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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte HANS-PETER HENTZE, DIETER NIEDERBERGER,
HANS WILLAX, JOACHIM BURGER,
and DANIEL PASCUAL GIENAP

Appeal 2012-000230
Application 12/307,926
Technology Center 1700

Before PETER F. KRATZ, JEFFREY T. SMITH, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's decision[1] finally rejecting claims 19-34 under 35 U.S.C. §102(b) over Jahns (US 2003/0125222 A1, published Jul. 3, 2003), and claim 36 under 35 U.S.C. § 103(a) over Jahns in view of Pushaw (US 5,955,188, issued Sep. 21, 1999).[2, 3] We have jurisdiction under 35 U.S.C. § 6(b).[4, 5]

We REVERSE.

"[I]t is an aspect of the [] invention to provide microcapsules having latent heat storage materials as a capsule core and enhanced durability to dry cleaning. Microcapsules having a higher tightness to diffusion of the core material are a

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[1] Final Office Action mailed Jul. 30, 2010 ("Final")
[2] Appeal Brief filed Feb. 25, 2011 ("App. Br.")
[3] Claims 19-34 and 36 were also provisionally rejected on the ground of nonstatutory obviousness-type double patenting as unpatentable over claims 1-18 of copending Application No. 12/444,051. (Examiner's Answer mailed May 11, 2011 ("Ans."), 3-4.) Appellants indicate "[t]his provisional rejection is currently held in abeyance until an indication of allowable subject matter in the present application and, thus, is not currently subject to this appeal." (App. Br. 3.) Subsequent to the docketing of this appeal on Oct. 12, 2011, claims 1-18 of the copending application were cancelled, new claims 19-31 were added (App. Br. 2-3), and a patent issued from the copending application as US 8,163,207 on Apr. 24, 2012. Because it is unclear whether the provisional obviousness-type double patenting rejection is still proper, we decline to reach this ground of rejection. *Cf. Ex Parte Jerg*, 2012 WL 1375142, at *3 (BPAI 2012) ("Panels have the flexibility to reach or not reach provisional obviousness-type double-patenting rejections." (citing *Ex parte Moncla*, 95 USPQ2d 1884 (BPAI 2010) (precedential))).
[4] An oral hearing was held before this panel on January 16, 2013.
[5] Appellants identify Appeal 2007-4235 as related to the present appeal. (App. Br. 1.) A decision affirming the Examiner's decision to reject the appealed claims was mailed in Appeal 2007-4235 on Feb. 25, 2008. (*See id.*, Related Proceedings Appx.) Appellants indicate US 7,572,397 has since issued from the application (SN 10/302,996) which was the subject of Appeal 2007-4235. (*Id.* at 1.)

further aspect of the [] invention." (Spec.[6] 2:19-22.) Claim 19 is representative of the invention and is reproduced below from the Claims Appendix to the Appeal Brief (emphasis added):

> 19. A microcapsule comprising a capsule core comprising more than 95% by weight of lipophilic substance and a capsule wall composed of a thermoset polymer and also, *disposed on the outer surface of said capsule wall, a polyelectrolyte comprising one or more cationic polyelectrolytes and having an average molecular weight in the range from 500 g/mol to 10 million g/mol.*

The issue in this appeal is: does a preponderance of the evidence support the Examiner's finding that Jahns' microcapsule comprises a polyelectrolyte as claimed?

The Specification defines "[t]he term polyelectrolyte generally [as] refer[ring] to polymers having ionizable or ionically dissociable groups which can be a polymer chain constituent or substituent." (Spec. 3:26-27.) "Depending on the identity of the dissociable groups, there are cationic and anionic polyelectrolytes (also known as polyion)." (*Id.* at 4:13-14.) "Cationic polyelectrolytes are formed from polymers comprising basic groups (polybases) by addition of protons or quaternization. Anionic polyelectrolytes are formed from polymers comprising acidic groups (polyacids) by detachment of protons." (*Id.* at 15-19.) "The polyelectrolyte is classified according to the resulting net charge of the polyion (i.e., without counter-ion). When the polyelectrolyte has predominantly positively charged, dissociated groups, it is a cationic polyelectrolyte. When it has predominantly negatively charged groups, it is an anionic polyelectrolyte." (*Id.* at 21-24.)

Appellants do not dispute the Examiner's findings that Jahns discloses a microcapsule comprising a core and a wall as claimed. (*See generally*, App. Br. 4-

[6] Specification filed Jan. 8, 2009.

9.) The Examiner finds Jahns' "microcapsules are dispersed in liquid formulations containing auxiliary agents including organic cobuilders, color transfer inhibitor[s] and surfactants" (Ans. 5) which "qualify as the polyelectrolytes of the [claimed] invention" (*id.* at 6). The Examiner finds Jahns discloses, for example, the use of vinylimidazole as an organic cobuilder, vinylimidazole being "described as . . . [a] cationic polyelectrolyte[] in the instant specification." (Ans. 5-6 (citing, e.g., Jahns [0073] and Spec. 5:24-28).)

Appellants argue Jahns' disclosure does not support a finding that Jahns teaches "*molecules* [which] bear a net positive charge" (App. Br. 8 (emphasis added); *cf.* Spec. 5:24-29 (identifying vinylimidazole as a "[u]seful cationic monomer for copolymerization with anionic monomers")), directing us to Specification page 4, lines 21-24 (*see* quotation *supra* p. 3), which define a cationic polyelectrolyte as having predominantly positively charged, dissociated groups (App. Br. 7-8). Appellants explain why the auxiliary agents and protective colloids of Jahns' detergent composition do not meet the claim limitation of a "cationic polyelectrolyte." (*See id.* at 4-8.) Appellants explain, e.g., that "when properly reading [Jahns] para. [0073] in conjunction with paras. [0066] and [0069], any comonomer bearing a cationic charge in Jahns [] would be in the minority (i.e., up to 20%) compared to comonomers bearing an anionic charge." (App. Br. 7.) The Examiner, in response, does not persuasively refute Appellants arguments, or clearly identify a teaching in Jahns of a polymer which meets the claim limitation of a "cationic polyelectrolyte." (*See* Ans. 9 (stating, in response to the above-quoted language from App. Br. 7: "This statement reveals that the appellant considers the 'organic cobuilder', vinylimidazole, a cationic polyelectrolytes [sic].").)

In sum, Appellants have persuasively argued a preponderance of the evidence fails to support the Examiner's finding that Jahns' microcapsule comprises a polyelectrolyte as claimed. As the rejections under both 35 U.S.C. §102(b) and 35 U.S.C. §103(a) are based on this finding, we reverse the Examiner's decision to reject claims 19-34 and 36.

REVERSED

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