

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte GUY J.G. CLAMEN, JOSEF H. JILEK II,  
ANGELO SANFILIPPO and ANDREW P. TRAPANI

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Appeal No. 1996-3936  
Application No. 08/261,514<sup>1</sup>

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ON BRIEF

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Before KIMLIN, JOHN D. SMITH and WALTZ, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

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<sup>1</sup> Application for patent filed June 17, 1994.

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This is an appeal from the final rejection of claims 2, 4  
and 6-10, all the claims remaining in the present application.

Claim 2 is illustrative:



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when the climatic conditions are 23EC, no air flow and 90% relative humidity. Dry-through is defined by ASTM D-1640-83 with the modification that no thumb pressure is exerted."

Given appellants' specification definition of the claimed fast drying aqueous traffic paint, we agree with appellants that the examiner has not established on this record that the applied reference, Bier, describes or suggests such a fast drying traffic paint. Bier describes his invention as relating to "water-based paints for interior use, in particular on ceilings" (column 1, second paragraph), and the examiner has not established the requisite correspondence between appellants' paint composition and paint compositions fairly taught by Bier to reasonably conclude that the paint of Bier is a fast drying aqueous traffic paint, as defined by appellants' specification. While the examiner points to Bier's disclosure at column 6, lines 22 et seq., that the paint was dry within 1 hour, and page 1 of appellants' specification states that "[a] fast drying paint normally has a dry-through time of less than 120 minutes," the examiner has taken the relevant passages out of context. As explained by appellants, Bier's paint dries within 1 hour under conditions

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of normal humidity, whereas the "dry-through time" referred to in appellants' specification pertains to climatic conditions of 23EC, no air flow and 90% relative humidity. For the examiner to conclude that Bier's paint has the dry-through time of appellants' paint requires the sort of speculation that cannot form the basis for a rejection under either § 102 or § 103.

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection. Appealed claims 2, 4 and 6-10 stand rejected under 35 U.S.C. § 103 as being unpatentable over the admitted state of the prior art found at page 1 of appellants' specification in view of prior art cited by appellants in information disclosure statements, namely, Japanese Patent Abstract No. 87-167594, JP-A-62-100 563 (JP '563), Japanese Kokai Patent No. SHO 63-170478 (Japanese Kokai '478), and Japanese Kokai Patent No. SHO 63-179978 (Japanese Kokai '978). Appellants' specification readily acknowledges that fast drying aqueous traffic paints were known in the art at the time of filing the present application, albeit, we are told, without the presence of fibers. However, the four secondary references made of record by appellants provide

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substantial evidence that it was known in the art to incorporate fibers in traffic paint compositions. Indeed, Japanese Abstract No. 87-167594 and JP '563 teach the incorporation of fibers into traffic paint for the purpose of rendering the paint crack-resistant. Accordingly, based on the prior art of record, we are convinced that it would have been prima facie obvious for one of ordinary skill in the art to add fibers to a fast drying aqueous traffic paint. Also, while we realize that appellants, earlier in the prosecution, argued that Japanese Kokai '478 and Japanese Kokai '978 are directed to non-aqueous paints, appellants have presented no reasoning why one of ordinary skill in the art would have been dissuaded from incorporating fibers in an aqueous traffic paint for the reasons set forth in Japanese Kokai '478 and Japanese Kokai '978.

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is reversed. A new ground of rejection has been entered for the appealed claims under the provisions of 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final

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rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203  
Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR § 1.196(b) provides, "[a] new ground of rejection shall  
not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant,  
WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise  
one of the following two options with respect to the new  
ground of rejection to avoid termination of proceedings (37  
CFR § 1.197(c) as to the rejected claims:

(1) Submit an appropriate amendment of the  
claims so rejected or a showing of facts relating to  
the claims so rejected, or both, and have the matter  
reconsidered by the examiner, in which event the  
application will be remanded to the examiner . . . .

(2) Request that the application be reheard  
under § 1.197(b) by the Board of Patent Appeals and  
Interferences upon the same record . . . .

No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

REVERSED - 37 CFR § 1.196(b)

EDWARD C. KIMLIN )  
Administrative Patent Judge )



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