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Henkel Corporation One Henkel Way Rocky Hill, CT 06067			ROSWELL, JESSICA MARIE	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RAYMOND ZHANG, DAOQIANG LU, and
SHABBIR ATTARWALA

Appeal 2019-001252
Application 14/162,301
Technology Center 1700

Before MICHAEL P. COLAIANNI, MONTÉ T. SQUIRE, and
SHELDON M. McGEE, *Administrative Patent Judges*.

McGEE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the
Examiner's decision to reject claims 1, 2, and 4–21.

We have jurisdiction. 35 U.S.C. § 6(b).

We affirm.

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as Henkel AG & Co. and Henkel IP & Holding GMBH. Br. 2.

CLAIMED SUBJECT MATTER

The claims are directed to an adhesive composition. Sole independent claim 1, reproduced below, is illustrative of the claimed subject matter:

1. An adhesive composition comprising, based on the total weight of the adhesive composition:

(1) from 38.0 to 75.0 percent by weight of a urethane oligomer having at least one (meth)acryloyloxy group;

(2) from 0.1 to 10.0 percent by weight of at least one multifunctional (meth)acrylate monomer;

(3) from 15.0 to 60.0 percent by weight of at least one monofunctional (meth)acrylate monomer;

(4) from 0.5 to 5.0 percent by weight of a photoinitiator;

(5) from 0.1 to 5.0 percent by weight of a silane coupling agent; and

(6) from 0 to 5.0 percent by weight of an additive selected from the group consisting of a tackifier, a thickening agent, a flame retardant, a leveling agent and a thermal initiator,

wherein the urethane oligomer having at least one (meth)acryloyloxy group has a Tg of from -80°C to 0°C and a Brookfield viscosity at 25°C of from 1000 mPa·s to 190000 mPa·s and wherein the cured product of the adhesive composition has a transparency greater than 92% as measured in accordance with ASTM D1003-2007.

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Acevedo	US 2004/0181007 A1	Sept. 16, 2004
Mitani	US 2005/0090574 A1	Apr. 28, 2005
Kita	US 2006/0154066 A1	July 13, 2006
Oshima	US 2008/0149270 A1	June 26, 2008
Ichikawa	US 2009/0246915 A1	Oct. 1, 2009
Oshima (“Oshima ’263”)	US 2010/0012263 A1	Jan. 21, 2010

REJECTIONS

On appeal, the Examiner maintains the following rejections:

- I. Claims 1, 2, and 4–16 are rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Oshima, in view of Kita, when taken with Acevedo and Mitani.
- II. Claims 1, 17, 19, and 20 are rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Oshima, in view of Ichikawa, when taken with Acevedo and Mitani.
- III. Claims 1, 18, and 21 are rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Oshima, in view of Ichikawa, and further in view of Oshima ’263, when taken with Acevedo and Mitani.

DISCUSSION

Each of the obviousness rejections include sole independent claim 1, which is the only claim that Appellant argues. Br. 10–19. We, therefore, focus our discussion on this claim.

In each of the obviousness rejections, the Examiner finds that Oshima teaches the claimed adhesive composition, except for the requirement that the silane coupling agent is present in recited amount. Final Act. 3–4, 7–8, 10–11. To address this difference, the Examiner turns to Kita (*id.* at 4) or,

alternatively, Ichikawa (*id.* at 8, 11), which the Examiner finds discloses the use of a silane coupling agent in an adhesive composition, and in an amount that falls within the claimed range. Based on the combined disclosures of Oshima and Kita, or Oshima and Ishikawa, the Examiner determines it would have been obvious to employ a silane coupling agent in an adhesive composition and in an amount that falls within the claimed range, “in order to improve adhesion of the adhesive layer, as is a well-known property to one of ordinary skill in the art.” *Id.* at 4, 8.

The Examiner relies on the disclosures of Acevedo and Mitani as evidence that the recited Tg and viscosity limitations would be satisfied by employing a species of urethane oligomer that falls within the scope of the claims. *See id.* at 4, 10. The Examiner also determines that, because the relied upon references teaches the claimed reagents in the claimed amounts, and substantially similar processes, the prior art composition would have the recited transparency. *Id.* at 4.

We have considered Appellant’s arguments (Br. 10–19) and are unpersuaded that Appellant has identified reversible error in the rejections. *In re Jung*, 637 F.3d 1356, 1365–66 (Fed. Cir. 2011). Therefore, we sustain the obviousness rejections before us based on the findings of fact, conclusions of law, and rebuttals to arguments expressed by the Examiner in the Final Action and in the Answer. We add the following only for emphasis.

Appellant spends a significant portion of its argument discussing the “object” of the prior art. Br. 10–15. Such arguments do not reveal error in the Examiner’s findings or the obviousness conclusion because the claims are composition claims. Here, the Examiner undisputedly finds that Oshima

discloses each claimed element—including the silane coupling agent—but does not expressly recite the *amount* of such a coupling agent. Final Act. 3, 7–8, 10–11. Thus, Oshima’s purported “object” vis-à-vis the purpose of the claimed adhesive is of little relevance.

[I]t is not necessary in order to establish a *prima facie* case of obviousness that both a structural similarity between a claimed and prior art compound (or a key component of a composition) be shown and that there be a suggestion in or expectation from *the prior art* that the claimed compound or composition will have the same or a similar utility *as one newly discovered by applicant*.

In re Dillon, 919 F.2d 688, 693 (Fed. Cir. 1990, en banc).

We also note that Appellant’s attempt to rely on case law specific to lead chemical compounds is inapposite because the claims at issue here are directed to compositions, not compounds. Br. 14–15.

Finally, we observe that Appellant’s assertions regarding the Examiner’s combination of Oshima and Kita, or alternatively, Oshima and Ichikawa, fail to explain why, precisely, the technologies disclosed in the prior art are so different that the skilled artisan would not have sought to combine them. Br. 16–17. Such assertions do not identify reversible error in the Examiner’s obviousness conclusion.

For these reasons, and those provided by the Examiner in the Final Action and the Answer, we sustain the obviousness rejections on appeal.

CONCLUSION

The Examiner’s rejections are affirmed.

DECISION SUMMARY

Claims	35 U.S.C. §	Reference(s)/ Basis	Affirmed	Reversed
1, 2, 4–16	103(a)	Oshima, Kita, Acevedo, Mitani	1, 2, 4–16	
1, 17, 19, 20	103(a)	Oshima, Ichikawa, Acevedo, Mitani	1, 17, 19, 20	
1, 18, 21	103(a)	Oshima, Ichikawa, Oshima '263, Acevedo, Mitani	1, 18, 21	
Overall Outcome			1, 2, 4–21	

TIME PERIOD FOR RESPONSE

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

AFFIRMED