

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

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** PATRICK ALBERT CLARK and KRISTIN WEIDEMAIER

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Appeal No. 2004-0977  
Application No. 10/043,762

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ON BRIEF

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Before GARRIS, JEFFREY T. SMITH and PAWLIKOWSKI, **Administrative  
Patent Judges.**

PAWLIKOWSKI, **Administrative Patent Judge.**

**DECISION ON APPEAL**

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-8.

Claim 1 is representative of the subject matter on appeal and is set forth below:

1. A method for predicting the outdoor durability of a first coating relative to the outdoor durability of at least one other of a set of coatings, all of said coatings having been formed from aqueous coating compositions comprising a thermoplastic emulsion polymer, said method comprising exposing said set of coatings to the same ambient outdoor conditions for the same period of time, subjecting said exposed coatings to a chemiluminescence test, and comparing the result of said chemiluminescence test performed on said first coating to the corresponding result for at least one other of said set of coatings.

The examiner relies upon the following references as evidence of unpatentability:

Okazaki et al. (Okazaki)                    3,891,451                    Jun. 24, 1975  
Dudler, et al., "Use of Chemiluminescence to the Study of Photostability of Automotive Coatings", Polymer Degradation and Stability, No. 60 (1998), pp. 35-365.

Claims 1-8 stand rejected under 35 U.S.C. § 103 as being obvious over Okazaki in view of Dudler.

On page 5 of the brief, appellants state that the claims stand or fall together. We therefore consider claim 1 in this appeal. 37 CFR § 1.192(c)(7) and (8)(2003).

**OPINION**

For the reasons set forth in the answer, and below, we affirm the rejection.

We refer to pages 3-5 of the answer regarding the examiner's position in this rejection.

Beginning on page 5 of the brief, appellants argue that Okazaki fails to teach or suggest the use or need for any alternative test, and merely compares related samples within a

set, and does not teach or suggest predicting the outdoor durability of a first coating relative to the known outdoor durability of at least one other set of coatings.

On page 6 of the brief, appellants argue that their method is a method of **predicting** outdoor durability [emphasis added]. Appellants argue that Okazaki in view of Dudler does not teach or suggest measuring the chemiluminescence of a coating in order to predict the outdoor durability of a first coating relative to the known outdoor durability of at least one other of a set of teachings.

First, with regard to the claimed phrase of "**predicting** the outdoor durability" [emphasis added], we refer to the examiner's comments made on pages 6-7 of the answer, which we incorporate as our own. Here, the examiner correctly points out that the specification shows that appellants are only comparing the results of chemiluminescence testing, and making a conclusion based on the results from such testing, regarding which coating will last longer. In this context, the examiner interprets the claimed phrase for "predicting the outdoor durability", as such. We agree. We note that it is a long-standing legal principal that, during examination proceedings, claims are to be given their broadest reasonable interpretation consistent with the specification. In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Hence we are not convinced by appellants' apparent emphasis on the word "predicting" in the claimed phrase "predicting the outdoor durability" as having a different meaning other than conducting tests on different coatings and comparing the results, and based upon such results, making a conclusion on which coating is more durable than the other.

With regard to appellants' argument that the applied art does not suggest predicting the outdoor durability of a first coating relative to at least one other set of coatings, we find that claim 1 recites "a method for predicting the outdoor durability of a first coating relative to the outdoor durability of at least one other of a set of coatings." Brief, pages 5-6. Again, all that is required is a method of conducting tests on different coatings and comparing the results of such tests with each other. As pointed on pages 5-6 of the answer, the examiner clearly explains how Okazaki teaches the concept of conducting tests on different coatings and comparing the results of such tests with each other. Hence, this aspect of the claimed invention is suggested by Okazaki.

Finally, appellants argue that Dudler "merely discloses that the use of chemiluminescence can be executed on samples exposed for varying times in different artificial weather instruments," and that Dudler does not teach that chemiluminescence scanning can be used to predict the outdoor durability of a coating. Brief, page 6. Appellants state that, to the contrary, Dudler states that extrapolation is not yet achievable, and refers to the Abstract of Dudler.

On pages 8-9 of the answer, the examiner rebuts and states that extrapolation is not what is being claimed. We agree for the reasons discussed above regarding the word "predicting". We reiterate that what is claimed is a method that involves conducting chemiluminescence tests on different coatings and making a comparison of the results in order to determine outdoor durability of such coatings as compared with each other.

As pointed by the examiner on page 9, Dudler teaches aging organic coatings, analyzing aged coatings using chemiluminescence testing, and comparing the results to

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previously aged coatings to conclude how the coatings compare with each other. We are, therefore, not convinced by appellants' arguments regarding extrapolation.

In view of the above, we determine that the combination of Okazaki in view of Dudler sets forth a prima facie case as discussed by the examiner in the answer. We, therefore, affirm the rejection.

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

**AFFIRMED**

BRADLEY R. GARRIS	)
Administrative Patent Judge	)
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	) BOARD OF PATENT
	) APPEALS AND
JEFFREY T. SMITH	) INTERFERENCES
Administrative Patent Judge	)
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BEVERLY A. PAWLIKOWSKI	)
Administrative Patent Judge	)

BAP/sld

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