

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte RUDOLF BRAUN, KARL BRAUNSPERGER,  
HERBERT SÖLLRADL, STEFAN OBERNEDER and ROBERT BRAUNSPERGER

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Appeal No. 1997-0311  
Application No. 08/340,017<sup>1</sup>

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ON BRIEF

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Before KIMLIN, WALTZ and KRATZ, Administrative Patent Judges.  
KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

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<sup>1</sup> Application for patent filed November 15, 1994. According to appellants, this application is a continuation of Application No. 08/056,088, filed May 3, 1993, now abandoned.

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This is an appeal from the final rejection of claims 1-5 and 7-12, all the claims remaining in the present application.

Claims 1 and 12 are illustrative:

1. An aqueous organopolysiloxane dispersion comprising (A) an organopolysiloxane containing groups which are capable of condensation, (B) a condensation catalyst, (C) an organo-polysiloxane resin which is at least partly soluble in organopolysiloxane (A) when present in amounts of up to 50% by weight based on the weight of (A), (D) a compound containing basic nitrogen and (E) a polyvinyl alcohol.
  
12. An elastomer prepared from an aqueous dispersion, comprising
  - (A) an organopolysiloxane containing groups which are capable of condensation,
  - (B) a condensation catalyst,
  - (C) an organopolysiloxane resin which is partly soluble in organopolysiloxane (A) when present in amounts of up to 50% by weight based on the weight of (A),
  - (D) a compound containing basic nitrogen and
  - (E) a polyvinyl alcohol,wherein said elastomer is transparent.

The examiner relies upon the following references as evidence of obviousness:

|                                       |           |               |
|---------------------------------------|-----------|---------------|
| Gamon et al. (Gamon)                  | 4,816,506 | Mar. 28, 1989 |
| Sittenthaler et al.<br>(Sittenthaler) | 4,833,187 | May 23, 1989  |
| Braun et al. (Braun)                  | 5,045,231 | Sep. 03, 1991 |

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Appellants' claimed invention is directed to an aqueous dispersion comprising five recited components. Appealed claim 12 defines a transparent elastomer that is prepared from the aqueous dispersion.

Appellants submit at page 2 of the Brief that, with the exception of claim 12, all the claims stand or fall together.

Appealed claims 1-5, 7, 8, 10 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gamon. Appealed claims 1-5 and 7-12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Braun in combination with Sittenthaler.

We have thoroughly reviewed the respective positions advanced by appellants and the examiner. In so doing, we find ourselves in complete agreement with the examiner that aqueous dispersions within the scope of claim 1 would have been obvious to one of ordinary skill in the art within the meaning of § 103 in view of the applied prior art. Accordingly, we will sustain the examiner's rejection of claims 1-5, 7, 8 and 10 over Gamon, as well as the rejection of claims 1-5 and 7-11 over the combination of Braun and Sittenthaler, for essentially those reasons expressed in the Answer. However,

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we will not sustain the examiner's rejections of claim 12.  
Our reasoning follows.

We consider first the rejection of claims 1-5, 7, 8 and 10 under § 103 over Gamon.<sup>2</sup> Appellants do not dispute the examiner's factual determination that Gamon discloses an aqueous dispersion comprising each one of components (A)-(E) of appealed claim 1. The thrust of appellants' argument is that claimed components (D), a compound containing basic nitrogen, and (E), a polyvinyl alcohol, are only taught by Gamon as optional components of the dispersion. However, we know no rule of law that requires a finding of nonobviousness when claimed components of a composition are taught by the prior art to be optional. In the present case, Gamon expressly teaches that the silicone dispersions of the disclosed invention may contain adhesion promoters, such as amino-functional silanes, which meet the requirement of the claimed "compound containing basic nitrogen" (see column 5, lines 4-16). In addition, Gamon specifically teaches that

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<sup>2</sup> Claims 2-5, 7, 8 and 10 stand or fall together with claim 1.

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thixotropic agents, such as polyvinyl alcohol, may also be included in the aqueous dispersion (column 5, lines 16-22). Accordingly, we agree with the examiner that it would have been prima facie obvious for one of ordinary skill in the art to add a compound containing basic nitrogen and polyvinyl alcohol to the aqueous dispersion of Gamon, which admittedly comprises the presently claimed organopolysiloxane containing groups which are capable of condensation (A), a condensation catalyst (B) and an organopolysiloxane resin which is at least partly soluble in the organopolysiloxane (C). We note and emphasize that appealed claim 1 fails to require that elastomers prepared from dispersions within the scope of claim 1 are transparent.

Appellants submit at page 4 of the Brief that "Appellants' claimed composition is not limited to Gamon's polydiorgano-siloxanes that must have terminal hydroxyl groups." However, the claimed "groups which are capable of condensation" clearly embrace the hydroxyl groups of Gamon which are taught to undergo condensation, and appellants' claim 4 specifies hydroxyl groups when R is a hydrogen atom.

