

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

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL E. BROKAW

Appeal 2006-2864
Application 10/211,746
Technology Center 1700

Decided: March 23, 2007

Before EDWARD C. KIMLIN, CHARLES F. WARREN, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the Examiner's final rejection of claims 1-4 and 11-22, the only claims pending in this application. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

Appellant's invention relates to a method for attaching an object to a surface using an adhesive, such as double-sided adhesive tape. The bonding or adhesion of the adhesive to the surface is enhanced by rubbing the surface with a rubber or soap eraser prior to applying the adhesive tape. According

to Appellant, prior to the invention, “there was no appreciation of a need for, and the advantages of, rubbing a surface with an eraser prior to bonding an object to the surface with double sided adhesive tape.” (Br. 2, ¶ V).

Independent claims 1 and 20 are illustrative of the invention:

1. A method of attaching an object to a surface, comprising:

rubbing the surface with a rubber or soap eraser; and

using double-sided adhesive tape at the rubbed surface to hold the object to the surface.

20. A method of attaching a storage rack to a surface of a room or building wall or furniture, comprising the steps of:

rubbing an eraser against an area of the surface a number of strokes;

applying adhesive to at least one of the area of the surface at which the eraser had been rubbed and the storage rack; and

pressing the object against such area with adhesive between the area and the storage rack.

In addition to Appellant’s admitted prior art, (“APA”, Specification 1: 9-20), the Examiner relies on the following prior art references to show unpatentability:

Jialanella	US 4,526,811	Jul. 2, 1985
Ficho	US 4,880,377	Nov. 14, 1989
Kreckel	US 5,672,402	Sep. 30, 1997

The Examiner made the following rejections:

1. Claims 1-4, 14-18 and 20-22 under 35 U.S.C § 103(a) as unpatentable over the admitted prior art (APA) in view of Jialanella. (Answer 3-5, ¶ 2).
2. Claims 11-13 under 35 U.S.C § 103(a) as unpatentable over the admitted prior art (APA) in view of Jialanella as applied to claim 1, and further in view of Kreckel. (Answer 5, ¶ 3).
3. Claim 19 under 35 U.S.C § 103(a) as unpatentable over the admitted prior art (APA) in view of Jialanella as applied to claim 1, and further in view of Ficho. (Answer 6, ¶ 4).

ISSUES

The Examiner contends that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify known methods of attaching an object to a surface with an adhesive by rubbing the surface with an eraser to improve adhesion, because use of an eraser to clean a surface is well known and conventional. Appellant contends that the Examiner has not established the requisite motivation to combine or modify the applied prior art to achieve the claimed invention. The issue before us is “has the Examiner properly established a *prima facie* case of obviousness within the meaning of 35 U.S.C § 103(a)?”

For the reasons discussed below, we answer this question in the affirmative. Accordingly, we affirm as to all three grounds of rejection.

FINDINGS OF FACT

- 1) At the time of the invention, it was known in the art that “[s]torage racks for small articles, ranging from pencils and pens to other items such as paint brushes, cassettes, computer floppy disks, small containers and

electrical cords are available in many sizes, styles, constructions and configurations.” (APA, Specification 1:9-11).

- 2) At the time of the invention, one of ordinary skill in the art was familiar with mounting storage racks to a support surface using an adhesive, such as a double sided adhesive tape, by placing the adhesive between the storage rack and the support surface. (APA, Specification 1:12-14).
- 3) One of ordinary skill in the art at the time of the invention was aware that the bond strength of the adhesive is effected by films, contaminants and the like that are present on the support surface. (APA, Specification 1:12-14).
- 4) At the time of the invention, one of ordinary skill in the art was aware that various cleaning methods were useful in removing contaminants from a surface. (APA, Specification 1:16-17).
- 5) At the time of the invention, a well known and conventional method of cleaning a surface was by rubbing an eraser against the area to be cleaned. (Official notice of fact by the Examiner, *see* Final Rejection 2, ¶ 2).

PRINCIPLES OF LAW

- 1) Description of prior invention by others which appears in an Applicant’s Specification may be relied on by the Examiner in a prior art rejection of the Applicant’s claimed invention. *See In re Nomiya*, 509 F.2d 566, 571 n. 5, 184 USPQ 607, 611-12 n. 5 (CCPA 1975) (figures labeled prior art in appellants’ patent application were properly considered in determining obviousness of appellants’ claimed improvement) and *In re Fout*, 675 F.2d 297, 301, 213 USPQ 532, 536

(CCPA 1982) (applicant's admission of actual knowledge of the prior invention of another, described in the preamble of a Jepson claim, held to constitute an admission that described invention was prior art to the applicant).

