

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte CRAIG V. BISHOP

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Appeal 1997-2375  
Application 08/376,282<sup>1</sup>

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Before: WILLIAM F. SMITH, Administrative Patent Judge,  
McKELVEY, Senior Administrative Patent Judge, and LORIN,  
Administrative Patent Judge.

McKELVEY, Senior Administrative Patent Judge.

Decision on appeal under 35 U.S.C. § 134

Upon consideration of the record, it is

ORDERED that the examiner's rejection of claims 1-21  
under 35 U.S.C. § 103 over Jex and Plueddemann is reversed.

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<sup>1</sup> Application for patent filed 20 January 1995. According to applicant, the application on appeal is a continuation of application 08/163,946, filed 8 December 1993. The real party in interest is McGean-Rohco, Inc.

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The claimed compositions cover silane "compositions" comprising (A) a silane coupling agent and (B) inter alia a tris(silylorgano)amine ("amine") having the general formula



Jex describes, inter alia, compounds which fall within the scope of applicant's "amine" which are said to be useful "as finishes for fibrous glass materials prior to the preparation of reinforced plastics therefrom" (col. 1, lines 38-39).

Plueddemann describes compositions comprising (A) a silane coupling agent and (B) a disilyl crosslinker having the formula



(col. 1, lines 49-55), where RO is a hydrolyzable group. The Plueddemann compositions are said to be useful as "primers" (col. 1, line 64) and for pretreating particulate fillers before compounding (col. 2, lines 1-2).

The examiner found that the utility of the Jex amine and the Plueddemann compositions were the same. Based on that

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finding, the examiner concluded that it would have been obvious to use for that utility a combination of (1) the Jex "amine" and (2) the Plueddemann composition comprising a (a) coupling agent and (b) a disilyl crosslinker. In support of the rejection, the examiner relies on In re Kerkoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) (it is generally prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is also used for that purpose).

Although it might be debatable, we will assume that the examiner is correct in finding that the Jex "amine" and Plueddemann composition have the same utility. We disagree, however, that the rationale of Kerkoven applies to the facts of this case. The disilyl crosslinker of Plueddemann is just that; it reacts with the coupling agent through the OR groups. The same would be true of the Jex "amine" which also has OR groups. Thus, we do not have a case where an applicant has mixed known ingredients to make a mixture of discrete ingredients having a utility similar to the utility of each of the ingredients. When the Jex "amine" is mixed with the

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Plueddemann compositions, both the Jex "amine" and the Plueddemann disilyl crosslinker will react with the coupling agent, and possibly with each other, to form a new "compound." The result will not be a simple mixture of coupling agent, Jex "amine" and Plueddemann disilyl compound.

While it is not the basis of the examiner's rejection, we would also agree with applicant that there is no suggestion, reason, teaching or motivation on the record for substituting the Jex "amine" for the Plueddemann disilyl compound to make a composition comprising a coupling agent and a Jex "amine."

On this record, the examiner's rejection is based on impermissible hindsight. Accordingly, it must be reversed.

**REVERSED.**

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WILLIAM F. SMITH,	)	
Administrative Patent Judge	)	
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FRED E. McKELVEY, Senior	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
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HUBERT C. LORIN )  
Administrative Patent Judge )

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