

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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 TOAN HARIMOTO, TOSHIRO
NANBU, JO KAWAMURA and
HISAO FURUKAWA

Appeal No. 94-3548
Application 07/703,718¹

HEARD: June 6, 1996

Before JOHN D. SMITH, TURNER and WEIFFENBACH, Administrative
Patent Judges.

TURNER, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the Examiner's decision rejecting claims 1, 4-9 and 11 which are all of the claims remaining in the application. Illustrative claim 1 is reproduced below.

¹ Application for patent filed May 22, 1991. According to applicant, the application is a continuation of Application 07/277,110, filed November 29, 1988 (ABN).

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PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
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1. A thermosetting composition comprising:
 - (A) a hydroxyl group-containing acrylic resin having a hydroxyl value of 20 to 150 mg KOH/g,
 - (B) an alkoxy silane group-containing acrylic copolymerand
 - (C) a compound accelerating or promoting the reaction of said component (A) and said component (B).

The reference of record relied upon by the Examiner is:

Kodera et al. (Kodera) 57-12058 Jan. 21, 1982

The appealed claims stand rejected under 35 U.S.C. § 103 as unpatentable over Kodera (referred to in the Answer as Japan '058 and in the Brief as JP 57-12058).

The subject matter on appeal is directed to a thermosetting composition comprising 1) a hydroxyl-containing acrylic resin with a hydroxyl value of 20 to 150 mg KOH/g, 2) an alkoxy silane group-containing acrylic copolymer, and 3) a curing catalyst. A more detailed description can be gleaned from a reading of claim 1.

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According to Appellants, the claims stand or fall together.

OPINION

We have carefully reviewed the record before us, including each of the arguments and comments advanced by Appellants and the Examiner in support of their respective positions. This review leads us to conclude that the Examiner's position is not well founded. Accordingly, we will not sustain the rejection. Our reasons follow.

We concur with the position and comments offered by Appellants in the Brief and offer the following further analysis. Claim 1 requires

1) a hydroxyl group-containing acrylic resin having a hydroxyl value of 20 to 150 mg KOH/g;

2) an alkoxysilane group-containing acrylic copolymer;
and

3) a compound accelerating or promoting the reaction of
1) and 2) above.

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The Kodera reference discloses

- 1) an alkoxysilane group-containing acrylic copolymer;
- 2) an accelerant or curing catalyst; and
- 3) a polyhydroxy compound (vinyl monomers possessing hydroxyl groups are described) but no hydroxyl group-containing acrylic resin is taught nor is there any indication of hydroxyl value for any of the polyhydroxy compounds.

It is our conclusion that the rejection fails for lack of a sufficient factual basis upon which to reach a conclusion of obviousness. The primary reasons for this conclusion are that the Kodera reference does not disclose the claim required hydroxyl group-containing acrylic resin and does not indicate that any of the polyhydroxy compounds should have hydroxyl values in any range. The Examiner has not made clear the motivation to select the hydroxyl group-containing acrylic resin and more specifically, such a resin having a hydroxyl value between 20 and 150 mg KOH/g when the applied prior art does not teach any specific hydroxyl group-containing acrylic resins and is completely silent as to hydroxyl values for any of the disclosed polyhydroxy compounds. It is the view of this merits panel that the Examiner's conclusion to combine the components of the claims

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in the manner proposed stems from Appellants' disclosure and not from the Kodera reference.

Accordingly, for the reasons set forth above and Appellants' comments, we reverse.

REVERSED

John D. Smith
JOHN D. SMITH)
Administrative Patent Judge)

Vincent D. Turner
VINCENT D. TURNER)
Administrative Patent Judge)

Cameron Weiffenbach
CAMERON WEIFFENBACH)
Administrative Patent Judge)

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