

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 SHELLY W. PRICE,
APPELLANT

Appeal 2007-4310

Application 10/950,830¹
Technology Center 1700

Decided: 26 October 2007

Before JAMESON LEE, CAROL A. SPIEGEL, and MARK NAGUMO,
Administrative Patent Judges.

NAGUMO, *Administrative Patent Judge.*

DECISION ON APPEAL

¹ Application filed 27 September 2004 ("830 Application"). The real party in interest is listed as Henkel Consumer Adhesives, Inc. (Appeal Brief filed 4 December 2006 ("Br.") at 4.)

A. INTRODUCTION

Appellant ("Price") appeals under 35 U.S.C. § 134 from the final rejection of claims 1–15, 18, and 19. Claims 1-15 and 17–19 are pending: claim 17 has been withdrawn from consideration and is not part of this appeal. We have jurisdiction under 35 U.S.C. § 6(b). We REVERSE.

The subject matter on appeal relates to skid-resistant shelf liners.

Claims 1, 18, and 19 are representative.

Claim 1

A shelf liner which defines a skid-resistant first major surface for contacting a shelf and a decorative second major surface, the shelf liner comprising

a scrim and a foamed resin in contact with the scrim,
the scrim comprising fibers,
the resin being discontinuous on the scrim,
such that at least a portion of the scrim fibers is
visible on the second major surface,
open pores extending from the first major surface to the
second major surface.

(Br. at 23 (Claims App'x); paragraphing and indentation added.)

Claim 18

A composite sheet material having first and second major surfaces consisting essentially of

a single layer of scrim formed of natural fibers and
a foamed latex resin thereon,
open pores extending from the first major surface to the
second major surface,

the foamed latex resin providing discontinuous coverage of the scrim fibers on the second major surface to provide a decorative surface.

(Br. at 24 (Claims App'x); paragraphing and indentation added.)

Claim 19

A shelf liner which defines a skid-resistant first major surface for contacting a shelf and a decorative second major surface, the shelf liner comprising

a single layer of scrim and a foamed resin in contact with the scrim, which defines the first major surface,

the scrim comprising fibers,

the resin being discontinuous on the scrim,

such that at least a portion of the scrim fibers is visible on the second major surface,

open pores extending from the first major surface to the second major surface,

the foamed resin being thicker, on average on a side of the scrim adjacent the second major surface, than on a side of the scrim adjacent the first major surface.

(Br. at 25 (Claims App'x); paragraphing and indentation added; underlining added to indicate major differences from claim 1.)

The Examiner has maintained the following rejections²:

1. Claims 1, 5, 11, 13, and 15 have been rejected under 35 U.S.C. § 102(e) in view of Mangum³. (Answer at 2.)

² Examiner's Answer mailed 22 March 2007 ("Answer").

³ Scott Mangum and Kevin Donovan, *Multi Scrim Non-Slip Pad and Method of Manufacture*, U.S. Patent 6,673,179 B1, issued 6 January 2004, based on application 10/005,045 filed 4 December 2001.)

2. Claims 12, 14, and 19 have been rejected under 35 U.S.C. § 103(a) in view of Mangum. (Answer at 3.)
3. Claims 2–4 have been rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Magnum and Jupina⁴. (Answer at 2.)
4. Claims 6–8 have been rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Magnum and Sobonya⁵. (Answer at 3.)
5. Claims 9 and 10 have been rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Magnum and Hawley⁶. (Answer at 3.)
6. Claim 18 has been rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Mangum, Sobonya, and Jupina. (Answer at 3.)

The principal legal questions in this case are:

- 1a. What is the meaning of the limitation, found in claim 19, "the shelf liner comprising a single layer of scrim"?
- 1b. What is the meaning of the limitation, found in claim 18, "[a] composite sheet material having first and second major surfaces consisting essentially of a single layer of scrim"?

⁴ Michael S. Jupina, *Continuous Foam Rug Gripper and Method of Using the Same*, U.S. Patent 6,558,786 B1, issued 6 May 2003.

