

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 DONG TIAN,
RALPH W. WRIGHT, JR., and
SCOTT WHALEN

Appeal 2007-3374
Application 10/448,758
Technology Center 1700

Decided: September 28, 2007

Before CHUNG K. PAK, CATHERINE Q. TIMM, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

PAK, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the Examiner's refusal to allow claims 1 through 23. Claims 24 through 45, the other claims pending in the above-identified application, stand withdrawn from consideration as being directed to a non-elected invention. We have jurisdiction pursuant to 35 U.S.C. § 6.

STATEMENT OF THE CASE

The subject matter on appeal is directed to surface coverings, such as floor coverings and wallpaper, “having difference in gloss in selected regions or zones . . . ” (Specification 1, para. 001). Further details of the appealed subject matter are recited in representative claim 1 reproduced below:

1. A surface covering comprising:

a) a surface covering substrate having a top surface and a bottom surface,

b) a primer overlying a portion of the top surface of the surface covering substrate, wherein the primer comprises a flattening agent, and

c) a top coat overlying at least a portion of the primer and overlying substantially all of the top surface of the surface covering substrate,

wherein the top coat overlying the primer has a gloss level less than the gloss of the top coat not overlying the primer.

The Examiner has relied upon the following references:

Carder	US 3,966,572	Jun. 29, 1976
Mawson	US 4,172,169	Oct. 23, 1979
Schneider	US 4,207,368	Jun. 10, 1980
Sigel '501	US 2002/0168501 A1	Nov. 14, 2002
MacQueen	US 6,759,096 B2	Jul. 6, 2004
Sigel '625	US 6,890,625 B2	May 10, 2005

The Examiner has rejected the claims on appeal as follows:

1. Claims 1 through 6, 14, and 16 through 18 under 35 U.S.C. § 102(a) as anticipated by the disclosure of Mawson;
2. Claims 7 through 10 under 35 U.S.C. § 103(a) as unpatentable over the disclosure of Mawson;
3. Claims 1 through 11 and 14 through 23 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Sigel ‘501 and Carder;
4. Claims 12 and 13 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Sigel ‘501, Carder, and Schneider;
5. Claims 1 through 11 and 14 through 23 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of MacQueen and Carder;
6. Claims 12 and 13 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of MacQueen, Carder, and Schneider; and
7. Claims 1 through 23 under the judicially-created doctrine of obviousness-type double patenting as unpatentable over Claims 1 through 36 of Sigel ‘625 in view of Carder.

The Appellants contend that the Examiner erred in rejecting the claims on appeal. This appeal ensues.

ISSUES

1. Has the Examiner demonstrated that Mawson clearly and unequivocally describes expressly or inherently each and every limitation recited in claim 1 within the meaning of 35 U.S.C. § 102(b)?

2. Has the Examiner identified a reason that would have prompted one of ordinary skill in the art to employ a flattening agent in an inner ink layer underneath of a photo-curable top coat having desired differential gloss within the meaning of 35 U.S.C. § 103(a)?

PRINCIPLES OF LAW, FACTUAL FINDINGS, AND ANALYSES
ANTICIPATION

For a § 102(b) rejection to be proper, the Examiner must demonstrate that the applied prior art clearly and unequivocally describes each and every element of a claimed invention, without any need for picking, choosing, and combining various disclosures therein. *In re Arkley*, 455 F.2d 586, 587-88, 172 USPQ 524, 526 (CCPA 1972). When the Examiner relies upon a theory of inherency, “the [E]xaminer must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (BPAI 1990) (emphasis omitted). It must be emphasized that inherency “may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Ex parte Skinner*, 2 USPQ2d 1788, 1789 (BPAI 1986).

Applying the above principles of law to the present situation, we concur with the Appellants that the Examiner has not established a *prima facie* case of anticipation within the meaning of 35 U.S.C. § 102(b). As correctly pointed by the Appellants (Br. 10-17), Mawson does not teach, much less clearly and unequivocally teach, employing silica (delustrant) in

an inner layer completely covered by an outer layer (col. 4, ll. 20-43). We find that Mawson teaches employing chemically different polymers and/or delustrants, such as silica, to first and second layers exposed to the outer environment to provide differential gloss (*id.*). For those embodiments involving in a first inner layer completely covered by a second outer layer, Mawson clearly states at col. 3, ll. 2-7:

[A]s explained in more detail below when a profiled effect only is desired, without differences in gloss, the first [inner] layer may be discontinuous and the second [outer] layer may completely overlie the first layer, so that the differences in profile arise at least in part from the deposits of the first layer.

