

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN S. CAPOCCIA

Appeal 2007-1365
Reexamination Control 90/006,595
Patent 6,289,548
Technology Center 1700

Decided: May 24, 2007

Before FRED E. McKELVEY, *Senior Administrative Judge*, and MICHAEL P. TIERNEY, and MARK NAGUMO, *Administrative Patent Judges*.

TIERNEY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. ' ' 134 and 306 (2006) from the Examiner's final rejection of claims 1-20 in the above-identified reexamination proceeding.

We affirm.

I. STATEMENT OF THE CASE

A request for reexamination was filed on April 9, 2003 by patent owner for reexamination of its U.S. Patent 6,289,548 (the '548 patent) issued September 18, 2001 to John S. Capoccia. The '548 patent is exclusively licensed to TexMaster Tools Inc.

Patentee's invention relates to patterned synthetic sponges for painting. More particularly, the invention relates to a synthetic sponge that has a pattern that simulates a natural sea sponge when creating faux paint finishes.

As explained in the background section of the '548 patent, broken pattern finishes were popular in the 1930's. Such finishes were produced by "sponging" or "ragging" techniques where a sponge or rag was used to disturb a freshly painted wall to produce a broken pattern. ('548, col. 1, ll. 21-26).

The '548 patent states that sea sponges produce the "most pleasing specialty faux finishes." (*Id.* at col. 1, ll. 42-44). Sea sponges however, are described as scarce and expensive. (*Id.*). The '548 patent attempts to mimic sea sponge finishes by using synthetic sponges where material is removed from the face of the synthetic sponge to create ragged edges. (*Id.* at col. 2, ll. 41-44).

There are three independent claims on appeal, claims 1, 8 and 15, all of which are directed to synthetic sponges having a pattern that simulates a natural sea sponge when faux painting. Claim 1 is representative of the independent claims on appeal and reads as follows:

A patterned synthetic sponge, which comprises:
a synthetic sponge formed from an open cell elastomeric material and bearing a pattern having ragged, torn edges, being at

least about 0.5" in depth, said patterned synthetic sponge simulating a natural sea sponge when creating faux paint finishes therewith.

(Br., Claims Appdx.).

The Examiner has set forth three (3) prior art rejections. The rejections are as follows:

- i) Claims 1, 5-8 and 12-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Australia Published Patent Application 1,405 (the "Australian application").
- ii. Claims 1-3, 5-10, 12-17, 19 and 20 rejected under 35 U.S.C. § 103(a) as being unpatentable over Wakat, U.S. Patent 5,713,095 ("Wakat") in view of the Australian application.
- iii. Claims 4, 11 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wakat and the Australian application and further in view of Moilanen, U.S. Patent 2,994,899 ("Moilanen").

Patentee (Capoccia) generally contends that the prior art references fail to describe making a synthetic sponge mimic a natural sponge. (Br. at 10). Patentee contends that the prior art references teach "cutting" a pattern on a sponge or roller and do not describe a tearing action, which would create Patentee's claimed ragged, torn edge pattern that helps simulate a natural sea sponge paint finish. (Br. at 10-11). Additionally, Patentee states that the prior art references fail to recognize that the depth of the pattern is important. (Br. at 11-12).

The Examiner found that the Australian application teaches that any desired pattern character may be formed on the face of a sponge by removing portions of the face. (Ans. at 3). The Examiner further found that one of ordinary skill in the art would understand how to modify the pattern

depth on the sponge face to achieve the desired pattern character. (Ans. at 4). The Examiner further finds that one of ordinary skill in the art would recognize that Australian application Figure 1 depicts a non-linear pattern and that the cutting of a sponge would produce a “torn” or “ragged” edge, giving those terms their broadest reasonable construction. (Ans. at 5).

We affirm the Examiner’s rejections.

ISSUE

The issue is whether Patentee has shown that the Examiner erred in rejecting the claims. Specifically, the issue is:

Has Patentee demonstrated that the Examiner was incorrect in finding that one of ordinary skill in the art would have been able to follow the teachings of the prior art and remove portions of a synthetic sponge face for its desired effect?

FINDINGS OF FACT

A. Patentee’s ‘548 Specification and Claims

- 1) Patentee’s claims on appeal are directed to synthetic sponges having a pattern on their face that simulates a natural sea sponge when creating a faux paint finish. (Br., Independent claims 1, 8 and 15).

