

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARY E. ROSENBERGER and DONALD B. JONES

Appeal No. 95-1092
Application 08/044,436¹

ON BRIEF

Before GARRIS, WEIFFENBACH and ELLIS, Administrative Patent Judges.

WEIFFENBACH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-9. The remaining claim in the case, claim 10, has been withdrawn from

¹Application for patent filed April 8, 1993.

consideration pursuant to a restriction requirement under 37 CFR § 1.142(b). We affirm-in-part.²

The Claimed Subject Matter

The claims on appeal are directed to a process of applying waterborne coating compositions. The process involves continuously modifying the water content of the waterborne coating composition as it is being sprayed in response to humidity measurements. Claim 1 is illustrative of the claimed subject matter:

1. A method of applying waterborne coating compositions onto a substrate under varying humidity conditions comprising:

(a) measuring relative humidity in the spray area in which a stream of waterborne coating composition is being supplied to a spray device;

(b) based on the relative humidity measurement controlling the proportionate flow rates of the stream of waterborne coating and an aqueous additive to be mixed into the waterborne coating composition stream;

(c) mixing the additive into the waterborne coating composition stream at the proportionate flow

²We note that appellants filed a reply brief (Paper No. 12) which was denied entry by the examiner (Paper No. 13) because it was not directed to only new points of argument raised in the answer. Accordingly, we have not considered the reply brief in our deliberations.

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rates selected in step (b) to obtain an adjusted formulation of the waterborne coating composition;

(d) spraying the adjusted waterborne coating composition onto the substrate that is to be coated in the spray area.

The Rejection

The following prior art references are relied upon by the examiner to support the rejection of the claims:

Fujisawa	4,738,219	Apr. 19, 1988
Iwatsu et al. (Iwatsu)	5,127,362	Jul. 7, 1992

Claims 1-9 rejected under 35 U.S.C. § 103 as being unpatentable over Fujisawa in view of Iwatsu.

Opinion

On page 3 of the brief, we note that appellants consider claims 7-9 to be separately patentable. Appellants submit that "the features of claims 7, 8, and 9 are simply not shown in any prior art of record ..." (brief, page 7). The examiner held that the "rejection of claims 1-9 stand or fall together because appellant's [sic] brief does not include a statement that this grouping of claims does not stand or fall together" (answer, page 2). Notwithstanding this statement, however, the examiner considered the separate patentability of claims

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7-9 on page 4 of the answer. Accordingly, even though appellants, in the technical sense, have not complied with the requirements of 37 CFR § 1.192(c)(5) (1993) by making a statement that the claims do not stand or fall together, we will consider the separate patentability of claims 7-9 to the extent that the claims have been separately argued in the brief and addressed in the examiner's answer. Accordingly, dependent claims 2-6 will stand or fall with claim 1 while dependent claims 8 and 9 will stand or fall with claim 7.

We have carefully considered the respective positions advanced by appellants and the examiner. For the reasons set forth below, we will sustain the examiner's rejection of claims 1-6 for essentially those reasons expressed in the answer with additional comments added below primarily for emphasis. However, we will reverse the rejection of claims 7-9 for reason stated below.

The Rejection of Claims 1-6 over
Fujisawa in view of Iwatsu

Appellants argue that the examiner has misinterpreted the Fujisawa reference and that the examiner has not made out a prima facie case of obviousness since there would have been "no motivation to apply the teachings of the Iwatsu reference to the context of the Fujisawa reference" (brief, pages 2 and 3).

For the most part, appellants argued the references separately. The test of obviousness under 35 U.S.C. § 103 is not what the references expressly or individually teach, but rather, what their combined teachings would have fairly suggested to a person skilled in the art. In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Rosselet, 347 F.2d 847, 851, 146 USPQ 183, 186 (CCPA 1965). Here, we conclude that the person of ordinary skill in the art having the Fujisawa and Iwatsu references before him or her, as well as the admitted prior art on pages 1 and 2 of appellants' specification, would have arrived at the invention embraced by the claims on appeal because the combined references and admitted prior art would fairly suggest the claimed method. Appellants' admitted knowledge of prior art may be used in determining patentability of their claimed

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subject matter. In re Davis, 305 F.2d 501, 503, 134 USPQ 256, 258 (CCPA 1962).

