

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL MARIE VANDEVOORDE,
ANTONIUS H. G. VAN ENGELEN
and ANN ALFRED J. LEMAIRE

Appeal No. 2004-2275
Application No. 09/444,968

ON BRIEF

Before GARRIS, DELMENDO and JEFFREY T. SMITH, *Administrative Patent Judges*.

JEFFREY T. SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicants appeal the decision of the Primary Examiner finally rejecting claims 1 to 5 and 12.¹ We have jurisdiction under 35 U.S.C. § 134.²

¹ According to the Appellants, Brief page 2, claims 7 to 11 and 13 to 17 have been withdrawn from consideration as directed to a non elected invention. The subject matter of claim 6 has been allowed.

² In rendering this decision, we have considered Appellants' arguments presented in the Brief filed March 17, 2003 and the Reply Brief filed July 26, 2004.

CITED PRIOR ART

As evidence of unpatentability, the Examiner relies on the following reference:

Ho	5,798,409	Aug. 25, 1998
Mayer et al. (Mayer)	6,309,707	Oct. 30, 2001

The Examiner rejected claims 1, 2, 4, 5 and 12 under 35 U.S.C. § 102(e) as anticipated by Ho; claims 1 to 3, 5 and 12 under 35 U.S.C. § 102(e) as anticipated by Mayer; and claim 3 under 35 U.S.C. § 103(a) as unpatentable over Ho. (Answer pp. 4 to 6).

Appellants' invention relates to a coating composition comprising a hydroxy group-containing film forming polymer having a hydroxy value between 75 and 300 mg KOH/g solid resin, a polyisocyanate compound, and a diol. According to Appellants, the claimed invention exhibits good thinnability, low VOC, good mixing properties and low application viscosities. (Specification, p. 3). Claim 1, which is representative of the claimed invention, appears below:

1. A coating composition comprising a hydroxy group-containing film forming polymer with a hydroxy value between 75 and 300 mg KOH/g solid resin, a polyisocyanate compound, and a diol of the general formula

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HO-CH₂-CR(C₂H₅)-CH₂OH, wherein R is an alkyl group having 3-6 carbon atoms.

OPINION

Upon careful review of the respective positions advanced by Appellants and the Examiner, we find that the Examiner has failed to carry the burden of establishing a *prima facie* case of anticipation or obviousness. Consequently, we will not affirm the rejection of the claims under §§ 102 and 103. Rather than reiterate the conflicting viewpoints advanced by the Examiner and Appellants concerning the above-noted rejections, we refer to the Answer and the Briefs. We reverse for the reasons presented in the Briefs and add the following.

The Examiner acknowledges that both the Ho and Mayer references teach coating compositions that comprise an hydroxy group-containing film forming polymer and a polyurethane, i.e., the reaction of a diol and polyisocyanate. (Answer, pp. 4 and 5). The Examiner also asserts "the claims do not limit the compositions to unreacted components, and the appellant's examples show rapid reaction of the claimed components." (Answer, p. 6). It appears that the Examiner is asserting that the claimed

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invention encompasses a composition from a two-step reaction. First is the formation of an intermediate prepolymer (polyurethane) and a subsequent step wherein the prepolymer is reacted with hydroxy group-containing film forming polymer. We do not agree.

It is well known by persons of ordinary skill in the art that diols, polyisocyanates and polyurethanes have different reactive groups. These reactive groups can undergo various reactions to form other compounds with different reactive groups. As stated by Appellants, "[t]he hydroxyl groups of the diol and the isocyanate groups of the polyisocyanate can undergo an addition reaction to form urethane groups. A polyurethane resin thus prepared no longer comprises the starting compounds, i.e., the diol as a compound with hydroxyl groups and the polyisocyanate having isocyanate groups, but a polymer having urethane groups." (Brief, p. 7).

Appellants' invention is directed to a coating composition comprising hydroxy group-containing film forming polymer, a polyisocyanate compound, and a diol. The present invention may also comprise a polyurethane. (Specification, p. 4). However, the composition must contain a diol and a polyisocyanate and a hydroxy group-containing film forming polymer as specified in the claimed

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invention. The specification describes the formation of coating compositions from a polyisocyanate component, a hydroxy group-containing film forming polymer component and a diol component. These components are mixed together to form the coating composition. (Specification, pp. 13-19). The specification does not disclose that the polyisocyanate component and the diol component are first mixed together to form a polyurethane component and subsequently mixed with the hydroxy group-containing film forming polymer component to form the coating composition. Neither Ho nor Mayer describes or suggests a coating composition as claimed.

The rejections of claims 1, 2, 4, 5 and 12 under 35 U.S.C. § 102(e) as anticipated by Ho; claims 1 to 3, 5 and 12 under 35 U.S.C. § 102(e) as anticipated by Mayer; and claim 3 under 35 U.S.C. § 103(a) as unpatentable over Ho are reversed.

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CONCLUSION

For the foregoing reasons, the Examiner's rejections of the claims are reversed.

REVERSED

BRADLEY R. GARRIS
Administrative Patent Judge

ROMULO H. DELMENDO
Administrative Patent Judge

JEFFREY T. SMITH
Administrative Patent Judge

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JOAN M. MCGILLYCUDDY
AKZO NOBEL INC
INTELLECTUAL PROPERTY DEPARTMENT
7 LIVINGSTONE AVENUE
DOBBS FERRY, NY 10522-3408