The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte MARK H. COPP

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Appeal No. 2006-1062
Application No. 10/246,994

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ON BRIEF

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Before KIMLIN, PAK and FRANKLIN, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 4-7, 14 and 16, all the claims remaining in the present application. Claim 4 is illustrative:

> 4. A hand held paint shield assembly for providing protection for a masked surface comprising in combination:
>
> a handle having a proximal end and a distal end, said proximal end rigidly connected with a paint shield;
>
> a paint shield formed as a generally flat, elongated

plate having a straight longitudinal distal edge, a working surface against which paint is collected when said distal edge is held against a surface being painted and a non-working surface in partial contact with the masked surface during operation; and

a plurality of overlying and paint impervious cover elements, in a detachably stacked relationship, each said element having an upper surface and a lower surface, each said lower surface including a pressure sensitive adhesive coating upon at least a portion thereof, said pressure sensitive adhesive on at least one element adhesively connected to said paint shield, said elements arranged in overlying and juxtaposed relationship thereby providing a plurality of renewable and multi-use protective upper surface of said cover elements, said cover elements in contiguous contact with the paint shield for providing substantially complete protective cover to said paint shield.

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

De Guzman	4,917,975	Apr. 17, 1990
Frazier	4,937,910	Jul. 3, 1990
Thompson	4,962,722	Oct. 16, 1990
Holt	5,201,954	Apr. 13, 1993
Su	5,286,546	Feb. 15, 1994
Renetta	6,315,831	Nov. 13, 2001

Appellant's claimed invention is directed to a hand held paint shield for protecting a surface to be masked during painting. The assembly comprises a generally flat, elongated plate connected to a handle. The working surface of the paint shield collects the paint that is masked and is protected by a plurality of overlying, paint impervious cover elements. A

pressure sensitive adhesive is used to render the cover elements detachable with respect to each other. According to the present specification, "[c]ommercially available paint shields have the unavoidable disadvantage of accumulating excess paint on their distal edge and working face" (page 3, lines 3-5). The specification further states that "[t]o avoid these disadvantages the painter is required to frequently clean the paint shield manually by wiping it with a cloth to remove the excess paint" (page 3, lines 11-13). Hence, the purpose of the claimed invention is to eliminate the problem of excess paint accumulating on the working surface of the paint shield and dripping in areas where it is not wanted.

The appealed claims stand rejected under 35 U.S.C. § 103(a) as follows:

(a) claims 4 and 5 over Thompson in view of Holt,

(b) claims 6 and 7 over the stated combination of references further in view of De Guzman,

(c) claim 14 over Thompson in view of Holt and further in view of either Frazier or Su, and

(d) claim 16 over Thompson in view of Holt and Renetta.

We have thoroughly reviewed each of appellant's arguments for patentability. However, we are in complete agreement with

the examiner's reasoned analysis and application of the prior art, as well as her cogent and thorough disposition of the arguments raised by appellant. Accordingly, we will adopt the examiner's reasoning as our own in sustaining the rejections of record, and we add the following for emphasis only.

There is no dispute that Thompson discloses what appellant admits to be known in the present specification, namely, a hand held paint shield of the type claimed without the plurality of paint impervious cover elements on the working surface. However, we fully concur with the examiner that Holt evidences the obviousness of employing such a plurality of cover elements on any surface that is to be protected or masked during a painting operation, whether it be the wall of a building, as disclosed by Holt, or the working surface of Thompson's paint shield. We find Thompson and Holt to be analogous art since both are directed to the problem of shielding areas that are not to be painted. As noted above, appellant's specification acknowledges that the problem of paint accumulating on the working surface of the paint shield was known in the art, and we have no doubt that the solution of this problem would have been readily apparent to one

of ordinary skill in the art i.e., using a plurality of covers of the type disclosed by Holt. See In re Ludwig, 353 F.2d 241, 244, 147 USPQ 420, 421. (CCPA 1965).

We do not subscribe to appellant's position that Thompson teaches away from using the covers of Holt by stating that conventional taping and laying of sheets of paper to mask surfaces are time consuming and not cost effective. The teaching of Thompson is that the inventive paint shield is preferable to the conventional methods of masking a surface and would not teach against covering the shield itself to prevent the undesirable accumulation of paint.

Appellant also maintains that "Holt is not directed to separating a surface not being painted from a surface being painted" (page 7 of brief, third paragraph). According to appellant, "[t]here is no shielding or protection of a surface to be left unpainted in the Holt patent" (id.). This argument is without merit, however, inasmuch as Holt indeed provides separation between the wall not to be painted and the car that receives the paint.

Regarding claims 6 and 7, we agree with the examiner that, based on De Guzman, it would have been obvious for one of ordinary skill in the art "to provide a tab in cooperation with and extending from each protective sheet cover element in a stack of protective sheet cover elements with an adhesive free tab to facilitate removal of a sheet cover element from the stack as well as enable a quantity of the elements to be ascertained upon visual inspection" (paragraph bridging pages 4 and 5 of answer). We are not persuaded by appellant's argument that there is nothing in De Guzman "that relates to protecting a surface not being painted from a surface being patented" (page 8 of brief, third paragraph). As explained by the examiner, De Guzman is cited for establishing that it was known in the art to use tabs to facilitate removing a sheet from a stack and to prompt the user regarding the number of sheets remaining in the pack.

We also find no fault in the examiner's conclusion that, based on the teachings of Frazier or Su, it would have been obvious for one of ordinary skill in the art to extend the lower most backing layer from the working surface around to the non-working area to ensure proper tightness or tension of the cover elements, or to inform the user when the bottom layer is reached.

As for claim 16, appellant does not contest the examiner's legal conclusion that one of ordinary skill in the art would have found it obvious to taper the surface of the paint shield, as disclosed by Renetta.

As a final point, we note that appellant bases no argument upon objective evidence of nonobviousness, such as unexpected results, whcih would serve to rebut the prima facie case of obviousness established by the examiner.

In conclusion, based on the foregoing and the reasons well-stated by the examiner, the examiner's decision rejecting the appealed claims 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

EDWARD C. KIMLIN Administrative Patent Judge	)	
CHUNG K. PAK Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
BEVERLY A. FRANKLIN Administrative Patent Judge	)	

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