hydroxy functional, carboxy functional polymer comprising the reaction product of
 - i) at least 5% by weight α,β -ethylenically unsaturated hydroxy functional monomer,
 - ii) at least 30% by weight ethylenically unsaturated carboxylic acid monomer,
 - iii) 0% by weight to less than 50% by weight α,β -ethylenically unsaturated nonhydroxy functional, noncarboxy functional monomer, and
 - iv) chain transfer agent; and
 - b) condensation accelerator.

The reference set forth below is relied upon by the Examiner as evidence of anticipation:

Arkens US 5,661,213 Aug. 26, 1997

All of the appealed claims stand rejected under 35 U.S.C. § 102(b) as being anticipated by Arkens.

This rejection cannot be sustained.

As correctly argued by Appellants' (Substitute Brief 11, Reply Br., filed Jan. 2, 2007, 4; Reply.Br., filed May 3, 2006, 2-3), Arkens contains no anticipatory disclosure of the claim 1 requirements "at least 5% by weight ... hydroxyl functional monomer" and "at least 30% by weight ... carboxylic acid monomer." The Examiner points out Arkens' polymer is made from 1% to 100% by weight of ethylenically unsaturated carboxylic acid monomer and optionally additional ethylenically unsaturated monomers such as hydroxyethyl acrylate which would be present in an amount from 0% to 99% by weight (Supplemental Answer 5-6; Arkens, col. 4, ll. 1-20). However, the fact that Arkens' very broad weight percent ranges somewhat overlap the claim 1 weight ranges is inadequate to establish anticipation. *Atofina v. Great Lakes Chem. Corp.*, 441 F.3d 991, 999-1000, 78 USPQ2d 1417, 1424 (Fed. Cir. 2006).

The Appellants also correctly argue that the Examiner's anticipation finding is inappropriately based upon selectively choosing and excluding various disclosures in Arkens (Reply Br., filed Jan. 2, 2007, 4; Reply Br., filed May 3, 2006, 3). The Examiner has not responded to this argument.¹ Moreover, it is well settled that, for a § 102 rejection to be proper, the applied reference must clearly and unequivocally disclose the claimed composition without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the

¹ The Examiner also has not responded to the Appellants' arguments concerning separately grouped dependent claims 13, 14, and 15.

reference. *In re Arkley*, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972).

For the above stated reasons, we cannot sustain the Examiner's § 102 rejection of all appealed claims as being anticipated by Arkens.

REMAND

We remand this application to the Examiner for consideration of whether any one or all of the claims on appeal should be rejected under 35 U.S.C. § 103(a) as being obvious over Arkens. In this regard, we emphasize that a claimed range, while not anticipated, may be rendered obvious by an overlapping prior art range. *In re Peterson*, 315 F.3d 1325, 1329, 65 USPQ2d 1379, 1382 (Fed. Cir. 2003). Similarly, the act of picking, choosing and combining various disclosures in a reference, while improper in a § 102 rejection, may be entirely proper in a § 103 rejection. *In re Arkley*, 455 F.2d at 587, 172 USPQ at 526.

In responding to this remand, the Examiner must provide the record with an explanation of why the Arkens reference does or does not render the claims on appeal unpatentable under 35 U.S.C. § 103(a).

This remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) is **not** made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) does not apply.

Appeal 2007-1688
Application 10/222,617

SUMMARY

The decision of the Examiner is REVERSED.

The application is REMANDED to the Examiner.

REVERSED/REMANDED

cam

Julie Post
H.B. Fuller Company
1200 Willow Lake Blvd.
P. O. Box 64683
| ST. Paul, MN 55164-0683