

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 56

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DOUGLAS H. LARROW and LAWRENCE E. THIEBEN

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Appeal No. 95-3715  
Application No. 08/042,899<sup>1</sup>

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ON BRIEF

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Before JOHN D. SMITH, GARRIS, and KRATZ, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

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<sup>1</sup> Application for patent filed April 5, 1993. According to appellants, this application is continuation of Application 07/799,928, filed November 26, 1991, now abandoned; which is a continuation of Application 07/474,260, filed February 5, 1990, now abandoned; which is a continuation of Application 07/168,453, filed March 15, 1988, now abandoned.

This is a decision on appeal from the examiner's final rejection of claims 51 through 69, which are all of the claims pending in this application.

The appellants' invention relates to a refinish primer system comprising a first layer of refinish primer composition that includes an organic solvent based dispersion and a second layer of a primer surfacer composition. An understanding of the invention can be derived from a reading of exemplary claim 63, which is reproduced below.

63. A refinish primer system comprising a first layer of refinish primer composition and a second layer of primer surface composition, said refinish primer composition comprising;

an organic solvent based dispersion having a solids content in the range from about 45 to 70%, by weight, wherein said organic solvent is selected from the group consisting of: aprotic solvents or mixtures thereof;

and wherein said solids comprise:

from about 10 to about 50%, by weight, crosslinked acrylic polymer microparticles having a diameter of 0.1 to 10 microns which are insoluble in the organic solvent and are stabilized in the solvent system by steric barriers;

from about 30 to about 60%, by weight, an oxidatively-curable resin;

from about 15 to about 40%, by weight, one or more ingredients, selected from the group consisting of: corrosion

inhibitors, inert fillers, pigments, surface builders and mixtures thereof;

and said primer surfacer composition comprising:

an organic solvent system, and oxidatively curable or plastic resin, and an inert filler.

The sole prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Backhouse	4,403,003	Sep.
6, 1983		

Claims 51-69 stand rejected under 35 U.S.C. § 103 as being unpatentable over Backhouse.

OPINION

We have carefully reviewed the respective positions presented by appellants and the examiner. In so doing and based on the present record, we find ourselves in agreement with appellants that the examiner has failed to establish a *prima facie* case of obviousness of the claimed subject matter. Accordingly, we will not sustain the examiner's rejection for essentially those reasons advanced by appellants in the brief (page 2, last paragraph through page 4, line 4) as supplemented below.

According to appellants (brief, page 2), the claims stand or fall together. Moreover, the examiner has agreed with that statement (answer, page 2).

The claimed subject matter (claim 63 is a representative claim) relates to a system including first and second layers of primer. A review of the record indicates to us that both appellants and the examiner have construed the appealed claims as being drawn to a primer system including two separate layers with the first protective (undercoat) layer including an organic solvent based dispersion of specified solids (i.e. in an uncured state) and the second primer surfacer layer composition laid onto the uncured first layer (specification, page 3, line 16 through page 8, line 6). In deciding this appeal, we shall treat the claims similarly. In this regard, we construe the claims to be drawn to a two-layer uncured primer system including a first layer composition comprising an aprotic organic solvent based dispersion overlaid by a second layer composition including an oxidatively-curable or plastic resin.

The fatal flaw in the examiner's rejection is that Backhouse, the sole reference relied upon by the examiner, does

not teach or suggest the combination of particular layers which comprise the claimed system including an aprotic organic solvent based dispersion as a first layer but rather an aqueous based composition for the first layer. Moreover, the examiner has failed to provide any convincing reasons based on the applied prior art, or on the basis of knowledge generally available to one of ordinary skill in the art, as to how one skilled in the art would have arrived at the specific claimed two layer system from the teachings of the prior art discussed in Backhouse.

The examiner\*s overall position appears to be that one of ordinary skill in the art, if not concerned with atmospheric pollution, would have understood that the prior art discussed in Backhouse would have suggested the alternative of using an aprotic organic solvent based dispersion for the first layer in the inventive coating of Backhouse instead of the aqueous based dispersion taught by patentees notwithstanding the express teachings of Backhouse to use an aqueous medium for dispersion of the polymer solids in the first layer. However, in reviewing the reference relied on by the examiner, it is difficult to discern on what basis this conclusion was reached. Clearly, a

skilled artisan would have been concerned with pollution when using prior art organic solvent borne base coat/clearcoat systems that utilize an additive that imparts gel-like character to a freshly formed base coat film from the teachings of Backhouse regarding such (column 1, lines 29-52). In our view, the rejection as proposed by the examiner would appear to destroy the inventive concept of Backhouse which requires that the first layer be a water based composition as disclosed by Backhouse (column 2, line 3 through column 4, line 63). See Ex parte Hartmann 186 USPQ 366, 367 (Bd. App. 1974). Thus, we find ourselves in agreement with appellants that the applied prior art does not suggest the claimed invention.

In our view, the examiner appears to have relied on impermissible hindsight in making his determination of obviousness. Accordingly, we cannot sustain this rejection based on the present record.

#### OTHER ISSUES

The examiner should consider whether the language "refinish primer composition according to" as used in dependent claims 51-62 is consistent with the "refinish primer system" as

recited in independent claim 63. An amendment of each of claims 51 -62 to conform with claim 63 would appear to be in order.

The decision of the examiner is reversed.

REVERSED

JOHN D. SMITH	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
BRADLEY R. GARRIS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
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	)	
PETER F. KRATZ	)	
Administrative Patent Judge	)	

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