

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte HOWARD I. HEITNER and RODERICK G. RYLES

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Appeal No. 95-3647  
Application No. 08/169,782<sup>1</sup>

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ON BRIEF

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Before KIMLIN, GARRIS and WEIFFENBACH, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-9. Claims 10-18, the other claims remaining in the present application, stand withdrawn from consideration as being drawn to non-elected inventions. Claim 1 is illustrative:

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<sup>1</sup> Application for patent filed December 17, 1993.

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1. A stable, gel-free water-in-oil microdispersion comprising 1) a continuous phase of a hydrocarbon oil and an emulsifier which is effective so as to prevent the detrimental agglomeration of polymer micelles and 2) a discontinuous phase comprising micelles of an aqueous solution of an hydroxamated vinyl polymer having a weight average molecular weight of over about 1,000,000.

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

Von Euler-Chelpin	3,753,939	Aug. 21, 1973
Anderson et al. (Anderson)	Re. 28, 474	July 8, 1974
Candau et al. (Candau)	4,521,317	June 4, 1985
Fong et al. (Fong)	4,886,872	Dec. 12, 1989

Appellants' claimed invention is directed to a stable, gel-free water-in-oil microdispersion comprising a continuous phase and a discontinuous phase. The continuous phase comprises a hydrocarbon oil and an emulsifier, whereas as the discontinuous phase comprises micelles of an aqueous solution of an hydroxamated vinyl polymer. The weight average molecular weight of the polymer is over about 1,000,000.

Appellants submit at page 3 of the Brief that, with the exception of claim 3, all the appealed claims stand or fall together.

Appealed claims 1-9 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter appellants

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regard as their invention.<sup>2</sup> Claims 1, 2 and 4-9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fong in view Anderson and Candau. In addition, claim 3 stands rejected under 35 U.S.C. § 103 as being unpatentable over the stated combination of references in further view of Von Euler-Chelpin.

We have thoroughly reviewed the respective positions advanced by appellants and the examiner. In so doing, we will not sustain the examiner's rejection under 35 U.S.C. § 112, second paragraph. However, we fully concur with the examiner that the claimed subject matter 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 § 103 rejections for essentially those reasons expressed in the Answer, and we add the following primarily for emphasis.

We consider first the examiner's rejection of claims 1-9 under 35 U.S.C. § 112, second paragraph. According to the examiner, the language "stable, gel-free" of claim 1 is ambiguous and confusing since page 4 of appellants' specification states that the claimed microdispersion "may contain gelled polymer."

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<sup>2</sup> The examiner has withdrawn the rejection under 35 U.S.C. § 112, first paragraph (see page 2 of the Answer).

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However, it is well settled that claim language must be considered not in a vacuum but in light of the supporting specification and teachings of the prior art as it would be interpreted by one of ordinary skill in the art. In re Kroekel, 504 F.2d 1143, 1146, 183 USPQ 610, 612 (CCPA 1974); In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). In the present case, we concur with appellants that the first paragraph at page 4 of the specification adequately defines the language "stable, gel-free" such that one of ordinary skill in the art would understand that the language defines a microdispersion that is free flowing and that may contain some gelled polymer, as long as the microdispersion is still pourable. As recognized by the examiner, an applicant may be his own lexicographer, and we do not find the claim language so repugnant to the ordinary meaning of its terms that appellants be precluded from its use.

We now turn to the rejection of claims 1, 2 and 4-9 under § 103 over Fong in view of Anderson and Candau. Appellants do not dispute that Fong discloses a hydroxamated vinyl polymer in the water phase in a water-in-oil emulsion (column 6, lines 9-19). Like appellants, Fong employs the water-in-oil emulsion as a flocculating agent, and Fong teaches that the emulsion may be prepared in accordance with the Anderson reissued patent.

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Anderson discloses the preparation of water-in-oil emulsions having acrylamide polymers in the water phase for use as flocculating agents, and further discloses at column 4, lines 25 et seq., the inclusion of emulsifiers that are preferred by appellants. In addition, Anderson teaches that it is desirable that the microemulsions be stable and comprise a polymer of a particle size within the range of 5 millimicrons up to about 5 microns (column 4, lines 24-32). Anderson also teaches that the acrylamide polymers are of greatest usefulness when their molecular weight is in excess of 1,000,000, as required by the appealed claims (column 2, lines 28-32). Accordingly, when the water-in-oil emulsions of Fong are prepared in accordance with Anderson, we agree with the examiner that there is no apparent distinction between the microemulsions of the prior art and appellants' water-in-oil microdispersion. We also agree with the examiner that although Fong and Anderson do not expressly disclose microemulsions that are gel-free, based on the close correspondence between appellants' and Anderson's method of preparing the microemulsion, the burden is properly upon appellants to prove with objective evidence that the prior art microemulsions are not gel-free, at least to the extent that the term "gel-free" is broadly defined by appellants' specification.

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In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990); In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

Appellants contend at page 9 of the Brief that the "critical feature of the herein claimed microdispersions is accomplished by the use of an emulsifier which prevents the micelles of polymer solution from detrimentally agglomerating." However, as explained by the examiner, the purpose of the Anderson disclosure is to prepare commercially stable emulsions, and Anderson specifically discloses the use of emulsifiers that are preferred by appellants. Inasmuch as appellants state at page 6 of their Brief that the use of suitable emulsifiers "would be well within the skill of one versed in the art to which this invention relates," we concur with the examiner that only routine experimentation would have been required by the skilled artisan to select the emulsifiers of Anderson that result in a stable microemulsion. We do not subscribe to appellants' argument that Anderson "does not focus specifically on the use of an emulsifier which prevents the detrimental agglomeration of polymer micelles as required by the instant claims" (page 10 of Brief), since Anderson expressly focuses upon the attainment of stable microemulsions and, therefore, one of ordinary skill in the art

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would have selected emulsifiers that achieve this end. We note that the appealed claims fail to recite any particular class of emulsifier. Regarding specification Examples 1, 34 and 35 cited by appellants, we agree with the examiner that the examples are not probative of nonobviousness inasmuch as they are not representative of the applied prior art, i.e., Fong and/or Anderson. In re Johnson, 747 F.2d 1456, 1461, 223 USPQ 1260, 1263-64 (Fed. Cir. 1984).

As for separately argued claim 3, which requires the presence of a stabilizer which stabilizes the polymer against degradation due to the presence of hydroxylamine, we agree with the examiner that Von Euler-Chelpin evidences the obviousness of utilizing appellants' thiosulfates as stabilizers for acrylamide polymers. While appellants contend that Von Euler-Chelpin does not disclose the inclusion of a stabilizer against degradation due to the presence of hydroxylamine, Von Euler-Chelpin discloses the use of appellants' stabilizers to stabilize acrylamide polymers against thermal and oxidative degradation. Accordingly, we find that one of ordinary skill in the art would have been motivated to employ stabilizers of Von Euler-Chelpin to stabilize appellants' acrylamide polymers against thermal and oxidative degradation. It is not required for a finding of obviousness

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that the motivation of the skilled artisan be the same as an applicant's motivation. In re Kemps, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1311 (Fed. Cir. 1996); In re Dillon, 919 F.2d 688, 693, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990), cert. denied, 500 U.S. 409 (1991).

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
	)	
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	)	
BRADLEY R. GARRIS	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
CAMERON WEIFFENBACH	)	
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