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Dickinson Wright PLLC/Sherwin Williams 1825 Eye St. N.W. Suite 900 Washington, DC 20006			DAVIS, ZACHARY M	
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* URBAN CASTELBERG and KURT HANS ASCHWANDEN

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Appeal 2023-003393  
Application 14/267,479  
Technology Center 1700

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Before TERRY J. OWENS, N. WHITNEY WILSON, and  
LILAN REN, *Administrative Patent Judges*.

WILSON, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner’s September 7, 2022 decision to finally reject claims 56–59 and 61–75 (“Final Act.”)<sup>2</sup>. An oral hearing was held on April 4, 2024, a transcript of which will be made part of the record. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

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<sup>1</sup> “Appellant” refers to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as SWIMC LLC (Appeal Br. 2).

<sup>2</sup> We note that Appellant did not provide page numbers on its Appeal Brief (no Reply Brief was filed). The Board has assigned page numbers to the Brief for purposes of reference in this decision. Appellant’s attorneys are urged to include page numbers in any future papers filed with this Board in connection with this, or any other, appeal.

.CLAIMED SUBJECT MATTER

Appellant's disclosure is directed in part to a coating composition for use on aluminum monobloc containers, which are described as typically being formed from an aluminum slug using an impact extrusion process (Abstract, Spec. ¶ 4). The coating composition comprises a polyester polymer which preferably includes one or more heterocyclic groups including a nitrogen atom and a carbonyl group. The claims are directed to articles comprising aluminum monobloc containers and coating compositions which are incorporated on interior surfaces of the containers to protect those surfaces from the packaged products contained therein (Appeal Br. 4). Claim 56, reproduced below from the Claims Appendix, is representative of the claimed subject matter:

56. An article, comprising:

an aluminum monobloc container or a portion thereof;

and

a coating formed from a spray-applied coating composition that does not include n-methyl-2-pyrrolidone (NMP), comprises an adhesion promoter and is substantially free of bisphenol A, the coating disposed on at least a portion of an interior surface of the aluminum monobloc container or a portion thereof, wherein the coating composition includes at least 15 weight percent of a polyester polymer that includes one or more heterocyclic groups having a ring that includes one or more nitrogen atoms and one or more carbon atoms of carbonyl groups, based on the total nonvolatile weight of the coating composition;

wherein the coating exhibits no corrosion or adhesion loss after storage for one week at 55 °C while contacting a mixture comprising, by volume, 1/3 dimethyl ether, 1/3 water, and 1/3 ethanol.

## REFERENCES

The Examiner relies on the following references to reject the claims:

Name	Reference	Date
Hohlein	US 5,260,138	Nov. 9, 1993
Tada	US 5,750,223	May 12, 1998
Stenson	US 2010/0260954 A1	Oct. 14, 2010
Otsuki <sup>3</sup>	JP H11-116895	
Lubrizol	2063 Technical Data Sheet	June 4, 2007

## REJECTIONS

The Examiner maintains the following rejections:

<input type="checkbox"/> Claim(s) Rejected	35 U.S.C. §	Reference(s)/ Basis
56–59, 65–68	103(a)	Tada, Otsuki
60–64	103(a)	Tada, Otsuki, Lubrizol
69–71	103(a)	Tada, Otsuki
72	103(a)	Tada, Otsuki, Lubrizol
73, 74	103(a)	Tada, Otsuki, Lubrizol, Stenson
75	103(a)	Otsuki, Lubrizol, Stenson, Hohlein

## OPINION

Appellant relies on the same arguments for each of the foregoing rejections (see, Appeal Br. 19–21). Accordingly, we decide this appeal based on Appellant’s arguments relating to claim 56.

We review the appealed rejections for error based upon the issues identified by Appellant and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential) (“Filing a Board appeal does not, unto itself, entitle an appellant to *de novo* review of all aspects of a rejection. If an appellant fails to present arguments

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<sup>3</sup> The Board relies on the machine translation of record, as do the Examiner and Appellant.

on a particular issue — or, more broadly, on a particular rejection — the Board will not, as a general matter, unilaterally review those uncontested aspects of the rejection.”), *cited with approval in In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011) (“[I]t has long been the Board’s practice to require an applicant to identify the alleged error in the examiner’s rejections.”)).

The Examiner’s findings may be found at pages 3–14 of the Answer. In general, the Examiner finds that Tada discloses the claimed monobloc aluminum container including an interior coating, but does not explicitly teach the claimed coating (Ans. 3). The Examiner further finds that Otsuki teaches a coating which meets the claimed limitations, and that it would have been obvious to use that coating in Tada’s container because it yields “excellent acid resistance, retort resistance, adhesion, and processability” (Ans. 4).

Most pertinent to our decision is the Examiner’s finding that “Table 1 and 3 of the instant specification disclose that a coating composition such as that taught by Otsuki demonstrates the required properties[,]” namely that “the coating exhibits no corrosion or adhesion loss after storage for one week at 55°C while contacting a mixture comprising, by volume, 1/3 dimethyl ether, 1/3 water, and 1/3 ethanol” as recited in claim 56.

Appellant contends that the foregoing finding implicitly is a finding that Otsuki’s coatings inherently have the claimed properties (Appeal Br. 12), and argues that the Examiner has not met the burden needed for a reliance on the doctrine of inherency (Appeal Br. 12–13).

Ultimately, the Examiner agrees that the doctrine of inherency is necessary to sustain the rejection:

Appellant argues that a *prima facie* case of obviousness was not established regarding the claimed corrosion and adhesion loss

limitation (Brief, pages 15-16). Appellant is correct. However, the claimed limitation is not obvious over the prior art; it is inherently met by a composition having the claimed components.

(Ans. 15). Accordingly, the dispositive issue is whether a preponderance of the evidence of record supports the Examiner’s finding that Otsuki’s coating inherently discloses a coating having the claimed properties.

“It is well settled that a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it. Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates.” *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002) (citations omitted). “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted).<sup>4</sup>

In this instance, as explained by Appellant – and not disputed by the Examiner (*see*, Ans. 15) the coating formulations shown in Tables 1 and 3 of Appellant’s Specification are different from the coating formulations of either Tada or Otsuki (Appeal Br. 13–14). In particular, the formulations disclosed in the Specification include an adhesion promoter (*see*, Table 1, pp. 27–28). The Specification explicitly notes that an adhesion promoter will have an effect on the claimed properties (Spec. ¶¶ 92–94). Otsuki’s formulations do not have those adhesion promoters. Accordingly, the

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<sup>4</sup> Inherency can be an issue in either the anticipation or the obviousness context. *In re Napier*, 55 F.3d 610, 613 (Fed. Cir. 1995).

evidence does not support a finding that Otsuki's coating would necessarily (i.e., always) have the claimed properties.

Therefore, we do not sustain the rejections.

### CONCLUSION

The Examiner's rejections are reversed.

### DECISION SUMMARY

The following table summarizes our decision:

<b>Claim(s) Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/ Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
56–59, 65–68	103(a)	Tada, Otsuki		56–59, 65–68
60–64	103(a)	Tada, Otsuki, Lubrizol		60–64
69–71	103(a)	Tada, Otsuki		69–71
72	103(a)	Tada, Otsuki, Lubrizol		72
73, 74	103(a)	Tada, Otsuki, Lubrizol, Stenson		73, 74
75	103(a)	Otsuki, Lubrizol, Stenson, Hohlein		75
<b>Overall Outcome</b>				56–59, 60–75

REVERSED