- 2) Broken pattern finishes were popular in the 1930’s and were produced by “sponging” or “ragging” techniques where a sponge or rag was used to disturb a freshly painted wall to produce a broken pattern. (‘548, col. 1, ll. 21-26).

- 3) Sea sponges are said to produce the “most pleasing specialty faux finishes.” (*Id.* at col. 1, ll. 42-44).
- 4) Sea sponges are said to be scarce and expensive. (*Id.*).
- 5) Patentee alleges that it is able to simulate the desired affect of a natural sea sponge with synthetic sponges having ragged, torn edges that are at least about 0.5 inches in depth. (‘548, col. 2, ll. 40-45 and claim 1).

B. Prior Art

Australian Published Patent Application 1,405

- 6) The Australian application is directed to improvements in tools for producing decorative finishes on painted walls. (Australian Application, Title).
- 7) The Australian application states that pattern effects on fresh paint cannot be produced using flat face sponge pads. (*Id.* at col. 1, ll. 15-16).
- 8) The Australian application teaches that natural and artificial sponges can be used to create desired patterns. (*Id.* at col. 2, ll. 1-16).
- 9) According to the Australian application, “[a]ny desired pattern character is formed on the face of the pad by removing portions of the face or attaching pieces of like material to the face . . .” (*Id.* at col. 2, ll. 10-12).

10) The Australian application teaches that the patterned face may be a shape pattern complementary to the pattern of floral or any other desired pattern required to be produced on a painted surface. (*Id.* at col. 2, l. 24 to col. 3, l. 4).¹

11) The Australian application specifically states:

The thus produced type face may be a shape pattern complementary to the pattern of floral or other figure character required to be produced on the plastered or painted surface; or it may be a rib, curl, wove, reticulated, checker-like, or any other pattern.

(Col. 2, l. 24 to col. 3, l. 4).

12) The Australian application informs the person of ordinary skill in the art that:

It will be understood that the sponge face may be etched in any desired design, for instance, interlaced circles, ashlar pattern, or otherwise.

(*Id.* at col. 3, ll. 25-29).

¹ The Australian application specifically states:

The thus produced type face may be a shape pattern complementary to the pattern of floral or other figure character required to be produced on the plastered or painted surface; or it may be a rib, curl, wove, reticulated, checker-like, or any other pattern.

(Col. 2, l. 24 to col. 3, l. 4).

Wakat, U.S. Patent 5,713,095

- 13) Wakat states that sponge and rag painting are popular and are “considered aesthetic to a great number of people.” (Wakat, col. 1, ll. 10-12).

- 14) Wakat states that “sponge painting and rag rolling are labor intensive methods and hence are expensive.” (*Id.* at col. 1, ll. 14-15).

- 15) Wakat describes a bifurcated paint roller where the paint roller has two roller portions that rotate independently of each other. (Wakat, Abstract).

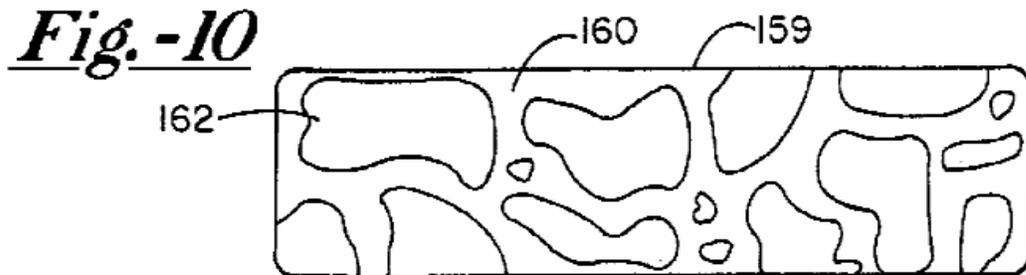
- 16) Wakat describes its invention as follows:

Another object of the present invention is to provide a hand tool which is uniquely bifurcated. Specifically, the hand tool includes a pair of roller portions spaced transversely from each other. Each roller portion is rotatable independently from the other roller portion. By randomly rolling the paint-dipped roller portions on a surface, a sponge or rag rolling effect is achieved where each roller has a paint of a different color or characteristic.

(*Id.* at col. 1, ll. 40-47).

