

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANK PELOSI, JR.

Appeal No. 2002-1749
Application No. 09/395,270

ON BRIEF

Before STAAB, MCQUADE, and NASE, Administrative Patent Judges.
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

Frank Pelosi, Jr. appeals from the examiner's final rejection of claims 1-10, all the claims currently pending in the application.

Appellant's invention pertains to a method of applying a carpet to a subfloor. Claim 1, the sole independent claim on appeal, is exemplary of the appealed subject matter and reads as follows:

1. A method of applying a carpet to a subfloor comprising the steps of:

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providing a dimensionally stable sheet having a backing with a top side and a bottom side, said backing being made from a material and having adhesive applied to at least one of said top or bottom sides;

placing said sheet on an existing subfloor;

providing a carpet; and

placing said carpet on said sheet.

The references applied by the examiner in the final rejection are:

| | | |
|------------------------|-----------|---------------|
| Murphy et al. (Murphy) | 5,601,910 | Feb. 11, 1997 |
| Wyman | 5,902,658 | May 11, 1999 |

SIGA, *Installation Instructions Tips & Tricks*, pages unnumbered, no date available.

Shaw Indus. (Shaw), *Technical Bulletin*, Nos. 78, 82, 83, pages unnumbered (Shaw Indus., December 1995).

The following rejections are before us for review:

(1) claims 1-8 and 10, rejected under 35 U.S.C. § 103 as being unpatentable over Wyman in view of SIGA;¹

(2) claim 9, rejected under 35 U.S.C. § 103 as being unpatentable over Wyman in view of SIGA and further in view of Murphy;

¹In the final rejection, claims 1-8 and 10 were also rejected under 35 U.S.C. § 103 as being unpatentable over Wyman and claim 8 was also rejected under 35 U.S.C. § 103 as being unpatentable over Wyman in view of Shaw, however, these rejections have since been withdrawn. See page 3, lines 15 to 18, and page 4, last two lines, of the answer.

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(3) claims 1-4 and 6-8, rejected under 35 U.S.C. § 102(b) as being anticipated by Shaw;

(4) claims 5 and 10, rejected under 35 U.S.C. § 103 as being unpatentable over Shaw in view of Wyman; and

(5) claim 9, rejected under 35 U.S.C. § 103 as being unpatentable over Shaw in view of Murphy.

Reference is made to appellant's brief (Paper No. 11) and to the examiner's final rejection and answer (Paper Nos. 9 and 12) for the respective positions of appellant and the examiner regarding the merits of these rejections.

Grouping of Claims

Appellant states on page 4 of the brief that claims 1-4, 6-8 and 10 stand or fall together as a first group, that claim 5 stands or falls alone as a second group, and that claim 9 stands or falls alone as a third group. We note that these groups do not correspond to the claims as grouped according to the various grounds of rejections, and that appellant has provided separate arguments with respect to only a few of the claims. Accordingly, for each of the above noted grounds of rejections (1) through (5), the claims will stand or fall in accordance with the success or failure of appellant's arguments. See *In re Hellsund*, 474 F.2d 1307, 1309-10, 177 USPQ 170, 172 (CCPA 1973); *In re Wood*,

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582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978); and *In re Nielson*, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987).

Rejection (1)

Wyman discloses a dimensionally stable water impervious rug underlay used for adhering a rug to a carpet to prevent the rug from slipping relative to the carpet. The underlay comprises a woven backing 7 made of flat, monofilament polypropylene yarns (column 3, lines 46 to 49), with non-aggressive adhesive 10 and 11 applied to each side of the backing, to which is applied a release film 12 and 13 (column 4, lines 7 to 11). Wyman describes a method of using the underlay at column 2, lines 36 to 51. Basically, the adhesive on the top side of the underlay is exposed and the underlay is adhered to the back of a rug, whereafter the adhesive on the bottom side of the underlay is exposed so that the underlay may be adhered to an existing carpet. SIGA pertains to a pressure sensitive mesh material for applying new carpeting to existing flooring or carpeting. In SIGA, the mesh material is first adhered to the existing flooring or carpeting, whereafter the new carpeting is adhered to the mesh material.

