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Ashland LLC WILLIAM J. DAVIS, ESQ. 1005 U.S. 202/206 Bridgewater, NJ 08807			MULCAHY, PETER D	
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MICHAEL J. SUMNER, CHARLES L. FISHER,  
and ROBIN F. RIGHETTINI

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Appeal 2018-003137  
Application 12/228,820  
Technology Center 1700

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Before KAREN M. HASTINGS, GRACE K. OBERMMAN, and  
WESLEY B. DERRICK, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants<sup>1</sup> request our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1–3, 7–9, 11, 13–15, 18 and 25–27 under 35 U.S.C. § 103(a) as being unpatentable over Fujita et al., (US 6,808,821 B2, issued Oct. 26, 2004). We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

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<sup>1</sup> The real party in interest is stated to be Ashland Licensing and Intellectual Property, LLC. (Appeal Br. 2).

We AFFIRM.

Claim 1 is illustrative of the subject matter on appeal (emphasis added to highlight key limitation in dispute):

1. A gelcoat composition comprising an unsaturated polyester base resin, a reactive diluent component, a pigment and more than about 2% by weight inorganic extended filler wherein the reactive diluent component comprises styrene *and one or more alternative reactive diluents selected from the group consisting of 1,6-hexanediol diacrylate, butylmethacrylate, butyl acrylate and 2-ethylhexylacrylate, wherein a total amount of the one or more alternative reactive diluents comprises about 20% or less by weight of the reactive diluent component, wherein the gelcoat composition has a blush measured as DE of less than about 2.20 after being submerged in water at about 65 °C for about 6 hours and then remaining in the water for about 14 hours.*

Independent claim 11 is similar to that of claim 1, except it recites a “yellowing” property instead of the “blush” property of claim 1 (Claims Appendix 14). Claim 14 is directed to a process for making a gelcoat as recited in either of claims 1 in 11, wherein the gelcoat composition has either the “blush” property of claim 1 or the “yellowing” property of claim 11 (Claims Appendix 15).

#### ANALYSIS

We have reviewed each of Appellants’ arguments for patentability. We will sustain the Examiner’s rejections for essentially those reasons expressed in the Answer, including the Response to Argument section, and we add the following primarily for emphasis.

It is well established that when claimed ranges overlap or lie inside ranges disclosed by the prior art for every component in a claim, a prima facie case of obviousness is established. *In re Harris*, 409 F.3d 1339, 1341 (Fed. Cir. 2005); *In re Peterson*, 315 F.3d 1325, 1330 (Fed. Cir. 2003). It is also well established that a reference is not limited to its examples or preferred embodiments; see *Merck & Co., Inc. v. Biocraft Labs., Inc.*, 874 F.2d 804, 807 (Fed. Cir. 1989) (holding that the prior art's disclosure of over 1200 possible combinations rendered all possible formulations obvious).

In reviewing the relevant facts of this case, the Examiner's determination that Fujita suggests overlapping ranges for all of the compositional components is reasonable (*see, e.g.*, Ans. 6). Appellants' main argument that Fujita does not teach or suggest 20% by weight or less of the acrylate diluent is unavailing for reasons set out by the Examiner (Ans. 3–5 (pointing out that one of ordinary skill would have appreciated from the entirety of the reference that Fujita is teaching that styrene is the preferred diluent and an acrylate in amounts of 50% or less may be admixed therewith)).<sup>2</sup> Notably, Appellants admit that the examples of Fujita exemplify that styrene is the preferred diluent that may be combined with a minor amount of acrylate as exemplified in Example 3 of Fujita (Appeal Br. 5, 6). While Appellants observe that the acrylate used in Example 3 of Fujita is not one of those listed in claim 1, the Examiner aptly points out that Fujita explicitly lists the acrylate diluents recited in claim 1 as alternatives to the methyl methacrylate used in Fujita's Example 3 (Ans. 2, discussing Fujita col. 6, l. 43 to col. 7, l. 18).

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<sup>2</sup> No reply brief has been filed.

Thus, a preponderance of the evidence supports the Examiner's position that it would have been prima facie obvious to use an acrylate alternative reactive diluent (in combination with a styrene reactive diluent) as claimed in amounts that overlap the claimed range. Accordingly, one of ordinary skill in the art, using no more than ordinary creativity, would have selected amounts of the styrene/acrylate mixture that would have naturally resulted in the claimed properties (*see, e.g.*, Ans. 5, 6).

The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims. These cases have consistently held that the Appellants must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range. *See e.g., In re Peterson*, 315 F.3d at 1329; *In re Woodruff*, 919 F.2d 1575, 1578 (Fed. Cir. 1990). The burden rests with Appellants to establish (1) that the alleged unexpected results presented as being associated with the claimed invention are, in fact, unexpected, (2) that the comparisons are to the disclosure of closest prior art, and (3) that the supplied evidentiary showing is commensurate in scope with the claimed subject matter. *See In re Klosak*, 455 F.2d 1077, 1080 (CCPA 1972).

Appellants point to examples presented in the Specification as providing evidence of the criticality of using the appropriate acrylate diluent (*not* methyl methacrylate) so as to result in the claimed "blush" property of claim 1 (Appeal Br. 8, 10, 11; Spec. Table 1, E2 and E6). However, a preponderance of the evidence supports the Examiner's position that this evidence has not been shown to be "unexpected," nor is the evidence commensurate in scope with the claims (*see, e.g.*, Ans. 5). For example,

claim 1 uses the open-ended term “comprising” and thus may include other unrecited components. Indeed, neither claim 11 nor claim 14 require the “blush” property recited in claim 1. As previously discussed, Fujita also explicitly teaches using an amount of the acrylates recited in claim 1 throughout the claimed range.

We, therefore, discern no error in the Examiner's determination that the applied prior art would have rendered obvious the gelcoat composition of claim 1 (or claim 11, or claim 14).

Thus, Appellants have not persuasively argued that the facts and reasons relied on by the Examiner are insufficient to establish a prima facie case of obviousness. In light of these circumstances, the preponderance of the evidence supports the Examiner’s rejection. Accordingly, we sustain the rejection of the claims on appeal.

#### DECISION

The decision of the Examiner is affirmed.

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