

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* RICHARD A. MILLER

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Appeal 2008-3961  
Application 10/912,381  
Technology Center 1700

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Decided: November 12, 2008

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Before BRADLEY R. GARRIS, PETER F. KRATZ, and MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

*STATEMENT OF THE CASE*

Appellant appeals under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1-31. We have jurisdiction under 35 U.S.C. § 6.  
We REVERSE.

Appellant claims a hot melt adhesive composition comprising a thermoplastic polyamide, an adhesion promoter, and wax having a melting point greater than 82°C.

Representative claims 30 and 31 read as follows:

30. A hot melt adhesive composition comprising:

thermoplastic polyamide;

adhesion promoter comprising at least one acid group; and

wax having a melting point greater than 82°C.

31. The hot melt adhesive composition of claim 30, wherein said adhesion promoter comprises alkylene-maleic anhydride copolymer.

The prior art set forth below is applied by the Examiner in the § 102 and § 103 rejections before us as evidence of unpatentability:

Eernstman	US 4,132,690	Jan. 2, 1979
Wichelhaus	US 4,791,164	Dec. 13, 1988
Akao	US 4,876,125	Oct. 24, 1989
Frihart	US 5,385,986	Jan. 31, 1995
Blumenthal	US 5,750,605	May 12, 1998

Claim 31 is rejected under the second paragraph of 35 U.S.C. § 112 for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention.

Claims 1-3, 10-15, 18-25, and 30 are rejected under 35 U.S.C. § 102(b) as being anticipated by Eernstman.

The remaining claims on appeal are rejected under 35 U.S.C. § 103(a) as being unpatentable over Eernstman in various combinations with Wichelhaus, Frihart, Blumenthal, and Akao.

THE § 112, SECOND PARAGAPH, REJECTION

*ISSUE*

Does the dependent claim 31 requirement for an adhesion promoter comprising alkylene-maleic anhydride copolymer conflict with the parent claim 30 requirement for an adhesion promoter comprising at least one acid group, thereby rendering claim 31 indefinite as determined by the Examiner (Ans. 3-4)?

*FINDING OF FACT*

Claim 30 recites “adhesion promoter comprising at least one acid group” (emphasis added).

*PRINCIPLE OF LAW*

The transitional term “comprising” is open-ended and does not exclude additional, unrecited elements. *Mars Inc. v. H. J. Heinz Co.*, 377 F.3d 1369, 1376 (Fed. Cir. 2004).

*ANALYSIS*

As correctly argued by Appellant (App. Br. 10-11), the "comprising" language of parent claim 30 opens this claim to the inclusion of not only the recited acid group adhesion promoters but also other types of adhesion promoters such as the alkylene-maleic anhydride copolymer of dependent claim 31. Therefore, contrary to the Examiner's position, dependent claim 31 does not conflict with parent claim 30.

*CONCLUSION OF LAW*

For the above stated reasons, claim 31 does not conflict with parent claim 30 and therefore is not indefinite.

Accordingly, we do not sustain the § 112, second paragraph, rejection of claim 31.

## THE § 102 AND § 103 REJECTIONS

### *FINDINGS OF FACT*

Eernstman discloses a hot melt adhesive composition comprising thermoplastic polyamide and an acid group adhesion promoter (Abstract). Eernstman further discloses that, "[i]f desired, the hot-melt adhesive compositions of the present invention may also contain additional tackifying agents, diluents and/or minor amounts of various other ancillary constituents as are known in the art" (col. 4, ll. 28-31). According to Eernstman, "[i]llustrative diluents which may likewise be employed in the instant compositions include, for example petroleum waxes such as paraffin and microcrystalline wax, or synthetic waxes such as Fischer-Tropsch wax or polyethylene waxes described in U.S. Pat. Nos. 2,504,400; 2,683,141; and 2,712,534" (col. 4, ll. 39-44).

The Examiner finds that "three of the four wax groups disclosed by Eernstman et al. inherently exhibit melting points within the claimed range" (Ans. 7). In response to Appellant's argument that Eernstman's wax teaching would yield the claimed wax only by non-anticipatory picking and choosing, the Examiner additionally finds that "one must only decide to include a diluent and further select only one suitable wax from the list of three suitable illustrative diluents" (Ans. 7-8) and that "the selection of one element from one list is not considered picking or choosing" (Ans. 8). In conflict with this latter finding is the Examiner's finding that the three out of four wax groups

said to include waxes having Appellant's claimed melting points also include waxes which do not have such melting points (Ans. 8, first full para.).

*ISSUE*

Has Appellant persuasively argued that the Examiner's § 102 rejection is improper because providing Eernstman's composition with wax having a melting point greater than 82°C as required by all appealed claims would involve non-anticipatory picking and choosing (Subt. App. Br., para. bridging 11-12)?

*PRINCIPLE OF LAW*

For a § 102 rejection to be proper, the prior art must clearly and unequivocally disclose the claimed invention or direct those skilled in the art to the claimed invention without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference. Such picking and choosing may be entirely proper in making a § 103 rejection, but it has no place in a § 102 rejection. *In re Arkley*, 455 F.2d 586, 587-88 (CCPA 1972). *See also Net Moneyin, Inc. v. Verisign, Inc.*, - - - F.3d - - -, 2008 W. L. 4614511 (Fed. Cir. 2008).

*ANALYSIS*

We agree with Appellant that the claimed invention would result only by picking and choosing various disclosures in Eernstman. Specifically, the claimed composition would result only (1) by choosing to provide Eernstman's composition with constituents patentee teaches may be added "[i]f desired" (col. 4, l. 28), (2) by picking as such additional constituents a

Appeal 2008-3961  
Application 10/912,381

diluent, (3) by choosing as such diluent one of the three out of four wax groups that contain waxes having, *inter alia*, Appellant's claimed melting point, and (4) by picking from such wax groups a wax having a melting point above rather than below 82°C. "Such picking and choosing may be entirely proper in the making of a 103, obviousness rejection, . . . but it has no place in the making of a 102, anticipation rejection" (*Arkley*, 455 F.2d at 587-88).

#### *CONCLUSIONS OF LAW*

The Examiner's § 102 rejection improperly involves non-anticipatory picking and choosing. It follows that we do not sustain the § 102 rejection of claims 1-3, 10-15, 18-25, and 30 as being anticipated by Eernstman.

The additionally applied references in the § 103 rejections have not been relied upon by the Examiner to supply the above discussed deficiencies of Eernstman. Therefore, we also do not sustain any of the § 103 rejections advanced by the Examiner in this appeal.

#### *ORDER*

The decision of the Examiner is reversed.

REVERSED

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