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Independent claim 1 is directed to a method of applying a carpet to a subfloor and calls for the steps of providing a dimensionally stable sheet, placing the sheet on an existing subfloor, providing a carpet, and placing the carpet on the sheet.

As framed by appellant (see pages 4 to 7 of the answer), the dispositive issue with respect to the standing rejection of claim 1 as being unpatentable over the combined teachings of Wyman and SIGA is whether the applied prior art teaches or suggests the order or sequence of steps called for in the claim. More particularly, appellant argues as follows:

The method disclosed in Wyman does not disclose the steps of providing a dimensionally stable sheet, placing the sheet on an existing subfloor, and then placing a carpet on the sheet as recited by the Appellant Appellant strenuously disagrees with the Examiner's conclusion [that the sequence of steps is an obvious matter of choice] [T]he sequence of Appellant's steps are critical and are not merely an obvious design choice. [Brief, page 5; emphasis added.]

Unless the steps of a method claim actually recite an order, the steps are not ordinarily construed to require one. *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1369, 65 USPQ2d 1865, 1869 (Fed. Cir. 2003); *Interactive Gift Express, Inc. v. CompuServe Inc.*, 256 F.3d 1323, 1342-43, 59 USPQ2d 1401, 1416 (Fed. Cir.

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2000). See also *Loral Fairchild Corp. v. Sony Corp.*, 181 F.3d 1313, 1322, 50 USPQ2d 1865, 1870 (Fed. Cir. 1999). However, such a result can ensue when the method steps implicitly require that they be in the order written. *Interactive Gift Express, Inc. v. CompuServe Inc.*, 256 F.3d at 1342-43, 59 USPQ2d at 1416.

In the present case, nothing in the claim language requires as a matter of logic or grammar that the step of placing the sheet on an existing subfloor to be performed before the step of placing the carpet on the sheet. Moreover, nowhere in the specification is there any statement that the order of steps as written in the claim is important, or any disclaimer of any other order of steps. In this regard, while we appreciate that the method of installation described in the paragraph spanning pages 6 and 7 of the specification calls for a particular order of steps, there is no indication that this is the only order of steps that will achieve appellant's objective of providing dimensionally stability to the new carpeting. Thus, we conclude that appellant's claim 1 does not require the step of placing the sheet on an existing subfloor to be performed before the step of placing the carpet on the sheet. It follows that appellant's

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position that the method recited in claim 1 distinguishes over the method disclosed by Wyman by virtue of performing the steps in the order written in the claim is not persuasive.

We therefore shall sustain the standing 35 U.S.C. § 103 rejection of claim 1 as being unpatentable over Wyman in view of SIGA. We shall also sustain the standing 35 U.S.C. § 103 rejection of claims 2-8 as being unpatentable over Wyman in view of SIGA since appellant has not separately argued these claims with any reasonable degree of specificity.

Claim 10 depends from claim 1 and adds, among other things, that the thickness of the backing is approximately 1 mil to approximately 2 mils. With respect to claim 10, appellant argues (brief, page 5, lines 20 to 21, that the claimed thickness is not an obvious variant depending on the application surface. We agree.

Wyman discloses (column 3, lines 2-4) that the thickness of the underlay is approximately 1 mm, which is about 20 to 40 times the claimed thickness of approximately 1 to 2 mils.² SIGA, the other reference relied upon in the rejection, is silent as the thickness of the mesh material used as a carpet underlay. In

²1 mm = 39.37 mils.

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addition, appellant's specification at page 6, lines 5 to 10, indicates that the claimed thickness range is selected to be thick enough to be dimensionally stable yet not so thick that it functions to add additional padding. Under these circumstances, the claimed range cannot be dismissed as a matter of design choice, as the examiner appears to have done. *Compare In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975), where the use of particular connection in lieu of those used in the prior art was held to be an obvious matter of design choice within the skill in the art *where the particular connection solves no stated problem*. Here, the claimed thickness range is described in the specification as solving a stated problem (i.e., providing a degree of dimensional stability without providing additional padding) and therefore cannot be dismissed as a matter of design choice.

