

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CRAIG JOHN REIBER

Appeal No. 2001-1666
Application 08/818,333

ON BRIEF

Before OWENS, WALTZ and LIEBERMAN, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1-4, 19, 21 and 26-28. Claims 5, 6, 8, 9, 12, 13, 15-18, 20 and 22-25, which are all of the other claims remaining in the application, stand withdrawn from consideration by the examiner as being directed toward a nonelected invention.

THE INVENTION

The appellant claims a process for onsite installation of decorative tiles. Claim 3 is illustrative:

3. A process for on site installation by a tile setter of small individual decorative tiles of varying sizes and shapes on a surface in a desired pattern comprising the steps of:

a) selecting a portable hand holdable matrix having ridges to locate and space a strip of tiles in the desired pattern said matrix being of sufficient stiffness to support said strip of tiles for manual handling;

b) placing tiles of the desired shape and color face down in said matrix;

c) securing a layer of perforated paper having adhesive material on the backside of said tiles to create a tile strip;

d) applying adhesive to said surface to be decorated;

e) removing said tile strip with the paper layer from said matrix and placing the tile strip against said surface to be decorated; and

f) applying grout to the spaces between said tiles.

THE REFERENCES

Worth	712,168	Oct. 28, 1902
Hopkins	1,359,893	Nov. 23, 1920
Cable	2,852,932	Sep. 23, 1958
Du Fresne	2,931,751	Apr. 5, 1960
Schmidt	3,775,856	Dec. 4, 1973
Kingston et al. (Kingston)	4,712,309	Dec. 15, 1987

THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 103 as follows: claims 1-4, 21, 26 and 27 over the appellant's admitted prior art in view of Du Fresne and Worth;¹ claim 19 over the appellant's admitted prior art in view of Du Fresne, Worth and Kingston, Knight or Cable; claims 26 and 27 over the appellant's admitted prior art in view of Du Fresne, Worth and Hopkins; and claim 28 over the appellant's admitted prior art in view of Du Fresne, Worth, Schmidt and optionally Hopkins.

OPINION

We reverse the aforementioned rejections. We need to address only one of the independent claims, i.e., claim 3.^{2,3}

¹ The examiner omits claims 26 and 27 from the rejection over the appellant's admitted prior art in view of Du Fresne and Worth in the examiner's answer (page 6). These claims are included in this rejection in the final rejection (mailed July 12, 2000, paper no. 17, page 2) and are included in the discussion of this rejection in the examiner's answer (page 9). We therefore consider the omission of claims 26 and 27 from the statement of this rejection in the examiner's answer to be inadvertent.

² Claim 1, the only other independent claim, is of comparable scope to claim 3.

³ The references applied to the dependent claims are not relied upon by the examiner for a teaching which remedies the deficiency in the applied prior art as to the independent claims.

Appeal No. 2001-1666
Application 08/818,333

During patent prosecution, claims are to be given their broadest reasonable interpretation consistent with the specification, as the claim language would have been read by one of ordinary skill in the art in view of the specification and prior art. See *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983); *In re Herz*, 537 F.2d 549, 551, 190 USPQ 461, 463 (CCPA 1976); *In re Okuzawa*, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976). Limitations, however, are not to be read from the specification into the claims. See *In re Prater*, 415 F.2d 1393, 1405, 162 USPQ 541, 551 (CCPA 1969).

The preamble of claim 3 recites that the claimed process is for on site installation of tiles. The appellant's specification indicates that "on site installation" includes not only applying, to the surface to be decorated, tiles attached to perforated paper but, rather, requires that all of the steps recited in claim 3 be carried out onsite (page 1, lines 3-19). Consequently, this is the interpretation we give to the claim.⁴

⁴ This is how the claim is interpreted by the appellant (brief, page 6) and the examiner (answer, page 14).

The appellant's admitted prior art relied upon by the examiner (answer, page 6) is the statement that "[s]ome tile installers have used a paper or fabric backing to hold a pattern of tiles together but this has been done with the gluing as a separate step and requires waiting for the glue to dry before the tile assembly can be moved" (page 1, lines 16-19).

