

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT A. SCHMITZ

Appeal No. 1999-2085
Application 07/839,409

ON BRIEF

Before WINTERS and WILLIAM F. SMITH, Administrative Patent Judges, and MCKELVEY, Senior Administrative Patent Judge.

WILLIAM F. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 through 24, all the claims pending in the application. Claim 1 is representative of the subject matter on appeal and reads as follows:

1. A composition of matter having bioactive properties comprising particles of a coordinated complex of a basic, hydrous condensation polymer of:

(i) carbonyl compound and

(ii) a monomer capable of reacting therewith with a capacitance adding compound, said particles being no larger than 2000 nm.

The references stated by the examiner to be used in a rejection under 35 U.S.C. § 103 (a) on page four of the Examiner's Answer are¹:

Moyle et al. (Moyle)	3,215,596	Nov. 2, 1965
Geary	3,223,513	Dec. 14, 1965

Claims 1 through 24 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the examiner relies upon Geary or Moyle. We reverse.

BACKGROUND

1. Subject matter on appeal

There are two main aspects to the claimed invention. The first (claim 1) is a composition of matter which comprises particles of a coordinated complex of a specified basic hydrous condensation polymer and a "capacitance adding compound." The particles are to be no larger than 2,000 nm. The second aspect (claim 2) is a method for

¹ The examiner also states on page 3 of the Examiner's Answer that U.S. Patent 3,016,327 (Schmitz) is "relied upon in the rejection of claims under appeal." However, Schmitz is not included in the heading for the rejection on page 4 of the Examiner's Answer but is mentioned in the body of the rejection. We will discuss this issue infra.

preparing a bioactive composition of matter which comprises forming a mixture of a specified amino compound and a carbonyl compound, condensing the mixture for a time sufficient to cause condensation to a limited degree in order to form a hydrous polymer dispersion having particle sizes of less than 2,000 nm and terminating the polymerization reaction. The method set forth in claim 16 does not require the formation of a complex with the polymer by providing a "capacitance adding compound." Rather, claim 17 is directed to that step.

Appellant describes suitable capacitance adding compounds on pages 16-19 of the specification, e.g., diols such as 1,2 propylene diol, amino diols, triols, amides, ethers, esters, alkanolamines, sugars, soaps/surfactants and various so-called miscellaneous compounds such as nicotine or silica.

2. Proceedings below

The examiner issued a final rejection on March 4, 1993 (Paper No. 4). Therein, claims 1 through 24 were rejected under three different bases: (1) under 35 U.S.C. §103 based upon Geary or U.S. Patent No. 3,102,108 (Aebi) alone or together with Schmitz, (2) under 35 U.S.C. § 103 as unpatentable over Moyle or U.K. 473,116 alone or in view of Schmitz, and, (3) under 35 U.S.C. § 112, first paragraph (enablement).

The communications which occurred after the final rejection between applicant's representative and the examiner resulted in the application being held abandoned. In a decision from the Office of Petitions (Paper No. 20, May 20, 1997), the application was

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revived. During appellant's efforts to revive the application, an Appeal Brief was filed on July 18, 1997 (Paper No. 21). In Section 6 of the Appeal Brief, appellant stated that the three rejections set forth in the Final Rejection are the issues which the Board should decide in this appeal. Appellant also stated in the paragraph bridging pages 3-4 of the Appeal Brief that claims 1 through 15 and claims 16 through 24 are "distinct" groups. In arguing the merits of the rejections under 35 U.S.C. § 103, we note that appellant separately argued claim 16 apart from claim 1. See, e.g., the paragraph bridging pages 7-8 of the Appeal Brief.

The examiner entered his Answer on November 26, 1997 (Paper No. 22). At page 2 of the Answer, the examiner stated "[t]he appellant's statement of the issues in the brief is correct." At page 3 of the Answer, the examiner determined "[t]he rejection of claims 1-24 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof."

Despite agreeing with appellant that there are three issues for the Board to decide in this appeal, the examiner only set forth a single ground of rejection in the Examiner's Answer, i.e., under 35 U.S.C. § 103(a) based upon Geary or Moyle. The examiner did not indicate the status of the enablement rejection nor the status of Aebi and U.K. 473,116 in rejecting the claims under 35 U.S.C. § 103. Nor does the examiner address the separate arguments contained in the Appeal Brief directed to claim 16.

Appellant filed a Reply Brief on January 28, 1998 (Paper No. 24). Therein, appellant interpreted the Examiner's Answer as withdrawing the rejection under 35 U.S.C. § 112 as well as withdrawing portions of the rejections made under 35 U.S.C. § 103 in the Final Rejection. Appellant states on page 1 of the Reply Brief "[a]ny discussion of Applicant's process claims and their steps is also conspicuously absent." Appellant then discussed what he considered to be new issues raised by the examiner in the Examiner's answer.

The examiner issued a communication on April 30, 1998 (Paper No. 25) acknowledging submission of the Reply Brief.

