

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOHN S. MICHELMAN

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Appeal No. 1999-0697  
Application No. 08/743,151

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ON BRIEF

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Before WALTZ, KRATZ and PAWLIKOWSKI, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

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

BACKGROUND

Appellant's invention relates to a hot melt wax coating and a paper coated therewith. All of appellant's claims require that the coating includes: (1) about 50-90%, by weight, of a paraffin wax, microcrystalline wax, or mixture thereof; (2) about 10-30% of at least one chemical compound, which compound is capable of dispersing the wax in an aqueous environment or capable of being chemically modified to so disperse the wax; and (3) a specified thermoplastic polymeric material. Appellant discloses that stearic acid is a chemical compound that could be chemically modified to so disperse the wax. According to appellant, a paper coated with such a coating composition may be repulped in an aqueous environment (specification, page 9, last paragraph). Claim 1 further illustrates the subject matter on appeal and is reproduced below.

1. A hot melt wax coating composition comprising:

from about 50-90% by weight of at least one wax selected from the group consisting of paraffin wax and microcrystalline wax,

from about 10-30% of at least one chemical compound incorporated in said at least one wax which is capable of undergoing chemical modification so as to be capable of dispersing said at least one wax in a substantially aqueous environment, and

a thermoplastic polymeric material, selected from the group consisting of hydrocarbon resin and copolymers of ethylene and vinyl acetate.

The sole prior art references of record relied upon by the

examiner in rejecting the appealed claims is:

Laumann  
1978

3,950,578

Apr. 13,

Claims 1-24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Laumann.

#### OPINION

Upon careful review of the entire record including the respective positions advanced by appellant and the examiner, we find ourselves in agreement with appellant that the examiner has failed to carry the burden of establishing a prima facie case of obviousness. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1471-1472, 223 USPQ 785, 787-788 (Fed. Cir. 1984). Accordingly, we will not sustain the examiner's rejection.

Laumann discloses a coated paper that is not wet-strength grade, such as a tissue or toilet paper, that will disintegrate upon toilet flushing disposal thereof. Laumann teaches a coating that includes a paraffin or microcrystalline wax and wax modifiers such as ethyl vinyl acetate or other copolymers or synthetic rubbers that may be used together with a lining for coating that type of paper (column 1, lines 9-34). Laumann discloses that "[t]he wax may be further modified by the inclusion of stearic acid or other stearates and softened by the inclusion of lanolin, petrolatum or other wax softeners" (column 1, lines 34-37). According to the examiner, Laumann "teaches other modifying agents ... can be utilized in an amount of about 10 to 30 parts as instantly claimed" and "it would be obvious for one of ordinary skill in the art to utilize the stearic acid modifying agent in amounts as set forth by the patent for other modifying agents" (answer, page 5).

Appellant, on the other hand, points out that while Laumann discloses stearic acid as an optional ingredient, Laumann furnishes no examples utilizing stearic acid and does

not teach the purpose of that ingredient or how much stearic acid may be optionally used for that unstated purpose (brief, pages 8 and 9 and reply brief, page 2).

On this record, we agree with appellant that the examiner has not carried the burden of establishing that Laumann would have rendered the claimed coating composition and paper coated with same prima facie obvious to one of ordinary skill in the art. Here, we find insufficient direction in the relied upon teachings of Laumann to alone have reasonably suggested including an amount of stearic acid in a coating corresponding to the appellant's claimed amount to one of ordinary skill in the art. While we are mindful that the examiner has opined that stearic acid is a known wax dispersant (answer, page 5), we note that appellant has disputed that assertion (answer, page 9 and reply brief, page 2). The examiner has offered no other evidence to support that allegation and we are not inclined to dispense with such proof under these circumstances. Moreover, the examiner has not established that it would have been prima facie obvious to one of ordinary skill in the art to use stearic acid in amounts corresponding to the claimed amount in the coating composition for any

purpose from Laumann's teachings, let alone the unsubstantiated dispensant utility asserted by the examiner. On this record, the examiner has simply not furnished any convincing reasons to suggest that the amounts of other coating components used by Laumann would be viewed by one of ordinary skill in the art as instructive as to the amount of stearic acid to be optionally added.

Accordingly, the rejection fails for lack of a sufficient factual basis upon which to reach a conclusion of obviousness. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

The decision of the examiner to reject claims 1-24 under

35 U.S.C. § 103 as being unpatentable over Laumann is  
reversed.

REVERSED

Thomas A. Waltz	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
Peter F. Kratz	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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Beverly A. Pawlikowski	)	
Administrative Patent Judge	)	

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PFK/cam

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