In light of the foregoing, we shall not sustain the rejection of claim 10 as being unpatentable over Wyman in view of SIGA.

Rejection (2)

Claim 9 depends from claim 1 and adds that the backing is made from a spun-bonded, non-woven fabric having a thickness of approximately 8 mils.

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In rejecting this claim, the examiner relies on Murphy for its showing of a rug underlay made of a non-woven material. Concerning the thickness range called for in the claim, the examiner states (answer, page 5) that "[i]f one were experiencing a lack of stability of the backing, merely increasing the thickness of the backing would have been well within the purview of one of ordinary skill in the art." Appellant counters (brief, page 8) that none of the cited references teaches a spun-bonded, non-woven fabric with a thickness of approximately 8 mils, that such a fabric is not an obvious design choice, and that the particular fabric and thickness are important to appellant's invention.

The appellant's position is well taken. First, the underlay of Wyman would have to be made thinner, rather than thicker as implied by the examiner, in order to conform to the thickness of approximately 8 mils called for in the claim. In any event, the applied prior art does not disclose, suggest or teach the claimed fabric with the claimed thickness, and, for the reasons explained above in our treatment of claim 10, the claimed thickness cannot be dismissed as a matter of design choice.

Accordingly, we shall not sustain the rejection of claim 9 as being unpatentable over Wyman in view of SIGA and Murphy.

Rejections (3) to (5)

Fundamental to each of these rejections is the examiner's position that claim term "dimensionally stable" is broad and "virtually meaningless since even the most loosely woven or no woven [sic, non-woven] material has at least some degree of dimensional stability" (answer, page 4). Based on this interpretation, the examiner concluded that the mesh material underlay of Shaw is dimensionally stable at least to some degree, such that the method of Shaw includes the step of providing a dimensionally stable sheet.

In proceedings before it, the PTO applies to the verbiage of claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification. *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). In the present case, appellant's specification does not contain a precise definition of the term "dimensionally stable." However, in the "Background of the Invention" section of the specification it is explained on page 1 that laying broadloom carpet is often a difficult process because the carpet

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itself "is not completely *dimensionally stable*. That is, when one walks across broadloom carpet that has been installed, *it can shift in lateral directions or stretch*" (emphasis added). In keeping with this statement, we consider that the one of ordinary skill in the art would understand the term "dimensionally stable" as used in appellant's claims to denote that the sheet of backing material would not shift or stretch in lateral directions to any significant degree when one walks across it.

Returning to Shaw, the description of the underlay used therein is rather meager. The only enlightenment as to its nature is found in the description in several places (see, for example, Shaw #78, left column under the heading "General Information") that the carpet is secured to the floor by a dry sheet bonding process which uses "a pressure sensitive mesh material." Based on the sparse disclosure of Shaw regarding the nature of the underlay sheet, we consider that the examiner has not made out a *prima facie* case that the underlay sheet of Shaw is "dimensionally stable" as that term would be understood by one of ordinary skill in the art. See *In re Turlay*, 304 F.2d 893, 899, 134 USPQ 355, 360 (CCPA 1962) (it is well settled that an anticipation rejection cannot be predicated on an ambiguous reference).

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For this reason, we shall not sustain the anticipation rejection of claims 1-4 and 6-8 based on Shaw. We also shall not sustain the Section 103 rejection of claims 5 and 10 based on Shaw in view of Wyman, or the Section 103 rejection of claim 9 based on Shaw in view of Murphy, since, for the reasons stated above, Shaw's underlay cannot be said to be "dimensionally stable," and the examiner does not propose that it would have been obvious to modify Shaw such that the underlay thereof is a "dimensionally stable" material.

Summary

The rejection of claims 1-8 as being unpatentable over Wyman in view of SIGA is affirmed.

All other rejections are reversed.

The decision of the examiner is affirmed-in-part.

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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-IN-PART

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| LAWRENCE J. STAAB |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| JOHN P. MCQUADE |) | APPEALS AND |
| Administrative Patent Judge |) | INTERFERENCES |
| |) | |
| |) | |
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