

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MARTIN BRAHM, EBERHARD ARNING  
LUTZ SCHMALSTIEG, HARALD MERTES and JURGEN SCHWINDT

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Appeal 1997-3039  
Application 08/436,939<sup>1</sup>

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Before: McKELVEY, Senior Administrative Patent Judge, and  
SCHAFER and LEE, Administrative Patent Judges.

McKELVEY, Senior Administrative Patent Judge.

**MEMORANDUM OPINION and ORDER**  
**Decision on appeal under 35 U.S.C. § 134**

Upon consideration of the record, including the Appeal Brief (Paper 9), the Examiner's Answer (Paper 10) and the Reply Brief (Paper 11), it is

ORDERED that the examiner's rejection of claims 1-15 as being unpatentable under 35 U.S.C. § 103 over Slack and

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<sup>1</sup> Application for patent filed 8 May 1995. Applicants claim priority under 35 U.S.C. § 119 of German application P 44 177 45.3, filed 20 May 1994. The real party in interest is Bayer AG.

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Brahm (alternatively published Canadian Patent Application 2,155,684) is reversed.

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The broadest claim on appeal is claim 1, which reads:

An olefinically unsaturated polyisocyanate containing allophanate groups and having:

- a) an NCO [isocyanate] content of 6 to 20% by weight,
- b) a content of olefinic double bonds corresponding to an iodine value of 15 to 150,
- c) a content of hydrocarbon chains containing 12 to 30 carbon atoms of 100 to 700 mg/g and
- d) a content of allophanate groups (expressed as  $C_2NH_2O_3$ , molecular weight = 101) of 10 to 300 mg/g.

Slack describes polyisocyanates which are similar to those claimed which can be made from a wide variety of hydroxy-containing compounds (col. 3, line 29 through col. 5, line 28). Included among the hydroxy-containing compounds are "fatty alcohols having 10 to 20 carbon atoms" (col. 3, lines 56-57). The difference between claim 1 and Slack is that Slack does not explicitly describe the use of a fatty alcohol having "olefinic double bonds."

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The examiner found, inter alia, that fatty alcohols having 10 to 20 carbon atoms includes fatty alcohols with olefinic double bonds. Accordingly, the examiner reasons that applicants have selected one of many hydroxy-containing compounds described as useful for making the polyisocyanates containing allophanate groups. Assuming arguendo the correctness of the examiner's finding, the rejection cannot be sustained on the basis of the rationale of the Federal Circuit in In re Baird, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) (fact that claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious).

Alternatively, the examiner cites Brahm and published Canadian Patent Application 2,115,684 (equivalent documents) for the proposition that it is known to react isocyanates with fatty alcohols having olefinic unsaturation (Brahm, col. 3, lines 49-54). Based on what is taught by Brahm, the examiner reasons that it would have been obvious to use a fatty alcohol having olefinic unsaturation in the process described by Slack. The examiner's reasoning is based on impermissible hindsight. The reaction temperature described by Slack (at

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least 150EC; col. 2, lines 31-32) is higher than the reaction temperature described by Brahm (10 to 140EC; col. 4, line 14). Brahm is not concerned with making products having allophanate groups. Based on the record before us, we are unable to find any reason, suggestion, motivation or teaching to use the fatty alcohols having olefinic unsaturation described in Brahm in the process described by Slack.

There is no basis for concluding that an invention would have been obvious solely because it is a combination of elements that were known in the art at the time of the invention. The relevant inquiry is whether there is a reason, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the teachings of the references, and that would also suggest a reasonable likelihood of success. Such a suggestion or motivation may come from the references themselves, from knowledge by those skilled in the art that certain references are of special interest in a field, or even from the nature of the problem to be solved. Smith Industries Medical Systems, Inc. v. Vital Signs, Inc., 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1420-21 (Fed. Cir. 1999). In this case, the examiner has failed to

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identify a motivation, teaching or suggestion to combine the  
prior art in the manner suggested in the examiner's answer.

**REVERSED.**

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FRED E. McKELVEY, Senior	)	
Administrative Patent Judge	)	
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	)	
_____	)	
RICHARD E. SCHAFER	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
_____	)	
JAMESON LEE	)	
Administrative Patent Judge	)	

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