

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(2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEN J. CHIANG

Appeal No. 1996-2398
Application 08/140,840¹

ON BRIEF

Before DOWNEY, WARREN and ELLIS, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner refusing to allow claims 1 and 3 through 5 as amended subsequent to the final rejection. These are all of the claims remaining in the application as claim 2 was canceled subsequent to the final rejection.²

We have carefully considered the record before us, and based thereon, find that we cannot

¹ Application for patent filed October 25, 1993.

² Amendment of March 6, 1995 (Paper No. 9). We observe that while the examiner stated that this amendment would be entered upon the filing of an appeal in his advisory action of March 14, 1995 (Paper No. 10), the amendment has not been clerically entered.

sustain the rejection of the appealed claims under § 103 over Bernard (answer, pages 2-3). It is well settled that the examiner must satisfy his burden of establishing a *prima facie* case of obviousness by showing some objective teaching or suggestion in the applied prior art taken as a whole or that knowledge generally available to one of ordinary skill in the art would have led that person to the claimed invention, including each and every limitation of the claims, without recourse to the teachings in appellant's disclosure. *See generally In re Oetiker*, 977 F.2d 1443, 1447-48, 24 USPQ2d 1443, 1446-47 (Fed. Cir. 1992) (Nies, J., concurring); *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988)

We construe claim 1 to require that the gel content of the acrylic-based pressure sensitive adhesive (PSA) is reduced to no more than about 2% by the use of an adequate amount of chain transfer agent during emulsion interpolymerization, which amount is further specified in claim 4 to be "more than 0 up to about 2 weight %, based on the weight of the interpolymerizable monomer." The examiner finds that Bernard teaches that a chain transfer agent can be used in the preparation of the emulsion polymerized PSAs disclosed therein, wherein an optimum amount falling within claim 4 is disclosed, pointing to col. 5, line 64, to col. 6, line 5. Even though the examiner finds that the reference does not specifically state the purpose of the chain transfer agent, the examiner concludes that "the reference teaches [the use of a] chain transfer agent to lower molecular weight which reduces gel" (answer, page 3). In response to the *prima facie* case of obviousness made out by the examiner, appellant submits that Bernard teaches that the emulsion polymerized PSAs "have a gel content of 50-70% (col. 2, line 17, col. 4, line 47 and col. 7 (claim 1) lines 51-53)" (brief, page 2). Appellant points out in this respect that the reference specifies the use of diesters of a dicarboxylic acid and a reactive surfactant in preparing the emulsion polymerized PSAs and further submits that it is apparent from the reference that "sterilization-resistant crosslinking is built into the polymer during polymerization" (*id.*).

In view of the argument and evidence of nonobviousness submitted in rebuttable by appellant, the patentability of the claimed invention must be determined based on the totality of the record, and if it is found that appellant's argument rebuts the examiner's initial *prima facie* case based on the applied reference(s), the examiner must again establish a *prima facie* case of nonobviousness over the

reference(s), taking into account appellant's argument and evidence of nonobviousness, in order to maintain the rejection based on the reference(s). *See generally Oetiker*, 977 F.2d at 1445-46, 24 USPQ2d at 1444-45. We find on this record that the examiner has not established by scientific reasoning or evidence that, given the ingredients and resulting high gel content of the emulsion polymerized PSAs of Bernard pointed to by appellant, one of ordinary skill in this art would still have reasonably expected that the addition of the chain transfer agent in the amounts taught in the reference would reduce the gel content taught of the emulsion polymerized PSAs of the reference to "no more than about 2%" as specified in claim 1.

Accordingly, we reverse the ground of rejection of the appealed claims over Bernard because the examiner has not established a *prima facie* case of obviousness.

The examiner's decision is reversed.

Reversed

MARY F. DOWNEY)	
Administrative Patent Judge)	
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)	
CHARLES F. WARREN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
JOAN ELLIS)	
Administrative Patent Judge)	

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