⁵ William A. Sobonya and Elizabeth A. Flores, *Composite Sheet Material*, U.S. Patent Application Publication 2002/0,197,922 A1, published 26 December 2002, based on application 09/891,568, filed 26 June 2001.

⁶ James K. Hawley et al., *Smooth Surfaced Foam Laminate and Method of Making Same*, U.S. Patent 6,130,174, issued 10 October 2000.

2a. What is the meaning of the limitation, found in independent claims 1 and 19, "the resin being discontinuous on the scrim, such that at least a portion of the scrim fibers is visible on the second major surface"?

2b. What is the meaning of the limitation, found in independent claim 18, "the foamed latex resin providing discontinuous coverage of the scrim fibers on the second major surface"?

To each of these legal questions corresponds the factual question, does Mangum teach (or suggest) the limitation?

It is also necessary to resolve the factual question, does Mangum teach "multi-scrim non-slip pads comprising multiple layers of the same scrim type" that have a "skid-resistant" surface as required by independent claims 1 and 19?

B. FINDING OF FACT (FF)

The following findings of fact and any set out in the Discussion, *infra*, are supported by a preponderance of the evidence of record.

The 830 Application

1. According to Price, it is conventional to make drawer and shelf liners by coating a generally porous sheet material that has openings that pass from one surface to the other, called a "scrim," with a resin that is then foamed. (830 Application at 1, ¶ 2.)

2. Price describes an embodiment, illustrated schematically in Figures 1 and 2 (830 Application at 3, ¶ 14).

{Figures 1 and 2 of the 830 Application are shown below:}⁷

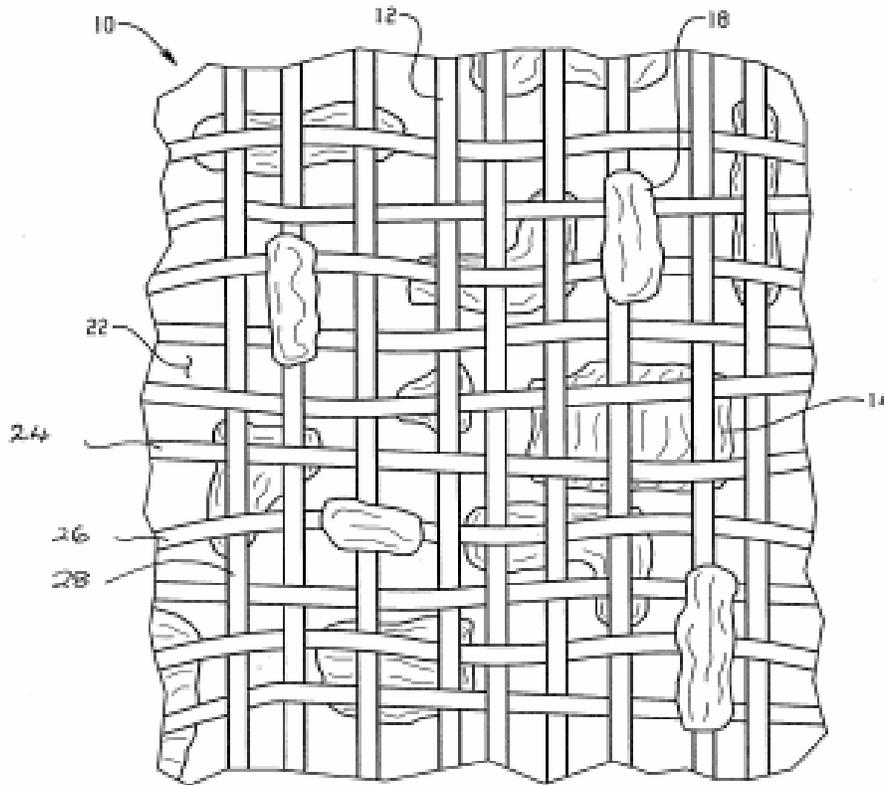


Fig. 1

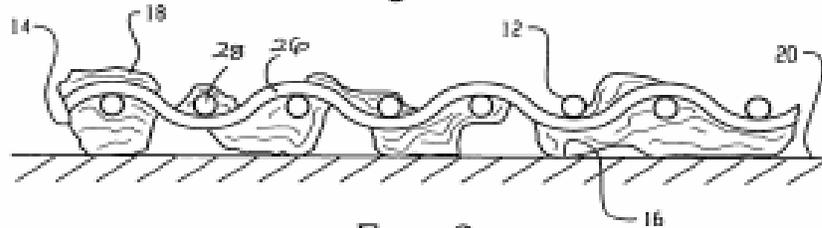


Fig. 2

{Figures 1 and 2 are said to depict face and edge views of a sheet of the invention}

