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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte EKKEHARD BEER, KARL-HEINZ KOCHEM and MICHAEL SCHMIDT

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Appeal No. 96-0044
Application 08/014,136[1]

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ON BRIEF

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Before DOWNEY, GARRIS and OWENS, Administrative Patent Judges.

DOWNEY, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. §134 from the final rejection of claims 1, 3-8, 10-16, 30-31 and 33-42, all the claims pending in the application.

[1] Application for patent filed February 5, 1993.

The subject matter on appeal is directed to a coating composition comprising an intrinsically electrically conductive polymer, a binder, a solvent and an additive having low adhesion to metal. The coating composition is said to be useful in metal transferration processes to coat a transfer metallization plastic film whereby a metal layer deposited on the coated plastic film is transferred to a second carrier, thus allowing the coated plastic film to be reused.

Appellants indicate and argue that the claims do not stand or fall together. For purposes of this decision, we find it necessary to address claim 1, which is the only independent claim. Claim 1 reads as follows:

1. A coating composition for a transfer metallization plastic film comprising an intrinsically electrically conductive polymer in an amount effective to provide antistatic properties when coated onto the plastic film;

one or more additives which have a low adhesion to a metal layer in an amount effective to allow release of the metal layer from the plastic film;

one or more binders in an amount effective to improve the adhesion of the coating to the surface of the plastic film, wherein the binder is other than the conductive polymer and the additive; and

a solvent to dissolve, swell, or disperse the electrically conductive polymer, binder, and the additive.

The references relied upon by the examiner are:

Kampf 5,286,414 Feb. 15, 1994

Schildknecht, C., Polymer Processes, pp. 329 and 685-686, 1956

Textbook of Polymer Science, 3rd. edition, Billmeyer F. Jr., pp. 401 and 449, 1984

Claims 1, 3-8[2], 10-16, 30-31 and 33-42 stand rejected under 35 U.S.C.§ 103 as unpatentable over Kampf in view of either the Textbook of Polymer Science or Polymer Processes.

After careful consideration of the arguments of appellants and the examiner and of the record before us, we find that we cannot sustain the examiner's rejection. Accordingly, we reverse. Our reasons follow.

The instant claims are directed to a coating composition that comprises , at a minimum, four (4) ingredients, to wit, (1) an intrinsically electrically conductive polymer in an amount effective to provide antistatic properties when coated onto the plastic film (5-90% by weight to dry weight of coating composition), (2) a binder other than a conductive polymer and additive in an amount effective to improve the adhesion of the coating to the plastic film (1-90% by weight to dry weight of coating composition), (3) a solvent, and (4) an additive having low adhesion to a metal layer in an amount effective

[2] Claims 3 and 4 refer to concentrations as based on the dry weight of the coating "agent". The term agent does not have any antecedent support. It would appear that appellants are referring to the coating or coating composition. These claims should be corrected.

to allow release of the metal layer from the plastic film (1-85% by weight to dry weight of coating composition). The additive as defined by appellants in their specification includes so-called release resins composed of fluorine-containing and/or fluorine-modified polymers, silicone resins, silicone oils, polysiloxane and also conventional release agents and lubricants, such as, for example, fatty acids and their metal salts, alkylamines, fatty acid esters, fatty acid amides and sulfonates.

Kampf describes a coating composition comprising 10-100% by weight of an intrinsically electrically conductive polymer, 0-90% by weight of a binder, a solvent and an lubricant additive. The secondary references, the Textbook of Polymer Science and Polymer Processes, describe known lubricants useful in plastics. It is the examiner's position that it would have been obvious to employ the lubricants of the secondary references as the lubricant in Kampf. The examiner alleges that Kampf clearly teaches percentages of lubricant additives which overlap with the instantly claimed percentages (Answer, page 7, lines 7-9). However, the examiner fails to point out, and we fail to find, where in Kampf this teaching can be found. Accordingly, we find no basis in fact for the examiner's allegation.

Even if we were to assume for purposes of argument that one of ordinary skill in the art would have found it obvious to add the known lubricants of the secondary references to the coating composition of Kampf, contrary to the examiner's allegation,

Kampf fails to disclose the amount of lubricant used. Kampf also does not explain the purpose for the lubricant. In general, the concentration and choice of lubricants are viewed as important because excessive lubricant can nullify the intended effects or properties. Here, Kampf indicates that an object of his invention is to produce electroconductive coatings which do not have certain known disadvantages, one disadvantage being that metal coatings vapor deposited on plastic films often exhibit poor coating adhesion. Hence on this record, since Kampf's coating composition aids in the adhesion of the metal layer to the plastic film base, we must presume that the amount used is different from the amount used by appellants to "allow release of the metal layer from the plastic film". Moreover, on this record, the examiner has not presented any evidence to establish that the amount of lubricant is a result effective

variable with respect to adhesion. See In re Antonie, 559 F.2d 618, 620, 195 USPQ 6, 8-9 (CCPA 1977); cf. In re Yates, 663 F.2d 1054, 1056, 211 USPQ 1149, 1151 (CCPA 1981). The determination of a specific parameter can be an obvious expedient only when the art appreciates that said parameter is a result effective variable.

On this record, the examiner's rejection is reversed.

REVERSED

MARY F. DOWNEY Administrative Patent Judge	)
BRADLEY R. GARRIS Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
TERRY J. OWENS Administrative Patent Judge	)

MFD/PGG

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