



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/026,221	02/05/2008	Barry N. Burns	ICC-267-A-US	2669
31217	7590	02/22/2013	EXAMINER	
Henkel Corporation One Henkel Way Rocky Hill, CT 06067			BUSHEY, CHARLES S	
			ART UNIT	PAPER NUMBER
			1776	
			MAIL DATE	DELIVERY MODE
			02/22/2013	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL
AND APPEAL BOARD

Ex parte BARRY N. BURNS and JONATHAN P. WIGHAM

Appeal 2011-003971
Application 12/026,221
Technology Center 1700

Before JEFFREY T. SMITH, BEVERLY A. FRANKLIN, and
KAREN M. HASTINGS, *Administrative Patent Judges*.

PER CURIAM

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 27-32. We have jurisdiction under 35 U.S.C. § 6.

STATEMENT OF THE CASE

Claim 27 is representative of the subject matter on appeal and is set forth below:

27. A method of modifying a one part, curable composition from a self reactive shipping classification to a non self reactive shipping classification, the composition selected from the group consisting of adhesives, sealants and coatings, comprising:

selecting a curable component and a latent curing agent component for curing the curable component to provide a mixture of the curable component and the curing agent component having a cure onset temperature, an end temperature of reaction, a reaction exotherm of at least 300 J/g and a self reactive shipping classification;

providing the curable component;

providing the latent curing agent component;

providing a predetermined amount of an inert, heat absorbing component having a phase change in the range of temperatures between the cure onset temperature and the end temperature of the reaction, the amount being predetermined to provide a mixture of the curable component, the curing agent component and the heat absorbing component with a reaction exotherm of less than 300 J/g; and

mixing the curable component, the curing agent and the predetermined amount of heat absorbing component to form the one part, curable composition having a reaction exotherm of less than 300 J/g and not requiring a self reactive shipping classification.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Miyagawa

JP 11-021535

Jan. 26, 1999

THE REJECTION

Claims 27 - 32 are rejected under 35 U.S.C. §102(b) are anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Miyagawa.¹

We sustain the above rejection based on the findings of fact, conclusions of law, and rebuttals to arguments expressed by the Examiner in the Answer. We add the following for emphasis only.

¹ This is a new ground of rejection (the Examiner indicates that this rejection now includes claim 28). Ans. 3. Appellants argue that there is no basis for a new ground of rejection because this rejection is of record. Br. 3-5. Because Appellants acknowledge that the rejection has been in the record, we view it as properly before us now.

With respect Appellants' argument pertaining to whether Miyagawa is an enabling reference, we note that when the reference relied on expressly anticipates or makes obvious all of the elements of the claimed invention, the reference is presumed to be operable. Once such a reference is found, the burden is on applicant to provide facts rebutting the presumption of operability. *In re Sasse*, 629 F.2d 675, 681 (CCPA 1980) (it is applicant's burden to demonstrate non-enablement of a reference); discussed further in *In re Antor Media Corp.*, 689 F.3d 1282, 1288 (Fed. Cir. 2012) (“we now hold that a prior art printed publication cited by an examiner is presumptively enabling”). In the instant case, Appellants have not provided such facts.

With respect to the issue of whether the Miyagawa inherently provides for a mixture having a reaction exotherm of at least 330 J/g, and a self-reactive shipping classification (as discussed by the Examiner on page 4 of the Answer), we agree with the Examiner's position. We note that there is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure at the time of invention, but only that the subject matter is in fact inherent in the prior art reference. *Schering Corp. v. Geneva Pharm. Inc.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003). Also, when the claim recites using an old composition or structure and the “use” is directed to a result or property of that composition or structure, then the claim is anticipated. *In re May*, 574 F.2d 1082, 1090 (CCPA 1978). See also *In re Tomlinson*, 363 F.2d 928, 931 (CCPA 1966). Finally, where the Examiner establishes a reasonable assertion of inherency and thereby evinces that a claimed process appears to be identical to a process disclosed by the prior art and/or that the products claimed by the applicant and disclosed in the prior

Appeal 2011-003971
Application 12/026,221

art appear to be the same, the burden is properly shifted to the applicant to show that they are not. *See In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990); *In re Best*, 562 F.2d 1252, 1254-56 (CCPA 1977). *Cf. In re Crish*, 393 F.3d 1253, 1259 (Fed. Cir. 2004).

The decision of the Examiner is affirmed.

CONCLUSIONS OF LAW AND DECISION

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1).

AFFIRMED

sld