

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* RONALD DAVID BAKULE

---

Appeal No. 2006-2393  
Application 10/439,947

---

ON BRIEF

---

Before WARREN, JEFFREY T. SMITH and GAUDETTE, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

*Decision on Appeal and Opinion*

We have carefully considered the record in this appeal under 35 U.S.C. § 134, and based on our review, find that we cannot sustain the grounds of rejection advanced on appeal: claims 2, 3, 5 and 6 under 35 U.S.C. § 102(b) as being anticipated by Sarkar (answer,<sup>1</sup> pages 3-4); claims 2 through 6 under 35 U.S.C. § 102(b) as being anticipated by Nyssen<sup>2</sup> (answer, pages 4-5); claims 7 and 8 under 35 U.S.C. § 103(a) as being unpatentable over Sarkar or Nyssen as applied to claims above, further in view of *Paint and Surface Coatings* (answer, pages 5-6); and claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Nyssen as applied to

---

<sup>1</sup> We have considered the answer mailed February 2, 2006. We note that the examiner mailed a supplemental answer on July 3, 2006, subsequent to the mailing of the Appeal Docketing Notice, which is stated to only correct “section (8) to indicate references relied upon.”

<sup>2</sup> There is no dispute that the published World Intellectual Property Organization Application WO 00/60015, in German, is equivalent to United States Patent US 6,818,050 B1, and thus the examiner has relied on the latter as a translation of the former (answer, page 4; brief, page 7).

claims 2 through 6 above, further in view of Sarkar (answer, page 6).<sup>3</sup>

We refer to the answer and to the brief for a complete exposition of the positions advanced by the examiner and appellant.

The issues in this appeal require that we interpret representative independent claim 1 by giving the terms thereof the broadest reasonable interpretation in their ordinary usage in context as they would be understood by one of ordinary skill in the art in light of the written description in the specification unless another meaning is intended by appellant as established therein, and without reading into the claims any disclosed limitation or particular embodiment. *See, e.g., In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004); *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

Contrary to the examiner's position (answer, page 8), we determine that when the preambular language and the corresponding language in the body of the claim with respect to "forming at least one paint line" is considered in the context of the claimed invention as a whole, including consideration thereof in light of the written description in appellant's specification, it must be given weight as a claim limitation which characterizes the claimed method in order to give meaning to the claim and properly define the invention. *See generally In re Fritch*, 972 F.2d 1260, 1262, 23 USPQ2d 1780, 1781 (Fed. Cir. 1992) (citing *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 896, 221 USPQ 669, 675 (Fed. Cir.), cert. denied, 469 U.S. 857 [225 USPQ 792] (1984), *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989), *In re Stencel*, 828 F.2d 751, 754-55, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987). As appellant points out (brief, pages 6, 7 and 8), the written description in the specification specifically defines the term "paint line" as "includes at least two different paints which exhibit dried film properties that differ materially from each other in at least one observable property" (page 9, ll. 12-15).

The plain language of claim 1 further specifies that the method for forming at least one paint line comprises at least (1) providing a set comprising at least three prepaints, (2) dispensing

---

<sup>3</sup> Claims 2 through 9 are all of the claims in the application and stand of record as submitted in the amendment filed October 6, 2005, entered by the examiner in the advisory action mailed

any amount of each of the prepaints of the set into a container to form the at least one paint line, and (3) mixing any amount of thickener with at least one of the prepaints. We determine from the context of the claim and the written description in the specification that the prepaints are part of a set and it is at least some amount of each of the prepaints in the set which is dispensed into a container to form the at least two paints of the paint line. The use of the term “set” in the context of the claim and the written description in the specification in this manner is indeed, the customary and ordinary meaning that one of ordinary skill in the art would associate with this term.<sup>4</sup>

Each of the three required prepaints is specified in the same language of which the following is representative: “at least one prepaint z, comprising at least one polymer binder.” We interpret this language to mean that “prepaint z” comprising at least any amount of any polymer which can be characterized as a binder to any extent. Thus the claim is not drawn to a “binder prepaint,” which term is defined in the specification (page 7, ll. 2-3) as appellant argues (brief, page 5; see also “opacifying prepaint,” page 8). In any event, the definition of “binder prepaint” in the specification requires only “that the prepaint contains at least 50 percent by weight . . . of at least one polymer binder” (page 7, ll. 2-3) and does not preclude a polymer binder that also functions as a thickener, or the presence of any other ingredients including opacifying pigments and extender pigments. Further, claim 1 specifies that at least one of the prepaints is a solid. However, contrary to appellant’s arguments, there is no limitation in claim 1 which specifies that a solid prepaint cannot be combined with a liquid in a container or application device and the resulting liquid or slurry combined with other prepaints, as liquids or slurries, in the same or additional containers or application devices.

We note here that the open-ended term “comprising” used in transition and in the body of the claim, opens the claim to include any method containing any manner of additional steps and ingredients. *See generally, Exxon Chem. Pats., Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1555, 35 USPQ2d 1801, 1802 (Fed. Cir. 1995) (“The claimed composition is defined as comprising -

---

October 31, 2005.

