The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte D. STERLING HUBBELL

Appeal No. 2003-1067
Application No. 09/775,662

HEARD: November 5, 2003

Before KIMLIN, WARREN and OWENS, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 16-39, all the claims remaining in the present application. Claim 16 is illustrative:

16. An applicator for use in applying a conversion coat solution comprising:

a tube having a reservoir;

a tip extending from one end of the tube;

a conversion coat solution disposed in the reservoir; and

a seal closing a second end of the tube and confining the conversion coat solution in the reservoir;

said tip being in fluid communication with said reservoir to allow said conversion coat solution to flow through said tip when in use.

In addition to the admitted prior art, the examiner relies upon the following references:

Ronco	3,369,543	Feb. 20, 1968
Brockman	3,688,450	Sep. 05, 1972
Jones	3,881,828	May 6, 1976

Appellant's claimed invention is directed to an applicator used for applying a conversion coat solution which is employed in the aircraft industry for treating aluminum parts to prevent corrosion. When a portion of the conversion coating is damaged or removed, the claimed applicator is used to apply additional conversion coat solution to the damaged area. According to appellant's specification, "[t]he applicator may be a well-known conventional 'felt tip' type marking pen or similar structure which is filled with the hazardous chemical solution rather than a non-hazardous marking fluid" (page 2, lines 21-23). The "hazardous chemical solution" is the claimed conversion coat solution. The specification further states that the claimed applicator is used instead of the conventional cotton balls, Q-tips, rags, or sponges and the like for applying the

conversion coat solution and, thereby, avoids the spillage of hazardous waste.

The present application is related to U.S. Application No. 08/038,033, which is directed to a method of repairing a conversion coat solution by utilizing the claimed applicator. An appeal was taken to this Board in the related application and, in a decision dated January 26, 1999, the Board affirmed the examiner's rejection under 35 U.S.C. § 103 over the admitted prior art and Brockman, the same Brockman presently applied by the examiner. The related application eventually matured into a patent, U.S. Patent No. 6,217,935.

Appealed claims 16-35 stand rejected under 35 U.S.C. § 103 as being unpatentable over Jones in view of the admitted prior art, Brockman and Ronco. Claims 36-39 also stand rejected under 35 U.S.C. § 103 over Jones in view of the admitted prior art, Brockman and Ronco.

Appellant submits at page 5 of the principal brief that "[c]laims 16, 19, 20, 21, 23-25, 36 and 37 stand or fall together," as do claims 26, 29-31, 33-35, 38 and 39.

We have thoroughly reviewed each of appellant's arguments for patentability, as well as the declaration evidence relied upon in support thereof. However, we concur with the examiner

that the claimed subject matter would have been obvious to one of ordinary skill in the art within the meaning of § 103 in view of the applied prior art. Accordingly, we will sustain the examiner's rejections for essentially those reasons expressed in the Answer.

There is no dispute that the structure of the claimed applicator, without the conversion coat solution contained therein, was known in the art at the time of filing the present application. Indeed, as noted above, appellant's specification acknowledges that the claimed applicator may be a well-known conventional "felt tip" type applicator. Since none of the applied prior art expressly teaches such an applicator containing the presently claimed conversion coat solution, at issue is the obviousness of including a conversion coat solution in the conventional applicator for the purpose of applying the conversion coat solution.

Based on the applied prior art, particularly Brockman, we are convinced that it would have been obvious for one of ordinary skill in the art to substitute the claimed conversion coat solution for the inks and paints of the prior art in a conventional felt-tip applicator. While Brockman discloses the application of paint and enamel, Brockman also expressly teaches

"a simple and inexpensive tool assembly for touching-up painted or otherwise coated surfaces and which includes the necessary coating compositions together with the necessary tools required for the job in a convenient compact unitary device" (column 1, lines 20-25, emphasis added). The reference also discloses "[t]he body **92** defines a reservoir for the paint, enamel or other coating composition and is slightly tapered toward the spout **96**" (column 3, lines 64-66, emphasis added). Accordingly, we find that it would have been obvious for one of ordinary skill in the art to employ the claimed conventional applicator for applying any liquid composition having a suitable viscosity for the known advantages of avoiding waste of the material and effecting a more precise application. As for appellant's advantage of minimizing the danger to workers of exposure to the claimed conversion coat solution, there is no teaching in Brockman that the applicator is limited to applying non-hazardous materials and, as noted in the prior Board decision, many paints are toxic. Appellant has apprised us of no reason why one of ordinary skill in the art would be dissuaded from utilizing a conventional applicator to dispense a hazardous material, and we find that the use of a conventional applicator, rather than rags and sponges, for applying a hazardous material in a touch-up manner would have

