

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

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROLAND GRUETZMACHER,
ULRICH NAGORNY,
WOLFGANG GRESS,
RAINER HOEFER,
ANDREAS HEIDBREDER,
and
BIRGIT HIRSCHBERGER

Appeal No. 2000-2123
Application No. 09/029,637

ON BRIEF

Before GARRIS, PAK, and PAWLIKOWSKI, *Administrative Patent Judges*.

PAK, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 10 through 33, which are all of the claims pending in the above-identified

Appeal No. 2000-2123
Application No. 09/029,637

application.

Claims 10 and 18 are representative of the claimed
subject matter and read as follows:

Appeal No. 2000-2123
Application No. 09/029,637

10. A process for producing coating compositions comprising: (a) providing a reactive diluent, (b) providing an inert solvent, (c) providing a polymeric polyol, (d) providing an isocyanate, (e) reacting (a)-(d) in a reactive diluent comprising a ring opening product of a carboxylic acid ester epoxide with a dihydric or higher alcohol.

18. Coating compositions comprising:

a ring opening product of combining carboxylic acid ester epoxide with dihydric or higher alcohol as a reactive diluent;

polymeric polyol;

inert solvent; and

isocyanate.

The sole prior art reference relied upon by the examiner is:

Noury et al. (Noury)	1,100,404	Jan. 24,
	1968	
(published Great Britain Patent Application)		

The appealed claims stand rejected as follows:

1) Claims 10 through 33 stand rejected under 35 U.S.C. § 103 as unpatentable over the disclosure of Noury.

We reverse.

The examiner's § 103 rejection is predicated upon obviousness of using solvent in the solvent-free system described in Noury. To establish obviousness, the examiner

Appeal No. 2000-2123
Application No. 09/029,637

states (Answer, pages 3 and 4) that:

The appellants argue that because the reference excludes solvent, it wouldn't be obvious to include solvent. Solvents are well known in coatings, even to those not skilled in the art. One of ordinary households frequently add solvents, which can be bought at hardware and paint stores, to coatings and paints to reduce the viscosity in order to spray a coating rather than applying it with a brush, or to reduce the viscosity of coatings when the temperature is low. **Many inventors have developed formulations that don't require solvents in order to meet regulations pertaining to volatiles that harm air quality. The invention of the claims takes a step back in the art.** [Emphasis added.]

The examiner's own statement, however, does not demonstrate that one of ordinary skill in the art would not be taught away from employing solvent in the solvent-free system described in Noury. See *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994) ("A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.") To add the solvent to the solvent-free system as proposed by the examiner would be to destroy the invention on which Noury is based. *Ex parte Hartmann*, 186 USPQ 366, 367 (Bd. App. 1974).

Appeal No. 2000-2123
Application No. 09/029,637

In view of the foregoing, the decision of the examiner is reversed.

REVERSED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
CHUNG K. PAK)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
BEVERLY A. PAWLIKOWSKI)	
Administrative Patent Judge)	

CKP:hh

Appeal No. 2000-2123
Application No. 09/029,637

WAYNE C. JAESCHKE
HENKEL CORPORATION PATENT DEPT.
2500 RENAISSANCE BLVD., STE. 200
GULPH MILLS, PA 19406