DISCUSSION

We, like appellant, will consider that the enablement rejection has been withdrawn by the examiner. We will also assume that the two rejections set forth in the final rejection under 35 U.S.C. § 103 have been withdrawn in favor of the rejection made under this section of the statute in the Examiner's Answer. While the examiner's failure to list Schmitz in the statement of the rejection is problematic, we have considered all three references in reaching our decision.

The sum and substance of the examiner's rejection under 35 U.S.C. § 103(a) is set forth on page 4 of the Examiner's Answer as follows:

The “basic hydrous condensation polymer” of the appealed claims is disclosed in the cited prior art polymerization instructions.

The use of “capacitance” adding compounds such as ethers or polyhydric alcohols is disclosed at example 1 of Moyle et al. and example 13 of Geary. The “capacitance” adding compound as claimed has not [sic] definite chemical structure (see claims 1-11, 13-19 and 21-24) and thus may be any solvent conventionally used with the resin compositions of the cited prior art. The particle size range of the claimed dispersion is not outside the less than 4 micron limit of Schmitz. The composition and method of the appealed claims is considered to comprise a routine embodiment of the cited prior art resin-solvent dispersions.

As we understand the examiner's position, the compositions described in Example 1 of Moyle and Example 13 of Geary satisfy the claim requirements but for the limitation that the coordinated complex of claim 1 and the hydrous polymer dispersion formed in claim 16 have particle sizes of less than 2,000 nm. Presumably, the examiner relies upon Schmitz to account for this difference. We can only guess as to what the examiner's position is because as is apparent, the examiner has not favored the record with a statement as to what would have been obvious to one of ordinary skill in the art from a consideration of these references.² Be that as it may, it appears clear that Example 1 of Moyle and Example 13 of Geary are at the heart of the examiner's rejection, and thus, we will focus on these disclosures.

² It is always curious when an examiner issues a rejection under 35 U.S.C. § 103 and does not specifically state what would have been obvious to one of ordinary skill in the art. For future guidance we refer the examiner to MPEP § 706.02(j) for a guide of how to consider issues under this section of the statute and structure a rejection.

Example 13 of Geary describes the formation of a composition which is prepared from, inter alia, paraldehyde, urea and ethylene glycol. Those three ingredients along with others are polymerized and after polymerization is complete, the material is ground in a hammermill and mixed with bentonite and sodium sulphosuccinate. Example 1 of Moyle is directed to the formation of an oil paint. While not clear from the Examiner's Answer, we believe the examiner has focused on that portion of Example 1 which appears at column 6, lines 31-52. Therein, a composition was prepared from a halophenol and polyaminealdehyde using propylene glycol monomethyl ether as a solvent. From the examiner's statement of the rejection, it appears that he believes that the propylene glycol monomethyl ether solvent of Moyle and ethylene glycol as used in Example 13 of Geary are the "capacitance adding compound" required by claim 1 on appeal. While the examiner has observed that the particle size required by the claims on appeal is "not outside the less than 4 micron limit of Schmitz" the examiner has not explained why it would have been obvious to one of ordinary skill in the art to modify the compositions of Moyle or Geary in order to arrive at that particle size.

Turning first to claim 1 on appeal, the examiner has not explained how or why the compositions set forth in Example 13 of Geary and Example 1 of Moyle describe "particles of a coordinated complex" of the specified basic, hydrous condensation polymer and a capacitance adding compound. While the solvents identified by the examiner may be included within appellant's list of capacitance adding compounds, that does not

necessarily mean that the compositions described in the two examples necessarily and inevitably result in the formation of a “coordinated complex” as required by claim 1 on appeal. Absent a fact-based explanation from the examiner as to why these two compositions do describe a coordinated complex as required by claim 1 on appeal, we have no basis to determine that the subject matter of claim 1 as a whole would have been obvious to one of ordinary skill in the art from a consideration of these references.

Nor has the examiner properly considered that aspect of the claimed subject matter directed to particle size. Merely pointing to disclosure in a reference of a given particle size does not satisfy the examiner's burden under this section of the statute. The examiner has not explained why it would have been obvious to one of ordinary skill in the art to modify the compositions relied upon in Geary or Moyle in order to arrive at this particle size.

As previously indicated, claim 16 does not require the presence or use of the capacitance adding compound and consequently the formation of the coordinated complex required by claim 1 on appeal. However, claim 16 does require that the specified mixture be condensed for a time sufficient to cause a limited degree of condensation to form a hydrous polymer dispersion having particle sizes of less than 2,000 nm. As explained above, the examiner has not properly considered this aspect of claim 16 under this section of the statute. Again, merely pointing to a reference as describing a particle size does not meet the examiner's obligations under 35 U.S.C.

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§ 103.

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The decision of the examiner is reversed.

REVERSED

Sherman D. Winters
Administrative Patent Judge

William F. Smith
Administrative Patent Judge

Fred E. McKelvey
Senior Administrative Patent Judge

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