been obvious to one of ordinary skill in the art. It is our opinion that both the problem of waste and exposure to hazardous material, as well as appellant's solution of using a conventional applicator for dispensing the hazardous material, would have been obvious to one of ordinary skill in the art. In re Ludwig, 353 F.2d 241, 243, 147 USPQ 420, 421 (CCPA 1965). Also note that Brockman, like appellant, discloses that "[t]he assembly includes replaceable cartridges for containing the desired coating compositions" (column 4, lines 36-37).

Unlike in the prior appeal, appellant relies upon evidence of nonobviousness in the form of commercial success. In particular, appellant proffers the Miller Declaration of September 7, 1999 and the Miller Supplemental Declaration of March 20, 2000, as well as the Kukalis Declaration of April 2, 2002 as evidence of commercial success which demonstrates that sales of the claimed applicator far exceeded sales of the assignee's brush applicator from the years 1995 to 2001. The Kulalis Declaration also states that the sales of the claimed applicator were generated without sales promotions or mass media advertising and was not due to any outside forces, such as a change in environmental regulations. The Kulalis Declaration further states many advantages of the claimed applicator over the admitted prior art rag and sponge

applicators, e.g., unlike the uneven coating produced by a rag or brush, "the claimed applicator provides a continuous flow of conversion coat solution from the reservoir through the tip during application of the conversion coat solution to the damaged area, thereby resulting in an even application of the conversion coat solution to the metal surface where needed" (page 13 of principal brief, second paragraph). Also, the Miller Declaration refers to a publication of Delta Airlines which describes appellant's applicator as "revolutionary" in providing an annual savings of $602,000. The Miller Supplemental Declaration states that the assignee's customers were willing to pay much more for the conversion coat solution packaged in the applicator than the cost of buying bulk quantities of the solution with a brush kit. The Supplemental Declaration also asserts that a third party copied appellant's applicator.

The examiner has not attacked the validity of appellant's evidence of commercial success, and we find that appellant has, indeed, demonstrated commercial success for the claimed applicator vis-à-vis the brush kit. However, it is well settled that evidence of commercial success is but one evidentiary consideration that of itself does not necessitate a finding of nonobviousness. In re Rynkiewicz, 390 F.2d 742, 746, 156 USPQ 462, 465 (CCPA 1968). When evidence of commercial success or

other evidence of nonobviousness is submitted, we must start anew in weighing the evidence of obviousness against the evidence of nonobviousness in order to determine whether the invention, as a whole, would have been obvious to one of ordinary skill in the art within the meaning of § 103. In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). In the present case, having weighed the evidence of obviousness presented by the examiner against the evidence of nonobviousness proffered by appellant, while taking into consideration that the structure of the claimed applicator was admittedly known in the art and the advantages of using the applicator would have been readily apparent to one of ordinary skill in the art, it is our judgment that the evidence of obviousness outweighs the evidence of nonobviousness. In re Nolan, 553 F.2d 1261, 1267, 193 USPQ 641, 645 (CCPA 1977). We note that there is no evidence of record that the advantages of using the claimed applicator espoused by appellant would have been considered truly unexpected by one of ordinary skill in the art, and it is our view that such advantages would have been expected. In re Merck & Co., 800 F.2d 1091, 1099, 231 USPQ 375, 381 (Fed. Cir. 1986). Also, there is no evidence that the applicator that was assertedly copied was not made independently due to its obviousness.

In conclusion, based on the foregoing and the reasons set forth by the examiner, the examiner's decision rejecting the appealed claims is affirmed.

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

AFFIRMED

EDWARD C. KIMLIN Administrative Patent Judge	)	
CHARLES F. WARREN Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
TERRY J. OWENS Administrative Patent Judge	)	

ECK:clm

ROYLANCE, ABRAMS, BERDO
& GOODMAN, L.L.P.
1300 19TH Street, N.W.
Suite 600
Washington, DC 20036