

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERD KONRAD and HEINRICH HARTMANN

Appeal No. 95-2269
Application No. 08/047,159¹

ON BRIEF

Before WINTERS, OWENS and WEIMAR, Administrative Patent Judges.
WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claim 22, which is the only claim remaining in the application.

The appealed claim reads as follows:

22. A water-thickening copolymer, consisting essentially of:
- (a) from 85 to 99% by weight of acrylamide copolymerized with

¹ Application for patent filed April 13, 1993. According to appellants, this application is a continuation of Application No. 07/716,732, filed June 17, 1991, now abandoned.

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(b) from 1 to 15% by weight of at least one monomer selected from the group consisting of N-dodecylmaleamic acid and N-C₈/C₁₈-alkylmaleamic acid;

said copolymer having a viscosity of greater than 443 mPa.s at a shear rate of 1.0s⁻¹ at 0.5% by weight in 10% by weight NaCl solution.

The reference relied on by the examiner is:

Fong et al. (Fong) 4,801,388 Jan. 31, 1989

The issue presented for review is whether the examiner erred in rejecting claim 22 under 35 U.S.C. § 103 as unpatentable over Fong.

DISCUSSION

On consideration of the record, we reverse the examiner's rejection under 35 U.S.C. § 103.

Claim 22, component (b), requires from 1 to 15% by weight of "at least one monomer selected from the group consisting of N-dodecylmaleamic acid and N-C₈/C₁₈-alkylmaleamic acid." N-dodecylmaleamic acid contains a dodecyl group attached to the nitrogen atom of maleamic acid. The dodecyl group is derived from dodecane, which is a saturated hydrocarbon containing 12 carbon atoms. Respecting N-C₈/C₁₈-alkylmaleamic acid, this derivative contains a C₈-C₁₈-alkyl mixture attached to the nitrogen atom of maleamic acid (specification, page 10, lines 28 through 34). In our judgment, the Fong reference is insufficient to support a conclusion of obviousness of claims drawn to either

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embodiment. In setting forth the rejection, the examiner relies on Fong's disclosure of a copolymer having N-substituted maleamic acid units wherein the substituent group may be, inter alia, linear or branched alkyl having from 1 to 10 carbon atoms (Fong, column 3, lines 12 through 28). The examiner does not establish that Fong would have led a person having ordinary skill in the art to the claimed copolymer, prepared from at least one monomer selected from the group consisting of N-dodecylmaleamic acid and N-C₈/C₁₈-alkylmaleamic acid. Simply stated, the Fong reference is insufficient to support a conclusion of obviousness of claim 22 in view of component (b) recited therein. Fong's disclosure does not reach N-dodecylmaleamic acid or N-C₈/C₁₈-alkylmaleamic acid recited in claim 22.

Furthermore, claim 22 defines a water-thickening copolymer consisting essentially of (a) from 85 to 99% by weight of acrylamide copolymerized with (b) from 1 to 15% by weight of at least one monomer selected from the group consisting of N-dodecylmaleamic acid and N-C₈/C₁₈-alkylmaleamic acid; said copolymer having a specified viscosity set forth in the last clause of the claim. The examiner has not established that Fong would have led a person having ordinary skill in the art to a copolymer having those specified portions by weight of components, namely, acrylamide (85 to 99% by weight)

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copolymerized with 1 to 15% by weight of at least one monomer selected from the group consisting of N-dodecylmaleamic acid and N-C₈/C₁₈-alkylmaleamic acid. For this reason too, we do not sustain the rejection under 35 U.S.C. § 103.

Where, as here, the examiner has not adduced sufficient evidence to establish a prima facie case of obviousness of the appealed claim, we find it unnecessary to discuss the Konrad declaration, executed November 22, 1993. That declaration was filed under the provisions of 37 CFR § 1.132 in an effort to rebut any such prima facie case.

The examiner's decision is reversed.

REVERSED

SHERMAN D. WINTERS)	
Administrative Patent Judge)	
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TERRY J. OWENS)	BOARD OF PATENT
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