3. The surface **16** is said to be an exposed outer surface of the liner that in various embodiments is covered or substantially covered by the foamed

⁷ The text in curly braces preceding and following the Figures is provided to ensure compliance with section 508 of the U.S. Rehabilitation Act for publication of this Decision on the USPTO website pursuant to the Freedom of Information Act. It is not part of the Decision.

resin and that contacts the substrate and resists slipping along the substrate.
(830 Application at 3, ¶ 14.)

4. The "second major surface" **18** is characterized as a decorative surface that is partially covered by the foam resin, "leaving at least portions of the scrim material exposed or covered with a sufficiently thin layer of foam that the texture of the scrim material is clearly visible." (830 Application at 3, ¶ 14; emphasis added.)

5. In some embodiments, Price teaches that "[p]ortions **24** of the warp and weft strands **26, 28** on the decorative side **18** are free of the foam. For example, at least 10% and in one embodiment, at least 20% of the length of the warp and weft threads are exposed, at least to the naked eye."
(830 Application at 4, ¶ 17.)

6. In other embodiments, Price teaches that a decorative surface to the composite sheet material is "due to the outline of the weave which . . . shows through the surface of the foamed resin." (830 Application at 4, ¶ 21.)

7. Price also describes embodiments in which:

[t]he weave of the scrim is preferably spaced apart so that when the scrim is impregnated with the foamable resin composition, the composition penetrates into the weave and only partially fills the spaces between the warp and the weft strands.

(830 Application at 3, ¶ 17.)

8. According to Price, in these embodiments, "[w]hen the impregnated composition is foamed, open pores **22** extend from one surface of the sheet material to the opposite surface." (830 Application at 3-4, ¶ 17.)

9. Price describes a method of making the claimed composite sheets or liners in the following words:

a portion of the liquid foamable material is removed, after it is applied, from what will be the decorative surface **18**, for example with a knife or other blade. . . . The scraping leaves at least some portions of the fibers on the decorative surface **18** which, at least to the naked eye, are completely free of the foamed material.

(830 Application at 5, ¶ 24.)

10. As a result, according to Price, "[t]he coating on the non-slip surface **16** is thus generally thicker, on average, than on the decorative surface. This results in a larger portion of the foam being on the side of the scrim adjacent surface **16** after foaming and drying." (830 Application at 5, ¶ 24.)

Mangum

11. Mangum relates to non-slip products such as kitchen drawer inserts having multiple scrims, each coated with liquid polyvinyl chloride that is then baked in an oven to form foamed coating layers around the scrims.

(Mangum at 1:7-17.)

12. Mangum describes the coated scrims as being "welded" together when they are heated together in the oven. (Mangum, *e.g.*, at 2:65 and at 3:62.)

13. Mangum teaches that a variety of scrims may be used (Mangum at 1:37–61), stating that "the type of scrim utilized often effects [sic: affects] the porosity, as well as amount of coating retained by the scrim." (Mangum at 1:61–63.)

14. Mangum also notes that the characteristics of the polyvinyl chloride are known to affect the characteristics of the foam coating. (Mangum at 1:64-2:14.)

15. According to Mangum, all of these factors can be varied to achieve different products to meet end-user requirements. (Mangum at 2:15-40.)

16. In certain embodiments, Mangum is concerned with two-scrim non-slip pads in which the first and second foamed resin-coated scrims have different properties. (Mangum at 3:1-15.)

17. For example, according to Mangum, Figures 5 and 6 depict a non-slip pad **10** having a first scrim **12** that has, in the alternative, "very small holes extending through the scrim, when coated with polyvinyl chloride liquid and the liquid coating is cured about the first scrim **12**." (Mangum at 4:15-19.)

