

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JAMES R. ERICKSON,  
DAVID J. ST. CLAIR and  
MICHAEL A. MASSE

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Appeal No. 1998-3087  
Application 08/399,864

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ON BRIEF

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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 1, 2, 9-16, 19-21 and 23, which are all of the claims remaining in the application.

*THE INVENTION*

Appellants' claimed invention is directed toward unsaturated monohydroxylated polydiene polymers. Claims 1, 2 and 21 are illustrative:

1. A partially unsaturated monohydroxylated polydiene polymer which is comprised of at least two polymerizable ethenically unsaturated hydrocarbon monomers wherein at least one

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is a diene monomer which yields unsaturation suitable for epoxidation, and wherein the polymer has been hydrogenated such that from 0.1 to 7 meq per gram of polymer of aliphatic double bonds remain.

2. An epoxidized monohydroxylated polydiene polymer which is comprised of at least two polymerizable ethenically unsaturated hydrocarbon monomers wherein at least one is a diene monomer which yields unsaturation suitable for epoxidation, and wherein the polymer has been epoxidized such that it contains from 0.1 to 7.0 meq of epoxy per gram of polymer.

21. An unsaturated monohydroxylated polydiene polymer which is comprised of at least two polymerizable unsaturated hydrocarbon monomers wherein at least one is a diene monomer which yields unsaturation suitable for epoxidation.

#### THE REFERENCES

Short et al. (Short)	3,269,978	Aug. 30, 1966
Pritchett et al. (Pritchett)	3,308,170	Mar. 7, 1967
Richards et al. (Richards)	4,518,753	May 21, 1985
Coolbaugh et al. (Coolbaugh)	5,149,895	Sep. 22, 1992
Erickson et al. (Erickson)	5,229,464	Jul. 20, 1993
Handlin, Jr. et al. (Handlin)	5,376,745	Dec. 27, 1994

(filed Dec. 1, 1993)

#### THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 103 as follows:

1) claims 1, 2, 9-16, 19-21 and 23 over Coolbaugh in view of Short, Pritchett, Richards and/or Handlin, and further in view of Erickson, and 2) claim 21 over Pritchett.

#### OPINION

We reverse the rejection of claims 1, 2, 9-16, 19, 20 and 23 over Coolbaugh in view of Short, Pritchett, Richards and/or Handlin, and affirm the rejection of claim 21 over these

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references and also over Pritchett taken alone.

The examiner has made an election of species requirement (Office action mailed November 17, 1995, paper no. 5, pages 2-3). Appellants elected for prosecution in this application the species I-B-S-OH and I-EB-S-OH, where I is isoprene, B is butadiene, S is styrene, and EB is hydrogenated butadiene (response filed February 26, 1996, paper no. 6, page 2). Appellants acknowledge in the brief (page 2) that they have elected these species, and this acknowledgment is noted by the examiner in the answer (page 4). There is no indication in the record that any nonelected specie was examined. Consequently, the issue before us is whether the elected species would have been obvious to one of ordinary skill in the art over the applied prior art. We therefore discuss only that issue and take no position regarding the patentability of nonelected species which are encompassed by appellants' claims. *See Ex parte Ohsaka*, 2 USPQ2d 1461, 1461 (Bd. Pat. App & Int. 1987).

*Rejection over Coolbaugh in view of Short, Pritchett, Richards and/or Handlin, and further in view of Erickson*

*Claims 1, 2, 9-16, 19, 20 and 23*

Appellants' claims require that the polydiene polymer is monohydroxylated. The examiner acknowledges that Coolbaugh does not disclose such a polymer, and relies upon Short, Pritchett,

Richards and Handlin to remedy this deficiency (answer, pages 4-5). The only reference relied upon for providing a reason to modify Coolbaugh is Richards, and the examiner does not explain why Richards, alone or in combination with the other references, would have led one of ordinary skill in the art to monohydroxylate the Coolbaugh polymer. See *id.* The examiner merely states that if the Coolbaugh polymer were monohydroxylated, one of ordinary skill in the art would have expected the result to be useful curing properties (answer, page 5). In order for a *prima facie* case of obviousness to be established, the references must be such that they would have provided one of ordinary skill in the art with both a suggestion to carry out appellants' claimed invention and a reasonable expectation of success in doing so, see *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988), and the examiner has not carried the burden of establishing that the applied references meet these requirements.

Moreover, regarding the claims which recite an adhesive composition, the examiner states that both Coolbaugh and Erickson disclose use of their block copolymers in adhesives (answer, page 5). Coolbaugh, however, teaches that the copolymers are elastomeric vulcanizates having properties such as high

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elongation and excellent aging characteristics (col. 1, lines 32-35). The examiner points out (answer, page 5) that Coolbaugh teaches that the copolymers can contain a tackifier (col. 20, lines 20-21), but has not established that an elastomeric vulcanizate containing a tackifier necessarily is an adhesive, or that a disclosure of such a vulcanizate would have fairly suggested an adhesive to one of ordinary skill in the art. Consequently, the examiner has not adequately explained why Coolbaugh and Erickson, which discloses an adhesive (col. 1, lines 49-51), are combinable.

For the above reasons, we hold that the examiner has not carried the burden of establishing a *prima facie* case of obviousness of the invention recited in claims 1, 2, 9-16, 19, 20 and 23 over Coolbaugh in view of Short, Pritchett, Richards and/or Handlin, and further in view of Erickson.

*Claim 21*

Appellants do not challenge the rejection of claim 21 over Pritchett (brief, pages 3 and 5). For this reason and because the above combination of references includes Pritchett, we affirm the rejection of claim 21 over Coolbaugh in view of Short, Pritchett, Richards and/or Handlin, and further in view of Erickson.

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*Rejection over Pritchett*

Because appellants do not challenge the rejection of claim 21 over Pritchett (brief, pages 3 and 5), we summarily affirm this rejection.

*REMAND*

The independent claims in application no. 08/320,807 are identical to those in the present case, but in that case different species within these claims were elected. The board affirmed the rejection of all claims in that application over the applied references (appeal no. 1996-4069, mailed September 18, 2000) which, except for Coolbaugh, are the same references as in the present case. We remand the application to the examiner to consider rejecting the claims based upon rationale comparable to that set forth by the board in application no. 08/320,807.<sup>1</sup>

Furthermore, we note that the independent claims in the present case are not limited to the elected species but, rather, encompass the species which the board found in application no. 08/320,807 to have been fairly suggested to one of ordinary skill in the art by the applied references. The examiner, therefore, should consider rejecting the claims for this additional reason.

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<sup>1</sup>The examiner also should review the board decision in related appeal no. 1997-4371, application no. 08/438,427.

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Also, in further prosecution the examiner should address the issue of whether claims 19 and 20 include the elected species.

*DECISION*

The rejection under 35 U.S.C. § 103 of claims 1, 2, 9-16, 19, 20 and 23 over Coolbaugh in view of Short, Pritchett, Richards and/or Handlin, and further in view of Erickson is reversed, and the rejections of claim 21 over these references and over Pritchett alone are affirmed. The application is remanded to the examiner.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

*AFFIRMED-IN-PART and REMANDED*

Sherman D. Winters	)	
Administrative Patent Judge	)	
	)	
	)	
John D. Smith	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
Terry J. Owens	)	
Administrative Patent Judge	)	

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