

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 JAMES N. HARDWICK

Appeal 2007-1124¹
Application 10/349,639
Technology Center 1700

Decided: May 21, 2007

Before CATHERINE Q. TIMM, JEFFREY T. SMITH, 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 24-38, 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 vinyl tiles for use as surface coverings. The individual tiles are routed and mechanically embossed on two adjacent

¹ An oral hearing was held on May 9, 2007.

edges. When installed, the surface covering has the appearance of individual tiles, each having grout lines on all edges. Specification [0001].

Independent claims 24 and 34 are reproduced below:

24. A surface covering, comprising:

a resilient tile having an even number of edges wherein one-half of said even number of edges have been routed, mechanically embossed to impart a texture thereon, and covered with a coating or an ink, and the other one-half of said even number of edges have not been routed;

wherein each of said routed edges is adjacent to at least one other routed edge.

34. A resilient tile having an even number of edges and comprised of a resilient composite substrate having a first upper surface, a printed film layer or an inlaid layer having a second upper surface, said printed film layer or inlaid layer overlaying and adhered to said first upper surface, and an optional top coat layer overlaying and adhered to said second upper surface, one half of the even number of edges having a reduced thickness and a third upper surface thereon, said third upper surface being approximately parallel to said first and second upper surfaces and having a mechanically embossed texture, said one half of the even number of edges being adjacent to one another, the other half of the even number of edges optionally being beveled edges.

The Examiner relies on the following prior art references to show unpatentability:

| | | |
|------------|--------------|---------------|
| Hodakowski | US 4,212,899 | Jul. 15, 1980 |
| Smith | US 4,678,528 | Jul. 7, 1987 |
| Ehrhart | US 5,362,560 | Nov. 8, 1994 |

The Examiner made the following rejections:

1. Claims 34 and 36-38 under 35 U.S.C. § 102(b) as anticipated by Smith;

2. Claim 35 under 35 U.S.C. § 103(a) as unpatentable over Smith;
3. Claims 24-30, 32, and 33 under 35 U.S.C. § 103(a) as unpatentable over Smith in view of Ehrhart; and
3. Claim 31 under 35 U.S.C. § 103(a) as unpatentable over Smith in view of Ehrhart and further in view of Hodakowski.

ISSUES

- I. The Examiner contends that Smith anticipates the invention as claimed in claims 34 and 36-38. Appellant contends that Smith fails to disclose tile edges having a mechanically embossed texture. The issue for us to decide is: Has the Examiner shown that Smith, either expressly or inherently, discloses the feature of mechanically embossed texture on the tile edges?
- II. The Examiner contends that Appellant's claimed surface covering would have been obvious to one of ordinary skill in the art at the time of the invention in view of the combined teachings of Smith and Ehrhart. Appellant contends that the Examiner's proposed combination fails to teach or suggest the claimed feature of the tile edges having a mechanically embossed texture. The issue before us is: Has the Examiner shown that it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the feature of mechanically embossed texture to the edges of tile based on the combined teachings of Smith and Ehrhart?

For the reasons discussed below, we answer both of these questions in the negative. Accordingly, we reverse as to all four grounds of rejection.

RELEVANT FINDINGS OF FACT (“FF”)

- 1) The term “bevel” refers to the angle or inclination of a line or surface that meets another at any angle but 90°. The American Heritage Dictionary of the English Language, (4th ed. 2006). *See Answer*, 9 n.1.
- 2) Smith discloses a method and apparatus for making a solid vinyl tile on which a decorative layer of print has been embossed. Col. 3, ll. 34-37.
- 3) Smith’s method includes the steps of transferring a layer of print 19 from a preprinted release paper to a plastisol layer 14, laminating the print and plastisol layers to a continuous base web 31, embossing the laminate in register with the print, tile cutting in register with the embossing and print, beveling the cut tiles and applying a urethane coating. *See* col. 3, ll. 42-53.
- 4) Smith discloses that the beveling step results in smooth edges. Col. 7, ll. 35-36.
- 5) Ehrhart discloses a rigid tile having a flexible interlocking edge configuration. Abstract.
- 6) The edges of Ehrhart’s tile are made of a flexible grout material such as a urethane and interlock by means of a tongue and groove or shiplap configuration. Col. 2, ll. 5-8.

ANALYSIS AND CONCLUSIONS

- I. Has the Examiner shown that Smith, either expressly or inherently, discloses the feature of mechanically embossed texture on the tile edges?"

Appellant argues that Smith cannot anticipate the claims because Smith fails to disclose a mechanically embossed texture on the tile edges. Br. 8. Although the Examiner correctly notes that Smith teaches the step of embossing vinyl tiles to form a decorative layer (Answer 6), it is clear from Smith's disclosure that the tile edges are beveled after the embossing step. The beveling step provides smooth edges. (FF 4). Accordingly, we are in agreement with Appellant that Smith fails to disclose, either expressly or inherently, a mechanically embossed texture on the tile edges.

The rejection of claims 34 and 36-38 under 35 U.S.C § 102(b) as anticipated by Smith is reversed. Because the rejection of claim 35 under 35 U.S.C § 103(a) is similarly based on the Examiner's finding that Smith discloses a tile having mechanically embossed edges, we also reverse the rejection of claim 35 as unpatentable over Smith.

- II. Has the Examiner shown that it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the feature of mechanically embossed texture the edges of tile based on the combined teachings of Smith and Ehrhart?"

The Examiner found that Smith discloses the invention as claimed in claim 24 with the exception of one half of the even number of edges being routed and each of the routed edges being adjacent to one another. Answer 5. The Examiner relies on Ehrhart for a disclosure of tiles having routed edges. Answer 5. The Examiner maintains that it would have been obvious

to one of ordinary skill in the art at the time of the invention to “provide Smith et al. with that [sic] one half of the even number of edges are routed and that each of the routed edges are adjacent to one another in order to interlock the edges together to promote ease of installation (col. 1, line 6-7, col. 2,, line 7-8) as taught by Ehrhart et al.” Answer 5-6.

Appellant argues that the combined teachings of Smith and Ehrhart fail to disclose or suggest the claimed feature of a mechanically embossed texture on the tile edges. Br. 12. The Examiner again relies on Smith for a disclosure of this feature. The Examiner further maintains that Ehrhart’s flexible grout material necessarily has the appearance of grout. Answer 8-9. We are in agreement with Appellant that the Examiner has not identified a teaching or suggestion in the applied prior art of providing a mechanically embossed texture to the edges of a tile, nor has the Examiner explained why one of ordinary skill in the art would have been motivated to make such a tile based on the combined teachings of Smith and Ehrhart.

Accordingly, we reverse the rejection of claims 24-30, 32, and 33 under 35 U.S.C § 103(a) as unpatentable over Smith in view of Ehrhart. Because the Examiner’s reliance on Hodakowski is limited to its teaching of an embossed substrate, we reverse the rejection of claim 31 under 35 U.S.C § 103(a) as unpatentable over Smith in view of Ehrhart and further in view of Hodakowski for the reasons stated above in connection with claim 24, from which claim 31 depends.

REVERSED

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