

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 JOHN C. CAPOCCIA

Appeal No. 2004-1142
Application No. 09/892,001

ON BRIEF

Before PAK, WALTZ, and JEFFREY T. SMITH, **Administrative Patent Judges**.

WALTZ, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's final rejection of claims 11 through 20, which are the only claims remaining in this application.¹ We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellant, the invention is directed to a method for creating two-color faux paint finishes on surfaces by using a pair of paint applicator heads carried by a single core

¹Claims 1-10 were cancelled in appellant's amendment subsequent to the final rejection (see the amendment dated Jan. 7, 2003, Paper No. 9, entered as per the Advisory Action dated Jan. 21, 2003, Paper No. 10; Brief, page 5).

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mounted on a paint roller handle assembly, where the roller pan is divided into two paint reservoirs created by a central divider wall to enable the user to roll each applicator head separately in each paint reservoir simultaneously (Brief, page 7).

Appellant states that the claims are not in a single group but each stands on its own (Brief, page 10). However, as correctly noted by the examiner (Answer, pages 2-3, ¶(7)), appellant has not provided specific, substantive reasons for the separate patentability of any individual claim (see the Brief in its entirety). Accordingly, we select one claim from each group of rejected claims (i.e., claims 11, 12 and 13) and decide the grounds of rejection in this appeal on the basis of these claims alone. See 37 CFR § 1.192(c)(7)(2002); *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002).

Representative independent claim 11 is reproduced below:

11. Method for applying two different paint sources, which comprises:

(a) providing a paint roller, which comprises an annular applicator which surmounts a single interior annular core, said applicator having a central valley for forming a pair of spaced-apart first and second applicator heads, said paint roller being mounted on a paint roller handle assembly;

(b) providing a roller pan having a central divider wall for forming a first and a second paint reservoir adapted to be simultaneously accessed by the applicator heads, wherein the depth of the central valley is at least about as great as the height of the pan divider wall;

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(c) placing a first paint source in said first paint reservoir and a second paint source in said second paint reservoir; and

(d) simultaneously rolling first applicator head in said first paint source and said second applicator head in said second paint source,

whereby said paint roller is capable of simultaneously creating two paint source finishes.

The examiner relies upon the following references as evidence of obviousness:

Wakat	6,117,494	Sep. 12, 2000
Jackson et al. (Jackson)	6,330,731 B1	Dec. 18, 2001 (filed Oct. 2, 1998)
Tolchiner (U.S. Patent Application Publication)	US 2001/0047560 A1	Dec. 06, 2001 (filed Feb. 23, 2001)

Claims 11 and 19-20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Wakat (Answer, page 3). Claims 12 and 13 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Wakat in view of Tolchiner (Answer, page 5). Claims 13-18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Wakat in view of Jackson (Answer, page 8). We *affirm* all of the rejections on appeal essentially for the reasons stated in the Answer and those reasons set forth below.

OPINION

A. The Rejection over Wakat

The examiner finds that Wakat discloses a method and apparatus for applying multiple paint colors simultaneously where

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a paint roller is formed with an annular applicator with a single annular core attached to a paint roller handle, with the applicator having a central valley forming two spaced apart first and second applicator heads, each head capable of accessing a roller paint pan provided with a central divider wall so that different paints can be simultaneously applied to a surface (Answer, pages 3-4). The examiner recognizes that Wakat fails to specifically teach the height of the pan divider wall (Answer, page 5). However, the examiner finds that Wakat teaches that the pan is to be designed dependent on the design of the roller apparatus so that the rollers are capable of dipping into the paint reservoir simultaneously (*id.*). Therefore, based on these findings, the examiner concludes that it would have been obvious to one of ordinary skill in this art to have provided pan measurements such that each roller head could be dipped into the paint reservoir simultaneously as required by Wakat (*id.*). We agree.

Appellant's principle argument is that Wakat does not teach a single core, but rather two separate cores upon which roller covers are mounted, in order that "each roller rolls *separately* from an adjacent roller." Brief, page 11. Appellant submits

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that the single core of the present invention means that both roller covers must turn at the same rate and turn together (*id.*).

These arguments are not well taken since Wakat clearly discloses all the features of the roller as recited in claim 11 on appeal, particularly since the axle 112 of Wakat is a single annular axle in the interior and at the core of the roller cover holder, thus corresponding to the "single interior annular core" as claimed (Answer, page 11). Appellant is correct that "[a] single core cannot roll at different rates" (Brief, page 11). However, Wakat does not teach that the single interior annular core (axle 112) rolls at different rates. Wakat teaches a roller apparatus that allows "each of the *roller covers* to rotate at different speeds" (col. 3, ll. 24-26, italics added; see also col. 6, ll. 2-5). As explained by Wakat, the roller covers do not move at different speeds when the roller apparatus is moved straight up or down but

...when the roller apparatus **100** or **200** is moved in an arcuate manner or other than straight up and down, the rollers on the outside of the arc are capable of moving along at a faster velocity than the roller covers toward the inside of the arc. In other words, each roller rolls separately from an adjacent roller. [col. 5, ll. 36-41].

