

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARIE-ESTHER SAINT VICTOR
and GRANNIS S. JOHNSON

Appeal No. 2002-1107
Application No. 09/662,540

ON BRIEF

Before KRATZ, DELMENDO and TIMM, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-8, 12-25, 29-42 and 46-51.¹ The subject matter of claims 9-11, 26-28 and 43-45 has been indicated as allowable by the examiner. Those claims stand objected to as being dependent upon a rejected base claim. Claim 52, which is the only other claim that remains pending in this application,

¹ We note that the propriety of the examiner's objection to claims 18-34 as being substantial duplicates of claims 35-51 relates to a petitionable matter and not to an appealable matter. See 37 CFR § 1.181 and Manual of Patent Examining Procedure (MPEP) §§ 706.03(k), 1002 and 1201, (Aug., 2001). Accordingly, that objection is not before us for review.

has not been made a subject of this appeal (brief, pages 1 and 2 and answer, page 2, item No. 4). See the examiner's advisory action (Paper No. 7) mailed August 03, 2001 wherein a rejection of claim 52 under 35 U.S.C. § 112, second paragraph was indicated as being overcome (withdrawn).

BACKGROUND

Appellants' invention relates to a coating composition and a process of making same. An understanding of the invention can be derived from a reading of claims 1 and 18, which are reproduced below.

1. A process for making a water-dispersible, radiation curable coating composition comprising:
 - (a) providing from about 10 to about 90% by weight of a cationic oligomer;
 - (b) providing from about 10 to about 30% by weight of an epoxy functional monomer;
 - (c) providing from about 0.01 to about 30% by weight of a surfactant component;
 - (d) providing from about 0.01 to about 10% by weight of a transfer agent;
 - (e) providing from about 1 to about 15% by weight of a photoinitiator, all weights being based on the weight of the composition; and
 - (f) mixing (a)-(e) to form the coating composition.

18. The product of the process of claim 1.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Koleske et al. (Koleske)	4,977,199	Dec. 11, 1990
Roth	5,889,084	Mar. 30, 1999

Claims 1-4, 6, 13-21, 23, 30-38, 40 and 47-51 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Koleske. Claims 1-8, 12-25, 29-42, and 46-51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Koleske. Claims 1-8, 12-25, 29-42, and 46-51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Roth.

We refer to the briefs and to the answer for the opposing viewpoints expressed by appellants and by the examiner concerning the above-noted rejections.

OPINION

Having carefully considered each of appellants' arguments set forth in the brief and reply brief, appellants have not persuaded us of reversible error on the part of the examiner. Accordingly, we will affirm the examiner's rejections. We add the following primarily for emphasis.

Appellants state that the rejected claims do not stand or fall together. See page 3 of the brief. However, as correctly determined by the examiner (answer, paragraph bridging pages 2 and 3), appellants have not presented separate arguments for each of the appealed claims in compliance with 37 CFR § 1.192(c)(7) and (c)(8) (2000). Nor have appellants challenged that

determination of the examiner in the reply brief. Also, see In re McDaniel, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002) ("if the brief fails to meet either requirement, the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim"). Accordingly, we select claim 18 as the representative claim for deciding this appeal as to each ground of rejection before us. See 37 CFR § 1.192(c) (7) (2000).

Representative claim 18 calls for a coating composition made from a mixture of specified amounts of a cationic oligomer, an epoxy functional monomer, a surfactant component, a transfer agent, and a photo initiator.

Because claim 18 is drawn to a product in terms of the process for making same, we determine that the representative appealed claim 18 is in product-by-process form. Thus, the patentability of the claimed invention is determined based on the product itself, not on the method of making it. See In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985) ("If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is

unpatentable even though the prior art product was made by a different process.").

