

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* PATRICK GLOCKNER,  
GISELHER FRANZMANN,  
JORN-VOLKER,  
and MARTIN SCHMITTHENNER

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Appeal 2008-0449  
Application 10/732,514  
Technology Center 1700

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Decided: January 11, 2008

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Before BRADLEY R. GARRIS, THOMAS A. WALTZ, and  
KAREN M. HASTINGS, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1, 3-28, and 30-58. We have jurisdiction under 35 U.S.C. § 6.

We AFFIRM.

Appellants claim a polymer-modified resin comprising a hydroxy-functional polyester and a polyacrylate wherein the polyester comprises an alcohol component containing from 0.5 to 80 mol% of dicidol. Appellants also claim a binder, adhesive, and coating comprising the aforementioned resin as well as a process of preparing the resin.

Representative resin claim 1 reads as follows:

1. A polymer-modified resin, comprising:
  - I. at least one hydroxy-functional polyester; and
  - II. at least one polyacrylate having at least one hydroxy group or at least one carboxy group or both;

wherein said polyester I comprises an alcohol component containing of from 0.5 to 80 mol% of dicidol and said polyester I has an OH number of from 5 to 250 mg KOH/g, an acid number of from 0 to 30 mg KOH/g, a Tg of from -30 to 100°C, a dynamic viscosity, as measured in 75 % solution in a C10-11 aromatic hydrocarbon fluid, of from 1 to 40 Pa·s, and an OH functionality of from 1 to 10; and

wherein the resin is obtained by free-radical polymerization of the starting component(s) for preparing of said polyacrylate II in the presence of the polyester I in at least one organic solvent.

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

Höhlein	4,382,114	May 3, 1983
Burzin (as translated)	EP 0 025 089 A1	Mar. 18, 1981
Kuwamura (as translated)	JP 60-241970	Nov. 30, 1985
Lenz	4,578,426	Mar. 25, 1986
Epple	6,048,936	Apr. 11, 2000

Claims 1, 3-23, 25-28, 30-32, 34-40, 42-48, and 50-58 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lenz, Höhle, and Kuwamura in view of Burzin.

Claims 1, 3-28, and 30-58, all of the appealed claims, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Epple in view Burzin.

The issue raised by this appeal is whether it would have been obvious to formulate the polyester of Lenz, Höhle, Kuwamura or Epple using as the alcohol component from 0.5 to 80 mol% of dicidol as required by all of the claims before us.

In addition to argument concerning this limitation of the independent resin claims, Appellants reiterate the recitation of the other appealed claims followed by an unembellished statement that the applied prior art contains no teaching or suggestion of the recited claim features. (Br. 12-32). However, merely pointing out what a claim recites does not constitute an argument for separate patentability of the claim in accordance with 37 C.F.R. § 41.37(c)(1)(vii, last sentence). Moreover, Appellants' unembellished statements that the prior art contains no teaching or suggestion of claim features are completely inadequate to reveal errors in the Examiner's detailed analyses in support of an obviousness conclusion for each of the rejected claims (*see* the Answer in its entirety). For these reasons, we need focus on only representative independent resin claim 1 in order to fully resolve the obviousness issue raised by this appeal.

It is undisputed that each of the primary references to Lenz, Höhle, Kuwamura, and Epple discloses resins comprising hydroxy-functional polyester and polyacrylate wherein the polyester is formulated by reacting carboxylic acids with alcohols generally. It is also undisputed that Burzin

discloses polyesters having desirable properties such as hardness which are formulated from 5-50 mol% dicidol specifically as the alcohol. The Examiner concludes that it would have been obvious for one with ordinary skill in this art to formulate the polyester of the primary references from 5-50 mol% dicidol so as to obtain the aforementioned desirable properties in accordance with the teachings of Burzin (Ans. 6, 7).

In support of their contrary view, Appellants argue that the applied references contain no teaching or suggestion of their reason for using dicidol in formulating the here-claimed polyester, namely, to improve miscibility of the polyester with the polyacrylate of the appealed claims (Br. 12, 22). This argument is unpersuasive.

As the Supreme Court has recently explained, in determining whether the subject matter of a claim is obvious, neither the particular motivation nor the avowed purpose of the inventor controls. *KSR Int'l. Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741-42 (2007). Under the correct analysis, any need or problem known in the field of endeavor at the time of the invention can provide a reason for combining the elements in the manner claimed. *KSR*, 127 S. Ct. at 1742.

Therefore, an obviousness conclusion is not forestalled merely because the applied references contain no teaching or suggestion of the miscibility problem addressed by Appellants. Here, an obviousness conclusion is supported by the undisputed facts that the primary references teach using polyesters derived from alcohols generally and the Burzin reference teaches polyesters having improved properties derived from dicidol specifically. These facts support a conclusion that an artisan would have found it obvious to use dicidol in formulating the polyesters of the

primary references in order to obtain the desirable properties taught by Burzin.

An obviousness conclusion is reinforced by the fact the Lenz discloses forming polyesterols, (i.e., hydroxy-functional polyesters) not only from alcohols generally (col. 14, ll. 34-52) but also from specific alcohols which include a dihydroxymethyltricyclo decane (col. 15, ll. 39-40). This specifically taught alcohol is indistinguishable from the bis(hydroxymethyl) tricyclo decane alcohols taught by Appellants to be encompassed by the here-claimed dicicol (Specification 5:14-24). Therefore, a conclusion of obviousness is additionally supported by the fact that Lenz expressly teaches preparing polyesterols from a specific alcohol encompassed by Appellants' claimed dicidol.

We emphasize that the combination of familiar elements (i.e., Burzin's dicidol or Lenz's dihydroxymethyltricyclo decane in combination with a carboxylic acid in order to prepare polyesters) is likely to be obvious when it does no more than yield predictable results. *KSR*, 127 S. Ct. at 1739.

Appellants imply that the use of dicidol yields unpredictable results as shown by examples in their Specification (Br. 10). However, neither the Brief (*id.*) nor the Specification disclosure (Specification 15-16) characterizes the results in question as unpredictable or unexpected. Furthermore, as correctly indicated by the Examiner (Ans. 8-9), the Specification examples do not present a comparison to the closest prior art and are not commensurate in scope with representative claim 1. *See In re Baxter Travenol Labs.*, 952 F.2d 388, 392 (Fed. Cir. 1991) and *In re Peterson*, 315 F.3d 1325, 1330-31 (Fed. Cir. 2003).

Appeal 2008-0449  
Application 10/732,514

For the reasons set forth above and in the Answer, we determine that the Examiner has established a prima facie case of obviousness which Appellants have failed to successfully rebut with argument or evidence of nonobviousness. We hereby sustain, therefore, each of the § 103 rejections advanced by the Examiner on this appeal.

The decision of the Examiner is affirmed.

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).

AFFIRMED

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