

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROGER O. EDWARDS, GREGORY I. FOSTER,
KEVIN H. GREEN, and GARRY M. MCKAY

Appeal No. 1996-0575
Application No. 08/219,551¹

HEARD: August 5, 1999

Before CAROFF, GARRIS and ROBINSON, Administrative Patent Judges.
ROBINSON, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 5-7, 9-11, 13-15, 17-48, and 50-69, which are all of the claims pending in the application.

¹ Application for patent filed March 29, 1994. According to appellants, this application is a continuation of Application 07/967,877, filed October 29, 1992, now abandoned.

Claims 22 and 23 are illustrative of the subject matter on appeal and are reproduced below:

22. A thermosettable paint composition suitable for application from a solid block thereof as a hot melt to a substrate heated to a temperature which is hot enough to melt a surface portion of said solid block upon contact therewith, said composition comprising:

a pigment; and

A thermosettable mixture of resins, having an averaged glass transition temperature (T_g) of greater than -30°EC and less than $+60^{\circ}\text{EC}$ and having a melt viscosity of from about 0.1 to 12 poise when measured at 180°EC and at a shear rate of 10,000 Hz;

wherein said mixture of resins comprises:

a first resin having a glass transition temperature T_g of greater than $+20^{\circ}\text{EC}$, and

a second resin having a glass transition temperature T_g of below $+20^{\circ}\text{EC}$ and a melt viscosity of 0.1 to 7 poise when measured at 180°EC and at a shear rate of 10,000 Hz,

wherein said pigment is dispersed in said first resin and this dispersion is admixed with at least said second resin to make said solventless paint composition.

23. A method of manufacture of a thermosettable solventless paint composition, having the ability to be applied as a hot melt from a solid block comprising said composition onto a substrate in contact with said block which substrate has been heated to a temperature hot enough to melt a surface portion of said solid block within the time that said substrate is in contact with said block, comprising the steps of:

(i) selecting a first resin having a glass transition temperature (T_g) greater than $+20^{\circ}\text{EC}$,

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(ii) selecting a second resin having a glass transition temperature (T_g) less than +20EC and a melt viscosity of 0.1 to 7 poise when measured at 180EC and at a shear rate of 10,000 Hz, wherein at least one of said first and second resins is thermosettable,

(iii) dispersing a pigment in the first resin to form a pigmented first resin, and

(iv) combining the pigmented first resin and the second resin in proportions such that the glass transition temperature (T_g) of the combined mixture of resins is greater than -30EC and less than ± 60 EC, and such that the combined mixture of resins has a melt viscosity of about 0.1 to 12 poise when measured at 180EC and at a shear rate of 10,000 Hz to thereby form said solventless paint composition.

The references relied upon by the examiner are:

Grenfell	3,917,123	Nov. 4, 1975
Wallace	4,028,458	June 7, 1977
Pettit, Jr. (Pettit)	4,988,767	Jan. 29, 1991

Ground of Rejection

Claims 5-7, 9-11, 13-15, 17-48, and 50-69 stand rejected under 35 U.S.C. § 103.

As evidence of obviousness, the examiner relies upon Pettit, Grenfell and Wallace.

We reverse.

BACKGROUND

The applicants' invention, as described at page 3 of the specification, is directed to a solventless coating composition which can be applied as a hot melt and which avoids or at least ameliorates the disadvantages of coatings of the prior art.

DISCUSSION

The rejection under 35 U.S.C. § 103

Claims 13-15, 17-21,23, 30-40, 48, 50-58, 62-63, 65-66, and 68-69:

These claims are directed to a method of manufacturing a thermosettable solventless paint composition. All of the claims require that a pigment is first dispersed in a first defined resin and the resulting pigment-first resin mixture is then combined with a second defined resin to form the paint composition.

Obviousness is a legal conclusion based on the underlying facts. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966); Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1270, 20 USPQ2d 1746, 1750 (Fed. Cir. 1991); Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1566-68, 1 USPQ2d 1593, 1595-97 (Fed. Cir. 1987). Here, the examiner has failed to make the finding of facts which would reasonably support a determination that the claims subject matter would have been prima facie obvious to those of ordinary skill in this art at the time of the invention. The examiner does not separately address any one of the method claims, but states at page 4 of the Examiner's Answer (Answer) "Such a composition can be prepared by melt blending the ingredients." At page 6 of the Answer, the examiner states "Pettit teaches the composition with its ingredients including pigment/s (sic) as well as the method of preparation of the composition." As noted by the appellants (Reply Brief, page 9):

Pettit, Jr. discloses a one step method of putting all of the resins and pigments and other ingredients together and thoroughly blending them (column 7, lines 15-20). The instant claimed method is a two step method

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requiring putting one specifically defined resin and the pigment together, and then putting this first mixture together with the second specifically defined resin.

