

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JASON Q. NIU, ROBERT E. HEFNER,
JAMES P. GODSCHALX, JAMES T. PECHACEK,
and KIM E. ARNDT

Appeal 2008-5568
Application 10/365,938
Technology Center 1700

Decided: December 23, 2008

Before LINDA M. GAUDETTE, MICHAEL P. COLAIANNI, and
JEFFREY B. ROBERTSON, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 16-23, 25-28, 30,
32, 34, 36-40, and 61-71.¹ (Br. 1.) We have jurisdiction under

¹ Claims 24, 29, 31, 33, and 35, also pending in the Application, are objected to, but have been indicated as allowable if rewritten in independent form. (Final Office Action, mailed August 25, 2005; Br. 2.)

According to Godschalx, the precursor compositions preferably comprise “cyclopentadienone functional compounds and acetylene functional aromatic compounds, and/or partially polymerized reaction products of such compounds” (col. 4, ll. 15-18). Godschalx discloses that the most preferred precursor compositions comprise the following monomers and/or the partially polymerized reaction products: (a) a biscyclopentadienone, (b) a polyfunctional acetylene, and, optionally, (c) a diacetylene. (Col. 4, ll. 20-65.)

The Examiner finds that Godschalx discloses forming partially polymerized reaction products using monomers and process steps which are substantially identical to those claimed by Appellants. (Ans. 5.) The Examiner maintains that there is “a reasonable basis to believe that that claimed ‘partially polymerized reaction products’, the type of *leaving group (L)* that ‘is removed to form an aromatic ring structure’, ‘the highly crosslinked polymer’, and ‘the branched, crosslinkable oligomer or polymer’ as claimed are inherently possessed in Godschalx.” (Ans. 5.)

Appellants point out that the claimed polymers are “the reaction product of monomers having at least four reactive functional groups of two different types on the same monomer.” (Br. 3.) Appellants maintain that Godschalx’s reaction products are necessarily different because Godschalx utilizes separate monomers having either dienophiles or diene groups, i.e., both functional groups are not present on the same monomer. (Br. 3.) According to Appellants, “[t]his difference in starting materials and the associated steric hindrances difference in linkages and the like necessarily leads to a difference in the reaction product.” (Br. 3.)

According to Appellants “[e]vidence of these differences is found for example in the TICA results related to modulus in Example 9 and the excellent porosity results obtained (see e.g. Examples 10-12 and 32-37) as compared to the data in the ‘091 patent.” (Br. 3.) Beyond this statement, Appellants have not provided any explanation of the Specification examples and how a comparison to Godschalx’s examples establishes a difference between the claimed and partially polymerized reaction products of Godschalx.

The Examiner disagrees with Appellants’ assertion that Godschalx’s starting materials are different. (Ans. 6.) The Examiner finds that “[w]hen components (a), (b), and (c) of Godschalx et al. are combined (or partially polymerized), the partially polymerized product would have comprised both dienophiles and diene in the same compound, or a single monomer having multiple functional groups of two different types.” (Ans. 6 (citing Godschalx, col. 4, l. 20 - col. 5, l. 56) (emphasis omitted).)

PRINCIPLES OF LAW

When a claimed product appears to be substantially identical to a product disclosed by the prior art, the burden is on the Appellants to prove that the product of the prior art does not necessarily or inherently possess characteristics or properties attributed to the claimed product. *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990); *In re Best*, 562 F.2d 1252, 1254-55 (CCPA 1977).

“[W]hen the prior art evidence reasonably allows the PTO to conclude that a claimed feature is present in the prior art, the evidence ‘compels such a conclusion if the applicant produces no evidence or argument to rebut it.’”

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In re Crish, 393 F.3d 1253, 1259 (Fed. Cir. 2004) (quoting *Spada*, 911 F.2d at 708 n.3).

All evidence of nonobviousness, including data in the specification, must be considered when assessing patentability. *In re Soni*, 54 F.3d 746, 750 (Fed. Cir. 1995) (citing *In re Margolis*, 785 F.2d 1029, 1031 (Fed. Cir. 1986)). However, the burden of analyzing and explaining data to support nonobviousness rests with the Appellants. *In re Klosak*, 455 F.2d 1077, 1080 (CCPA 1972).

ANALYSIS

The Examiner provided a reasonable basis to conclude that Godschalx discloses partially polymerized products which are substantially the same as Appellants' claimed product for the reasons stated in the Answer. The burden was, therefore, properly shifted to Appellants to establish a patentable difference between the claimed and prior art products.

Appellants' sole argument is that the claimed partially polymerized reaction product would not necessarily be the same as Godschalx's product, because Godschalx utilizes different starting monomers. We are not persuaded by this argument, because Appellants have not explained why the Examiner erred in finding that Godschalx's partially polymerized mixture of components would have comprised the same components in the claimed reaction mixture, i.e., "both dienophiles and diene in the same compound, or a single monomer having multiple functional groups of two different types" (Ans. 6 (emphasis omitted)). Appellants' mere reference to examples in the Specification and Godschalx does not provide convincing evidence of patentability, since it is unclear, and Appellants have not explained, how the

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evidence shows a difference in the claimed and prior art products attributable to differences in the starting monomers.

CONCLUSION

Accordingly, we conclude that Appellants have not shown that the Examiner reversibly erred in finding that Godschalx discloses a partially polymerized product that would inherently be the same as Appellants' claimed product. The rejection of claims 16-23, 25-28, 30, 32, 34, 36-40, and 61-71 under 35 U.S.C. § 102(e) as unpatentable over Godschalx is sustained. Because anticipation is the epitome of obviousness, we also sustain the rejection under the 35 U.S.C. § 103(a).

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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