

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD P. HART, JR.
and ROBERT C. STROUP

Appeal No. 1996-0837
Application 08/043,062

ON BRIEF

Before CAROFF, ELLIS and OWENS, **Administrative Patent Judges**.

ELLIS, **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, 57 and 88, all the claims remaining in the application.

Claim 1 is illustrative of the subject matter on appeal and reads as follows:

1. A printing coating composition for forming a decorative coating on a substrate comprising:

(A) (i) at least one homopolymer of ethylene having a melt index of at least about 220 grams per ten minutes as determined by ASTM D1238, condition 190/2.16, or (ii) at

least one copolymer of ethylene and a second ethylenically unsaturated monomer having a melt index of at least about 20 grams per ten minutes as determined by ASTM D1238, condition 190/2.16, or (iii) at least one thermoplastic acrylic homopolymer or copolymer having a glass transition temperature (T_g) of greater than 0EC but less than 110EC, or (iv) a mixture of (i), (ii), and (ii) [sic, iii];

(B) at least one thermoplastic polymeric material different than (A) having a melting point in the range of about 0EC to about 130EC and being dispersible with (A) wherein the polymer composition of (A) and (B) is normally solid at room temperature but is a viscous liquid at about 200EF to about 300EF having a viscosity in the range of about 5,000 cps to about 100,000 cps; and

(C) an adhesion promoter, said adhesion promoter comprising an epoxy resin.

The references relied upon by the examiner are:

Cleveland et al. (Cleveland)	4,454,379	June 12, 1984
Couturier et al. (Couturier)	4,870,128	Sep. 26, 1989

Claims 1, 57 and 88 stand rejected under 35 U.S.C. § 103 as being unpatentable over Couturier in view of Cleveland.

We **reverse**.

As indicated by claim 1 above, the appellants' invention is directed to thermoplastic compositions of a "specific formulation of very specific components having specific physical properties." Specification, p. 8. The claimed compositions are said to be useful for providing a decorative coating on substrates such as "glass, ceramic, metal, fiberboard, textile or plastic (e.g., glass [sic] jars or bottles) preferably using hot melt screen printing." *Id.*, p. 6.

The examiner has based his conclusion of obviousness on the teachings of Couturier and Cleveland. Couturier discloses hot melt gasket compositions comprising “a copolymer of ethylene and an olefinic carboxylic acid . . . a modifier resin, filler and antioxidant.” Couturier, col. 1, lines 45-52. Couturier further discloses that the hot melt gasket composition has superior cracking and cut through resistance and is useful for closures such as warehoused products and pasteurized food stuffs which are subjected to elevated temperatures and/or excessive headload pressures. *Id.*, col. 4, lines 56-66. Cleveland discloses improved polyolefin-based shielding tapes (in the form of a plastic laminated metallic foil) for use in insulating underground electric cables. Cleveland, col. 2, lines 17-24 and 26-30. The shielding tape provides an electrostatic shield and moisture barrier to the cables. *Id.* According to the examiner, “it would have been obvious to one of ordinary skill in the art motivated to improve the adhesion of the composition taught by Couturier et al. to add an epoxy resin as an adhesion promoter, because Cleveland et al. teaches [sic, teach] epoxy resins improve the adhesion of the active adhesive ingredient, the copolymer, in this composition.” Answer, p. 3. We find that the examiner’s position lacks merit.

It is well established that the examiner has the initial burden under § 103 to establish a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1471-72,

223 USPQ 785, 787-88 (Fed. Cir. 1984). To that end, the examiner must show that some objective teaching or suggestion in the applied prior art, or knowledge generally available in the art would have led one of ordinary skill in the art to combine the references to arrive **at the claimed invention**. *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996).

Here, we do not find that the examiner has begun to provide reasons, based on the applied prior art or otherwise, as to why it would have been obvious to one of ordinary skill in the art to arrive at the claimed compositions. In fact, in his rejection, the examiner has **not mentioned** any of the compounds required by sections (A) and (B) of independent claims 1 and 88. Moreover, in reading the references, we do not find that they even allude to compounds having the limitations described in the claims. Thus, we cannot find any rational basis for the examiner's conclusion that the claimed invention would have been obvious to one of ordinary skill in the art in view of Cleveland and Courturier.

Even if we assume, **arguendo**, that the poly(alpha-methyl styrene) referred to in the rejection is a compound within the scope of section (B) of the claims, the examiner has not provided any explanation as to how this compound satisfies the claim limitations of having a melting point in the range of about 0EC to about 130EC and being dispersible with a compound described in section (A) of the claims. Nor has the examiner explained how the polymer composition of (A) and the poly(alpha-methyl styrene) is normally soluble at room

temperature, but a viscous liquid at about 200EF to about 300EF and has a viscosity in the range of about 5,000 cps to about 100,000 cps. Thus, we find that the examiner's rejection constitutes nothing more than an assertion that it would have been obvious to one of ordinary skill in the art to add an epoxy resin to the hot melt gasket composition described by Couturier.

Moreover, as developed in the appellants' Brief, the references relied upon by the examiner do not fall within the scope of relevant prior art. A reference is considered relevant art if it "is within the inventor's field of endeavor, and if it is not ... [it must be] reasonably pertinent to the particular problem confronting the inventor." *In re GPAC, Inc.*, 57 F.3d 1573, 1578, 35 USPQ2d 1116, 1120 (Fed. Cir. 1995). The Couturier and Cleveland patents do not meet either criterion. The appellants' field is directed to coating compositions for containers made of substrates such as glass, polyethylene, polypropylene, or polyvinyl chloride. Specification, p. 22. Neither Couturier, which is directed to hot melt gaskets, nor Cleveland, which is directed to electrical cable insulation, is within the appellants' field of endeavor. In fact, Couturier and Cleveland are not themselves within the same field of endeavor. Thus, we find that the examiner is attempting to combine references from two totally different fields to establish the obviousness of an invention in a third field. Under certain circumstances; i.e., when the applied prior art addresses the same problem as that which was confronted by the

inventor, such a combination may be appropriate. However, this is not the case here. To the contrary, neither patent relates to the same problem addressed by the present invention; i.e., the difficulty of applying an ink to the surface of the aforementioned substrates. Therefore, we do not find that either patent would have logically commended itself to the appellants' attention in addressing their particular problem.

Accordingly, in view of the foregoing, the rejection is summarily reversed.

REVERSED

Marc L. Caroff)
Administrative Patent Judge)
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Joan Ellis) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
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Terry J. Owens)
Administrative Patent Judge)

Appeal No. 1996-0837
Application 08/603,014

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