

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 9

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID B. SELLEY, DIPAK NARULA and ANH BE

Appeal No. 1996-3657
Application No. 08/287,552¹

ON BRIEF

Before CAROFF, ELLIS and WALTZ, Administrative Patent Judges.
CAROFF, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 12-15, 18 and 21.

The claimed invention relates to a composition for enhancing the release and antideposition characteristics of a hard impermeable surface.

¹ Application for patent filed August 8, 1994. According to the appellants, the application is a division of Application No. 08/201,517, filed February 24, 1994.

Appeal No. 1996-3657
Application No. 08/201,517

Appellants' acknowledge on page 3 of their brief that the appealed claims stand or fall together. Accordingly, we limit our consideration to claim 21, the sole independent claim, which reads as follows:

21. A release agent for improving the release and antideposition characteristics of a hard impermeable surface comprising an aqueous solution formed by combining (i) 1-5% by weight of a dimer of at least two alkoxy functional silanes, (ii) an aqueous silicone emulsion of a polydiorganosiloxane, the solution including 1-5% by weight of the polydiorganosiloxane, (iii) the total content of water in the solution being 60-98% by weight including the water of the emulsion; and (iv) 1-30% by weight of a water soluble hydrophilic organic solvent selected from the group consisting of ethylene glycol, propylene glycol, ethylene glycol n-butyl ether, ethylene glycol phenyl ether, diethylene glycol methyl ether, diethylene glycol n-butyl ether, propylene glycol methyl ether, propylene glycol methyl ether acetate, dipropylene glycol methyl ether acetate, propylene glycol n-butyl ether, propylene glycol phenyl ether, dipropylene glycol methyl ether, dipropylene glycol n-butyl ether, and tripropylene glycol methyl ether.

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

Narula et al. (Narula) 1993	5,205,860	Apr. 27,
Price 1984	4,478,911	Oct. 23,
Roth 24, 1980	4,209,432	June

The claims on appeal stand rejected for obviousness under

Appeal No. 1996-3657
Application No. 08/201,517

35 U.S.C. § 103 in view of Narula taken in combination with Price and Roth.

Based upon the record before us, we agree with appellants that the examiner has failed to present a prima facie case of obviousness. Accordingly, we reverse the rejection at issue.

In our previous decision in parent application 08/201,517 (Appeal No. 95-0032), we reversed a similar rejection under 35 U.S.C. § 103 which had been based upon the same three prior art references before us now. That rejection, however, related to a claim directed to a method of using essentially the same composition defined by the present claims. Consistent with our reasoning in our prior decision, we find that the examiner has also failed to establish a prima facie case of obviousness as to the present composition claims.

As we previously found, none of the prior art references relied upon by the examiner teach or suggest use of any of the particular hydrophilic glycol, glycol ether, or glycol ether acetate solvents recited in the claims. We therefore concluded that there is nothing in the prior art of record which would have provided a person of ordinary skill in the art with the requisite motivation to include any of these

Appeal No. 1996-3657
Application No. 08/201,517

particular solvents in the water repellent composition of Narula. Even accepting, as a general proposition, that it would have been obvious to add an "alcohol" or an "ether" to the water repellent composition of Narula, as suggested by Price and Roth, the examiner has failed to explain why it would have been obvious to select one of the particular glycol, glycol ether or glycol ether acetate solvents recited in appellants' claims from a myriad of possibilities. See In re Baird, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994); and In re Jones, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (Fed. Cir. 1992).

In our view, the foregoing rationale applies equally to both the method claim which was the subject of our prior decision, and the present composition claims now before us. Accordingly, the decision of the examiner as to the composition claims is reversed.

REVERSED

MARC L. CAROFF)
Administrative Patent Judge)
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Appeal No. 1996-3657
Application No. 08/201,517

JOAN ELLIS
Administrative Patent Judge

THOMAS A. WALTZ
Administrative Patent Judge

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