18. Mangum further describes the second scrim **20** as having "alternating apertures . . . when coated, the coating is not retained in the larger apertures, but substantially coats the remaining portions of the second scrim **20**. This design has been found to provide an advantageous texture on its top surface while providing good cushioning effects." (Mangum at 4:22-26.)

19. Mangum states that "[o]ther embodiments could utilize multiple layers of the same and/or different scrim types." (Mangum at 4:22-26.)

The Examiner's Rejections

20. With regard to claim 1, the Examiner finds that "Mangum teaches a multi-scrim non-slip pad comprising multiple layers of the same scrim types wherein each scrim is substantially coated with a polyvinyl chloride coating such that the coating is not retained in the larger apertures of the scrim for

providing a desired texture on a top surface of the scrim." (Answer at 4, citing Mangum at 4:20–30.)

21. The Examiner finds that the bottom surface would define a skid-resistant surface "because the texture is provided on its top surface." (Answer at 4.)

22. The Examiner also finds that the incomplete coating of the top surface "further implies a portion of the scrim fibers being uncovered by the coating for imparting a textured or hairy surface." (Answer at 4.)

Price's Arguments

23. Price has not challenged the prior art status of any of the references applied by the Examiner.

24. Moreover, Price has not offered separate substantive arguments for the patentability of dependent claims other than claims 11 and 12, which depend from claim 1, and which are rejected solely over Mangum.

25. Substantively, regarding claims 1–15, Price argues first that the references do not disclose or suggest a shelf liner having open pores extending from one major surface to the other major surface. (Br. at 12.)

26. In particular, according to Price, the Examiner relies on an improper combination of two different embodiments of Mangum, namely, the description of the coated second scrim having apertures, and the teaching that multi-scrim no-slip pads can be made from multiple layers of the same scrim type. (Br. part VII.A.1, at 12–13.)

27. Moreover, Price argues that the combination of two of the second scrims taught by Mangum would not result in a liner having a skid resistant

surface on one side and visible scrim fibers on the other. (Br. part VII.A.2, at 14.)

28. In particular, Price argues that there is no suggestion that the texture taught by Mangum is provided by "discontinuous coverage of the scrim fibers" as required by Claim 1. (Br. part VII.A.2, at 14–15.)

29. Although Price offers a summary of the teachings of the secondary references, Price's only substantive argument is that the secondary references do not cure the failure of Mangum to teach discontinuous foam on the scrim. (Br. part VII.A.3, at 15–16.)

30. Price argues further that there is no suggestion that the use of two identical scrims, as proposed by the Examiner, would result in a product having foamed resin on a first major surface, as required by claims 11 and 12. (Br. part VII.B, at 17.)

31. Finally, Price argues that the Examiner has misconstrued claims 18 and 19 by reading the limitations "consisting essentially of a single layer of scrim . . ." and "comprising a single layer of scrim . . ." on embodiments having multiple layers of scrim. (Br. part VII.C and D, at 17–21.)

C. DISCUSSION

The predecessor to our reviewing court explained over three decades ago that, for rejections for anticipation to be proper, the "reference must clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without *any* need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference." *Application of Arkley*, 455 F.2d 586, 587,

172 USPQ 524, 526 (CCPA 1972) (emphasis original). Similarly, for claimed subject matter to be obvious, the differences required by the claim limitations must be such that they are described or obvious, as a whole, in view of the prior art. *The Gillette Co. v. S.C. Johnson & Son, Inc.*, 919 F.2d 720, 724, 16 USPQ2d 1923, 1927 (Fed. Cir. 1990) (“Focusing on the obviousness of substitutions and differences, instead of on the invention as a whole, is a legally improper way to simplify the often difficult determination of obviousness.”) On appeal, the procedural burden is on the Applicant to show that the Examiner has committed reversible error in maintaining the rejections.

