

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JAMES J. FINLEY, MEHRAN ARBAB and THOMAS J. WAYNAR

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Appeal No. 95-2799  
Application No. 07/799,806<sup>1</sup>

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HEARD: February 10, 1999

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Before SOFOCLEOUS, KIMLIN and GARRIS, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-10. Claim 11-20, the other claims remaining in the present application, stand withdrawn from consideration pursuant to a restriction requirement. Claim 1 is illustrative:

1. A temperable, metallic coated article comprising:

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<sup>1</sup> Application for patent filed November 29, 1991

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- a. a transparent glass substrate;
- b. on a surface of said glass substrate a stabilizing layer selected from the group consisting of silicon, titanium, zirconium, tantalum, chromium, niobium, silicon alloys, nickel-chromium alloys and aluminum nitride;
- c. a metal compound film with metallic properties selected from the group consisting of metal borides, metal nitrides, metal carbides and metal oxynitrides; and
- d. a protective layer which prevents oxidation of the metal compound film upon heating selected from the group consisting of the nitrides and oxynitrides of silicon and silicon alloys.

The examiner relies upon the following references:

Goodman et al. (Goodman)	4,847,157	Jul. 11, 1989
Belkind et al. (GB '428) (Great Britain patent application)	2 201 428	Sep. 1, 1988
Suzuki et al. (JP '248) (Japanese patent publication)	63-242948	Oct. 7, 1988

Appellants' claimed invention is directed to a metallic coated article comprising a transparent glass substrate, a stabilizing layer on the glass substrate consisting of, e.g., silicon, a film on the stabilizing layer of a metal compound, e.g., titanium nitride, and a protective layer for the metal compound film consisting of nitrides and oxynitrides of silicon and silicon alloys. According to appellants, the

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metal compound film retains its metallic properties upon heating due to the presence of the protective layer.

Notwithstanding the grouping of claims set forth at page 3 of appellants' principal Brief, appellants present separate arguments only for claims 8-10, as a group. Accordingly, appealed claims 1-7 stand or fall together with claim 1. In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987); Ex parte Schier, 21 USPQ2d 1016, 1018-19 (Bd. Pat. App. & Int. 1991). See also 37 CFR § 1.192(c)(5) and (c)(6) (1993).

Appealed claims 1-7 stand finally rejected under 35 U.S.C. § 103 as being unpatentable over JP '948 in view of GB '428. Claims 1-10 stand finally rejected under 35 U.S.C. § 103 as being unpatentable over JP '948 and GB '428 or Goodman.<sup>2</sup> Appealed claims 1-9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Goodman.

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<sup>2</sup> The statement of this rejection in the Examiner's Answer does not include the JP '948 reference. However, inasmuch as the final rejection of claims 1-10 includes JP '948, and appellants' Brief acknowledges the final rejection of claims 1-10 as an issue on appeal, we will consider the omission of JP '948 in the Answer's statement of the rejection an oversight and harmless error.

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Upon careful consideration of the opposing arguments presented on appeal, we will sustain the examiner's § 103 rejection of the appealed claims over the collective teachings of JP '948 and GB '428.<sup>3</sup> We will not, however, sustain the examiner's rejection of claims 1-9 under § 102 over Goodman.

We consider first the § 103 rejection of the appealed claims over the combined teachings of JP '948 and GB '428. Appellants do not dispute the examiner's factual determination that JP '948 discloses a metallic coated article comprising the presently claimed transparent glass substrate, a stabilizing layer selected from the group consisting of silicon, titanium, zirconium, tantalum, chromium, niobium, and silicon alloys, a metal compound film comprising metal nitrides, and a protective layer for the metal compound film. It is appellants' contention that JP '948 "does not teach the nitride or oxynitride protective layer of the invention" (page 2 of principal brief). However, while JP '948 discloses aluminum and silicon oxides as the protective layer, the examiner correctly points out that GB '428 teaches the

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<sup>3</sup> The examiner's rejection of claims 1-10 over the combination of JP '948, GB '428 and Goodman subsumes the rejection of claims 1-7 over JP '948 and GB '428.

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equivalence of oxides and nitrides of aluminum and silicon as protective layers for metal and dielectric coatings of articles having glass substrates (see GB '428 at page 2, second paragraph and page 4, last paragraph). Accordingly, based on the disclosure of GB '428, we concur with the examiner that it would have been prima facie obvious for one of ordinary skill in the art to substitute appellants' nitride protective layer for the oxide protective layer of JP '948.

Appellants make the argument that JP '948 "does not show bending or tempering the coated glass, whereas the present invention relates to a coating which has metallic properties that are retained throughout a high temperature processing step such as tempering or bending the coated glass" (page 3 of principal Brief). However, as noted by the examiner, insofar as the claim language "temperable" is simply a statement of intended use that imparts no structure to the claimed metallic coated article, this argument is not germane to the claimed subject matter. It is well settled that a finding of obviousness does not require that the prior art disclose the same motivation as an applicant.

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In re Dillon, 919 F.2d 688, 693, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). In the present case, we find that one of ordinary skill in the art would have been motivated to utilize the silicon nitride protective layer of GB '428 as the protective coating in the glass article of JP '948. Although appellants contend at page 4 of the principal brief that "there is no incentive in either the Japanese or the British reference to replace the oxide top layer of the Japanese metal/metal nitride coating with any protective layer of the British patent," appellants do not provide any factual basis for such a statement.

Appellants also maintain at page 4 of the principal brief that "the overcoat of the British reference is an aluminum alloy, not a silicon alloy." However, since the appealed claims fail to define any specific amount of silicon in the claimed silicon alloys, we do not perceive any meaningful distinction between the claimed silicon alloys and the alloys of GB '428 which contain silicon.

Regarding separately argued claims 8-10, which require an additional layer between the metal compound layer and the protective layer, appellants' counsel at oral hearing

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acknowledged that the additional layer may comprise the same composition as the protective layer (see claim 9). In our view, it would have been prima facie obvious for one of ordinary skill in the art to apply an additional protective layer to the article of JP '948 for the purpose of providing additional protection against corrosion and abrasion.

We note that appellants base no argument upon objective evidence of nonobviousness, such as unexpected results, with respect to the § 103 rejection.

We will not sustain the examiner's rejection of claims 1-9 under § 102 over Goodman. Simply put, we find no description in Goodman of the claimed protective layer comprising nitrides and oxynitrides of silicon and silicon alloys, and the examiner has pointed to no disclosure of such in the reference. The discussion of a transition layer in the paragraph bridging columns 6 and 7 of Goodman does not provide a description of the claimed protective layer.

As a final point, appellants' counsel at oral hearing withdrew the appeal of claim 4 as being redundant regarding the composition of the protective layer.

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In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims 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

MICHAEL SOFOCLEOUS	)	
Administrative Patent Judge	)	
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	)	
EDWARD C. KIMLIN	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
BRADLEY R. GARRIS	)	
Administrative Patent Judge	)	

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