

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES L. HEDRICK, DONALD C. HOFER,
JEFFREY W. LABADIE, ROBERT B. PRIME and THOMAS P. RUSSELL

Appeal No. 95-0318
Application 08/031,046¹

ON BRIEF

Before KIMLIN, JOHN D. SMITH and WALTZ, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 13-15, 17 and 23, all the claims remaining in the present application.

Claim 13 is illustrative:

13. A process for forming a foamed polymer having a pore size less than about 1000D comprising the steps of:

- a. forming a copolymer of a matrix polymer and a thermally decomposable polymer which thermally decomposes at a

¹ Application for patent filed March 11, 1993. According to appellants, this application is a continuation of Application 07/759,022, filed September 13, 1991, now abandoned.

Appeal No. 95-0318
Application 08/031,046

temperature below the decomposition temperature of the matrix polymer;

- b. heating said copolymer to a temperature at or above the decomposition temperature of the thermally decomposable polymer and below the glass transition temperature and the decomposition temperature of the matrix polymer to form said foam polymer.

In the rejection of the appealed claims, the examiner relies upon the following reference:

Scheuerlein et al. (Scheuerlein) 3,917,761 Nov. 4, 1975

Appellants' claimed invention is directed to a process for forming a foamed polymer having a pore size less than about 1000D. The process comprises two steps: (1) forming a copolymer of a matrix polymer, such as a polyimide, and a thermally decomposable polymer, such as poly(propylene oxide); (2) heating the formed copolymer to a temperature that is above the decomposition temperature of the thermally decomposable polymer but below the glass transition temperature and the decomposition temperature of the matrix polymer.

Appealed claims 13-15, 17 and 23 stand rejected under 35 U.S.C. § 102(e) or, in the alternative, under 35 U.S.C. § 103 as being unpatentable over Scheuerlein.

Upon careful consideration of the opposing arguments presented on appeal, we will not sustain the examiner's rejection.

We fully concur with appellants that the examiner has not established on this record that Scheuerlein describes the claimed step of forming a copolymer to support the § 102 rejection, nor does the reference suggest forming the claimed copolymer to support an obviousness rejection under § 103. It is apparently the examiner's position that since Scheuerlein discloses heating a composition comprising a polyimide and a thermally decomposable polymer, the claimed copolymer would inherently be formed in the referenced process. However, we find that the clear teaching of the reference militates against a finding of inherency.

Scheuerlein discloses a composition comprising a coalescible polyimide powder and a solid particulate polymer of formaldehyde, which composition is heated to a temperature above 300°C to coalesce the polyimide particles and obtain a porous polyimide shaped article (column 5, lines 37-40). Scheuerlein expressly teaches that the product formed is a porous polyimide shaped article, not a polyimide copolymer. Also, Scheuerlein discloses that the solid particulate polymer of formaldehyde pyrolyses cleanly to formaldehyde gas and is evolved from the preform without leaving a formaldehyde residue in the preform product (column 5, lines 44-51). Such a clean evolution of formaldehyde gas would not suggest that the particulate polymer of formaldehyde reacts with the polyimide to form a copolymer. That

Appeal No. 95-0318
Application 08/031,046

JOHN D. SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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THOMAS A. WALTZ)	
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Appeal No. 95-0318
Application 08/031,046

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