

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(2) is not binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL A. DALUISE

Appeal No. 1997-2275
Application 08/390,281

ON BRIEF

Before GARRIS, WARREN, and KRATZ, Administrative Patent
Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection
of claims 1 through 6, 8 through 11 and 20 through 26 which
are all of the claims pending in the application.

The subject matter on appeal relates to a method of

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applying a running track to a substrate which comprises introducing into a nozzle a first stream comprising a rubber particulate material and separately introducing into the nozzle a second stream comprising a binder for the particulate material and causing the binder to encapsulate the particulate material and form a first combined stream in the nozzle and dispensing this combined stream from the nozzle onto the substrate to form a first surface layer of the running track. Further details of this appealed subject matter are set forth in representative independent claim 1, a copy of which taken from the appellant's brief is appended to this decision.

The references relied upon by the examiner as evidence of obviousness are:

Fritz	2,025,974	Dec. 31, 1935
Coke et al. (Coke)	4,420,513	Dec. 13, 1983
Sorathia et al. (Sorathia)	5,320,870	Jun. 14, 1994 (filed Aug. 28, 1991)

All of the claims on appeal are rejected under 35 U.S.C. § 103 as being unpatentable over Coke in view of Sorathia and Fritz.

We refer to the brief and reply brief and to the answer for a thorough discussion of the opposing viewpoints expressed by the appellant and the examiner concerning the above noted

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rejection.

OPINION

For the reasons set forth below, this rejection cannot be sustained.

In the paragraph bridging pages 4 and 5 of the answer, the examiner expresses his basic position as follows:

It is the Examiner's position that, based on the combined teachings of Coke, Fritz, and Sorathia, it would have been obvious to one of ordinary skill in the art to have utilized the nozzle of Fritz to apply the mixture of Coke because Coke wants to wet particles with a binder and apply them to a substrate, Sorathia teaches that it is advantageous to supply particles and a binder separately to a substrate in order to avoid clogging of spray equipment, and Fritz teaches a suitable nozzle which can be used to wet particles with a binder which does not pre-mix the materials. It is the Examiner's position that one having ordinary skill in the art would recognize (based on the Sorathia teachings) that by applying the rubber/latex mixture of Coke without premixing (i.e., using the Fritz nozzle) one would obtain an advantageous result, no clogging of the spray equipment. Furthermore, it is the Examiner's position that there would have been a reasonable expectation by one having ordinary skill that the nozzle of Fritz, when utilized to spray the rubber coatings of Coke, would have provided results similar to those obtained by Coke, i.e., the final product would be the same.

Notwithstanding a careful consideration of the examiner's position, we agree with the appellant that the here applied references would not have suggested the method defined by the

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claims on appeal. Fundamental to the examiner's position is the proposition that Sorathia would have suggested avoiding a clog-problem in the method of Coke whereby the artisan with ordinary skill "would recognize (based on the Sorathia teachings) that by applying the rubber/latex mixture of Coke without premixing (i.e., using the Fritz nozzle) one would obtain an advantageous result, no clogging of the spray equipment". As correctly indicated by the appellant, however, the clogging problem of Sorathia is avoided by using milled or powdered fibers in patentee's resin/fiber mixture (see lines 9 through 16 in column 3).

Thus, even assuming that an artisan would have considered Coke's method to have a clog-problem and would have been motivated to avoid this problem in light of the other applied references, the resulting method would not correspond to the here claimed method. This is because Sorathia, the only reference to disclose a clog-problem, avoids the problem by using relatively small fibers. From our perspective, it follows that, at best, Sorathia would have suggested avoiding a potential clog-problem in Coke's method by modifying the premixing technique of this method (see the paragraph bridging

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columns 7 and 8 of the Coke patent) so as to employ relatively small granular particles.

In essence, the deficiency of the examiner's rejection lies in the fact that none of the applied references including Sorathia contains any teaching or suggestion of avoiding a clog-problem of the type under consideration by separately introducing particulate material and the binder therefor into a nozzle where these ingredients are combined into a stream which is then dispensed from the nozzle in accordance with the here claimed method. It is only the appellant's own disclosure which contains any such teaching. It is reasonably apparent, therefore, that the examiner's rejection is based upon impermissible hindsight derived from the appellant's own disclosure rather than a teaching, suggestion or incentive derived from the applied prior art. W.L. Gore & Assocs. v. Garlock, Inc., 741 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983), cert. denied, U.S. 851 (1984).

Under the circumstances recounted above, we cannot sustain the examiner's section 103 rejection of the appealed claims as being unpatentable over Coke in view of Sorathia and Fritz.

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The decision of the examiner is reversed.

REVERSED

	Bradley R. Garris)	
	Administrative Patent Judge)	
)	
)	
)	
	Charles F. Warren)	BOARD OF
PATENT)	
	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
	Peter F. Kratz)	
	Administrative Patent Judge)	

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APPENDIX

form a second surface layer of said running track:

dispensing said second combined stream from said nozzle onto the set first surface layer to form a second combined stream in said nozzle:

causing said binder in said fourth stream to encapsulate said rubber particulate material in said a latex:

for said particulate material selected from the group consisting of an asphalt emulsion, a urethane and

separately introducing a fourth stream into said nozzle, said fourth stream comprising a binder diene monomer, and styrene-butadiene rubber having an average particle size greater than 2 μm:

material selected from the group consisting of terpolymer elastomer made from ethylene-propylene

introducing a third stream into a nozzle, said third stream comprising a rubber particulate allowing said first surface layer to set:

surface layer of said running track:

dispensing said first combined stream from said nozzle onto said substrate to form a first stream in said nozzle:

causing said binder to encapsulate said rubber particulate material and form a first combined urethane and a latex:

binder for said particulate material selected from the group consisting of an asphalt emulsion, a

separately introducing a second stream into said nozzle, said second stream comprising a diene monomer, and styrene-butadiene rubber having an average particle size greater than 2 μm:

material selected from the group consisting of terpolymer elastomer made from ethylene-propylene

introducing a first stream into a nozzle, said first stream comprising a rubber particulate

1. A method of applying a running track to a substrate, comprising: