

Ex parte Santure et al.

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PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES
THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

95-1282

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID J. SANTURE, GUNTHER OTT, UDO REITER
ULRICH HEIMANN, HANS-JOSEF OSLOWSKI

Appeal No. 95-1282
Application No. 07/820,620¹

ON BRIEF

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

PAK, Administrative Patent Judge.

DECISION ON APPEAL

Santure et al. (appellants) appeal from the rejection of claims 10 through 15 under 35 U.S.C. § 103. No appeal is taken as to the rejection of claims 16 through 19.

¹ Application for patent filed January 24, 1992.

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Claim 13 is illustrative of the broadest subject matter on appeal and reads as follows:

13. An aqueous coating composition which contains a⁻ cationic, amine-modified epoxy resin and an at least partly protonated adduct containing urethane groups which is obtained by reacting with one another

(A) a polyol selected from the group consisting of a polyether polyol, polyester polyol and mixtures thereof, having a number average molecular weight of 400 to 5000,

(B) at least one polyisocyanate, and

(C) a compound which contains a hydroxyl group and at least one ketimine group in the molecule or a mixture of such compounds,

and at least partly protonating the primary amino groups formed after hydrolysis of the ketimine groups, the adduct being obtained by reacting with one another components (A), (B) and (C) in proportions such that 0.75 to 1.5 equivalents of hydroxyl groups are present per equivalent of isocyanate groups.

The references of record relied upon by the examiner are:

Perner et al. (Perner) 5,015,672 May 14, 1991

Handbook of Epoxy Resins, McGraw-Hill Book Co., Lee et al., page 7-25 (1967) (hereinafter referred to as "Lee")².

Claims 10 through 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Perner in view of Lee. We reverse.

² In the answer, the examiner designated this prior art reference as "Lee and Neville". To avoid any possible confusion, we have redesignated it as "Lee".

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and a secondary amine containing ketimines. Nowhere does Perner indicate that the by-products resulting from the above reaction include the claimed partly protonated adduct having not only urethane groups, but also the claimed ratio of hydroxyl groups per isocyanate groups. Nor does the examiner point to any portion of Perner or Lee that describes using the claimed reactants in the claimed proportions to provide the claimed ratio of hydroxyl groups per isocyanate groups to the claimed adduct. It may be possible that the claimed adduct may be formed if particular proportions of particular reactants are chosen together with particular reaction conditions from a myriad of possible combinations described or suggested in Perner. However, as correctly noted by appellants, a mere possibility is not inherency. The claimed adduct must be necessarily produced from the reaction described in Perner. This the examiner has not demonstrated.

To the extent the examiner might have relied on obviousness based on the suggestion supplied in Perner, we do not share the examiner's position that Perner would have rendered the claimed coating composition obvious. Perner, as indicated supra, is directed to forming amine-modified epoxy resins. Nowhere does Perner mention the necessity for forming the claimed adduct. Nor

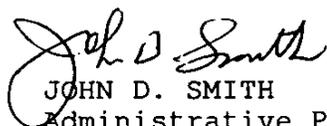
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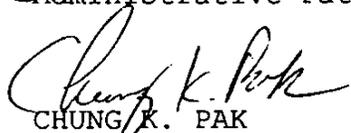
does it recognize that the claimed adduct is useful as a part of a coating composition. The fact that the claimed adduct may be present inherently together with the amine modified epoxy resins in Perner's reaction product does not provide the requisite motivation or suggestion to utilize such a combination as a coating composition absent recognition by one of ordinary skill in the art regarding the inherent presence of the claimed adduct in Perner's reaction product and the usefulness of the claimed adduct as a coating composition. As properly quoted by appellants, "[t]hat which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown." In re Naylor, 369 F.2d 765, 768, 152 USPQ 106, 108 (CCPA 1966)."

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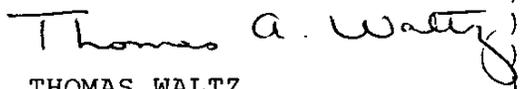
Accordingly, the decision of the examiner is reversed.

~~REVERSED~~


JOHN D. SMITH)
Administrative Patent Judge)


CHUNG K. PAK)
Administrative Patent Judge)

) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES


THOMAS WALTZ)
Administrative Patent Judge)

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