

The opinion in support of the decision being entered today 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* LAURA KIEFER-LIPTAK,  
JOHN M. DUDIK,  
RONALD R. AMBROSE,  
KEVIN C. OLSON and  
PADMANABHAN SUNDARARAMAN

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Appeal 2007-3547  
Application 10/231,652  
Technology Center 1700

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Decided: August 22, 2007

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Before BRADLEY R. GARRIS, PETER F. KRATZ, and CATHERINE Q. TIMM, *Administrative Patent Judges*.

KRATZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the Examiner's final rejection of claims 7, 8, 15-22, 36-48, 50, and 51. We have jurisdiction pursuant to 35 U.S.C. §§ 6 and 134.

Appellants' claimed invention is directed to a film-forming coating composition including a polyester, an acrylic copolymer, a crosslinker, and a solvent. Claim 36 is illustrative and reproduced below:

36. A film-forming composition suitable for coating food cans comprising:

- (a) a polyester;
- (b) an acrylic copolymer;
- (c) a crosslinker; and
- (d) a solvent,

wherein the polyester and acrylic copolymer are grafted together and the graft copolymer reacts with the crosslinker to form the film, and wherein the composition is substantially epoxy free.

The Examiner relies on the following prior art references as evidence in rejecting the appealed claims:

Kadowaki	US 4,728,684	Mar. 1, 1988
Taga	JP 08269427	Oct. 15, 1996
Simms	US 6,037,414	Mar. 14, 2000

Claims 7, 8, 15, 17, 36, 37, 39, 40, and 42-48 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kadowaki. Claims 7, 8, 15-22, 36-48, 50, and 51 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Taga. Claims 7, 8, 15, 17, 36, 39, 41, and 43-48 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over Simms.

We affirm all of the stated rejections for substantially the reasons set forth by the Examiner in the Answer and Final Office Action. We offer the following for emphasis.

Appellants argue the rejected claims together as a group respecting each of the separately stated rejections. Accordingly, we select claim 36 as the representative claim on which we decide this appeal as to each of the separate rejections before us.

“To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.” *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); accord *Glaxo, Inc. v. Novopharm, Ltd.*, 52 F.3d 1043, 1047, 34 USPQ2d 1565, 1567 (Fed. Cir. 1995). However, anticipation by a prior art reference does not require that the reference recognize either the inventive concept of the claimed subject matter or the inherent properties that may be possessed by the prior art reference. See *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987).

Anticipation under this section is a factual determination. See *In re Baxter Travenol Labs.*, 952 F.2d 388, 390, 21 USPQ2d 1281, 1283 (Fed. Cir. 1991) (citing *In re Bond*, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990).

Respecting the first two rejections, the Examiner has determined that Kadowaki and Taga each describe a composition that includes all of the features required by representative claim 36 (Answer 3; Kadowaki, col. 2, l. 5 – col. 4, l. 18; Tada, 2-7). Appellants do not dispute that Kadowaki and

Taga each describe a coating composition including a polyester urethane rubber grafted with an acrylic acid (Br. 2-3). Nor do Appellants argue that either of these separately applied references fails to include a solvent and a crosslinker in the respective coating compositions of each. Rather, Appellants assert that one of ordinary skill in the art would not interpret the described adhesive coating composition of each of these separately applied references to be a polyester-containing composition “suitable for coating food cans.” In other words, Appellants maintain that the claimed polyester-containing composition would not read on the described polyester urethane-containing composition of either of these applied references because such a claim construction would be at odds with the asserted food can coating utility of the claimed composition (Reply Br. 1).

We are not persuaded of reversible error in either of the Examiner’s first two stated anticipation rejections by this argument for reasons stated by the Examiner (Answer 4-5). In particular, Appellants' Specification does not define the claimed polyester component as excluding polyester urethanes. Significantly and as noted by the Examiner, Appellants include tris-hydroxyethylisocyanurate (a urethane forming component) as being useful in making the claimed polyester component of the claimed composition (Answer 5; Specification 3).

Regarding the asserted “suitability for coating food cans” argument, we note that Appellants have not furnished any persuasive evidence to establish that the coating compositions of either Kadowaki or Taga are unsuitable for such a use. When a claimed product appears to be substantially identical to a product disclosed by the prior art, the burden is

on the Applicant to prove that the product of the prior art does not necessarily or inherently possess characteristics or properties attributed to the claimed product. *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

In particular, we note that representative claim 36 does not require that the claimed composition be suitable for employment as a final coating layer for the inside surface of a food can and/or as a composition that meets a particular regulatory standard. Thus, the claimed coating is open to the inclusion of a prior art coating including the broadly recited components in a coating composition, such as described by Kadowaki or Taga, and which coatings are suitable for use as an outer can coating or as an under layer or adhesive primer for a final (food-contacting) coating layer of a food-side surface of a can.

For the aforementioned reasons, we affirm the Examiner's first and second stated anticipation rejections.

As for the Examiner's § 102(b)/§ 103(a) rejections of claims 7, 8, 15, 17, 36, 39, 41, and 43-48 over Simms, Appellants contend that the pigment dispersant of Simms is not a film-forming coating composition, as required by representative claim 36 (Br. 3). Moreover, Appellants additionally contend that the optional obviousness position of the Examiner is in error because Simm's pigment dispersion is not a film forming component; that is, it does not form part of a film (Br. 4; Reply Br. 1-2).

On the other hand, the Examiner contends that Simms describes a coating composition without epoxy, the composition including a solvent, a cross-linker, and polyester grafted with acrylic copolymer, which

composition anticipates and/or would have rendered representative claim 36 obvious to one of ordinary skill in the art at the time of the invention (Answer 4). On this record, we agree with the Examiner's anticipation and obviousness positions. Accordingly, we affirm the stated rejection over Simms for substantially the reasons set forth in the Answer and below.

As pointed out by the Examiner, Simms describes a coating composition including a crosslinker, solvent and the polyester/acrylic grafts of the pigment dispersion (Answer 5-6; Simms, col. 5, l. 61 – col. 6, l. 10).

We note that Appellants employ open “comprising” language in representative claim 36. Thus, the claimed composition is open to the inclusion of the other coating composition ingredients disclosed by Simms. Moreover, Simms describes the coating composition including the added pigment dispersion as being capable of forming a film (*id.*). On this record, we affirm the Examiner's anticipation/obvious rejection over Simms.

#### CONCLUSION

The decision of the Examiner to reject claims 7, 8, 15, 17, 36, 37, 39, 40, and 42-48 under 35 U.S.C. § 102(b) as being anticipated by Kadowaki; to reject claims 7, 8, 15-22, 36-48, 50, and 51 under 35 U.S.C. § 102(b) as being anticipated by Taga; and to reject claims 7, 8, 15, 17, 36, 39, 41, and 43-48 under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over Simms is affirmed.

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Application 10/231,652

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)(iv) (2006).

AFFIRMED

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