Appellants argue that Koleske does not teach use of a transfer agent and surfactant being required and use of an amount of epoxy functional monomer, transfer agent and surfactant as appellants' claim. However, Koleske teach and exemplify a coating that includes epoxy monomer, surfactant, photo initiator and polyol (transfer agent²) in admixture. The amounts of surfactant, transfer agent and photo initiator fall squarely within the claimed amounts for those components in Example 36 of Koleske. Moreover, the epoxide "monomer" in Example 36 of Koleske is a diepoxide. See Epoxy 4 definition at column 24 of Koleske. The monomer and oligomer of representative claim 18 can be epoxides (specification, pages 4-10 and claims 1 and 3). Since appellants' oligomers are disclosed as being reactable in forming a cured coating (cationically curable), they are polymerizable materials (monomers). Thus, the diepoxy "Epoxy 4"

² The examiner (answer, page 4) has determined that the polyol of Koleske is a transfer agent within the scope of the appealed claims. This finding is not inconsistent with appellants' specification (page 17) wherein a variety of polyols are listed (non-exclusively) as transferring agents. Appellants have not specifically refuted that factual finding of the examiner.

of Example 36 of Koleske reasonably satisfies the claimed requirement for a monomer and oligomer in the amounts claimed.

Moreover, regarding the product of representative claim 18, we further note that appellants state:

More particularly, it is not known whether the mixing of one or more of the claimed components results in some sort of a reaction taking place such that when the final product is analyzed for the individual components, and claimed amounts of each present therein, whether the results will be different from the starting materials. Thus, it is quite conceivable that when the final product is analyzed, a smaller amount of each claimed component may be present than what was first used due to some side reaction that has taken place.

Against that background, appellants' argument that Koleske does not teach use of an amount of epoxy functional monomer as here claimed cannot be found persuasive. Whether a rejection is under 35 U.S.C. § 102 or § 103, when appellants' product and that of the prior art appears to be identical or substantially identical, the burden shifts to appellants to provide evidence that the prior art product does not necessarily or inherently possess the relied upon characteristics of appellants' claimed product. See In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980); In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-434 (CCPA 1977); In re Fessmann, 489 F.2d 742, 745, 180 USPQ 324, 326 (CCPA 1974). The reason is that the Patent and

Trademark Office is not able to manufacture and compare products. See Best, 562 F.2d at 1255, 195 USPQ at 434; In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). This, appellants have not done. Accordingly, on this record, we shall sustain the examiner's § 102 and § 103 rejections over Koleske.

With regard to the examiner's § 103 rejection over Roth, we note that Roth discloses a coating composition that can include an admixture of epoxy monomers and oligomers (column 3, line 38 through column 5, line 25, a surfactant in amounts overlapping the claimed amount (column 11, lines 32-35), a photo initiator in amounts overlapping the claimed amount (column 9, lines 25-28) and a polyol (transfer agent) in amounts sufficient to speed up kinetics as set forth at column 8, lines 30-61. Consequently, appellants arguments that Roth does not disclose the claimed amount of surfactant is not persuasive. Also, since Roth teaches that the amount of transfer agent is result effective to speed up kinetics, it would have been obvious for one of ordinary skill in the art to arrive at the claimed amount of transfer agent from the teachings of Roth upon routine experimentation in determining the workable amounts for improved kinetics as suggested by Roth. As for the claimed amount of epoxy functional monomer, Roth suggests that monomers or oligomers or mixtures of oligomers and

monomers may be used and exemplifies using from 40 to 98 weight percent epoxy monomer. See example 1. From that disclosure, one of ordinary skill in the art would have been led to use amounts of epoxy monomers and oligomers, such as 20 weight percent of each, that overlap the amounts here claimed when both oligomers and monomers are employed in formulating the coating as taught by Roth.

Consequently, we shall sustain the examiner's § 103 rejection over Roth.

CONCLUSION

The decision of the examiner to reject claims 1-4, 6, 13-21, 23, 30-38, 40 and 47-51 under 35 U.S.C. § 102(b) as being anticipated by Koleske; to reject claims 1-8, 12-25, 29-42, and 46-51 under 35 U.S.C. § 103(a) as being unpatentable over Koleske; and to reject claims 1-8, 12-25, 29-42, and 46-51 under 35 U.S.C. § 103(a) as being unpatentable over Roth is affirmed.

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

AFFIRMED

PETER F. KRATZ)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ROMULO H. DELMENDO)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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PFK/sld

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