Du Fresne discloses an offsite process wherein tiles are placed face down in a matrix, a resin emulsion adhesive is sprayed onto the backside of the tiles, an open mesh woven fabric is placed on the adhesive, the adhesive is cured, and the backing is folded onto itself to form a compact unit for shipment and ready installation (col. 3, line 25 - col. 4, line 8). The exemplified dimensions of the matrix are 2 to 4 feet wide and 4 to 8 feet long (col. 3, lines 34-35).

Worth discloses a process wherein paper, linen, or other suitable fabric or material, having any number of holes or perforations, is cemented or pasted to the rear faces of tiles having varying sizes and shapes, to form pre-assembled tiles for application to a surface by a tile installer (page 1, lines 14-28 and 59-72; page 2, lines 3-45).

Appeal No. 2001-1666
Application 08/818,333

The examiner argues that De Fresne's 2 ft by 4 ft matrix is hand holdable (pages 6-7), and that using this matrix at the site of installation would have been within the purview of the skilled artisan to more uniformly space the tiles apart and to permit handling of the tiles prior to setup of the glue used to fasten the tiles to the backing (answer, pages 14 and 16). The examiner argues that "there is simply no reason to believe that the tile installer would not have used the same techniques employed at the factory for forming the tile strip at the site of installation and such would have included the use of the template" (answer, page 14).

For a *prima facie* case of obviousness to be established, the teachings from the prior art itself must appear to have suggested the claimed subject matter to one of ordinary skill in the art. See *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). The mere fact that the prior art could be modified as proposed by the examiner is not sufficient to establish a *prima facie* case of obviousness. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

One of the benefits of Du Fresne's matrix relied upon by the examiner, i.e., uniform spacing apart of the tiles, is provided by Du Fresne's use of the matrix at the factory. The examiner has not established that one of ordinary skill in the art would have expected use of the matrix at the site of installation to be an improvement over using the matrix at the factory.

The other benefit of using Du Fresne's matrix at the site of installation relied upon by the examiner, i.e., permitting handling of the tile/backing assembly prior to set up of the glue used to hold the tile to the backing, is a benefit relative only to the admitted prior art process, because when Du Fresne's matrix is used at the factory, no setup of the glue at the site of installation is required.

The admitted prior art process requires, before the tile assembly can be moved, waiting for drying of the glue which holds the tiles to the backing (specification, page 1, lines 16-19). The examiner has not established that the applied prior art itself would have led one of ordinary skill in the art to reduce this waiting time by using Du Fresne's matrix at the site of installation, instead of eliminating this waiting time completely by using the matrix at the factory. Not only does Du Fresne use the matrix at the factory, but Worth makes pre-assembled tiles

Appeal No. 2001-1666
Application 08/818,333

for installation at the site (page 1, lines 14-28), and Cable makes tiles fastened to a grouting lattice for shipment from a factory (col. 2, lines 52-61) and teaches that prior art manufacturing methods made tiles glued to paper for shipment from a factory (col. 1, lines 39-45). The examiner does not rely upon any prior art which discloses a benefit of using a matrix at the site of installation.

For the above reasons we conclude that the examiner has not carried the burden of establishing a *prima facie* case of obviousness of the appellant's claimed invention.

DECISION

The rejections under 35 U.S.C. § 103 of claims 1-4, 21, 26 and 27 over the appellant's admitted prior art in view of Du Fresne and Worth, claim 19 over the appellant's admitted prior art in view of Du Fresne, Worth and Kingston, Knight or Cable, claims 26 and 27 over the appellant's admitted prior art in view

Appeal No. 2001-1666
Application 08/818,333

of Du Fresne, Worth and Hopkins, and claim 28 over the
appellant's admitted prior art in view of Du Fresne, Worth,
Schmidt and optionally Hopkins, are reversed.

REVERSED

)	
TERRY J. OWENS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
THOMAS A. WALTZ)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
PAUL LIEBERMAN)	
Administrative Patent Judge)	

TJO/ki

Appeal No. 2001-1666
Application 08/818,333

John E. Wagner
Wagner & Middlebrook
3541 Ocean View Blvd.
Glendale, CA 91028