

COMMISSIONER'S DECISION

Section 36, Breadth of Claims: Aqueous Coating Compositions Comprising Polymers and Cross Linkers. The claims are supported by the disclosure and since there is no evidence of lack of utility of any of the species disclosed, the claims are acceptable. Suggestion that a sample be submitted is withdrawn. Rejection reversed.

Patent application 253,678 (class 400-47) was filed on May 31, 1976 for an invention with the title "Aqueous Coating Compositions Comprising Acrylic Oligomers, High Molecular Weight Polymers and Crosslinkers." The inventors are Richard Martorano and William H. Brendly Jr. assignors to Rohm and Haas Company. The Examiner in charge of the application on April 6, 1981 took a Final Action on that date refusing to allow the application to proceed to patent.

The application describes and claims aqueous compositions useful in high speed, direct roll coating and lower speed direct and reverse roll coating applications. The aqueous compositions are said to avoid the noxious and fire-hazard related problems associated with organic media and to provide coatings having high gloss, mar resistance, hot stacking resistance and also resistance to deterioration or extraction under pasteurization conditions. The compositions claimed are combinations of a binder, consisting of an aqueous alkaline blend of a copolymer and an oligomeric copolymer, with a cross-linking agent reactive with both copolymer and oligomer, the entire composition being in the form of a dispersion or solution in water. The compositions are further characterized by their constituents, concentration ranges and weight-average molecular weight ranges. The cross-linking agent may be selected from a large number of conventional cross-linking agents. The blend of copolymer and oligomer is further described by its solids content, its volatiles content and its viscosity.

In the Final Action the Examiner rejected claims on two grounds and also suggested that Applicant produce a sample of the claimed coating composition. The first objection, applied by the Examiner to claims 2, 4, 7, 8 and 13, was that essential elements were missing from these claims. Applicant subsequently offered to amend these claims in the manner suggested by the Examiner. The Board considers this amendment will overcome the first ground for the rejection of claims 2, 4, 7, 8 and 13 and recommends that this amendment should be accepted.

The second objection, applied by the Examiner to all the claims, was that the claims are too broad in scope because of the large number of compounds covered by the general definitions of the constituents in the claims. Applicant submitted a partial amendment to claim 1 indicating that the carboxyl group-containing monomer is alpha-beta unsaturated but he argued against the Examiner's further requirements for restriction on this ground. In support of his position he said:

If the Examiner should feel that many or most of the compounds within the general definition given in Claims 1, 2, 7, 11 or 17 and in the broad statement of invention and description given in pages 7-9, 11-13, 15-16 and 19-24 of the disclosure, would be of little or no use in forming copolymers or as crosslinking agents (as the case may be) for the thermosettable composition of this invention, then it is up to him to furnish clear and unmistakable evidence that at least some of the compounds falling within the broad definition of monomers and crosslinking agents in Claim 1 would not be useful for the intended purpose; if the Examiner cannot do so, applicants submit that there is no valid basis for any possible objection by the Examiner that the definitions which applicants have used in the claims represents mere speculative claiming.

and he continued:

In the present case the Examiner has not furnished clear and uncontrovertible evidence that compounds falling within the scope of the general definition of monomers and crosslinking agents given in Claim 1 would be useless in forming the thermosettable compositions of the present invention, thus he has no valid basis, applicants contend, for making the objection to the claims as being broader than the invention disclosed.

Applicant then went on to discuss a number of cases to argue that this specification, being addressed to a person skilled in the art rather than to a member of the general public, satisfies Section 36 of the Patent Act because a person skilled in the art would find sufficient description of the monomers and cross-linking agents to enable him to carry out the cross-linking described. In particular he relied upon Monsanto v Commissioner of Patents (1979) 2 S.C.R. 1108 and Ciba-Geigy v Commissioner of Patents, F.C.C. May 28, 1982.

After reviewing the prosecution of this application, the Board is of the opinion that the insertion of a qualifying statement into the description of the cross linking agent in claim 1 so that the claim reads in part (with the insertion shown underlined)

...a water-soluble or water-dispersible cross
linking agent reactive with the carboxyl groups....

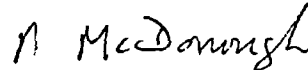
which is entirely in accordance with the disclosure, when read together with the limitation in the claims that the entire composition is in the form of a dispersion or solution in water, would restrict the definition of the cross linking agents to those which are clearly practical for the described purpose and would exclude those not practical. On the objection to the number of copolymers and oligomers covered by the claims, the Board agrees with the Applicant that in the absence of any evidence of inutility of any of the claimed subject matter, he should be permitted to make the claims.

With these considerations in mind we contacted the Patent Agent, Mr. Pole, to discuss the case with him. On February 26, 1982 a proposed amendment was submitted which would amend claim 1 in the manner discussed above, amend claim 4 to remove some ambiguous wording from that claim, amend claim 24 to avoid indefiniteness and, in addition, would make a number of editorial changes throughout the specification. The Board considers that the proposed amendment overcomes the objections to the claims and recommends that it be accepted.

In the Final Action the Examiner indicates that submission of a sample would suffice to overcome his objection based on breadth of claiming but did not require a sample to be provided. Furthermore he did not make that suggestion until the time of the Final Action. Since we have concluded that the claims as amended are not too broad, there is in fact no need for the sample.

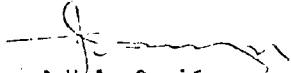


G.A. Asher
Chairman
Patent Appeal Board, Canada



A. McDonough
Member

I have reviewed the prosecution of this application and concur with the reasoning and findings of the Patent Appeal Board. Accordingly, I direct that prosecution should be resumed on the basis of the amended specification.



J.H.A. Gariépy
Commissioner of Patents

Dated at Hull, Quebec

this 9th. day of November, 1982

Agent for Applicant

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