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DOBRUSIN THENNISCH PC 29 W LAWRENCE ST SUITE 210 PONTIAC, MI 48342			DOLLINGER, MICHAEL M	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte HUIDE ZHU and DANIEL HEBERER

Appeal 2011-000285
Application 11/442,839
Technology Center 1700

Before LINDA M. GAUDETTE, KAREN M. HASTINGS, and
JAMES C. HOUSEL, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

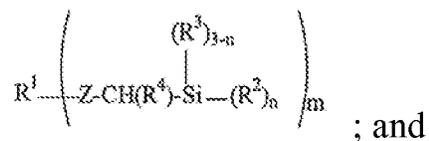
DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's decision¹ finally rejecting claims 1, 9-19, and 21-25 under 35 U.S.C. § 102(b) as anticipated by Wu (US 6,512,033 B1, issued Jan. 28, 2003) and claim 20 under 35 U.S.C. §103(a) as unpatentable over Wu in view of Kneisel (US 5,741,383, issued Apr. 21, 1988).² We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

“Th[e] invention relates to polyurethane sealant compositions which . . . can bond without the need for a primer to a coated surface such as a window flange and to glass, to clear plastic coated with an abrasion resistant coating (coated plastic) or to glass or coated plastic further coated with a frit such as a ceramic or organic frit.” (Spec.³ [0002].) Claim 1, the sole independent claim on appeal, is representative of the invention and is reproduced below from the Claims Appendix to the Appeal Brief:

1. A composition comprising:
 - (1) one or more urethane prepolymers having isocyanate moieties;
 - (2) a catalytic amount of one or more compounds which catalyze the reaction of isocyanate moieties with water or an active hydrogen containing compound; and
 - (3) one or more alpha hydrocarbyl silane compounds corresponding to the formula



wherein:

¹ Final Office Action mailed Jun. 2, 2009.

² Appeal Brief filed May 26, 2010 (“App. Br.”). We note the brief does not include pagination.

³ Specification filed May 30, 2006.

R¹ is independently in each occurrence an aliphatic polyether;
R² is independently in each occurrence a hydrolyzable group;
R³ is independently in each occurrence a monovalent hydrocarbon;
R⁴ is independently in each occurrence C₁₋₃ alkyl or hydrogen
Z is independently in each occurrence a heteroatom containing functional linkage; n is independently in each occurrence an integer of 1 to 3; and m is about 1 or greater.

We decide the following issue in favor of Appellants and, therefore, reverse the rejections of claims 1 and 9-25: Does the evidence support a finding that Wu teaches a composition comprising component (3) as claimed, i.e., a compound wherein “the hydrocarbyl group bonded to the functional linking group is an aliphatic polyether” (App. Br., p. 2 of § VII)?

Appealed claim 1 recites a composition comprising, in general, three compounds: (1) one or more urethane prepolymers, (2) a catalyst, and (3) one or more alpha hydrocarbyl silanes. The Examiner finds Wu teaches mixing an isocyanate urethane prepolymer and a catalyst meeting the limitations of Appellants’ claimed compounds (1) and (2), respectively, with an adduct. (Ans.⁴ 3-4 (citing Wu col. 1, ll. 54-67 (“In one aspect, this invention is a polyurethane sealant composition comprising [] a urethane prepolymer having an isocyanate functionality . . . ; [] a catalytic amount of a tin compound which catalyzes . . . ; and . . . [i]n a preferred embodiment[,] . . . a compound or polymer which contains silane moieties.”)).) Wu teaches the same polyisocyanates are useful in preparing the adduct and the isocyanate urethane prepolymer (compound (1) as claimed). (Wu col. 6, ll. 12-14., cited in Ans. 4.) The Examiner finds Wu’s “urethane prepolymer is preferably prepared from a diisocyanate and a polyol wherein the polyol is preferably ethylene oxide capped polyol prepared by reacting glycerin

⁴ Examiner’s Answer mailed Jul. 7, 2010.

with propylene oxide followed by reacting with ethylene oxide [column 4 lines 26-29] which reads on an aliphatic polyether.” (Ans. 4.)

Appellants contend the evidence is insufficient to support a finding that “Wu discloses an adduct containing an aliphatic polyether bonded to the functional linking group” (App. Br., p. 4 of § VII.), i.e., a compound (3) as claimed.

Appellants argue that while Wu states the same *polyisocyanates* are useful in preparing the adduct and the isocyanate urethane prepolymer (*id.* (citing Wu col. 6)), the Examiner has not identified a teaching in Wu of using a *polyether* to prepare the adduct and/or an adduct corresponding to the formula of compound (3) in appealed claim 1. (*See generally*, Wu col. 3, l. 3-56 (listing examples of useful polyisocyanates) and col. 5, l. 38-col. 7, l. 35 (describing preparation of the adduct).) The Examiner’s Response to Argument fails to fully address this argument. (*Cf.* Ans. 10-11.)

Appellants have persuasively argued the evidence relied on by the Examiner is insufficient to support a finding that Wu teaches a composition comprising compound (3) as claimed, i.e., a compound wherein the hydrocarbyl group bonded to the functional linking group is an aliphatic polyether. Because the rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a) are based on this unsupported finding, we reverse the Examiner’s decision to reject appealed claims 1 and 9-25.

REVERSED

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