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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARK D. LEWIS, WALTER J. ROBERTSON,
MARY KIMBRO, and NATHAN GOODNOW

Appeal 2015-007101
Application 13/548,524
Technology Center 1700

Before KAREN M. HASTINGS, CHRISTOPHER C. KENNEDY, and
JENNIFER R. GUPTA, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants¹ request our review under 35 U.S.C. § 134(a) of a decision of the Primary Examiner to reject claims 1–8 and 10 under 35 U.S.C. § 103(a) based on at least Gibson et al. (US Pub. No. 2006/0181707 A1, published Aug. 17, 2006) (“Gibson”).² The Examiner also rejected claim 1 under 35 U.S.C. § 112 as failing to comply with the written description requirement.

¹ The Real Party in Interest is stated to be PPG Industries Ohio, Inc. (Br. 1).

² The Examiner also applied Prakash et al. (WO 2008/103405 A1, published Aug. 28, 2008) (“Prakash”) in combination with Gibson to reject dependent claims 9 and 11 under 35 U.S.C. § 103(a) (Non-Final Action 4). Appellants rely upon the argument for claim 1 and do not add any additional arguments to address this rejection (Br. 7).

We have jurisdiction under 35 U.S.C. § 6.

Claims 1 is the sole independent claim on appeal (emphasis added to highlight key contested limitation):

1. A color matching method for coatings comprising:
 - providing a target formulation for a coating composition including types and target amounts of components of the coating composition to be included in the target formulation;
 - automatically dispensing the types of the components of the target formulation into a container to provide a sample coating composition and *automatically measuring the amount of each of the components of the sample coating composition dispensed into the container*;
 - comparing the measured amount of each of the components with the target amount of each of the components;
 - applying the sample coating composition to a test panel substrate and curing the sample coating composition to form a sample coating;
 - comparing characteristics of the sample coating with characteristics of a coating produced from the target formulation to determine whether there is an acceptable match of such characteristics; and
 - correlating any differences between the characteristics of the sample coating and the coating produced from the target formulation with the comparison between the measured amount of each of the components and the target amount of each of the components to thereby determine whether changes in the amounts of the components of the sample coating are necessary to match the characteristics of the sample coating to the coating produced from the target formulation.

ANALYSIS

The § 112 Rejection

For an applicant to comply with the 35 U.S.C. § 112, first paragraph, written description requirement, the applicant's Specification must "convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." *Carnegie Mellon Univ. v. Hoffmann-La Roche Inc.*, 541 F.3d 1115, 1122 (Fed. Cir. 2008)

(quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991)).

After review of the respective positions provided by Appellants and the Examiner, we find that a preponderance of the evidence supports Appellants’ position that the original disclosure provides support for the claimed term “automatically measuring” (Br. 3–5; Spec. *e.g.*, ¶¶ 12, 15, 28). As Appellants explains, the Specification describes in detail an automated coating system and method (Br. 5).

The Examiner’s position is that while the Specification supports automatically dispensing the components, it “does not say that the amounts are automatically measured” and thus, ““automatic measuring”” is new matter (Non-Final Action 3; *see also* Ans. 2).

However, a preponderance of the evidence supports Appellants’ position that one of ordinary skill in the art would have understood that the originally filed Specification encompasses automatically measuring the components (Br. 5). The claim need not use the same words as the specification; it is enough that one of ordinary skill in the art would recognize that the inventor invented what is claimed. *Union Oil Co. of Cal. v. Atlantic Richfield Co.*, 208 F.3d 989, 997 (Fed. Cir. 2000).

Accordingly, we reverse the Examiner’s § 112, first paragraph rejection of claim 1 on appeal.

The § 103 Rejection

Upon consideration of the appeal record, including the Appellants’ position in this appeal as set forth on pages 6–7 of the Appeal Brief, we affirm the Examiner’s rejection for essentially the reasons stated by the

Examiner (Non-Final Act. 4; Ans. 2, 3). All claims stand or fall with independent claim 1.

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 well settled that a reference stands for all of the specific teachings thereof as well as the inferences one of ordinary skill in this art would have reasonably been expected to draw therefrom. *See In re Fritch*, 972 F.2d 1260, 1264–65 (Fed. Cir. 1992).

Appellants’ sole argument in the appeal brief is that Gibson does not teach automatically dispensing and measuring the amounts of each of the components of a sample coating composition as the Examiner has suggested (Br. 6 and 7). This argument is not convincing of error in the Examiner’s rejection. Notably, Appellants do not specifically dispute the Examiner’s determination that it is prima facie obvious to automate a previously known manual activity, relying on *In re Venner*, 262 F.2d 91, 95 (CCPA 1958). (Non-Final Act. 3; *see also* Ans. 3; Br. *generally*). We agree with the Examiner and find “it is well settled that it is not ‘invention’ to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result.” *Venner*, 262 F.2d at 95 (citing *In re Rundell*, 48 F.2d 958, 959 (CCPA 1931)). Indeed, Gibson exemplifies automatic color matching computer programs (e.g., Gibson ¶¶ 5–19). One of ordinary skill would have inferred from Gibson’s description that measuring the amount of the colorant components was included in the process described therein. Moreover, Appellants admit in the Background

of the Invention section in their Specification that it was known to weigh a coating formula by selecting and manually pouring each component of the formula into a container on a scale (Spec. 2). Thus, weighing the coating colorant components was a known prior art step (albeit manually). An applicant cannot defeat an obviousness rejection by asserting that the cited references fail to teach or suggest elements which the applicant has acknowledged are taught by the prior art. *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1570 (Fed. Cir. 1988) and *In re Nomiya*, 509 F.2d 566, 571 n.5 (CCPA 1975) (A statement by an applicant that certain matter is prior art is an admission that the matter is prior art for all purposes).

Appellants have thus not shown error in the Examiner's determination that one of ordinary skill in the art, using no more than ordinary creativity, would have predictably automated a color matching process as exemplified in Gibson (including measuring the colorant components as in the admitted prior art) (*generally*, Ans.; Br.). As the Supreme Court has noted, "[t]he combination of familiar elements [or steps] according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR*, 550 U.S. 398, 416 (2007). Appellants have not come forward with any credible evidence that the Examiner erred in characterizing the references or in concluding that the claimed combination of familiar elements/steps for known purposes would have been obvious.

Accordingly, we affirm the Examiner's § 103 rejections on appeal.

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