

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MATTHEW S. GEBHARD
and ETHAN S. SIMON

Appeal No. 1996-3867
Application No. 08/153,239

ON BRIEF

Before WILLIAM F. SMITH, Administrative Patent Judge,
MCKELVEY, Senior Administrative Patent Judge, and PAK,
Administrative Patent Judge.

PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 1 through 12 which are all of the claims pending in the application.

Appeal No. 1996-3867
Application No. 08/153,239

OBVIOUSNESS

The examiner has rejected claims 1 through 12 under 35 U.S.C. § 103 as unpatentable over the disclosure of European Patent Application 0 388 915 published on September 26, 1990 (hereinafter referred to as "Glancy").

Having carefully reviewed the claims, specification and Glancy, including all of the arguments advanced by both the examiner and appellants in support of their respective positions, we conclude that the examiner's § 103 rejection is not well founded. Accordingly, we reverse the examiner's decision rejecting claims 1 through 12 under 35 U.S.C. § 103. Our reasons for this determination follow.

The claimed subject matter as represented by the broadest claim on appeal is directed to:

A method for reducing the amount of microfoam in a spray-applied waterborne polymeric composition comprising: forming a waterborne polymeric composition and spraying said composition using a gas having a solubility factor greater than about one.¹

According to page 3 of the specification, the claimed "waterborne polymeric composition" is defined as

¹ See claim 1.

Appeal No. 1996-3867
Application No. 08/153,239

a composition containing a soluble polymer dissolved in or an insoluble polymer dispersed in a medium which is predominantly composed of water, or mixtures thereof.

The term "predominantly" is not specifically defined in the specification. One definition of "predominate" is "[t]o be a greater . . . quantity."² This definition would mean that water is present in an amount of at least 50% in the medium, a fact entirely consistent with the amount of water employed in the examples at pages 7 through 14 of the specification. Moreover, according to pages 5 and 6 of the specification, a gas having the claimed solubility factor includes carbon dioxide and nitrous oxide.

As found by the examiner (Answer, page 3), the sole prior art reference, Glancy, describes using carbon dioxide as a useful compressed gas for a polymer coating composition. See Glancy, page 21, line 11. Glancy, however, does not teach, nor would have suggested, using carbon dioxide as a compressed gas for the claimed "waterborne polymer coating composition." Glancy teaches away from using more than 30% of water in the solvent/diluent in a polymer coating composition. See page 2,

² See page 927 of *WEBSTER'S New Riverside University Dictionary* published on 1984 attached herewith.

Appeal No. 1996-3867
Application No. 08/153,239

lines 32-37, page 6, lines 38-45 and page 11, lines 32-39. Accordingly, we agree with appellants that the examiner has not established a **prima facie** case of obviousness of the claimed subject matter within the meaning of 35 U.S.C. § 103. Since no **prima facie** case of obviousness is established, we need not address the sufficiency of unexpected results referred to by the examiner, but not mentioned by appellants. **See In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); **In re Rinehart**, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

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

OTHER ISSUE

U.S. Patent Nos. 4,842,900 and 3,661,605 and published Japanese Patent Application 60/85929 referred to at page 2 of the specification appear to be facially more relevant than Glancy.

Appeal No. 1996-3867
Application No. 08/153,239

The examiner may wish to review them and to take such further
action as the examiner may deem appropriate.

REVERSED

	William F. Smith)	
	Administrative Patent Judge)	
)	
)	
)	
	Fred E. McKelvey, Senior)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
	Chung K. Pak)	
	Administrative Patent Judge)	

CKP:tdl

Appeal No. 1996-3867
Application No. 08/153,239

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