

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(2) is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID J. ST. CLAIR

Appeal No. 1997-0282
Application 08/423,438

ON BRIEF

Before JOHN D. SMITH, PAK, and LIEBERMAN, Administrative
Patent Judges.

PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claim 16. Claims 17 and 18, the remaining claims in this application, stand withdrawn from consideration by the examiner as being drawn to a non-elected invention.

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Claim 16, the sole claim on appeal, reads as follows.

16. A moisture curable, isocyanate-capped hydroxy-functionalized selectively hydrogenated block copolymer of a vinyl aromatic hydrocarbon and a conjugated diene.

As evidence of obviousness, the examiner relies on the following prior art:

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|------------------------------------|-----------|----------|
| Gergen et al. (Gergen) 1986 | 4,578,429 | Mar. 25, |
| Markevka et al. (Markevka) 1989 | 4,820,368 | Apr. 11, |

Claim 16 stands rejected under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Gergen and Markevka.

We reverse.

Having reviewed the specification, claim and applied prior art, including all of the arguments advanced by the examiner and appellant in support of their positions, we agree with appellant that the applied prior art as a whole would not have rendered the claimed subject matter obvious within the meaning of 35 U.S.C.

§ 103. Our reasons for this determination follow.

The examiner states, and appellant does not dispute, that

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Gergen discloses a hydroxy-functionalized selectively hydrogenated block copolymer of a vinyl aromatic hydrocarbon and a conjugated diene, which can be crosslinked in a conventional manner. See Answer, page 4, with Brief, page 2. As argued by appellant (Brief, page 2), however, Gergen does not teach, nor would have suggested, a moisture-curable, isocyanate-capped hydroxy-functionalized selectively hydrogenated block copolymer of a vinyl aromatic hydrocarbon and a conjugated diene. To remedy this deficiency, the examiner relies on the disclosure of Markevka. See Answer, page 4. According to the examiner, Markevka would have suggested capping the hydroxy-functionalized selectively hydrogenated block copolymer of Gergen with isocyanate compounds to form the claimed block copolymer. See Answer, pages 4 and 5. We disagree.

As correctly indicated by appellant (Brief, page 3), Markevka is directed to forming an adhesive composition comprising, *inter alia*, an isocyanate terminated prepolymer and block copolymers, such as those described in Gergen. Thus, it appears that the applied prior art as a whole would

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have either suggested reacting prepolymers with isocyanate compounds to solidify green bond and/or using the block copolymer of Gergen as the block copolymer of the adhesive composition described in Markevka for purposes of improving its property. However, we do not find any suggestion in the applied prior art to cap the block copolymer of Gergen with isocyanate compounds to arrive at the claimed block copolymer. Nor do we find any reasonable expectation of success in the applied prior art that isocyanate compounds useful for improving the structure of a prepolymer would also be useful for improving the structure of the block copolymer of the type described in Gergen. On this record, we concur with appellant that the examiner has not established a *prima facie* case of obviousness within the meaning of 35 U.S.C.

§ 103.

In view of the foregoing, the decision of the examiner is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

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REVERSED

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| |) | |
| JOHN D. SMITH |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| CHUNG K. PAK |) | |
| Administrative Patent Judge |) | APPEALS AND |
| |) | |
| |) | INTERFERENCES |
| |) | |
| PAUL LIEBERMAN |) |) |
| Administrative Patent Judge |) | |

CKP:hh

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