

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT A. HALLMAN, ROBERT D. HENSEL
EUGENE M. KIRCHNER, JEFFREY S. ROSS
AND JEROME D. WISNOSKY

Appeal No. 96-3822
Application 08/143,384¹

ON BRIEF

Before RONALD H. SMITH, METZ and HANLON, Administrative Patent Judges.

RONALD H. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-13,
21, 22, 24, 26 and 27, all the pending claims in the application.

¹ Application for patent filed October 29, 1993. According to applicants, this application is a continuation-in-part of Application 07/813,669, filed December 27, 1991.

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The subject matter of the appealed claims relates to a surface covering composite comprising a substrate and a non-particulate inorganic wear layer. Claim 1 is illustrative of the appealed claims and reads as follows:

1. A surface covering composite comprising a substrate and a non-particulate inorganic wear layer, the wear layer being deposited on the substrate by a reduced pressure environment technique and then the composite being embossed, the deposited and embossed wear layer having a plurality of cracks on the exposed surface, a majority of the cracks forming a non-random pattern.

Appellants indicate on page 4 of their brief that the claims stand or fall together. Accordingly, we will limit our consideration to claim 1 in considering the rejection of the appealed claims. 37 CFR § 1.192(c).

The references relied on by the examiner are:

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|------------------------|-----------|----------------|
| Lewicke, Jr. (Lewicke) | 3,953,639 | April 27, 1976 |
| Hensel et al. (Hensel) | 5,077,112 | Dec. 31, 1991 |
| Hensel et al. (Hensel) | 5,188,876 | Feb. 23, 1993 |

Appellants' admissions, Section 18 of the Ross declaration.

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Claim 1-13, 21, 22, 24, 26 and 27 stand rejected under 35 U.S.C. § 103 as unpatentable over either Hensel `876 or Hensel `112 in view of Lewicki and applicants' admissions. We will not sustain this rejection.

As noted by the examiner and disclosed in the background section of appellants' specification, the Hensel references disclose the use of an inorganic wear layer on floor covering composites. Lewicki teaches the embossing of a floor material after the application of a wear layer. The examiner urges that it would have been obvious to one of ordinary skill in the art to emboss the non-particulate inorganic wear layer disclosed by Hensel in view of the teaching of post coating embossing by Lewicki "with the expectation of cracking and some loss of function of the wear layer by applicants' admissions."

We disagree with the examiner's characterization of the alleged admission and with the examiner's conclusion that the claimed invention would have been obvious. It is well settled that, in order to support a conclusion of obviousness, it must be shown that the prior art would have suggested to one of ordinary skill in the art that the process be carried out and "would have a reasonable likelihood of success" (emphasis added). In re Dow

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Chemical Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). The evidence relied on by the examiner as an admission, paragraph 18 of a Ross declaration, reads as follows:

18. In numerous conversations with experts as well as those of ordinary skill in the art, the opinion was expressed that embossing a reduced pressure environment technique deposited wear layer, particularly a thick layer, would create cracking which would destroy the desired properties of the wear layer. Therefore embossing a reduced pressure environment technique deposited wear layer, particularly a thick layer, was not obvious to those of skill in the art.

We agree with appellants that the Ross declaration does not support the examiner's conclusion of obviousness, rather, it supports appellants' position that those of ordinary skill in the art believed that embossing the reduced pressure environment technique deposited wear layer would "destroy the desired properties of the wear layer." See also page 5 of the specification. As noted by appellants, a belief in the destruction of the properties needed for a wear layer is the antithesis of an expectation of success. Accordingly, we agree with appellants that the claimed invention would not have been obvious to one of ordinary skill in the art.

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The decision of the examiner is reversed.

REVERSED

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| RONALD H. SMITH |) | |
| Administrative Patent Judge |) | BOARD OF PATENT |
| |) | |
| |) | APPEALS AND |
| |) | |
| ADRIENE LEPIANE HANLON |) | INTERFERENCES |
| Administrative Patent Judge |) | |
| |) | |

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Andrew H. Metz, Administrative Patent Judge, Concurring.

