

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WERNER KUBITZA, ROLF ROSCHU,  
FERDINAND ZOLLNER and HANS J. LAAS

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Appeal No. 96-2504  
Application 08/318,328<sup>1</sup>

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ON BRIEF

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Before KIMLIN, WEIFFENBACH and HANLON, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 7-24, all the claims remaining in the present application.

Claim 7 is illustrative:

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<sup>1</sup>Application for patent filed October 5, 1994. According to appellants, this application is a continuation of application 08/009,522, filed January 27, 1993, now abandoned.

Appeal No. 96-2504  
Application 08/318,328

7. A process for the preparation of a coating which comprises

a) applying to a water-resistant substrate an aqueous coating composition containing water and a binder which consists essentially of a hydrophilically-modified polyisocyanate component containing one or more hydrophilically-modified polyisocyanates which are dispersible in water, said hydrophilically-modified polyisocyanate component having a viscosity at 23°C of 100 to 5000 mPa.s, an average NCO functionality of 2 to 4, a content of (cyclo)aliphatically bound isocyanate groups of 12 to 21.5% by weight, based on the weight of said hydrophilically modified polyisocyanate component, and a content of ethylene oxide units (calculated as C<sub>2</sub>H<sub>4</sub>O, molecular weight = 44) present within polyether chains of 2 to 20% by weight, based on the weight of said hydrophilically modified polyisocyanate component, and

b) curing said aqueous coating composition in the presence of moisture to form a polyurea coating.

In the rejection of the appealed claims, the examiner relies upon the following references:

Hombach et al. (Hombach) 4,663,377 May 05, 1987

"Aqueous Polyurethane Dispersions from TMXDI® (MEDTA) Aliphatic Isocyanate", CYANAMID BULLETIN, Feb. 1989.

Appellants' claimed invention is directed to a process

Appeal No. 96-2504  
Application 08/318,328

for preparing a cured polyurea coating. The process comprises

coating a water-resistant substrate with a composition containing water and a binder which consists essentially of a hydrophil-ically-modified polyisocyanate having the recited characteris-tics.

Appellants separately argue claims 13-18, as a group, and claims 11, 12, 17, 18, 23 and 24, as a group. Accordingly, such two groups of claims stand or fall together, as do claims 7-10 and 19-22.

Appealed claims 7-24 stand rejected under 35 U.S.C. § 102 as being anticipated by Hombach. In addition, claims 7-24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hombach in view of the CYANAMID BULLETIN.

We have carefully reviewed the respective positions advanced by appellant and the examiner. In so doing, we will not sustain the examiner's section 102 rejection of claims 11, 12, 17, 18, 23 and 24. However, we will sustain the examiner's section 102 rejection of claims 7-10, 13-16 and 19-

Appeal No. 96-2504  
Application 08/318,328

22, as well as the section 103 rejection of all the appealed claims for essentially the reasons expressed in the answer.

We consider first the examiner's rejection of claims 7-10, 13-16 and 19-22 under 35 U.S.C. § 102. Appellants do not dispute

the examiner's factual determination that Hombach describes coating a substrate with a composition containing a hydrophilically-modified polyisocyanate of the kind claimed, including one having the recited viscosity. Appellants' principal contention on appeal is that the claim language "a binder which consists essentially of a hydrophilically-modified polyisocyanate component . . ." does not allow for the presence of the adhesive components disclosed by Hombach. However, we are in full agreement with the examiner that the claim language "coating composition containing water and a binder which consist essentially of" defines a coating composition which comprises the recited ingredients in addition to non-specified components. Appellants do not challenge the examiner's position that the claim term "containing" is equivalent to the term "comprises". On this

Appeal No. 96-2504  
Application 08/318,328

point, the examiner is on sound legal footing. See Swain v. Crittendon, 332 F.2d 820, 823, 141 USPQ 811, 813 (CCPA 1964), and In re Pangrossi, 277 F.2d 181, 185, 125 USPQ 410, 413 (CCPA 1960). Rather, appellants maintain that "the binder portion of the composition has been closed to other binder components, such as the adhesive binders of Hombach et al." (page 4 of principal

brief). We however, find no error in the examiner's reasoning articulated at page 5 of the answer:

Consistent with the PTO's policy to interpret claims in their broadest meaning reasonable to one of ordinary skill in the art, it is the examiner's position that "containing" allows the claimed composition to contain any other ingredients and is analogous to "comprising". Therefore, the added adhesive binder of Hombach et al. is not excluded. The consisting essentially of and consisting language cited by the applicant serves to limit the polyisocyanate subsequently described to those having the parameters following consisting essentially of and consisting.

The appealed claims do not specify that the recited binder is the only binder in the coating composition. In our view, the appealed claims encompass an aqueous coating composition

Appeal No. 96-2504  
Application 08/318,328

containing water, the specified binder, and other additional components, including additional binders. Also, we find no merit in the argument that since the final product of the reference is an adhesive, it is "not a coating." (page 2 of reply brief). Manifestly, the application of an adhesive composition results in an adhesive coating.

We also agree with the examiner that Hombach's disclosure of an emulsifier prepared from polyether alcohols having "generally about 10" ethylene oxide units anticipates the "9 alkylene units"

of claims 13-18. In re Ayers 154 F.2d 182, 185, 69 USPQ 109, 112 (CCPA 1946), see also In re DeVaney, 185 F.2d 679, 88 USPQ 97 (CCPA 1950).

We will not sustain the examiner's section 102 rejection of claims 11, 12, 17, 18, 23 and 24, which require that the coating composition contain a pigment. Appellants have presented objective evidence that the chalk disclosed by Hombach does not qualify as a pigment.

Regarding the section 103 rejection of all the appealed

Appeal No. 96-2504  
Application 08/318,328

claims, appellants do not challenge the examiner's legal conclusion that it would have been obvious for one of ordinary skill in the art to make the polyisocyanate of Hombach with TMXDI in order to give the polyurethanes a lower viscosity (page 10 of answer). Rather, appellants again contend that such compositions of Hombach "will be outside the scope of Claims 7-24, because these claims exclude the presence of the aqueous adhesives required by Hombach et al." (page 7 of brief). For the reasons discussed above, we find that this argument is non-persuasive. While appellants also maintain at page 7 of the principal brief "there would be no motivation for a skilled artisan to omit

these adhesives from the coating composition of Hombach et al."

this misstates the issue. Since we find that the claim language "containing" does not preclude the presence of Hombach's adhesive components in the claimed composition, we do not reach the issue of whether the claim language "consists essentially of" excludes the adhesive components of Hombach to

Appeal No. 96-2504  
Application 08/318,328

the extent that their incorporation in the claimed composition would materially affect the basic and novel characteristic of the claimed invention.

As for the separately argued claims, we are satisfied that Hombach's disclosure of preparing polyisocyanates from a polyether polyol having about 10 ethylene oxide units establishes a prima facie case of obviousness for the claimed polyether polyol having 9 ethylene oxide units. Also, we are convinced that one of ordinary skill in the art would have found it obvious to include a pigment, as well as a filler, in adhesive compositions of Hombach for the purpose of adding color to the composition. Also, concerning the section 103 rejection of the appealed claims, we note that appellants base no argument upon objective evidence of nonobviousness, such as unexpected results.

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

Appeal No. 96-2504  
Application 08/318,328

connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
CAMERON WEIFFENBACH	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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Appeal No. 96-2504  
Application 08/318,328

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