We begin by considering the meaning of the limitations "consisting essentially of a single layer of scrim," recited in claim 18, and "comprising a single layer of scrim," recited in claim 19. The transitional phrases "comprising" and "consisting essentially of" are, as the Examiner noted, open to additional materials and structures beyond those recited in the claims, the latter with certain reservations not relevant here. The Examiner errs, however, in reading these claims as being open to additional layers of scrim. To read these claims in that manner would render nugatory the express limitation, "a single layer of scrim". Although claims are to be read broadly during prosecution, so the full scope and content of their meaning may be explored while the applicant has a full and fair opportunity to amend them, *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), nonetheless every word must be given due consideration. In the present case, the 830 Application makes clear that the inventor is concerned with embodiments based on a single scrim layer. The Examiner has not identified any ambiguity in the claim language or any conflict with the

specification that indicates that the single scrim layer limitation should be read out of the claims as a grammatical accident or as an insubstantial superfluity. Moreover, the Examiner has not indicated that Mangum describes or suggests skid-resistant pads having only a single layer of scrim. Instead, the Examiner argues that the claims read on multi-scrim skid-resistant pads. The Examiner does not rely on Sobonya or Jupina for teachings or suggestions of single-scrim skid-resistant pads. Accordingly, the rejections of claims 18 and 19 under § 103(a) are REVERSED.

We consider next the "coverage" limitations in the independent claims, which are reproduced here for convenient reference (emphasis added):

Claims 1 and 19 require that the foamed latex resin be "discontinuous on the scrim, such that at least a portion of the scrim fibers is visible on the second major surface"; whereas

Claim 18 requires that the foamed latex resin provide "discontinuous coverage of the scrim fibers on the second major surface."

The difference in wording implies that resin that is "discontinuous on the scrim" is distributed differently from resin that is "discontinuous on the scrim fibers." *CAE Screen Plates, Inc. v. Heinrich Fiedler GMBH & Co. KG*, 224 F.3d 1308, 1317, 55 USPQ2d 1804, 1810 (Fed. Cir. 2000) ("In the absence of any evidence to the contrary, we must presume that the use of these different terms in the claims connotes different meanings.") (citation omitted). This impression is strengthened by the disclosure, which indicates that "[i]n one embodiment, the foamed resin . . . partially covers a second

major surface **18**, leaving at least portions of the scrim material . . . covered with a sufficiently thin layer of foam that the texture of the scrim material is clearly visible." (FF 4; Specification at 3, ¶ 14.) The disclosure also indicates that in certain embodiments, "[t]he weave of the scrim is preferably spaced apart so that when the scrim is impregnated with the foamable resin composition, the composition penetrates into the weave and only partially fills the spaces between the warp and the weft strands." (FF 7; 830 Application at 3, ¶ 17.) These two passages are consistent with the further limitation in claims 1 and 19 that "at least a portion of the scrim fibers is visible on the second major surface."

In contrast, the disclosure appears to describe another embodiment in which "the foamed resin . . . partially covers a second major surface **18**, leaving at least portions of the scrim material exposed." (FF 4; Specification at 3, ¶ 14.) The disclosure appears to describe this embodiment further, teaching that "[p]ortions **24** of the warp and weft strands **26, 28** on the decorative side **18** are free of the foam." (FF 5; 830 Application at 4, ¶ 17.) These descriptions are consistent with the limitation in claim 18 that the resin provides "discontinuous coverage of the scrim fibers on the second major surface," not merely the scrim as a whole.

With these interpretations in mind, we have no trouble determining that, while the Examiner has identified passages in Mangum that fairly describes textures in which the fibers of the scrim are visible, but covered by foamed resin, the Examiner has not indicated that Mangum describes non-slip pads in which scrim fibers are visually free of foamed resin. Nor has the Examiner directed our attention to any disclosure in Mangum of a process of making the non-slip pads that would necessarily result in such exposed

fibers. Furthermore, the Examiner has not relied on the other references for disclosure relating to the coverage of the scrim. We conclude that the rejection of Claim 18 over the combined teachings of Mangum, Sobonya, and Jupina should be and is REVERSED.

We return to claim 15. As Price points out (Br. at 12), claim 1 requires that the shelf liner be skid-resistant. Price argues that the combination of two scrims **20** "would not yield a liner in which one surface had visible scrim fibers and the other a skid resistant surface as required in claim 1." (Br. at 14.)