- 17) Wakat states that its bifurcated paint roller “provides a quick and easy method of achieving an effect identical to sponge or rag painting.” (Wakat, Abstract).

18) Wakat teaches that its rollers may have nap portions such as that depicted in Wakat Fig. 10 depicted below:



Wakat Figure 10 depicted above contains:

- 159 Roller portion
- 160 Cylindrical base for engaging the cage
- 162 Nap portions formed of mohair having irregular Peripheries

(*Id.* at col. 7, line 66 to col. 8, line 12 and Fig. 10).

19) Wakat teaches that the nap portions in Fig. 10 may be formed of synthetic material including urethane foam. (*Id.* at col. 11, ll. 51-54).

20) Wakat teaches that its nap portions may be from 0.125 inches up to .5 inches in height. (*Id.* at col. 9, ll. 16-23).

21) Wakat states that its bifurcated rollers provide the illusion that a substrate has been sponge painted while in fact the substrate has been quickly painted. (*Id.* at col. 11, ll. 58-61).

22) Wakat states that its bifurcated rollers provide a thicker paint coat

than that applied by sponge painting. (*Id.* at col. 11, ll. 62-65).

Moilanen, U.S. Patent 2,994,899

23) Moilanen is directed to a device for painting corners. (Moilanen, col. 1, ll. 8-13).

24) Moilanen describes a pair of sponges that are spaced slightly apart and mounted to a common annular core. (*Id.* at col. 2, ll. 2-27 and Fig. 2, part 15).

PRINCIPLES OF LAW

An invention which would have been obvious is not patentable under 35 U.S.C. § 103. *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1745-46, 82 USPQ2d 1385, 1400 (2007). The facts underlying an obviousness inquiry include:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.

Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966). In addressing the findings of fact, “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR* at 1739, 82 USQP2d at 1395. As explained in *KSR*:

One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of

invention a known problem for which there was an obvious solution encompassed by the patent's claims.

KSR at 1742, 82 USPQ2d at 1397.

Consistent with the principles established in *Graham* and followed in *KSR*, the “discovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art.” *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). In particular, where the general conditions of the claims are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). As explained in *KSR*, “[a] person of ordinary skill is also a person of ordinary creativity, not an automaton.” *KSR* at 1742, 82 USPQ2d at 1397.

On appeal, Applicant bears the burden of showing that the Examiner has not established a legally sufficient basis for combining the teachings of the prior art. Applicant's may be sustained their burden by showing that where the Examiner relies on a combination of disclosures, the Examiner failed to provide sufficient evidence to show that one having ordinary skill in the art would have done what Applicant did. *United States v. Adams*, 383 U.S. 39 (1966); *In re Fridolph*, 134 F.2d 414, 416, 57 USPQ 122, 124 (CCPA 1943) (does the prior art suggest doing the thing which the appellant has done?)

ANALYSIS

There are three grounds of rejection on appeal, each of which is based on obviousness under 35 U.S.C. § 103. The Examiner's rejections and

Patent Owner's response thereto are discussed below.

i) The Rejection of Claims 1, 5-8 and 12-14 over the Australian Application

Claims 1 and 8 are independent claims with claims 6 and 7 depending from claim 1 and 12-14 depending from claim 8. Claims 1 and 8 are directed to patterned synthetic sponges formed from synthetic open cell elastomeric material and having an outer surface that bears a pattern having ragged torn edges, being at least about 0.5 inches in depth. The sponge of claims 1 and 8 simulates a natural sea sponge when contacting a wall surface for creating faux finishes. Patentee's dependent claims require the synthetic sponge be formed from polyurethane, polyester or polyether (claims 5 and 12), have a pattern depth of from 0.5 to 0.75 inches (claims 7 and 14) and that the pattern be formed using a rotating grinding wheel (claims 6 and 13).

The Examiner found that the Australian application discloses the "invention substantially as claimed with the exception of a particular depth." (Ans. at 3-4). The Examiner further found that one of ordinary skill in the art would modify the depth of the pattern depending upon the type of pattern desired. (Ans. at 4). The Examiner still further found that one of ordinary skill in the art would have formed the artificial sponge using Patentee's claimed materials (polyurethane, polyester or polyether) due to the ready availability of the materials and cost. (*Id.*). The Examiner states that the use of the grinding wheel of claims 6 and 13 does not distinguish the resulting torn sponge from the sponges described in the Australian application. (*Id.*).

