

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte OLAF KUBE

Appeal No. 1997-1863
Application No.08/408,087

ON BRIEF

Before KIMLIN, JOHN D. SMITH, and KRATZ, *Administrative Patent Judges.*

KRATZ, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-6, 10-15 and 17-24, which are all of the claims pending in this application.

BACKGROUND

Appellant's invention relates to a moisture-curing hot melt adhesive containing a polyurethane prepolymer and isocyanurates. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A moisture-curing hotmelt adhesive containing:

a) polyurethane prepolymers with a content of NCO groups of 0.16 to 0.84 moles of NCO groups per kg of prepolymer formed by reaction of (i) at least partly crystalline polyester polyols which are solid at room temperature and have a degree of crystallization of at least 30% and a number average molecular weight in the range from 2000 to 10,000, optionally in admixture with liquid polyester polyols which are liquid at 20°C and have a glass temperature below 0°C, with amorphous polyester polyols which are solid at ambient temperature and have a glass temperature above 0°C, with polyether polyols having a number average molecular weight of 500 to 10,000, or with mixtures of any two or more of said liquid polyester polyols, amorphous polyester polyols, and polyether polyols with (ii) isocyanates; having a functionality of more than 1 which are not isocyanurates and

(b) isocyanurates that are trimers of diisocyanates.

The sole prior art references of record relied upon by the examiner in rejecting the appealed claims is:

Pedain et al. (Pedain)

4,801,675

Jan. 31,

1989

Claims 1-6, 10-15 and 17-24 stand rejected under 35
U.S.C.

§ 102 as anticipated by or, in the alternative, under 35
U.S.C.

§ 103 as being unpatentable over Pedain.

OPINION

We refer to appellant's briefs and to the answer for the opposing viewpoints expressed by appellant and the examiner concerning the above noted rejections. For the reasons which follow, we cannot sustain either of the examiner's stated § 102 and § 103 rejections.

The examiner's rejection of the appealed claims under § 102 as anticipated by Pedain is premised, at least in part, on the theory that the prepolymers of Pedain would inherently correspond to the prepolymers that are part of the claimed adhesive notwithstanding that Pedain does not specifically disclose the use of polyester polyols of a specified number average molecular weight having a crystallization of at least 30% as one of the required reactants used in making the prepolymer as recited in appellant's claims (see answer, e.g., pages 4, 7 and 8).

When an examiner relies upon a theory of inherency, "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Int. 1990). Inherency simply cannot be established based on probabilities or possibilities. *See In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981).

In the present case, the examiner has not met the heavy burden of furnishing an adequate factual foundation and/or technical reasoning to show that any of the polyester polyols, reactant component (b), of Pedain necessarily corresponds to the at least partly crystalline (crystallization of at least 30%) polyester polyol of appellant, let alone that any of the particularly disclosed reaction products thereof (prepolymer) inevitably corresponds to the polyurethane prepolymer component of appellant's adhesive.

In this regard, the examiner has failed to cite any compelling evidence which establishes that prepolymers within the scope of the appealed claims are the necessary product of the reaction disclosed by Pedain especially given that the

reactants of Pedain have not even been established as being within the scope of the reactants utilized by appellant in forming the claimed prepolymer component. In the absence of such factual evidence or convincing scientific rationale on the part of the examiner, we find that the examiner has failed to meet the initial burden of establishing the *prima facie* anticipation of the claimed invention.

Moreover, we note that the examiner has taken the position that:

"... if the polyester of Pedain et al. does not have the instantly claimed crystallinity or a value close to that of the instant claims, there is no rationale for modifying the polyester of Pedain et al. to possess the instantly claimed crystallinity"
(answer, page 8).

Hence, the examiner has also failed to establish a factual basis to support a legal conclusion that the claimed invention would have been obvious within the meaning of 35 U.S.C. § 103 to one of ordinary skill in the art.

Consequently, on this record, we will not sustain the examiner*s stated § 102 and § 103 rejections of the appealed claims based on the disclosure of Pedain.

CONCLUSION

The decision of the examiner to reject claims 1-6, 10-15 and 17-24 under 35 U.S.C. § 102 as anticipated by or, in the alternative, under 35 U.S.C. § 103 as being unpatentable over Pedain is reversed.

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JOHN D. SMITH)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
PETER F. KRATZ)	
Administrative Patent Judge)	

Appeal No. 1997-1863
Application No. 08/408,087

Page 7

HENKEL CORPORATION
LAW DEPARTMENT
SUITE 150
140 GERMANTOWN PIKE
PLYMOUTH MEETING, PA 19462