The coating apparatus shown in Fujisawa and Appellants' Fig. 1 show remarkable similarities. Each employs three reservoirs (one for the coating composition and two for additives), a sensing means which regulates the flow of material from the reservoirs, a means for mixing the materials from the reservoirs and a means for spraying the adjusted coating composition. Fujisawa teaches the concept of controlling the viscosity of a coating composition by measuring the temperature in coating booth **13**, using the temperature measurement to control the flow rates of the coating composition from the reservoir **1** and solvent from reservoirs **2** and **3**, mixing the coating composition and additional solvent in mixer **18** to obtain an adjusted formulation of the coating composition having the desired viscosity, and then spraying the adjusted composition onto a substrate in the spray area (abstract; col. 2, lines 35-42; and col. 3, lines 15-68). The teaching of Fujisawa is not limited to any particular coating material. Therefore, it

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would appear to be applicable to either oil based (organic) or water based (waterborne) coating compositions.

Appellants have found that "the effects of fluctuating humidity can be neutralized by adjusting the viscosity of a waterborne coating as it is being conducted to the spraying device" (specification, page 3). Appellants state that the "application of waterborne coatings is complicated by the fact that the evaporation rate of water is dependent on the relative humidity of the spray environment" and that too much or too little humidity will affect the quality of the coating obtained (specification, page 1, lines 12-24). However, appellants point out on page 1, line 26 to page 2, line 11 of their specification that it is known in the art to control the viscosity of the coating composition by controlling the temperature and humidity in the spray booth or spray zone.

We find that the teaching of the prior art, taken as a whole, would have suggested to a person skilled in the art to use a humidity sensor in the Fujisawa apparatus to measure humidity alone or a combination of humidity and temperature to control the viscosity of waterborne coating compositions. Fujisawa teaches the basic concept of controlling the

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viscosity of a coating by measuring temperature and adjusting the coating composition by adding solvent. While Iwatsu does not control the amount of solvent to be added to a coating composition, the reference does teach measuring humidity and/or temperature via a sensor to automatically control heaters **15** and **23** to regulate the viscosity of the coating composition applied. Since appellants admit it is known to control the viscosity of waterborne compositions by controlling humidity and temperature, one skilled in the art would have been led to use a humidity sensor in the Fujisawa process to control viscosity of waterborne compositions. Accordingly, the examiner's rejection of claims 1-6 is affirmed.

The Rejection of Claims 7-9 Over
Fujisawa in view of Iwatsu

As for the embodiments set forth by claims 7-9, we are constrained on this record to reverse the examiner. We find no suggestion or motivation in the prior art which would have led a person skilled in the art to arrive at adjusting a coating composition by adding a secondary coating composition which is similar, but not identical, to the primary coating

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composition. The examiner's position is that "it would have been obvious to one of ordinary skill to adjust the viscosity by adding a mixture of coating and solvent because it is desirable to minimize the amount of solvent used in spraying processes" (answer, page 4). The examiner has not pointed to any teaching in the references of record or provided any objective evidence to support this conclusion. Accordingly, we will reverse the examiner's rejection of claims 7-9 for obviousness.

Conclusion

For the aforementioned reasons, the examiner's rejection of claims 1-6 for obviousness is affirmed and the rejection of claims 7-9 is reversed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

	BRADLEY R. GARRIS)	
	Administrative Patent Judge))	
)	
)	
	CAMERON WEIFFENBACH)	BOARD OF
PATENT	Administrative Patent Judge))	APPEALS AND
)	INTERFERENCES
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	JOAN ELLIS)	
	Administrative Patent Judge))	

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