

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte CHRISTIAN LACH and ROLAND BAUMSTARK

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Appeal No. 2004-1348  
Application No. 09/972,253

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ON BRIEF

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Before KIMLIN, GARRIS and JEFFREY T. SMITH, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-11.

Claim 1 is illustrative:

1. A water-based, pigmented coating composition essentially free from volatile organic compounds and comprising
  - i) an aqueous binder formulation as component I, with a minimum film formation temperature MFFT  $\leq 5^{\circ}\text{C}$ , based on an aqueous polymer dispersion of one or more polymers P composed offrom 90 to 99.9% by weight of at least two different monomer varieties A1 and A2, the monomer A1 being selected from the C<sub>2</sub>-C<sub>12</sub> alkyl esters of acrylic acid and the monomer

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A2 being selected from the C<sub>1</sub>-C<sub>12</sub> alkyl esters of methacrylic acid;

from 0 to < 1% by weight of monomers B, selected from monoethylenically unsaturated monocarboxylic acids having 3 to 6 carbon atoms;

from 0 to 0.5% by weight of monomers C, selected from monoethylenically unsaturated dicarboxylic acids having 4 to 6 carbon atoms and ethylenically unsaturated sulfonic acids;

from 0 to 2% by weight of monomers D, selected from the amides of monoethylenically unsaturated monocarboxylic acids having 3 to 6 carbon atoms;

from 0 to 5% by weight of monomers E, selected from the C<sub>2</sub>-C<sub>4</sub> hydroxyalkyl esters of monoethylenically unsaturated monocarboxylic acids having 3 to 6 carbon atoms (monomers E1) and the esters of monoethylenically unsaturated monocarboxylic acids having 3 to 6 carbon atoms with poly(C<sub>2</sub>-C<sub>3</sub> alkylene oxides) (monomers E2), and

from 0 to 5% by weight of monomers F, selected from monoethylenically unsaturated monomers having a urea group and monoethylenically unsaturated monomers having an acetylacetoxy group (CH<sub>3</sub>C(O)CH<sub>2</sub>C(O)-O-group),

all proportions of the monomers being based on the overall amount of the monomers A to F;

the overall amount of the monomers B and C being less than 1% by weight; and

the sum of the amount of the monomers B, C, D, E and F being from 0.1 to 10% by weight

ii) at least one inorganic particulate pigment as component II,

iii) if desired, inorganic particulate fillers as component III, and



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The sole issue on appeal regarding the § 102 rejection is whether or not Zhao describes the claimed amount of photoinitiator in the disclosed water-based, pigmented coating composition that is essentially free from volatile organic compounds, i.e., an amount "less than 0.05% by weight." Although Zhao discloses that the object of the invention is achieved by including less than 0.3% by weight of photoinitiator (column 2, fourth paragraph), appellants contend that when the reference is read as a whole it does not describe an amount less than 0.05%, as claimed. Appellants emphasize Zhao's disclosed range of 0.05 to < 3% by weight (column 2, line 54). According to appellants, since the claimed amount of photoinitiator cannot be considered to touch or overlap with Zhao's disclosed range, "the subject matter of appellants' Claim 1 cannot be regarded as being anticipated by the teaching of **Zhao et al.**" (page 6 of Brief, first paragraph).

Manifestly, appellants are on sound footing in stating that Zhao must be considered in its entirety in determining whether a description of the claimed invention is found therein. It is our view, however, that when the entirety of Zhao is taken into consideration, a description of the claimed amount of photoinitiator is present in the reference. As appreciated by

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appellants, Zhao discloses that "[t]he amount of photoinitiator used is preferably more than 0.05% by weight" (column 4, lines 48-49), and it is our opinion that this disclosure fairly describes non-preferred embodiments wherein the amount of photoinitiator is less than 0.05% by weight. Our view is further buttressed by the reference disclosure at column 9, lines 11 et seq., wherein the amount of photoinitiator is described as "approximately" from 0.05 to less than 0.3% by weight. As a result, we find, as a matter of fact, that Zhao describes a photoinitiator content of approximately 0.05% by weight, which includes slightly less than 0.05%. Since slightly less than 0.05% by weight falls within the claimed range, Zhao describes the claimed amount of photoinitiator within the meaning of § 102.

As for the examiner's § 103 rejection, for the reasons set forth in appellants' Supplemental Reply Brief of December 19, 2003, the examiner's rejection is not appropriate. Appellants have stated on the record that the present application and the Zhao patent were, at the time the present invention was disclosed and claimed in the instant application, made, owned by, or subject to an obligation of assignment to BASF AKTIENGESELLSCHAFT. Appellants have properly referenced the pertinent sections of the MPEP in support of their position.

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In conclusion, based on the foregoing, 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	)	
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BRADLEY R. GARRIS	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
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JEFFREY T. SMITH	)	
Administrative Patent Judge	)	

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