

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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte CHRISTOPH KITTEL, GERHARD BURAK,  
CARSTEN KLIWER and CORNELIA PETERS

Appeal No. 98-3225  
Application No. 08/204,162

**HEARD  
MAY 22, 2001**

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Before PAK, OWENS and LIEBERMAN, Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

**DECISION ON APPEAL**

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner refusing to allow claims 6, 7, 9 and 11, and claims 8 and 10 as amended subsequent to the final rejection, which are all of the claims pending in this application. Claims 1 through 5 and 12 have been canceled.

## **THE INVENTION**

The invention is directed to a viscoelastic damping foam having an adhesive surface. The surface is prepared from a stoichiometric reaction of a polyisocyanate with a mixture of polyols. One polyol is based on polyethylene oxide and the other on polypropylene oxide. Additional features of the claimed subject matter are set forth in the following illustrative claim.

## **THE CLAIMS**

Claims 6 is illustrative of appellants' invention and is reproduced below.

6. A viscoelastic damping foam having an adhesive surface comprising a stoichiometric reaction product of a polyisocyanate and a polyol reactant, said polyol reactant consisting essentially of a first polyether polyol based on propylene oxide and a second polyether polyol based on ethylene oxide, wherein said first and said second polyether polyols have hydroxyl numbers no greater than 100, and wherein said first polyether polyol and said second polyether polyol are present in a weight ratio of from 5:1 to 1:5.

## **THE REJECTION**

Claims 6 through 11 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

application was filed, had possession of the claimed invention.

### OPINION

We have carefully considered all of the arguments advanced by the appellants and the examiner and agree with the appellants that the rejection of the claims as being unsupported is not well founded. Accordingly, we reverse this rejection.

As an initial matter the appellants have stated that all the claims on appeal stand or fall together. Accordingly, we select claim 6 the sole independent claim as representative of the claimed subject matter and limit our consideration thereto. See 37 CFR 1.192(c)(7) (1995).

#### **The Rejection under 35 U.S.C. § 112**

The examiner has first rejected the claims on appeal under 35 U.S.C. § 112, first paragraph, as, “[t]he examiner has not found support within the specification requiring that both polyols have hydroxyl numbers no greater than 100.” See Answer, page 4. We note that the language of this rejection is equivalent to stating that appellants’ disclosure fails to meet the “written description” requirement of 35 U.S.C. § 112, ¶1. See Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1560, 19 USPQ2d 1111, 1114 (Fed. Cir. 1991).

The examiner finds that the specification is not clear with respect to the claimed limitation permitting the hydroxyl number of polypropylene oxide to be no greater than 100. See Answer, page 4. The language, in dispute, on page 2 of the specification provides that, "[t]he polyether polyols are characterized by a hydroxyl number # 100 and are produced on the basis of 75% ethylene oxide in the presence of a starter. Common polyether polyols are based for example on 15 to 20% ethylene oxide. Mixtures of these two types of polyether polyol are incompatible with one another."

We find little ambiguity in the language particularly when read in conjunction with the description of the two polyols described in the specification on page 4, lines 7-13. The relevant specification states that, "Desmophen 3900 is a polyether polyol based on propylene oxide with a proportion of approximately 18% ethylene oxide, a molecular weight of 4800 and a hydroxyl number of 35; Arcol 2580 is a polyether polyol based on ethylene oxide with a proportion of approximately 70% ethylene oxide, a starter for example TMP (= trimethylol propane), a molecular weight of 4000 and a hydroxyl number of 42." On reading the two paragraphs together, it is our view that the term "polyether polyols" refers to both the polyethylene oxide and the polypropylene oxide polymers described on page 2 of the specification. The common polyether polyol based on 15 to 20% ethylene oxide is directed to a propylene oxide polyether having approximately 15 to 20% ethylene oxide as exemplified by Desmophen. The ethylene oxide polyol is similarly described and exemplified by Arcol 2580.

Moreover, our position is supported by the paragraph in the specification, page 2, lines 9-18 which immediately precedes reference to "the polyether polyols." The paragraph describes "two polyols preferably of the polyether type, which are incompatible with one another." Thereafter, the next paragraph begins with the statement that "[t]he polyether polyols." In our view, "the" refers to the abovementioned two incompatible polyols, each of which are properly characterized by a hydroxyl number no greater than 100. Accordingly, the preponderance of the evidence on the record before us supports our reading that each polyol has the requisite hydroxyl number not greater than 100.

*Ipsis verbis* disclosure is not necessary to satisfy the written description requirement of 35 U.S.C. § 112. The disclosure need only reasonably convey to those of ordinary skill in the art that the inventors had possession of the subject matter in question. *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1570, 39 USPQ2d 1895, 1904 (Fed. Cir. 1996). We agree with the appellants' that the disclosure reasonably conveys to one of ordinary skill in the art that appellants had possession of "said first and said second polyols have hydroxyl numbers no greater than 100," as recited in claim 6 on appeal.

The decision of the examiner is reversed.

**REVERSED**

CHUNG K. PAK  
Administrative Patent Judge

TERRY J. OWENS  
Administrative Patent Judge

PAUL LIEBERMAN  
Administrative Patent Judge

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