While I agree with the conclusion of the majority that Hallman et al.'s claims here on appeal are not unpatentable under 35 U.S.C. § 103, my reasons for so-concluding are distinct from the reasons expressed by the majority. Accordingly, I write separately.

As correctly noted by the majority, the patentability of Hallman et al.'s claims on appeal stand or fall with the patentability of claim 1. Claim 1 embraces a surface covering comprising a substrate and a non-particulate inorganic wear layer. Claim 1 also requires that the wear layer be deposited by a particular technique and that the composite is embossed such that the wear layer is embossed and has "a plurality of cracks on the exposed surface, a majority of the cracks forming a non-random pattern."

The Hensel references disclose that in a surface covering composite comprising a substrate and a non-particulate inorganic wear layer the substrate layer may be embossed before applying the ceramic film (wear layer). There is no disclosure or suggestion of embossing the wear layer which is a thin hard film

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of an inorganic oxide or nitride after deposition on the substrate (see '112, column 5, lines 59 through 61; '876, column 7, lines 57 through 59). Lewicki, Jr. teaches embossing the wear layer of a composite comprising a substrate and a wear layer after the wear layer is affixed to the substrate. The wear layer is describe as "vinyl or like wear layer" (column 1, lines 59 and 60).

In my opinion, the prior art relied on (excluding the so-called admissions) does not raise a *prima facie* case of obviousness. The primary references do not emboss the entire composite but only the substrate before laying down the wear layer. While the so-called secondary art embosses a composite after the wear layer is deposited on the substrate, the wear layer is not inorganic let alone a non-particulate inorganic. There is no prior art which teaches embossing in any manner a substrate comprising a non-particulate inorganic oxide film deposited by a reduced pressure environment technique. Therefore, I do not see that any *prima facie* case of obviousness is raised by the prior art patents on which the examiner relies to reject appellants' claims.

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To the extent the examiner relies on the so-called admissions from ¶ 18. of the Ross declaration² as evidence in support of the rejection under 35 U.S.C. § 103, I enter the following comments. In the first instance, the paragraph is gross hearsay! What experts? What persons of ordinary skill in the art? How did declarant distinguish between "an expert" and a person "of ordinary skill in the art"? While I recognize that hearsay is admissible in *ex parte* practice before the office, ¶18. is entitled to little or no weight because there is absolutely no foundation for the statements made therein. Assuming the declarant is an expert, even the opinions of experts must find some foundation or basis in some evidence in the record. Moreover, while ¶ 18. makes reference to the thickness of the layer, claim 1 has no recitation or requirement for a thick layer! Therefore, I strongly disagree with the appellants' conclusion and, accordingly, the majority's as well, that the Ross declaration "supports the position that experts in the field and those of ordinary skill in the art believe that embossing a reduced pressure environment technique wear layer would destroy

² ¶ 18. of the Ross declaration is reproduced at page 3 of the Examiner's Answer.

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the desired properties of the wear layer" (page 7 of appellants' main brief). In my view, ¶ 18. of the Ross declaration is neither an admission nor evidence of either obviousness or non-obviousness. It is gross hearsay unsupported by any underlying facts.

The majority also directs attention to page 5 of the specification, an apparent reference to lines 12 through 15 of said page, as evidence that there was a belief as of appellants' filing date that embossing an inorganic wear layer would destroy the properties of the wear layer. Therein it is stated:

It was believed that flexing or embossing would create unacceptable cracking, i.e. cracks which would be noticeable, reduce gloss level, or lead to unacceptable staining.

Nonetheless, this self-serving disclosure by appellants in their specification suffers from the same shortcomings as ¶ 18. of the Ross declaration: it is unsupported by any underlying facts.

In conclusion, I would reverse the examiner's rejection of the claims of the grounds that the examiner has failed to

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establish that the invention claimed by appellants would have been *prima facie* obvious at the time appellants' invention was made.

ANDREW H. METZ
Administrative Patent Judge

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