The examiner offers no evidence or facts which would have suggested to one of ordinary skill in this art at the time of the invention, that the method of preparation disclosed by Pettit should be modified in a manner which would reasonably lead to the claimed method of manufacture.

The examiner bears the initial burden of presenting a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). On the record before us, we conclude that the examiner has failed to establish a prima facie case of unpatentability with regard to the claimed method. Where the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Therefore, the rejection of claims 13-15, 17-21, 23, 30-40, 48, 50-58, 62-63, 65-66, and 68-69 under 35 U.S.C. § 103 is reversed.

Claims 5-7, 9-11, 22, 24-29, 41-47, 59-61, 64, and 67:

These claims are directed to thermosetting paint compositions comprising a mixture of resins having specifically defined glass transition temperatures (T_g) wherein the

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resulting composition has an average Tg of greater than -30° C and less than +60° C and an average melt viscosity of from about 0.1 to 12 poise (claims 22 and 41) or .05 to 25 poise (claim 24) when measured at 180° C and at a shear rate of 10,000 Hz.

In rejecting these claims the examiner relies on Pettit as disclosing a thermosetting powder coating composition comprising a combination of two resins which would reasonably appear to fall within the scope of the claim designated resins. Appellants urge that "the instant claimed compositions also **absolutely essentially and critically require** that the instant claimed resin composition have a melt viscosity, at 180o C, of 0.1 to 12 (or in some claims up to 25) poise. Nowhere does the Pettit patent disclose any composition which has this melt viscosity of up to 12 poise," (Principal Brief, page 38). Appellants addition urge that "the powder coating compositions of the Pettit patent are simply unsuited to be applied to this substrate as a melt. (Principal Brief, page 61). Appellants acknowledge (Reply Brief, page 13) that Pettit discloses a composition having a melt viscosity of 14.4 poise at 180° C (Example E at column 10), but urges that this is not a blend of two resins comprising a pigment as presently claimed. The examiner does not dispute this position. The examiner acknowledges that Pettit's range for melt viscosity is different from that of the claimed composition (Answer, page 6). However, the examiner urges that (Answer, paragraph bridging pages 6-7):

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[i]t is also true that it is within the scope of one's expertise to alter this range as per one's specific requirements. Examiner is of the opinion that the melt viscosity of the composition can be varied. ...the melt viscosity may be varied by changing the proportions of the two resins that make up the composition.

While it may be true that the average melt viscosity at 180°C at a shear rate of 10,000 Hz could be altered or modified in the manner suggested by the examiner, the examiner has provided no evidence or facts which would have reasonably suggested or motivated one of ordinary skill in this art to so modify the specific compositions disclosed by Pettit. To support such a modification of the prior art, there must be some reason, suggestion, or motivation found in the prior art, explicitly or implicitly, whereby a person of ordinary skill in the field of the invention would make the modification required. That knowledge can not come from the applicants' invention itself. Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678-79, 7 USPQ2d 1315, 1318 (Fed. Cir. 1988); In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). We find no reasonable suggestion, motivation, or direction in the prior art relied upon by the examiner, which would have lead one of ordinary skill in this art to modify the resin paint compositions of Pettit to arrive at a paint composition having the specified average Tg and viscosity required by the claims.

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Grenfell and Wallace, relied on to demonstrate the use of resin adhesive in the form of blocks, sticks, or other shapes, do not provide that which is missing in the disclosure of Pettit.

On the record before us, we find that the examiner has failed to provide the factual basis on which a prima facie case of unpatentability could reasonably be based. Where the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, supra. Therefore, the rejection of claims 5-7, 9-11, 22, 24-29, 41-47, 59-61, 64, and 67 under 35 U.S.C. § 103 is reversed.

SUMMARY

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To summarize, the decision of the examiner to reject claims 5-7, 9-11, 13-15, 17-48, and 50-69 under 35 U.S.C. § 103 is reversed.

REVERSED

MARC L. CAROFF)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
BRADLEY R. GARRIS)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
DOUGLAS W. ROBINSON)	
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