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Appellants' invention is directed to methods of applying a solvent-free enamel composition to a wire. (Spec. 1: 4; claims 9 and 19 (the only independent claims)).

Claim 9 is illustrative of the subject matter on appeal:

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1 The Appeal Brief on page 3 indicates that “Elantas GmbH” is the real party in interest.
9. A method of applying an enamel composition to a wire, wherein the method comprises melting the enamel composition in an extruder, applying the melted composition to the wire and subjecting the applied composition to post-crosslinking, the enamel composition being a solvent-free wire enamel composition comprising an extrudable, polyesterimide-containing binder prepared from (i) polyols, (ii) polycarboxylic acids, (iii) imide-forming components, and (iv) structural elements which are crosslinkable after extrusion, and wherein components (iii) are catenary imide-forming components and structural elements (iv) are unsaturated carboxylic acids and the composition comprises 30-60 wt% of catenary imide-forming components and 2-20 wt% of unsaturated carboxylic acids.

Appellants appeal the following rejections:


FINDINGS OF FACT & ANALYSIS

The Examiner’s findings and conclusions regarding Kertscher and Karkoski with regard to claims 9 and 19 are located on pages 2 to 5 and 7 to 9 of the Final Office Action.
Appellants argue that Kertscher teaches away from using Karkoski’s curable polyesterimide coating (App. Br. 11). Appellants contend that Kertscher discloses in the paragraph bridging columns 1 and 2 that cross-linkable thermoplastics in the extrusion coating of wire where the thermoplastics are crosslinked (hardened) after extrusion by electronic radiation or by heat-treatment does not result in a satisfactory insulation of the wires (App. Br. 10). Appellants contend that Kertscher’s invention uses thermoplastic polycondensates which require no hardening operation (App. Br. 11).

The Examiner responds that Kertscher’s teaching in the paragraph bridging columns 1 and 2 is not considered a teaching away because Kertscher does not disclose that post-cross-linkable thermoplastics cannot be used as wire coating materials (Ans. 25).

We understand Appellants to argue that based upon Kertscher’s teachings there would have been no reason to combine Karkoski’s thermoplastic polyesterimide coating composition, which is cured after application, with Kertscher’s process. We agree. Kertscher recognizes that cross-linkable thermoplastics that are post-cured do not provide adequate insulation to meet the German industry standards sought by Kertscher (col. 1, ll. 64–68; col. 2, ll. 1–9). Kertscher addresses this problem by using a thermoplastic polycondensate that does not require a hardening (i.e., post-cure) operation (col. 2, ll. 35–37). In light of Kertscher’s disclosures regarding the use of thermoplastic polycondensates that do not require a cross-linking step as a substitute for the thermoplastic cross-linkable coating materials, the Examiner has not adequately explained why one of ordinary skill in the art would have substituted Karkoski’s thermoplastic cross-
linkable polyesterimide for Kertscher’s thermoplastic polycondensate. The Examiner’s reasoning for substituting Karkoski’s coating for Kertscher’s is based upon Karkoski’s teaching that the coating provides excellent flexibility, heat shock, dielectric and thermal properties (Final Act. 3). The Examiner’s reasoning does not, however, explain why one of ordinary skill in the art would have substituted Karkoski’s cross-linkable polyesterimide for Kertscher’s thermoplastic polycondensate in light of Kertscher’s teaching that cross-linkable thermoplastics would not provide the requisite insulation properties necessary for Kertscher’s wires.

On this record, the Examiner has not dispensed with the initial burden of establishing a prima facie case of obviousness. We reverse the § 103(a) rejections of record.

DECISION

The Examiner’s decision is reversed.

ORDER

REVERSED