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Appellants also maintain at page 4 of the Brief that there is no requirement in Gamon that suggests the solubility requirement of claimed component (C) in component (A). However, since appellants do not dispute the examiner's finding that Gamon teaches organopolysiloxanes and organopolysiloxane resins that correspond to the claimed components, we agree with the examiner that it reasonably follows that the organopolysiloxane resins of Gamon would be at least partly soluble in the organopolysiloxane having hydroxyl groups in the terminal units. We note that appellants' specification, at page 7, attaches no criticality to the amount of organopolysiloxane resin employed, i.e., from 0.1 to 100 parts by weight per 100 parts by weight of organopoly-siloxane (A).

We are also not persuaded by appellants' argument that a high degree of selection from the Gamon disclosure is required to arrive at the claimed composition. Adhesion promoters are conventional additives for dispersions of the type claimed and disclosed by Gamon, and the only class of compounds disclosed by Gamon as an adhesion promoter is one encompassing amino-functional silanes, all of which meet the claimed requirement

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for "a compound containing basic nitrogen." Likewise, it is conventional to add thixotropic agents to aqueous dispersions and Gamon discloses appellants' polyvinyl alcohol as one of only two thixotropic agents that may be employed.

We also agree with the examiner that the collective teachings of Braun and Sittenthaler establish the prima facie obviousness of appealed claims 1-5 and 7-11. Our reasoning is essentially the same as that set forth above with respect to the § 103 rejection over Gamon. Appellants do not dispute the examiner's factual finding that Braun discloses an aqueous dispersion of organopolysiloxanes comprising all the presently claimed components with the exception of polyvinyl alcohol. However, as explained by the examiner, Braun teaches that the aqueous dispersions may contain conventional thixotropic agents and dispersing agents, and Sittenthaler discloses the use of polyvinyl alcohol as a dispersing agent in an aqueous dispersion of organopolysiloxanes. Hence, we are convinced that one of ordinary skill in the art would have found it obvious to incorporate polyvinyl alcohol in the aqueous dispersions of Braun as a dispersing agent. Furthermore, as discussed above, Gamon evidences that it was known in the art

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to employ polyvinyl alcohol as a thixotropic agent in aqueous dispersions of organopolysiloxanes.

Appellants rely upon the declaration of Dr. Rudolf Braun, one of the present inventors, as evidence of nonobviousness. According to appellants, the declaration demonstrates that the aqueous dispersion of Gamon's EXAMPLE 1 and that the aqueous dispersion of Braun's EXAMPLE 1 form cloudy elastomers, unlike the transparent elastomers of the present invention which are formed from dispersions comprising polyvinyl alcohol. However, like the examiner, we find the declaration to be of limited probative value. First, the limited showing of the declaration is hardly commensurate in scope with the degree of protection sought by appealed claim 1. In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 778 (Fed. Cir. 1983). There is no limitation in claim 1 that requires any elastomer prepared from the defined dispersion to be transparent. Appealed claim 1 simply defines a dispersion comprising five very broadly defined components. Secondly, appellants have not established on this record that the declaration results would be considered unexpected by one of ordinary skill in the art. In re Merck & Co., 800 F.2d 1091, 1099, 231 USPQ 375, 381 (Fed.

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Cir. 1986); In re Klosak, 455 F.2d 1077, 1080, 173 USPQ 14, 16 (CCPA 1972). Declarant Braun is silent with respect to the unexpectedness of the declaration data.

We will not sustain the examiner's rejections of claim 12, which requires a transparent elastomer. Regarding the rejection over Gamon, it is the examiner's position that "[a]s no difference would exist between the identity of the components in the reference and those in the instantly claimed invention, it is held that it would be fully expected for the elastomer to be transparent" (page 4 of Answer). The examiner states that "[i]t would be fully expected for the elastomeric coating to inherently be transparent" (page 5 of Answer). The examiner applies the same reasoning to the rejection over Braun and Sittenthaler, i.e., it is "the Examiner's position that the presence of the polyvinyl alcohol inherently produces a transparent film" (page 9 of Answer).

The flaw in the examiner's reasoning is that the examiner has not established that the presence of polyvinyl alcohol in the aqueous dispersions of Gamon and Braun inevitably produces transparent elastomers. Significantly, the dispersion of Gamon comprises a siliconate, while the dispersion of Braun



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| THOMAS A. WALTZ             | ) | BOARD OF PATENT |
| Administrative Patent Judge | ) | APPEALS AND     |
|                             | ) | INTERFERENCES   |
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| PETER F. KRATZ              | ) |                 |
| Administrative Patent Judge | ) |                 |

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Brooks & Kushman, P.C.  
1000 Town Center  
Twenty-Second Floor  
Southfield, MI 48075