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PPG Industries, Inc. IP Law Group One PPG Place 39th Floor Pittsburgh, PA 15272			YAGER, JAMES C	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHRISTOPHER L. MOST and ROBERT MCVAY

Appeal 2015-007056
Application 13/219,771
Technology Center 1700

Before KAREN M. HASTINGS, JAMES C. HOUSEL, and
WESLEY B. DERRICK, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants¹ seek our review under 35 U.S.C. § 134(a) of the Examiner's decision rejecting claims 1–5, 8–15, and 17–21 under 35 U.S.C. § 103(a) as unpatentable over at least the basic combination of McVay (US 7,475,786 B2, issued Jan. 13, 2009) in view of Coates (US 1,120,738, published July 24, 1968).²

We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

¹ The real party in interest is stated to be PPG Industries Ohio, Inc. (Br. 1).

² While the Examiner applies additional prior art to dependent claim 12, Appellants do not present any additional argument against this rejection (Br. 5).

Independent claim 1 is illustrative of the subject matter on appeal (emphasis added):

1. An aqueous composition comprising:
 - (a) a resinous binder,
 - (b) 5 to 35 percent by weight based on total solids weight of the composition of a product formed by mixing together and heating:
 - (i) *an epoxidized polybutadiene and*
 - (ii) a polyamide.

Appellants do not separately argue any of the claims (Br. 2–5); accordingly all of the claims stand or fall with claim 1.

ANALYSIS

Upon consideration of the evidence on this record and each of Appellants' contentions, we find that the preponderance of evidence supports the Examiner's conclusion that the subject matter of Appellants' claim 1 is unpatentable over the applied prior art. We sustain the Examiner's § 103 rejections essentially for the reasons set out by the Examiner in the Answer.

We add the following primarily for emphasis.

Appellants' principal arguments in the Appeal Brief are 1) that there is no motivation to modify the McVay composition to include the epoxide polybutadiene of Coates (Br. 3, 4), and 2) since Coates is an organic based solvent composition, an artisan would have been directed away from including the epoxide polybutadienes therein in the aqueous solution of the instant claims (Br. 4, 5). Appellants also rely upon a Rule 132 Declaration

by one of the inventors, Robert McVay,³ which reiterates these arguments (Br. *generally*).

It has been established that “the [obviousness] analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). Likewise, it is also well settled that a reference stands for all of the specific teachings thereof as well as the inferences one of ordinary skill in the art would have reasonably been expected to draw therefrom. *See In re Fritch*, 972 F.2d 1260, 1264–65 (Fed. Cir. 1992).

There is no dispute that the aqueous composition of claim 1 encompasses the aqueous composition of McVay, which is useful for coating and adhering to metal food cans, except for the inclusion of “an epoxide polybutadiene.” Coates exemplifies that one of ordinary skill in the art would have known that polyamides and epoxide polybutadienes may be mixed together for a composition used to seal/coat e.g., the seams of metal containers/cans (*see, e.g.*, Coates p. 1; Ans. 4). Appellants have not shown reversible error in the Examiner’s determination that a person of ordinary skill in the art would have, using no more than ordinary creativity, used a mixture of polyamide and epoxide polybutadiene as an alternative to the polyamide of McVay’s composition for known advantages of such mixtures (*e.g.*, Ans. 5-8; Coates *e.g.*, p. 1, ll. 31–58).

It is well established that the obviousness inquiry does not ask “whether the references could be physically combined but whether the

³ Rule 132 Declaration filed June 30, 2014 (Br., Evidence App.)

claimed inventions are rendered obvious by the teachings of the prior art as a whole.” *In re Etter*, 756 F.2d 852, 859 (Fed. Cir. 1985) (en banc); *see also In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (stating “[t]he test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference”); *In re Nievelt*, 482 F.2d 965, 968 (CCPA 1973) (“Combining the *teachings* of references does not involve an ability to combine their specific structures.”).

