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(2) is not binding precedent of the Board.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

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARVIS E. HARTMAN, MASSIMO P. REI,
MICHELA CASTAGNONE and STEVEN A. HAMAY

Appeal No. 95-4118
Application 07/600,799[1]

ON BRIEF

Before WARREN, OWENS and WALTZ, *Administrative Patent Judges.*

WARREN, *Administrative Patent Judge.*

Decision on Appeal and Opinion

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 1 through 14, 17, 46 and 47. Appellants amended claims 1 through 11, 13, 14 and 47 and canceled claims 12 and 46 subsequent to the examiner's answer,[2] which amendment was entered by the examiner.[3] Therefore, claims 1 through 11, 13, 14, 17 and 47 remain for consideration on appeal.

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[1] Application for patent filed October 22, 1990.
[2] Amendment of May 13, 1993 (Paper No. 17). .
[3] Supplemental answer of September 30, 1994 (Paper No. 18) (first supplemental answer).

We have carefully considered the record before us, and based thereon, find that we cannot sustain the grounds of rejection under 35 U.S.C. § 103 over Tennent alone or combined with Hess.[4,5] Our review of these grounds of rejection begins with consideration of the problem, acknowledged by appellants, of electrostatically overcoating with a finishing coat the electrical conductive primers on auto parts made from sheet molding compound (SMC), wherein the conductivity is provided by "relatively large amounts of conductive carbon black" in the primer with the "resultant disadvantage in that [the primers] tend to be black or very dark gray in color" (specification, page 1). *See generally In re Hedges*, 783 F.2d 1038, 1039-40, 228 USPQ 685, 686 (Fed. Cir. 1986); *In re Nomiya*, 509 F.2d 566, 570-71, 184 USPQ 607, 611 (CCPA 1975). Appellants' solution to the problem is the primer coating composition encompassed by claim 1, as amended, wherein a resinous film forming binder is combined with a light colored pigment and a fibrous, carbonaceous material which has the specified dimensions, wherein the coating composition when cured on the substrate is electrically conductive and has a Munsell value of more the 3.5.

Appellants further acknowledge in their specification that the fibrous, carbonaceous material is found, *inter alia*, in Tennent (specification, page 5). In the ground of rejection based on Tennent alone, the examiner has compared the claimed composition encompassed by claim 1 with Tennent and finds that *all* of the differences between the claimed compositions and the teachings of this reference are so notoriously well known in the art to one of ordinary skill in this art that no other reference is necessary to support his holding that the appealed claims would have been *prima facie* obvious to this person based on Tennent alone (answer, pages 3-5 and

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[4] Tennent and Hess are listed at page 2 of the answer. We refer in our opinion to the translation of Hess provided by appellants in their information disclosure statement of March 10, 1993 (Paper No. 13).

[5] The examiner entered the ground of rejection based on Tennent in view of Hess as a new ground of rejection in the answer (page 5). The examiner also entered new grounds of rejection of claim 12 under 35 U.S.C. § 112, fourth paragraph, and of claims 12 and 13 under § 112, fourth paragraph, in the answer (page 5). Upon cancellation of claim 12 by appellants (*see supra* note 2), the examiner, in the first supplemental answer, indicated that the ground based on § 112, fourth paragraph, was moot and withdrew the ground based on § 112, second paragraph, with respect to claim 13.

7-9). Appellants, in the principal brief, point out that Tennent does not disclose combining fibrous, carbonaceous materials with light colored pigments to form coatings and that Tennent uses said fibrous materials as reinforcement in composites used as structural members, citing three passages in the reference, in contending that motivation has not been established on the record to combine the fibrous, carbonaceous materials of the reference with the other ingredients as theorized by the examiner, which is tantamount to hindsight (pages 3-6).

The examiner stated in the answer that appellants had not challenged his findings with respect to that which is notoriously known in the art (page 10). However, in response to appellants' argument in the reply brief that there is "no reference in the case that suggests that carbon fibers have greater conductivity than carbon blacks, nor that carbon fibers provide higher conductivity with lesser amounts than carbon blacks" (page 5), the examiner reversed his position in the first supplemental answer (page 4) and relied on Hess for support for his contentions of notorious knowledge in the art. We find that the examiner has relied on Hess in this instance in the same manner as in the ground of rejection in which this reference is combined with Tennent. In further support of his position, the examiner cited Friend for the teaching that "less carbon fibers can be used to achieve the same level of conductivity as metal powders, and that lighter colored inks can be made while maintaining the electrical conductivity by using carbon fibers in place of graphite (metal) powder;" and Knobel et al. as showing the "notoriety of the idea that graphite fibers can be added to significantly lower volume concentrations and still give bulk conductive properties to thermoplastics and that use of carbon fibers allows for translucency of conductive coatings versus the black opaque coating provided by use of carbon black as a conductive filler" (first supplemental answer, pages 4-5).[6]

It is inescapable that the examiner relies on each of Hess, Friend and Knobel et al. to provide the evidentiary underpinnings for the thrust of his rejection based on Tennent alone, because his discussion of each of these references far exceeds the challenge with respect to conductivity stated by

[6] Friend was made of record by appellants in their information disclosure statement filed June 25, 1992 (Paper No. 6) and Knobel et al. was made of record in the final rejection of August 13, 1992 (Paper No. 7).

appellants in their reply brief, and restated in their second supplemental reply brief, filed May 12, 1995 (Paper No. 21), and reaches the issues of the use of fibrous, carbonaceous material *and* the matter of color or translucency. Indeed, as we noted above, Hess is relied on by the examiner in this instance in the same manner as in the second ground of rejection which we consider below. It is further inescapable from a complete review of Friend that this reference contains disclosure that is clearly and specifically applicable to appealed claim 1, as we discuss below in remanding this application to the examiner, which disclosure the examiner could not have avoided reviewing in reaching the disclosure concerning inks. Such use of references not included in the statement of the rejection is clearly impermissible. *See In re Hoch*, 428 F.2d 1341, 1342 n. 3, 166 USPQ 406, 407 n.3 (CCPA 1970); *compare Ex parte Raske*, 28 USPQ2d 1304, 1304-05 (Bd. Pat. App. & Int. 1993).