- 2) The Examiner may take official notice of facts unsupported by documentary evidence where the facts are asserted to be well-known, or to be common knowledge in the art and are "capable of such instant and unquestionable demonstration as to defy dispute" *In re Ahlert*, 424 F.2d 1088, 1090, 165 USPQ 418, 420 (CCPA 1970) (holding that the Board properly took judicial notice that "it is old to adjust intensity of a flame in accordance with the heat requirement").
- 3) Board may affirm a rejection under 35 U.S.C. § 103 based on Examiner's official notice of facts, without citation of references, where Appellant was sufficiently put on notice of the basis of the rejection and did not challenge the truth of the Examiner's assertion. *See In re Lundberg*, 244 F.2d 543, 551, 113 USPQ 530, 537 (CCPA 1957) (examiner's statement accepted as true in light of appellant's failure to question its accuracy or to present contradicting evidence); *In re Fox*, 471 F.2d 1405, 1406-07, 176 USPQ 340, 341 (CCPA 1973) (affirming rejection under 35 U.S.C. § 103 without citation of any prior art based on facts that were unchallenged by the appellant).
- 4) The criterion for determining whether a rejection is considered "new" is whether the appellants have had an opportunity to respond to the "thrust of the rejection." *See In re Kronig*, 539 F.2d 1300, 1302, 190 USPQ 425, 426 (CCPA 1976). *See also, In re De Blauwe*, 736 F.2d 699, 706 n. 9, 222 USPQ 191, 197 n. 9 (Fed. Cir. 1984).

ANALYSIS

The Examiner relies on Appellant's APA to provide the teaching of attaching an object such as a storage rack to a support surface. (Answer 6, ¶ 5). The Examiner also relies on the APA for a teaching of cleaning any surface prior to applying adhesive material to that surface. (Answer 7, ¶ 6). The Examiner takes official notice of the fact that "cleaning [a] surface by rubbing an eraser against an area is well known and conventional" (Answer 3, ¶ 2). We conclude that these findings are sufficient to establish a prima facie showing of obviousness.

Appellant argues that the Examiner has repeatedly changed his reasons for establishing that one of ordinary skill in the art would have been motivated to combine the APA and Jialanella in the manner claimed. Appellant maintains that the Examiner's arguments have changed since issuance of the Final Office Action and, therefore, the Examiner should have withdrawn the finality of the action and issued a new Office Action. (Reply Br. 2-3). Appellant argues that the Examiner improperly used the application disclosure as motivation to combine the references. (Br. 4-5). Appellant also attempts to rebut the Examiner's obviousness rejections by arguing that one of ordinary skill in the art would not have been motivated to combine the teachings of Appellant's APA and Jialanella.

Contrary to Appellant's assertion, the fundamental basis of the Examiner's rejections, as stated in the Final Rejection, has not changed. *Compare* Final Rejection 2-3, ¶ 2, with the Answer (relevant portions noted

above) and Advisory Action 2.¹ The Appellant was sufficiently put on notice of the basis of the rejection in the Final Office Action, but has not challenged the truth of the Examiner's assertion that "cleaning [a] surface by rubbing an eraser against an area is well known and conventional." Moreover, we find that the Examiner, in rejecting the claims as unpatentable over the APA, properly relied on only those portions of Appellant's Specification which clearly describe what was known by those of ordinary skill in the art at the time of Appellant's invention. Jialanella was cited as *an example* of a method in which an eraser is employed to clean a surface. (Answer 4-5, ¶ 2) and (Final Rejection 2, ¶ 2) ("cleaning the surface by rubbing an eraser against an area is well known and conventional as shown *for example* by Jialanella") (emphasis added). Accordingly, we do not find Appellant's argument regarding lack of motivation to combine Appellant's APA and Jialanella persuasive in overcoming the Examiner's prima facie showing of obviousness.

Appellant does not present any arguments that are reasonably specific to any particular claim on appeal. Accordingly, we conclude that the Examiner's findings are sufficient to establish a prima facie showing of unpatentability of appealed claims 1-4 and 11-22 under 35 U.S.C. § 103.

¹ We note that the issue of whether the Examiner raised a new ground of rejection is a petitionable one not subject to our review.

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ORDER

The rejection of claims 1-4, 14-18 and 20-22 under 35 U.S.C § 103(a) as unpatentable over Jialanella in view of the admitted prior art (APA) is affirmed.

The rejection of claims 11-13 under 35 U.S.C § 103(a) as unpatentable over Jialanella and the admitted prior art (APA) in view of Kreckel is affirmed.

The rejection of claim 19 under 35 U.S.C § 103(a) as unpatentable over Jialanella and the admitted prior art (APA) in view of Ficho is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

tf/ls

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