

COMMISSIONER'S DECISION

Divisional Status, Adequate Response: No request for review by the Commissioner of a Final Action was made, and as the amendments did not totally overcome the rejection, the application became abandoned. It was reinstated and a request for review included, and subsequent amendments made. The combined amendments and the explanations were found sufficient and the rejection withdrawn.

Patent application 338,583 (Class 400-48) was filed on October 26, 1979 for an invention entitled "Roof Coating Composition and Construction". The inventor is John H. Kaufman. The Examiner wrote a Final Action on April 14, 1981 refusing to accord divisional status to this application because it contained claims that were broader in scope than the originally filed disclosure of the parent application.

This application is a divisional application and relates to a coating composition for building elements such as roofs and walls. The composition is used to form a rubbery membrane over and adhering to a surface to resist the weather. The composition comprises a mixture of two binder compositions of elastomeric-type synthetic resins and attains a predetermined glass transition temperature. It also contains a finely divided inert extender or filler as a bodying agent to provide desired flow characteristics and application properties. When the coating composition is applied to a concrete shell, it is said that moisture-escape blisters are absent from the interface because discrete copolymer (acrylic) particles are dispersed in an emulsion or latex to form a membrane with minute capillary openings for the escape of moisture.

In the Final Action the Examiner pointed out that the objectionable claims had been refused in an earlier action and that, instead of deleting them, Applicant had attempted to provide support for them by adding a passage to the disclosure of this application. As the Examiner pointed out, what had originally been an essential feature in the disclosure of the parent was now described in this new passage of disclosure as merely a preferred embodiment. This new disclosure made it materially a different disclosure, in the opinion of the Examiner.

The Examiner said that to retain divisional status the disclosure must be restored to the same state as the disclosure of the parent case and the claims that depended for their support on the newly added material must be withdrawn. The Examiner also pointed out that Applicant had made no response to a previous requirement on this matter and he pointed out that Applicant's response of December 22, 1980 did not comply with Rule 45(3) and Rule 49 of the Patent Rules.

Applicant did not request a review by the Commissioner of the Examiner's action. Instead, on October 14, 1981, he attempted to overcome the objections in the Final Action by amending the disclosure and claims. By these proposed amendments the disclosure would have been restored to describe only the material described in the parent application as originally filed and claim 6, to which the Examiner had made an objection, would have been amended in an acceptable manner. In addition Applicant presented an explanation as to why his failure to respond to the Examiner's earlier objection should not be viewed as a failure to make a bona fide attempt to advance the application to allowance. However, Applicant did not propose acceptable amendments to claim 7. Consequently, since no request for review by the Commissioner was made and since the application was not amended as required by the Examiner, under Rule 47(4) the application was considered to be abandoned and Applicant was so informed.

Subsequently, by the letter and supporting affidavits of November 13, 1981, Applicant reinstated the application and requested a review by the Commissioner under Rule 47(2). Applicant submitted two additional proposed amendments on November 4, 1981 and January 25, 1982. As a result of all these proposed amendments Applicant had responded to and complied with all the requirements of the Final Action save one, that the subject matter of rejected claim 7 be deleted or amended. In addition a new claim, claim 6, had also been submitted on January 25, 1982, relating to a method which comprised mixing the components defined in the rejected claim 7.

After the Examiner pointed out that even after all these proposed amendments all the requirements for amendment made in the Final Action had not been met, Applicant submitted a new set of five claims on December 28, 1983 and requested deletion of the claims submitted on January 25, 1982.

The issues before the Board are: whether or not the new matter that was introduced into the application by amendment removes the divisional status of the application; whether or not Applicant's response of December 22, 1980 advances the application to allowance, and whether or not the claims submitted in the response of December 28, 1983, are broader in scope than the invention disclosed.

New claim 5 reads:

A substrate coated with a coating composition, comprising an intimate mixture of a first binder component which is an aqueous acrylic copolymer emulsion for plasticizer-free caulks having a glass transition temperature (T_g) of from about -40°C to about -45°C, a second binder component which is a high solids aqueous acrylic emulsion vehicle having a glass transition temperature (T_g) of from about 5°C to about 15°C, and a finely divided extender material in an amount from 50% to 60% by weight and which provides a coating film having a glass transition temperature of from -35°C to 45°C.

In dealing with the issue of the new matter introduced by amendment, we note that Applicant in each of his amendments of October 14, 1981 and January 25, 1982, has requested that pages 4 and 4a be deleted and replaced with a new page 4 containing matter identical to that in the application as filed. We are satisfied that the amendment restores the application to its original state, and removes the rejection based on new matter.

We now consider whether the response of December 22, 1980, is acceptable.

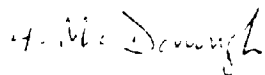
In a paragraph bridging pages 1 and 2 of Applicant's letter of October 14, 1981, he explained that he had tried to present the best possible claims on detailed aspect from a protective point of view. In view of this explanation we are

satisfied that Applicant has made a bona fide attempt to advance the prosecution of the application.

By his amendment of December 28, 1983, Applicant cancelled claims 6 and 7 and submitted claims 1 to 5. We find that new claim 5 includes the limitations which the Examiner stated in his Final Action must be present and that claims 1 to 4 are identical to claims which had not been rejected by the Examiner. We are satisfied therefore that the scope of claims 1 to 5 is the same as the scope of claims considered allowable by the Examiner.

In summary, we find that the explanations together with the amendments contained in the responses of October 14, 1981, January 25, 1982, and December 28, 1983, overcome the objections made in the Final Action.

We recommend that the above mentioned amendments be accepted and that the application be returned to the Examiner for normal prosecution.



A. McDonough
Chairman
Patent Appeal Board



M.G. Brown
Assistant Chairman



S.D. Kot
Member

I have reviewed the prosecution of this application and concur with the reasoning and the findings of the Board. Accordingly, I withdraw the Final Action and return the application to the Examiner for normal prosecution.



J.H.A. Gariépy
Commissioner of Patents

Dated at Hull, Quebec

this 13th. day of August, 1984

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