To the extent that Appellants argue that Coates is nonanalogous art, we note that in *KSR*, 550 U.S. at 419–420 the Supreme Court observed that:

In determining whether the subject matter of a . . . claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls. What matters is the objective reach of the claim. If the claim extends to what is obvious, it is . . . [unpatentable] under § 103.

See also Wyers v. Master Lock Co., 616 F.3d 1231, 1238 (Fed. Cir. 2010) (“[t]he Supreme Court’s decision in *KSR* . . . directs us to construe the scope of analogous art broadly,” stating that “*familiar items may have obvious uses beyond their primary purposes*, and a person of ordinary skill often will be able to fit the teachings of multiple patents together like pieces of a puzzle”). The scope of the field of endeavor is a factual determination based on the scope of the application’s written description and claims. *In re Bigio*, 381 F.3d 1320, 1326 (Fed. Cir. 2004). If a reference is not within the relevant field of endeavor, it may still be properly considered if it is reasonably pertinent to the problem; that is, if it would have logically commended itself to an inventor’s attention. *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992). The Examiner reasonably *de facto* found that the relevant field of endeavor was coating compositions, based on Appellants’

Specification and claims. Substantial evidence therefore supports the Examiner's finding that McVay and Coates are in the same field of endeavor and thus are analogous art. Furthermore, a § 103 analysis focuses on what is claimed apart from the motivation of the inventor. *See, e.g., KSR*, 550 U.S. at 419–420.

Appellants have not shown error in the Examiner's determination that one of ordinary skill would have appreciated that an epoxide polybutadiene/polyamide mix as exemplified in Coates' organic solvent composition would have had obvious uses in other products, such as for the polyamide component in the aqueous composition of McVay. As the Examiner pointed out, Appellants do not provide any evidence or rationale that one of ordinary skill "would not expect epoxidized polybutadiene to be capable of blending with polyamide in an aqueous composition" (Ans. 8). McVay's composition indeed may include up to 20 weight percent of organic solvents (McVay col. 3. ll. 28–33). Since the McVay Declaration does not contain any reasonably specific factual support for its opinions, we give more weight to the publications than the testimony of an interested party. We discern no reversible error in the Examiner's assessment of the weight to be given to the submitted evidence. *Yorkey v. Diab*, 601 F.3d 1279, 1284 (Fed. Cir. 2010) (The Board has discretion to give more weight to one item of evidence over another "unless no reasonable trier of fact could have done so"). *See also In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1368 (Fed. Cir. 2004) ("[T]he Board is entitled to weigh the declarations and conclude that the lack of factual corroboration warrants discounting the opinions expressed in the declarations."); *Velandar v. Garner*, 348 F.3d 1359, 1371 (Fed. Cir. 2003) ("In giving more weight to prior publications

than to subsequent conclusory statements by experts, the Board acted well within [its] discretion.”).

Appellants have not asserted that the proposed modification of McVay to include an epoxidized polybutadiene would have been beyond the capabilities of a person of ordinary skill in the art. Absent such an assertion, we “take account of the inferences and creative steps that a person of ordinary skill in the art would employ,” and find a person of ordinary skill in the art would have overcome those difficulties within their level of skill. *KSR*, 550 U.S. at 418; *see also id.* at 421 (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”); *Ball Aerosol & Specialty Container, Inc. v. Limited Brands, Inc.*, 555 F.3d 984, 993 (Fed. Cir. 2009) (under the flexible inquiry set forth by the Supreme Court, the PTO must take account of the “inferences and creative steps,” as well as routine steps, that an ordinary artisan would employ (emphasis omitted)).

Accordingly, we affirm the Examiner’s prior art rejections of the claims under 35 U.S.C. § 103(a) for the reasons given above and presented by the Examiner.

DECISION

The Examiner’s § 103 rejections are affirmed.

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1).

AFFIRMED