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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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID J. ST. CLAIR and JAMES R. ERICKSON

Appeal No. 96-1720
Application 08/389,520¹

ON BRIEF

Before WINTERS, JOHN D. SMITH and OWENS, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 2-5 and 15-25, which are all of the claims remaining in

¹ Application for patent filed February 16, 1995. According to appellants, the application is a division of Application 08/262,818, filed June 21, 1994.

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the application.

THE INVENTION

Appellants' claimed invention is directed toward a crosslinked coating, a crosslinked sealant, and a crosslinked adhesive, each of which is applied to a substrate and is comprised of a dispersion having the same recited composition. Claim 16 is illustrative and reads as follows:

16. A crosslinked adhesive comprising a dispersion which is applied to a substrate, said dispersion comprising:

(a) 10 to 65% by weight of a polydiene block polymer having a weight average molecular weight of from 2000 to 3,000,000 and containing at least five olefinic epoxy groups per molecule which are sterically hindered,

(b) 0.2 to 25% by weight of a compatible aminoplast,

(c) 0.1 to 10% by weight of a surfactant which is nonionic or anionic and has a volatile cation,

(d) 0.1 to 4% by weight of a proton-donating acid catalyst, and

(e) the balance of water.

THE REFERENCES

Udipi et al. (Udipi)	4,135,037	Jan. 16, 1979
Howell, Jr.	4,233,197	Nov. 11, 1980
Erickson et al. (Erickson)	5,247,026	Sep. 21, 1993

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THE REJECTION

Claims 2-5 and 15-25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Erickson, Udipi and Howell, Jr.

OPINION

We have carefully considered the specification, preliminary amendment, first Office action, amendment in response to the first Office action, final rejection, appeal brief, examiner's answer, and references of record. We find, based upon our review of these documents, that appellants' claims are unclear to the extent that the determination of obviousness of the claimed subject matter in view of prior art disclosures is not possible. Accordingly, we do not sustain the examiner's rejection.

Appellants claim a crosslinked coating (claim 15), a crosslinked adhesive (claims 16-20) and a crosslinked sealant (claims 21-25), each of which comprises a dispersion which is applied to a substrate. We give the terms in appellants' claims their broadest reasonable interpretation consistent with appellants' specification. See *In re Zletz*, 893 F.2d

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319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *In re Sneed*,
710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983); *In re*
Okuzawa, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976).

Appellants' specification states (page 19, lines 9-15):

It is highly preferred that the acid which is used in the surfactant be an acid which is capable of catalyzing the crosslinking of the polymer and the aminoplasts. Such acids are described above and include the various sulfonic acids described in the preceding paragraph. After the dispersion is applied to the substrate, usually after being formulated for a specific application such as a coating, adhesive or sealant, the volatile amine in the surfactant will evaporate into the atmosphere, freeing the acid to catalyze the curing reaction between the amino resin and the epoxidized polymer.

This portion of appellants' specification indicates that the term "crosslinked" in "crosslinked coating", "crosslinked adhesive" and "crosslinked sealant" means that a curing reaction has taken place between the aminoplast and the epoxidized polymer.

However, the dispersion recited in each of appellants' independent claims contains 10-65 wt% polydiene block polymer and 0.1-10 wt% aminoplast. These are the percentages of these components which appellants' specification states are present in the dispersion of crosslinkable polymer, i.e., polymer

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which has not been crosslinked (page 2, lines 9-17; page 16, lines 9-12).

Thus, when "crosslinked" in the preamble of appellants' claims is interpreted in view of appellants' specification, it is not clear whether the term means that the epoxidized polymer and aminoplast in the dispersion applied to the substrate are crosslinked, such that a curing reaction has taken place between the epoxidized polymer and the aminoplast, in which case the dispersion no longer necessarily has the composition recited in the independent claims, or whether the term means that a dispersion of the recited composition is applied to the substrate and that the epoxidized polymer and aminoplast in this dispersion are to be subsequently crosslinked.

In some instances, it is possible to make a reasonable, conditional interpretation of claims adequate for the purpose of resolving patentability issues to avoid piecemeal appellate review. In the interest of administrative and judicial economy, this course is appropriate wherever reasonably possible. See *Ex parte Saceman*, 27 USPQ2d 1472, 1474 (Bd. Pat. App. & Int. 1993); *Ex parte Ionescu*, 222 USPQ 537, 540

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(Bd. App. 1984). In other instances, however, it may be impossible to determine whether or not claimed subject matter is anticipated by or would have been obvious over references because the claims are so indefinite that considerable speculation and assumptions would be required regarding the meaning of terms employed in the claims with respect to the scope of the claims. See *In re Steele*, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962).

For the reason discussed above, we consider appellants' claims to be sufficiently indefinite that application of the prior art to the claims is not possible. On this basis, we do not sustain the rejection under 35 U.S.C. § 103. It should be understood that this reversal is not a reversal on the merits of the rejection but, rather, is a procedural reversal predicated upon the indefiniteness of the claims.

We remand the application to the examiner for the examiner and appellants to clarify the claim language and explain their positions regarding the patentability of the clarified claims.

DECISION

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The rejection of claims 2-5 and 15-25 under 35 U.S.C.
§ 103 over Erickson, Udipi and Howell, Jr. is reversed.

REVERSED and REMANDED

SHERMAN D. WINTERS)	
Administrative Patent Judge)	
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JOHN D. SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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