Patentee contends that the Australian application fails to distinguish between artificial and natural sponges. From this, Patentee contends that the

Australian application “is devoid of any teaching to make a synthetic sponge mimic a natural sponge nor how to accomplish such a task.” (Br. at 10).

One of ordinary skill in the art knows that sponge painting is popular and considered aesthetic to a great number of people. One of ordinary skill in the art also knows that natural sponges may be scarce and expensive. Further, one of ordinary skill in the art knows that the use of natural sponges, as opposed to artificial sponges on rollers, is labor intensive and expensive. The Australian application teaches one of ordinary skill in the art that any desired paint pattern may be formed using an artificial sponge that has had an appropriate amount of material removed from its face. Based upon the facts presented, we find that one of ordinary skill in the art would have been aware that there was a known problem with natural sea sponges for which there was an apparent solution, i.e., using artificial sponges that had pieces removed from their faces so that the paint pattern created by the artificially sponge mimics that of a natural sea sponge.

Patentee contends that the sponges described in the Australian patent are patterned by cutting “away material,” which leaves smooth edges as opposed to Patentee’s ragged, torn edges. (Br. at 11). Patentee states that ragged edges created by tearing yield a natural sponge-like affect when used in creating faux paint finishes. (*Id.*). As evidenced by the Australian application, a person of ordinary skill in the art would have understood the cause and effect relationship of removing portions from the face of the sponge and the paint pattern created. Specifically, we find that one of ordinary skill in the art could implement the teachings of the Australian application and remove material from the face of an artificial sponge in the manner necessary to achieve any desired “sponging” paint finish.

Patentee presented to the Examiner some paint rollers and samples. Patentee maintains that the paint rollers and samples it provided to the Examiner demonstrate that there is a difference between torn edges and cut edges. The Examiner was not impressed. We have reviewed the paint roller samples Patentee provided the Examiner. Patentee is correct that the torn artificial sponges provide a different paint pattern than artificial sponges that have material removed to leave smooth edges. However, whatever one is supposed to learn from the paint rollers and samples, would not negate the Examiner's finding that one of ordinary skill in the art would have been able to implement the teachings of the Australian application and remove the material from the surface of the artificial sponge to produce any desired pattern, i.e., would have understood that a smooth edge on a paint roller leaves a different paint pattern from that of a paint roller having torn edges. *KSR* at 1740, 82 USPQ2d at 1396 (“If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability.”).

As to dependent claims 5-7 and 9-12, Patentee states:

With respect to appealed claims 5, 12, and 19, Australia ‘405 does not mention types of elastomeric materials, such as those listed in this claim. With respect to appealed claims 6, 13, and 20, Australia ‘405 only mentions cutting. It specifically, does not recognize the use of a grinding wheel in order to tear away sponge material. With respect to appealed claim 7, there is no teaching in Australia ‘405 that depth of pattern is important, nor even a design variable.

(Br. at 11). Note, claims 19 and 20 were not rejected over the Australian reference alone.

I'd put n. 2 right here as text. The Patentee admits that “foam rollers were known prior to his invention.” (Br. at 12). Patentee does not dispute

that its claimed materials, e.g., polyurethane sponges, or the use of a grinding wheel to remove material² were unknown to one of ordinary skill in the art or provided unexpected benefits. Further, we can assume that Patentee may be correct in stating that the depth of the torn edge is not recited in the Australian application. The Australian application however, instructs one of ordinary skill in the art to remove sufficient material such that the desired pattern is created. Patentee's arguments have been considered but they do not sufficiently rebut the findings of fact made by the Examiner. Patentee has done no more than follow the teachings of the prior art and combine known elements to yield predictable results. Specifically, one of ordinary skill in the art would have used artificial sponges on rollers with portions of the sponge face removed in place of natural sea sponges as the use of the artificial sponges results in reduced labor and material costs as compared to natural sea sponges. *Cf.*, *KSR* at 1739, 82 USPQ2d at 1395. We conclude that Patentee has failed to demonstrate that the Examiner erred in rejecting claims 1, 5-8 and 12-14 as obvious over the Australian application.

² Patentee's recitation of a grinding wheel to produce the claimed sponge is a product-by-process claim as the product is defined at least in part in terms of the method or process by which it is made. *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 158 n., 9 USPQ2d 1847, 1855, n. (1989). In construing such a claim, the Federal Circuit has held that "[i]f the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985).