Therefore, we have considered the issue of the obviousness of the claimed composition encompassed by the appealed claims with respect to the applicability of Tennent alone, based solely on the evidence in that reference and the examiner's apparently unsupported allegations of matters "notoriously well known in the art." Even if the examiner's allegations are supported, we find no reason on this record why one of ordinary skill in this art would have been motivated to combine such knowledge with the teachings of Tennent to arrive at appellants' coating composition, in the absence of appellants' disclosure. *See generally, In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991), citing *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) ("Both the suggestion and the reasonable expectation of success must be found in the prior art and not in applicant's disclosure."); *In re Horn*, 203 USPQ 969, 971 (CCPA 1979) ("[S]implicity and hindsight are not proper criteria for resolving the issue of obviousness."); *Ex parte Levengood*, 28 USPQ2d 1300, 1301-02 (Bd. Pat. App. & Int. 1993) ("At best, the examiner's comments regarding obviousness amount to an assertion that one of ordinary skill in the relevant art would have been able to arrive at appellant's invention because he had the necessary skills to carry out the requisite process steps. This is an inappropriate standard for obviousness. . . . That which is within the capabilities of one skilled in the art is not synonymous with obviousness. *Ex parte Gerlach*, 212 USPQ 471 (Bd. App. 1980).").

Thus, we reverse the ground of rejection based on Tennent alone.

Turning now to the ground of rejection based on the combined teachings of Tennent and Hess (answer, sentence bridging pages 5-6), we agree with the examiner that Hess would have taught one of ordinary skill in the art that conductive floor coating compositions that contain a binder and carbon fibers "can be given any color" (Hess, page 3) and thus overcomes the same problem faced by appellants, that is, the "dark gray or black color" imparted to conductive floor coatings wherein the binder contains "graphite powder" (answer, pages 6 and 9; first supplemental answer, page 4; third supplemental answer of October 13, 1995 (Paper No. 22), pages 1-2). However, appellants point out that the carbon fibers of Hess "are grossly dissimilar to the carbon fibers required by the present claims," which include amended claim 1 as it stands before us (reply brief, page 3). The examiner responds that he "has not suggested that the fibers of [Hess] be substituted for the fibers of Tennent, only that lighter colored coating could be made using carbon fibers as a conductive filler as opposed to graphite" (first supplemental answer, page 2). We, like appellants, find no reason why one of ordinary skill in this art would have modified the composites of Tennent, in which the carbon fibers are used for structural reinforcement and, we observe, for conductivity (col. 8, lines 1-2), to contain color in the manner suggested by Hess for floor coating compositions, or alternatively, why one of ordinary skill in this art would have substituted the carbon fibers of Tennent, encompassed by amended claim 1, for the carbon fibers of different dimensions used by Hess in the floor coating compositions. Indeed, it is again inescapable that the only direction to appellants' claimed coating compositions on this record is provided by appellants' own application. *See generally, Vaeck, supra*; *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989).

Thus, we reverse the ground of rejection based on the combined teachings of Tennent and Hess.

The examiner's decision is reversed.

Remand To The Examiner

This application is remanded to the examiner to consider whether claims 1 through 11, 13, 14, 17 and 47 are unpatentable under § 103 over the combined teachings of Friend and Tennent. Friend

clearly discloses coating compositions containing between 1 and 4% by weight of the carbon fibers disclosed by Tennent along with one or more pigments, and indeed, when used as a primer for electrostatic overcoating on auto parts made from sheet molding compound (SMC), the coating "can be overpigmented so that the finished composite does not appear black" (Friend, col. 1, lines 15 and 35-44, col. 2, lines 17-62, and col. 3, line 17, to col. 4, line 2).

We observe that appellants withdrew the declaration and supplemental declaration of record under 37 CFR § 1.131 submitted to antedate Friend, the latter filed on October 25, 1994 (no separate paper number), in the second supplemental reply brief subsequent to the examiner's analysis of the combined submissions in the second supplemental answer of January 4, 1995 (Paper No. 20). In the event that appellants again rely on these declarations, the examiner should consider whether Friend is claiming the "same patentable invention, as defined in § 1.601(n)," as encompassed by any or all of appealed claims 1 through 11, 13, 14, 17 and 47, in determining whether the declarations can be considered under § 1.131.

Accordingly, we remand the case to the examiner for consideration of this matter consistent with current examining practice and procedure and to further augment the record as required.

We hereby remand this application to the examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

This application, by virtue of its "special" status, requires immediate action. *See* MPEP § 708.01(D) (7th ed., July 1998).

REVERSED and REMANDED

CHARLES F. WARREN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
TERRY J. OWENS	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES

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