Accordingly, we agree with the examiner that Wakat teaches dual roller heads mounted on a single core as recited in claim 11 on appeal.

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Appellant presents a similar argument with respect to the "paint roller handle assembly," namely that Wakat does not disclose a single core that rotates at the same rate for each roller cage (Brief, page 13). Regarding this argument, we adopt our comments from above. Appellant further argues that the assembly of Wakat has two separate cages upon which the roller covers are press fitted while appellant's assembly is made from a "conventional" paint roller handle assembly. This argument is not well taken since appellant has not pointed out how the paint roller handle assembly *as claimed* differs from the handle assembly disclosed by Wakat (see the Answer, page 14). Arguing limitations not found in the claims on appeal is not persuasive. See *In re Huang*, 100 F.3d 135, 139, 40 USPQ2d 1685, 1688 (Fed. Cir. 1996).

For the forgoing reasons and those stated in the Answer, we determine that the examiner has established a *prima facie* case of obviousness in view of the reference evidence. Based on the totality of the record, including due consideration of appellant's arguments, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of section 103(a). Accordingly, we affirm the examiner's

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rejection of claims 11 and 19-20 under 35 U.S.C. § 103(a) over Wakat.

B. The Rejection over Wakat in view of Tolchiner

Appellant presents no arguments on the merits concerning the combination of Wakat and Tolchiner (Brief, page 17).

Accordingly, we adopt the examiner's findings of fact and conclusion of law with respect to this rejection (Answer, pages 5-6 and 18).

Appellant's sole argument against Tolchiner is that this reference is not available as prior art against the claims on appeal since appellant should be afforded an effective filing date of June 25, 1999, for this appealed application (Brief, pages 15-16). Appellant's argument is not persuasive for the following reasons.

Appellant admits that the effective filing date of Tolchiner is Feb. 24, 2000 (Brief, page 16; see 35 U.S.C. § 102(e) (11/29/2000) and § 119(e) (1) (11/29/2000)). Appellant attempts to claim benefit of priority of SN 09/803,463, now U.S. Patent No. 6,289,548 (hereafter the '548 patent; Brief, page 15). However, the '548 patent was filed on March 9, 2001 (specification, page 1). Thus, even assuming *arguendo* that appellant is entitled to the effective date of the '548 patent, the undisputed effective date of Tolchiner is before appellant's effective date and

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Tolchiner is thus available as prior art against the claims on appeal. The effective date desired by appellant is June 25, 1999 (Brief, page 16), which is the filing date of grandparent application SN 09/344,479, now abandoned (specification, page 1). Although the '548 patent is recited as a "continuation" of application SN 09/344,479 (*id.*), appellant must establish that the essential matter (the depth of the central valley being at least about as great as the height of the pan divider wall) is found in this grandparent application SN 09/344,479. Appellant has not met this burden.

Most importantly, appellant must establish that the essential matter discussed above finds support in accordance with 35 U.S.C. § 112, ¶1, throughout the chain of applications if the date of the grandparent application is sought. *See In re Schneider*, 481 F.2d 1350, 1356, 179 USPQ 46, 50 (CCPA 1973). Appellant's reliance on U.S. Patent 5,713,095 (hereafter the '095 patent) is misplaced (Brief, page 15). First we note the '095 patent was not incorporated-by-reference for the essential matter discussed above, but was merely cited as an example where a more complex method of manufacture was used (see the '548 patent, col. 5, ll. 49-50, and col. 6, ll. 39-40). There is no teaching in the '548 patent (nor presumably in SN 09/344,479) that the paint

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pan dimensions in relation to the central valley of the '095 patent should be used in appellant's invention. Secondly, as noted by the examiner (Answer, pages 7-8 and 16-17) and not disputed by appellant, the '095 patent does not show the critical requirements of claim 11 on appeal.

For the foregoing reasons and those stated in the Answer, we determine that appellant has not established that he should be accorded the benefit of the effective filing date of June 25, 1999. Accordingly, we agree with the examiner that Tolchiner is available as prior art against the claims on appeal.

C. The Rejection over Wakat in view of Jackson

Appellant merely reiterates the same argument against Jackson as argued against Wakat, namely that Jackson discloses a dual head roller assembly where the roller heads roll independently (Brief, page 18). As noted by the examiner, this argument does not address the reasons for combining Wakat and Jackson (Answer, pages 8-9 and 19-20). Accordingly, we adopt our discussion about Wakat from above, as well as adopt the examiner's findings of fact and conclusion of law from the combination of Wakat and Jackson as stated in the Answer.

D. Summary

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The rejection of claims 11 and 19-20 under 35 U.S.C. § 103(a) over Wakat is affirmed. The rejection of claims 12-13 under 35 U.S.C. § 103(a) over Wakat in view of Tolchiner is affirmed. The rejection of claims 13-18 under 35 U.S.C. § 103(a) over Wakat in view of Jackson is affirmed. Therefore the decision of the examiner is affirmed.

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

AFFIRMED

CHUNG K. PAK)	
Administrative Patent Judge)	
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THOMAS A. WALTZ)	
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