- ii) The Rejection of Claims 1-3, 5-10, 12-17, 19 and 20 over Wakat, U.S. Patent 5,713,095 in view of the Australian application

The Examiner found that the Australian application describes forming a patterned sponge. (Ans. at 4). The Examiner further found that Wakat discloses a patterned roller that may be made of foam absorbent material and that Wakat describes the use of irregular patterns on the surface of the roller. (*Id.*). The Examiner still further found that Wakat teaches that rollers can be made to paint corners (“corner rollers”). The Examiner concluded that one of ordinary skill in the art would have adapted the device of Wakat to paint corners with a sponge painting pattern. (*Id.*).

Patentee contends that Wakat “is not related to making a synthetic sponge mimic a natural sponge . . .” (Br. at 12). Patentee asserts that Wakat fails to show or render obvious its claimed invention. Patentee also asserts that the Australian application fails to remedy the deficiencies of Wakat. (*Id.*).

Wakat describes adding nap portions to the face of a paint roller where the added nap portion is up to .5 inches in height. (Wakat at col. 9, ll. 16-23). These additional nap portions are used to create irregular shape patterns. (*Id.* at Fig. 24-37). Further, Wakat states that its bifurcated paint roller “provides a quick and easy method of achieving an effect identical to sponge or rag painting.” (*Id.*, Abstract). One of ordinary skill in the art would understand that Wakat teaches the use of artificial sponges, foam paint rollers, to achieve a painting effect identical to that of natural sea sponges.

The Australian application describes the use of tools for producing

decorative finishes on painted walls. The Australian application teaches that artificial sponges can be used to create desired patterns. In particular, the Australian application teaches that any desired pattern can be produced on painted surfaces by painting with sponges that had sufficient portions of the sponge face removed. Based upon the teachings of the prior art, one of ordinary skill in the art would have understood that a desired paint pattern may be created by removing portions from the surface of a paint roller to achieve the desired sponge painting effect.

Patentee contends that the Australian application teaches away from Patentee's claimed beveled corner roller as required by claims 2, 3, 9, 10, 16 and 17. (Ans. at 12). In particular, Patentee states that the Australian application describes its edges as substantially flat in order to avoid overlap marks. (*Id.*). Patentee states that Wakat shows a beveled corner roller. (*Id.*). One of ordinary skill in the art would have understood that the use of a beveled roller would aid in the painting of corners and that the Australian application does not teach otherwise.

Patentee argues that the prior art references fail to describe the use of a rotating grinding wheel to tear the face of the sponge as required by claims 6, 13, and 20. (Br. at 12). As discussed above, Patentee's grinding wheel recitation is a product-by-process limitation. Patentee has failed to demonstrate that the use of a grinding wheel creates a sponge face surface that is distinct from that suggested by the prior art, i.e., removing surface material such that the resulting surface creates the desired paint effect.

Patentee also contends that the prior art fails to show the depth of the pattern, such as the 0.5 inches to 0.75 inches set forth in Patentee's claim 7. Wakat however, describes the use of 0.5 inch nap portions to create irregular

paint patterns. And even more to the point is that the Australian application teaches removing a sufficient amount of material from the surface of the sponge to create a desired effect. The Patentee has failed to come to grips with the fact that the Examiner has rejected on a combination of references and that all the relevant teachings must be considered. One skilled in the art would have been able to implement the teachings of the prior art and remove the necessary amount of material to achieve any desirable natural sea sponge paint effect.

- iii) The Rejection of Claims 4, 11, and 18 over Wakat, U.S. Patent 5,713,095 and Australian application and further in view of Moilanen, U.S. Patent 2,994,899

Claims 4, 11 and 18 require a pair of spaced-apart pattern sponges.

Patentee contends that claim 4 is novel by virtue of its dependency on claim 1 and is silent as to claims 11 and 18. (Ans. at pages 4-5). For the reasons provided above with respect to claim 1, we likewise affirm the rejection as to claims 4, 11, and 18.

CONCLUSION

Patentee has failed to demonstrate that the Examiner erred in rejecting claims 1-20 over the cited prior art references. We AFFIRM the Examiner's final rejection of claims 1-20.

AFFIRMED

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