We find the Examiner's assertion that the coated scrim **20** has skid-resistant properties "because the texture is provided on its top surface" (FF 21; Answer at 4) unpersuasive. The Examiner has not explained why what Mangum describes at the top surface would affect the characteristics of the bottom surface. Indeed, the skid resistant pads described by Mangum appear to derive their skid-resistant characteristics from a foamed-resin coated scrim **12** that "substantially forms a non-porous sheet, or alternatively, has very small holes extending through the scrim." (FF 17; Mangum at 4:16–18.) The partially coated scrim **20** is "welded" to the coated scrim **12**, yielding the desired combination of skid-resistance, top-texture, and cushioning. (FF 18; Mangum at 4:23–25.)

Accordingly, we are constrained to REVERSE the Examiner's rejection of claim 1 under § 102 in view of Mangum.

The remaining claims are dependent on claim 1. The Examiner did not rely on the other references to remedy the deficiencies noted *supra*.

Accordingly, the Examiner's rejections of the remaining claims must also be REVERSED.

D. ADDITIONAL COMMENTS

In the event of further prosecution, we invite the Examiner and Price to consider the following issues regarding the patentability of claim 1 over each of Mangum and Hawley; the patentability of the dependent claims, further in view of the additional references of record, may also need to be revisited.

Mangum describes embodiments in which the first scrim is covered with a foamed resin resulting in a sheet having "very small holes extending through the scrim." (Mangum at 4:17–18.) The second scrim **20** is described as having open large apertures. (*Id.* at 21–24.) The combination appears to have open pores connecting the first major surface to the second major surface. The first major surface is described as being skid-resistant (*id.* at 3:35–36) and the second major surface is described as being textured (*id.* at 4:24–26.) Thus, claim 1 may be unpatentable over Mangum. The more complete coating of the first scrim **12** compared to the second scrim **20** would appear to meet the differential coating requirement of claim 11 and the differential friction coefficient requirement of claim 13. The principle of shifting the burden to the Applicant upon a prima facie showing that a prior art disclosure meets or renders obvious claimed subject matter should be considered. *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990) (“[W]hen the PTO shows sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the

burden of showing that they are not.”); *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

Hawley, at column 2, line 50, through column 3, line 4, describes a slip-resistant pad **14** that is "conventional and commercially available" (Hawley at 2:67-3:1). The pad **14** is said to be noncontinuous rubber or plastic material foamed onto a loosely woven scrim in such a way that the apertures are not filled (*id.* at 2:55-65). Preferred thicknesses are disclosed at column 3, lines 1–4. Again, this disclosure appears to have anticipate claim 1 and many of the dependent claims.

Claim 19 appears to invert, in the final clause, the recitations of the "second major surface" and the "first major surface," when it requires that the foamed resin be thicker on a side of the scrim adjacent the second major surface, compared to the first major surface. The "first major surface" is previously defined as the skid-resistant surface, which appears to have the thicker foamed resin.

E. CONCLUSION

On consideration of the record and for the reasons given, it is:

ORDERED that the rejection of claims 1, 5, 11, 13, and 15 under 35 U.S.C. § 102(e) in view of Mangum is REVERSED;

FURTHER ORDERED that the rejection of claims 12, 14, and 19 under 35 U.S.C. § 103(a) in view of Mangum is REVERSED;

FURTHER ORDERED that the rejection of claims 2–4 under 35 U.S.C. § 103(a) in view of the combined teachings of Magnum and Jupina is REVERSED;

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FURTHER ORDERED that the rejection of claims 6–8 under 35 U.S.C. § 103(a) in view of the combined teachings of Magnum and Sobonya is REVERSED;

FURTHER ORDERED that the rejection of claims 9 and 10 under 35 U.S.C. § 103(a) in view of the combined teachings of Magnum and Hawley is REVERSED;

FURTHER ORDERED that the rejection of claim 18 under 35 U.S.C. § 103(a) in view of the combined teachings of Mangum, Sobonya, and Jupina is REVERSED.

REVERSED

cc (via U.S. Mail)

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