

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MICHAEL A. GIALLOURAKIS

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Appeal No. 2002-1224  
Application No. 09/266,927

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ON BRIEF

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Before GARRIS, PAK, and MOORE, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-6, 8-11, 13-20, 22-24 and 26-28. Claims 7, 12, 21 and 25 stand objected to by the examiner as depending from a rejected claim but otherwise allowable. Claims 29-43 stand withdrawn from further consideration by the examiner as being directed to a

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nonelected invention.<sup>1</sup> These are all of the claims in the application.

The subject matter on appeal relates to a paint applicator apparatus comprising a backing base and a paint-applying medium connected to the lower surface of the backing base. The paint-applying medium may be a cross-section of a natural sponge or a chamois leather. This appealed subject matter is adequately illustrated by independent claims 1 and 28 which read as follows:

1. A faux finish paint applicator apparatus comprising a backing base having an upper surface and a lower surface, and a paint-applying medium connected to the lower surface of the backing base, wherein the paint applying medium is a cross-section of a natural sponge.

28. A paint pad apparatus comprising a backing base having an upper surface and a lower surface, and a paint-applying medium connected to the lower surface of the backing base, wherein the paint applying medium is chamois leather.

The references set forth below are relied upon by the examiner in the section 102 and section 103 rejections before us:

Sewell	3,083,392	Apr. 2, 1963
Tollin et al. (Tollin)	3,597,099	Aug. 3, 1971

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<sup>1</sup> As correctly indicated by the examiner in the answer (e.g., see pages 3, 8 and 9), the appellant's arguments and comments regarding claims 29-43 are simply not germane to the subject appeal since the nonelected-invention status of these claims involves a petitionable rather than an appealable issue. In re Hengehold, 440 F.2d 1395, 1403, 169 USPQ 473, 479 (CCPA 1971). Therefore, we shall not consider or further comment upon the appellant's remarks and arguments concerning the aforementioned claims.

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Hagen	3,817,178	Jun. 18, 1974
Edwards et al. (Edwards)	4,836,381	Jun. 6, 1989

Claims 1-6, 8, 9, 15-20, 22 and 23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Tollin.

Claims 1-6, 13, 15-20 and 26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Edwards.

Claim 28 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Sewell.

Finally, claims 1-6, 8, 10, 11, 13-20, 24, 26 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hagen.

On page 7 of the brief at the section entitled "GROUPING OF CLAIMS," the appellant states that "[t]he claims do not stand or fall together." However, under 37 CFR § 1.192(c)(7)(8)(2000), the patentability consideration of individual claims which are commonly rejected requires that the individual claims be separately argued as well as separately grouped. Ex parte Schier, 21 USPQ2d 1016, 1018 (Bd. Pat. App. & Int. 1991). While certain of the appealed claims have been separately argued in the "ARGUMENTS" section of the brief at pages 7-15 thereof, many of the claims have not been separately argued. Instead, the appellant has simply reiterated the feature defined by the last mentioned claims without even characterizing the feature as a

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distinction over the applied prior art. The mere reiteration of claim subject matter does not constitute an argument within the meaning of 37 CFR § 1.192(c). It follows that, in assessing the merits of the above noted rejections, we have separately considered only the claims which have been individually argued with reasonable specificity by the appellant.

We refer to the brief and reply brief and to the answer for a complete discussion of the opposing viewpoints expressed by the appellant and by the examiner concerning these rejections.

#### OPINION

For the reasons set forth in the answer and below, we will sustain each of the rejections before us on this appeal.

Concerning the section 102 rejections based on the Tollin and Edwards patents, the appellant argues that these references contain no teaching of the natural sponge feature required by the rejected claims. We agree with the examiner, however, that the "sponge" disclosure in these respective references is generic to both a synthetic as well as a natural sponge. In this regard, it is appropriate to emphasize that the appellant in his brief does not specifically contest or even acknowledge the examiner's position on this matter. Because we see no error in this position and because the appellant points to none, we consider

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this generic "sponge" disclosure of Tollin and Edwards to satisfy the natural sponge requirement of the here rejected claims.

As for the section 102 rejection of claim 28 based on Sewell, the appellant's sole "argument" is that "Sewell does not describe use of a natural sponge" (brief, page 11) and that "[c]laim 28 cannot be anticipated by Sewell because Sewell does not teach nor suggest [sic] the use of a cross section of a sponge or a natural sponge" (reply brief, page 3). As properly explained by the examiner in her answer, "[t]his argument is deemed moot because claim 28 does not require a natural sponge but [rather] a paint applying medium including chamois leather" (answer, page 8).

For the above stated reasons and the reasons expressed in the answer, we will sustain each of the section 102 rejections respectively based upon the Tollin, Edwards and Sewell references.

Regarding the section 103 rejection, the examiner states that:

Hagen fails to teach or suggest [sic] the use of a natural sponge, however, it would have been obvious to one of ordinary skill in the art to utilize a natural sponge as the paint applying medium since natural sponge has similar characteristics of the polyurethane foam such as being of an open cell construction and being capable of receiving and holding large quantities of the paint [answer, page 6].

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As the sole argument in support of his nonobviousness position, the appellant contends that the here rejected claims are patentable "because the examiner admits, 'Hagen fails to teach or suggest the use of a natural sponge...'" (brief, page 14) and "because, as Examiner points out, Hagen fails to teach or suggest the use of a natural sponge" (reply brief, page 3). This sole argument by the appellant is unpersuasive.

The examiner's above quoted statement "Hagen fails to teach or suggest the use of a natural sponge" is quite obviously an erroneous oversight. Instead, the examiner should have expressed the appealed claim distinction over Hagen by stating "Hagen fails to teach the use of a natural sponge." This error by the examiner is harmless, and the appellant's attempt to exploit this error as support for his nonobviousness position can only be regarded as unsuccessful. In this regard, we point out that the test for obviousness under section 103 is based upon what the prior art would have suggested to one with ordinary skill in the art rather than an inadvertent mis-statement by an examiner.

With the aforementioned test in mind, we share the examiner's ultimate conclusion that it would have been obvious for one with ordinary skill in the art to substitute a natural sponge for the polyurethane foam used as the paint applying

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medium of Hagen's apparatus. In essence, this is because both natural sponge and polyurethane foam are known in the art for use as a paint applying medium. Indeed, on pages 1 and 2 of his specification, the appellant refers to sponges generically as typically used to paint walls, etc. (see the paragraph bridging pages 1 and 2 and the first full paragraph on page 2 of the subject specification).

It follows that we also will sustain the examiner's section 103 rejection based on Hagen.

The decision of the examiner is affirmed.

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

AFFIRMED

Bradley R. Garris	)	
Administrative Patent Judge	)	
	)	
	)	
Chung K. Pak	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
James T. Moore	)	
Administrative Patent Judge	)	

BRG:tdl

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