Nowhere does Mawson teach adding a delustrant (corresponding to the claimed flattening agent) to the unexposed inner layer.

Accordingly, we are constrained to agree with the Appellants that Mawson does not expressly or inherently teach employing a delustrant (corresponding to the claimed flattening agent) in an inner discontinuous layer completely covered by an outer layer to provide differential gloss within the meaning of 35 U.S.C. § 102(b).

OBVIOUSNESS

Under 35 U.S.C. § 103, the factual inquiry into obviousness requires a determination of: (1) the scope and content of the prior art; (2) the differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) secondary considerations (e.g., unexpected results). *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18, 148 USPQ 459, 467(1966). “[A]nalysis [of whether the subject

matter of a claim would be obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007) quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336-37 (Fed. Cir. 2006). The analysis supporting obviousness, however, should be made explicit and should “identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does.” *KSR*, 127 S. Ct. at 1741, 82 USPQ2d at 1396.

*REJECTION BASED ON MAWSO*N

As evidence of obviousness of the subject matter defined by claims 7 through 10 under 35 U.S.C. § 103, the Examiner takes the position that the determination of optimum or workable thicknesses of the first and second layers taught by Mawson is well within the ambit of one of ordinary skill in the art (Answer 4-5). However, as indicated *supra*, Mawson is silent as to employing a flattening agent in an inner layer that is completely covered by an outer layer. Nevertheless, the Examiner has not identified any reason why one of ordinary skill in the art would have prompted to employ a flattening agent in an inner layer hidden behind an outer layer. Accordingly, we are constrained to agree with the Appellants that the Examiner has not established a *prima facie* case of obviousness within the meaning of 35 U.S.C. § 103(a).

REJECTIONS BASED ON SIGEL ‘501, MACQUEEN, AND SIGEL ‘625

Appellants do not dispute the Examiner’s finding that Sigel ‘501, MacQueen, and Sigel ‘625 all teach and/or claim applying an ink pattern containing a photoinitiator, thermal initiator, and/or a cure altering agent on a substrate and then coating the substrate and the pattern with a UV-curable coating composition to provide the claimed differential gloss, i.e., the top coat overlying the primer (corresponding to the ink pattern) has gloss level less than the gloss of the top coat not overlying the primer (ink pattern) (Sigel ‘501, p. 2, para. 0012 and 0013, MacQueen, cols. 8-10, and Sigel ‘625, claims 1-36).

The dispositive question is, therefore, whether the Examiner has identified a reason that would have prompted one of ordinary skill in the art to employ a flattening agent in an ink pattern completely covered by a photo-curable coating composition within the meaning of 35 U.S.C. § 103. On this record, we answer this question in the negative.

As acknowledged by the Appellants (Br. 17), Carder teaches that a flattening agent can be used in photo-curable compositions or photo-curable inks to provide differential gloss. However, nowhere does Carder teach or suggest employing a flattening agent in the inner ink layer completely covered by a photo-curable coating composition. In fact, we find that Sigel ‘501, MacQueen and Sigel ‘625 all teach employing a flattening agent in the *top* photo-curable layer to obtain differential gloss (Sigel ‘501, pp. 1-2, para. 0011, p. 4, para. 0037, and p. 5, para. 0061, MacQueen, col. 14, ll. 41-67, and Sigel ‘625, claim 1). Moreover, as indicated *supra*, Sigel ‘501, MacQueen and Sigel ‘625 already obtain the claimed differential gloss in the

selected areas via including a curing agent or cure altering agent to the ink pattern. Finally, Schneider is not relied on to teach or suggest the addition of a flattening agent to the inner ink layer (Answer 6-9). Hence, we do not find any reason or explanation proffered by the Examiner that would have prompted one of ordinary skill in the art to employ a flattening agent in the inner ink layer covered by a photo-curable coating composition having desired differential gloss. *See Answer in its entirety.*

Accordingly, we are constrained to agree with the Appellants that the Examiner has not established a *prima facie* case of obviousness within the meaning of 35 U.S.C. § 103 or a *prima facie* case of unpatentability within the meaning of the judicially-created doctrine of obviousness-type double patenting.

ORDER

The decision of the Examiner is reversed.

REVERSED

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