

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT J. MILLER, GREGORY FOWLER, BENNY RAY
WOOD and KIRK T. LOWE

Appeal 2008-1059
Application 10/219,938
Technology Center 3600

Decided: March 21, 2008

Before DONALD E. ADAMS, DEMETRA J. MILLS, and ERIC GRIMES,
Administrative Patent Judges.

ADAMS, *Administrative Patent Judge.*

DECISION ON APPEAL

This appeal under 35 U.S.C. § 134 involves claims 1-5, 7-18, and 20, the only claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

INTRODUCTION

The claims are directed to a laminate floor covering panel. Claims 1 and 3 are illustrative:

1. A laminate floor covering panel, comprising:

a. a laminate floor panel comprising a plurality of layers and having a first generally planar surface, a second generally planar surface opposed to said first surface, a first side edge and an opposed second side edge, each respective side edge extending between said first and second surfaces, respectively, a first coupling member defined within the first edge of the panel and comprising a protrusion extending therefrom, a complementary second coupling member defined within the second edge of the panel and comprising a recess sized and shaped to receive said protrusion therein; and

b. a self activating adhesive composition having an open time of at least about one month selectively applied to at least a portion of at least one of the first and second coupling members.

3. The laminate floor covering . . . [panel of claim 1, further comprising a first and a second one of said floor covering panels, respectively, the first coupling member of the first panel being received within the second coupling member of the second panel, and wherein the adhesive composition is positioned between the respective first and second coupling members of the two panels and forms an adhesive bond there between], wherein the adhesive composition forms a substantially non-refastenable bond after about 48 hours of connective attachment.

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

Durso et al.	US 2003/0003258 A1	Jan. 2, 2003
Pålsson	US 6,591,568 B1	Jul. 15, 2003

The rejections as presented by the Examiner are as follows:

1. Claims 1, 2, 5, 7-18, and 20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Pålsson and Durso.
2. Claims 3 and 4 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Pålsson, Durso, and Appellants' disclosure.

We reverse.

DISCUSSION

1. Claims 1, 2, 5, 7-18, and 20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Pålsson and Durso.

The Examiner finds that Pålsson teaches every element of Appellants' claimed invention with the exception of "a self-activating adhesive composition having an open time of at least about one month selectively applied to at least a portion of at least one of the first and second coupling members" (Ans. 4). Appellants do not dispute and therefore concede to this finding.

The Examiner relies on Durso to make up for the deficiency in Pålsson. Specifically, the Examiner finds that Durso teaches

A self-activating adhesive composition having an extended open time and extended shelf time (page 1 col 2 paragraph 11 lines 12 to end of paragraph) to enable the pre-application of adhesive to panels for later assembly and time for after-

assembly adjustment, the adhesive being applied to at least a portion of at least one of the first and second coupling members (figures 1-6).

(Ans. 4.)

Based on this evidence the Examiner concludes that

[i]t would have been obvious to one having ordinary [s]kill in the art to modify Palsson to show a self-activating adhesive composition having an open time of at least about one month selectively applied to at least a portion of at least one of the first and second coupling members because having a contact, self-activating adhesive between the coupling members of the panels would allow for the precise pre-application of adhesive to the panels for later use as taught by Durso et al, and having the adhesive with open time of at least about one month would allow for the storage of the unassembled pre-applied adhesive [for] an extended period of time prior to assembly as taught by Durso et al as extended periods of time in construction can be months per normal housing construction time frame.

(Ans. 4-5.)

Appellants disagree. According to Appellants “[a]s set forth in the instant [S]pecification, ‘self-activating’ requires no catalyst or activator to commence formation of a substantially non-refastenable bond upon mating of two floor covering panels.’ *See*, as-filed Specification at page 17, lines 23-26” (App. Br. 3). In this regard, Appellants assert that “Durso’s adhesive is activated (or cured) by a metallic initiator applied to one or more edges of a complimenting set of panels. *See e.g.*, Durso, para. 11, lines 5-6 and 11-12” (*id.*).

The Examiner responds with three arguments.

First, the Examiner asserts that “the adhesive of Durso needs no outside help to have the adhesive bonding together. Rather, [it is] the ingredients within the adhesive itself which interact with each other, namely in this case the metallic initiator start[s] the process of bonding of the chemicals. The adhesive is thus self-activating” (Ans. 7). We disagree.

Durso teaches an

assembly of a plurality of joined panel parts [to which] [s]ome of the individual parts contain a pre-applied curable adhesive to one or more sides or edges. An initiating metal activator is applied to complementing edges and cure is activated when the parts are assembled The activating metal . . . is affixed to one surface which is brought into proximity with the curable adhesive compound dispensed onto the complementing part.

(Durso, Abstract.) Thus, Durso’s adhesive is not “self-activating” as defined by Appellants’ Specification, but instead is activated by a metallic activator prior to joining the panel pieces. The Examiner does not identify, and we do not find, a teaching in Durso of a “self-activating” adhesive within the scope of Appellants’ claimed invention. Accordingly, we are not persuaded by the Examiner’s first argument.

Second, the Examiner asserts that “the limitation of ‘self-activating requiring no catalyst or activator to commence formation’ is not in the claims” (Ans. 7 (alteration original)). We are not persuaded. Appellants’ claims require the use of a “self activating adhesive composition” (Claim 1). According to Appellants’ Specification “the adhesive composition used in the present invention is ‘self-activating’ in that it requires no catalyst or activator to commence formation of a substantially non-refastenable bond upon mating of two floor covering panels” (Spec. 17: 23-26). When the

claims are read in light of the Specification the requirement in Appellants' claims of "a self activating adhesive composition" means that it "requires no catalyst or activator to commence formation of a substantially non-refastenable bond upon mating of two floor covering panels". Claim language must be analyzed "not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary skill in the pertinent art." *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971). Accordingly, we are not persuaded by the Examiner's second argument.

Third, the Examiner poses a number of questions relating to the scope of the term "self-activating" and concludes that "Durso's adhesive meets the claimed limitation of self-activated" (Ans. 7). For the foregoing reasons, we disagree with the Examiner's third argument.

The initial burden of presenting a *prima facie* case of obviousness rests on the Examiner. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). For the foregoing reasons, the Examiner has failed to present the evidence necessary to establish a *prima facie* case of obviousness. Accordingly, we reverse the rejection of claims 1, 2, 5, 7-18, and 20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Pålsson and Durso.

2. Claims 3 and 4 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Pålsson, Durso, and Appellants' disclosure.

The Examiner relies on the combination of Pålsson and Durso as discussed above. The Examiner relies on Appellants' disclosure to reach the limitations of claims 3 and 4, which ultimately depend from claim 1. We will not affirm this rejection.

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As Appellants point out this rejection is “misplaced because the rejection of Claim 1 is insufficient as set forth above” (App. Br. 3). For the reasons set forth above, we are not persuaded by the Examiner’s assertion that “[t]he rejections to dependent claims 3 and 4 . . . [are] proper as the rejection of claim 1 is proper” (Ans. 7).

Having found that the Examiner failed to present the evidence necessary to establish a prima facie case of obviousness over claim 1, we reverse the rejection of claims 3 and 4 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Pålsson, Durso, and Appellants’ disclosure.

CONCLUSION

In summary, we reverse the rejections of record.

REVERSED

NEEDLE & ROSENBERG, P.C.
SUITE 1000
999 PEACHTREE STREET
ATLANTA GA 30309-3915

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