

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 54

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RUDOLF RENZ, BODO MULLER
and WILLY VESPER

Appeal No. 1998-3154
Application No. 08/277,937

ON BRIEF

Before KIMLIN, OWENS and PAWLIKOWSKI, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 29-36, all the claims remaining in the present application.

Claim 29 is illustrative:

29. A method of coating a substrate comprising:

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adding an organic solvent and a non-volatile aliphatic polyether to a higher-viscosity basecoat composition so as to produce a lower-viscosity basecoat composition, said higher-viscosity basecoat composition being suitable for producing a polyether-free, lower-viscosity basecoat composition and said non-volatile aliphatic polyether containing at least one hydroxyl group per molecule, having a mean molecular weight not less than about 300 and being present in an amount from about 6 to about 10 weight percent of the total weight of the volatile and non-volatile components;

applying the polyether-containing, lower-viscosity basecoat composition to a substrate;

allowing a flash-off period to occur without baking;

overcoating the coated substrate with a clearcoat;
and

baking the overcoated substrate to produce a multicoat finish such that said finish has a metallic appearance equal to that of a metallic finish prepared from the polyether-free, lower-viscosity basecoat composition.

The examiner relies upon the following references as evidence of obviousness:

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|-----------------------------------|-----------|---------------|
| Benefiel et al. (Benefiel) | 3,639,147 | Feb. 1, 1972 |
| Backhouse | 4,220,679 | Sep. 2, 1980 |
| Garner | 4,333,845 | Jun. 8, 1982 |
| Kordomenos et al. (Kordomenos) | 4,694,051 | Sep. 15, 1987 |

Appellants' claimed invention is directed to a method of coating a substrate by utilizing a basecoat composition comprising a non-volatile aliphatic polyether. The basecoat

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is subjected to a flash-off, without baking, before applying an overcoat of a clear composition. The coated substrate is then baked to produce a multicoat finish. According to appellants, "the proportion of non-volatile components in organic-containing basecoat compositions can be increased by replacing up to 10% by weight of the basecoat volatile components with an aliphatic polyether or mixture of aliphatic polyethers" (page 2 of Brief, paragraph V).

Appellants submit at page 3 of the Brief that "[a]ll claims in this appeal, claims 29-36, stand or fall together with the sole independent claim 29."

Appealed claims 29-36 stand rejected under 35 U.S.C. § 103 as follows:

- (1) Benefiel in view of Garner,
- (2) Backhouse in view of Garner, and
- (3) Benefiel in view of Kordomenos.

Claim 29 also stands rejected under 35 U.S.C. § 112, second paragraph.

Upon careful consideration of the opposing arguments presented on appeal, we will not sustain the examiner's rejections.

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Concerning the examiner's three rejections under 35 U.S.C. § 103, we essentially agree with the position espoused by appellants. The examiner has not established the requisite motivation which establishes why one of ordinary skill in the art would have modified the base composition of Benefiel or Backhouse by incorporating a non-volatile aliphatic polyether therein, and our review of the applied references finds no such motivation. As emphasized by appellants, Benefiel exclusively discloses the use of volatile solvents in the base composition for the purpose of facilitating "the most rapid removal" of the solvents (column 1, line 68). The same can be said for the Backhouse disclosure. At most, the examiner has indicated why one of ordinary skill in the art might consider, or try, to add a non-volatile aliphatic polyether into the base compositions of Benefiel and Backhouse. However, such is not the proper standard for determining obviousness under § 103.

As for the § 112, second paragraph, rejection, we agree with appellants that one of ordinary skill in the art would understand that the criticized claim language defines a metallic appearance for the multicoat finish that is equal to

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that of a metallic finish prepared in the same way but for the absence of the recited non-volatile aliphatic polyether.

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In conclusion, based on the foregoing, the examiner's
decision rejecting the appealed claims is reversed.

REVERSED

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| EDWARD C. KIMLIN |) | |
| Administrative Patent Judge |) | |
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| TERRY J. OWENS |) | BOARD OF PATENT |
| Administrative Patent Judge |) | APPEALS AND |
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| BEVERLY PAWLIKOWSKI |) | |
| Administrative Patent Judge |) | |

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