<sup>4</sup> *See generally*, “**Set**” . . . n. **1**. A group of things of the same kind that belong together and are so used.” *The American Heritage Dictionary Of The English Language* 1593 (4th ed., Boston, Houghton Mifflin Company. 2000).

meaning containing at least - five specific ingredients.”); *In re Baxter*, 656 F.2d 679, 686-87, 210 USPQ 795, 802-03 (CCPA 1981) (“As long as one of the monomers in the reaction is propylene, any other monomer may be present, because the term ‘comprises’ permits the *inclusion* of other steps, elements, or materials.”). Thus, each prepaint comprises at least the specified ingredient *per se* as well as any additional ingredients mixed therewith; the prepaints in the set comprises at least the three specified prepaints and any number of additional ingredients which, singularly or in admixture, constitute a prepaint ingredient; and the steps comprise at least the three specified steps and any number of additional steps, including such additional steps as those specified in independent claims 4 and 5.

Turning now to the rejections under § 102(b), it is well settled that the examiner has the burden of making out a *prima facie* case of anticipation in the first instance by pointing out where each and every element of the claimed invention, arranged as required by the claim, is described identically in the reference, either expressly or under the principles of inherency, in a manner sufficient to have placed a person of ordinary skill in the art in possession thereof. *See generally, In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677-78, 7 USPQ 1315, 1317 (Fed. Cir. 1988); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). Whether the teachings and inferences that one skilled in this art would have found in the disclosure of an applied reference would have placed this person in possession of the claimed invention, taking into account this person’s own knowledge of the particular art, is a question of fact. *See generally, In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995), and cases cited therein (a reference anticipates the claimed method if the step that is not disclosed therein “is within the knowledge of the skilled artisan.”); *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968) (“[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom.”). It is also well settled that in order to establish that a claim element is inherent in a prior art reference, it must be established that such limitation is necessarily present in the description in the reference and that it would be recognized as such by one of ordinary skill in the art, as “[t]he

mere fact that a certain thing may result from a given set of circumstances is not sufficient. [Citations omitted.]” *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981); *see also Transclean Corp. v. Bridgewood Serv., Inc.*, 290 F.3d 1364, 1372-73, 62 USPQ2d 1865, 1870-71 (Fed. Cir. 2002); *MEHL/Biophile Int’l Corp. v. Milgram*, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1305-06 (Fed. Cir. 1999); *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268-69, 20 USPQ2d 1746, 1749-50 (Fed. Cir. 1991); *In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986).

There is no dispute that each of Sarkar and Nyssen would have disclosed to one skilled in this art paints that comprise the three ingredients which are employed as the specified ingredient in the three preprints specified in claimed method. However, as appellant points out, the examiner has not identified any disclosure in the references which expressly or inherently would have described the claimed methods encompassed by claims 2 through 6, as we have interpreted these claims above, to this person within the meaning of § 102(b). Indeed, in support of the contention that “at least two paint lines are inherently formed from the compositions” of the references, the examiner merely states that this is because the references are “open to various combinations of ingredients and is used in a variety of applications” (answer, pages 4 and 5). Thus, the examiner has not identified in either reference substantial evidence which supports the positions taken in the grounds of rejection under § 102(b), and accordingly, we reverse these grounds of rejection.

The grounds of rejection under § 103(a) require different considerations. In order to establish a *prima facie* case of obviousness under § 103(a), the examiner must show that some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in this art would have led that person to the claimed invention as a whole, including each and every limitation of the claims arranged as required by the claims, without recourse to the teachings in appellant’s disclosure. *See generally, In re Kahn*, 441 F.3d 977, 985-88, 78 USPQ2d 1329, 1334-37 (Fed. Cir. 2006); *In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Fritch*, 972 F.2d at 1265-66, 23 USPQ2d at 1783-84; *In re Fine*, 837 F.2d 1071, 1074-76,

5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Indeed, in each of these grounds of rejection, the examiner relies on the same analysis of Sarkar and of Nyssen set forth in the prior grounds of rejection under § 102(b) which does not address whether one of ordinary skill in this art routinely following the teachings of each of the references would have found therein the motivation or suggestion to successfully arrive at the claimed methods encompassed by claims 2, 4 and 5 as modified by claims 7 through 9. “Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of the reference. *See B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996).” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000).

Accordingly, on this record, we reverse the grounds of rejection under 35 U.S.C. § 103(a).

The examiner’s decision is reversed.

*Remand*

We remand the application to the examiner for consideration of issues raised by the record. 37 CFR § 41.50(a)(1) (2005); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 3, August 2005).

Upon further prosecution of the appealed claims upon the disposition of this appeal, the examiner should consider whether Sarkar and Nyssen, separately and/or combined together or with any additional prior art developed by the examiner, would have reasonably suggested the claimed invention encompassed by all of the appealed claims to one of ordinary skill in this art within the meaning of 35 U.S.C. § 103(a).

Further, we find of record United States Patent Publication US 2002/0016405 to Friel et al. (Friel) submitted by appellant and summarized at page 2 of the specification. There, appellant describes Friel as disclosing “a set of prepaints sufficient to formulate at least one paint line” but “does not disclose the use of prepaints in the form of a solid.” The examiner should consider whether Friel alone or as combined with any additional prior art developed by the examiner would have reasonably suggested the claimed invention encompassed by the appealed

claims, as we have interpreted the claims above, to one of ordinary skill in this art within the meaning of 35 U.S.C. § 103(a).

Accordingly, the examiner is required to take appropriate action consistent with current examining practice and procedure to consider whether a new ground or grounds of rejection should be entered on the record based on the above findings for purposes of further prosecution of the appealed claims, supplying and applying any other applicable prior art with respect to any or all of grounds as the examiner deems appropriate.

We hereby remand this application to the examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

*REVERSED*  
*REMANDED*

