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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ANTHONY HESSE, PAUL KITTLE, JOSEPH KAZMIER,
MORT WESTMAN, GREGORY T. FIRRIOLO, and
DOUGLAS J. LOGAN, JR.

Appeal 2010-010002
Application 10/405,046
Technology Center 3600

Before LINDA E. HORNER, STEFAN STAICOVICI, and
JOHN W. MORRISON, *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Anthony Hesse et al. (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's decision finally rejecting claims 1-11, 13, 14, 16-25, 48-57, 67, 69, 70, 77-89, 92-94, 97-99, and 102-104. Claims 12, 15, 26-47, 58-66, 68, and 71-76 have been canceled and claims 90, 91, 95, 96, 100, 101, 105, and 106 have been withdrawn by the Examiner. We have jurisdiction over this appeal under 35 U.S.C. § 6.

THE INVENTION

Appellants' invention relates to a landscaping material and a method and composition for treating a landscaping material using a foam delivery system. Spec. 1, para. [0002].

Claim 1 is illustrative of the claimed invention and reads as follows:

1. A method for delivering at least one treatment to a plurality of wood chips for landscaping comprising the steps of:
 - a) combining the treatment, a foaming agent, and a solvent to form a landscaping composition;
 - b) foaming the landscaping composition to form a delivery medium for delivering the treatment to the wood chips;
 - c) applying the delivery medium to the wood chips to deliver the treatment to the wood chips;
 - d) containing the wood chips in a landscaping material processing machine; and
 - e) mixing the delivery medium with the wood chips in the landscaping material processing machine to apply the delivery medium to the wood chips;wherein the delivery medium has a degree of stability such that the delivery medium does not persist as a foam on the wood chips.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Brown	US 4,571,360	Feb. 18, 1986
Platek	US 5,302,017	Apr. 12, 1994
Goodson	US 5,494,514	Feb. 27, 1996
Ceaser	US 5,612,385	Mar. 18, 1997
Chao	US 5,696,174	Dec. 9, 1997
Kaufmann	US 6,301,829 B1	Oct. 16, 2001
Mangold	US 6,321,804 B1	Nov. 27, 2001

Appellants present additional evidence in the Declaration filed under 37 C.F.R. § 1.132 of Anthony C. Hesse, filed on January 22, 2008 (hereafter the “Hesse Declaration”).

The following rejections are before us for review:¹

The Examiner rejected claims 67, 69, 70, 82, and 86 under 35 U.S.C. § 102(b) as anticipated by Mangold.

The Examiner rejected claims 1-11, 13, 16-21, 48-50, 53-55, 57, 67, 69, 77-89, 92-94, 97-99, and 102-104 under 35 U.S.C. § 103(a) as unpatentable over Mangold, Brown, and Chao.

The Examiner rejected claims 14, 51, 52, and 70 under 35 U.S.C. § 103(a) as unpatentable over Mangold, Brown, Chao, and Ceaser.

¹ The rejections of claims 1-11, 13, 14, 16-25, 48-57, 67, 69, 70, and 77-86 on the grounds of nonstatutory obviousness-type double patenting over claims 1-10 of copending U.S. Application 10/924,747 and over claims 1-4, 7-9, and 12-17 of copending U.S. Application 10/453,070 have been withdrawn by the Examiner. Ans. 3. Likewise, the rejection of claims 87-89, 92-94, 97-99, and 102-104 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, has also been withdrawn by the Examiner. *Id.*

The Examiner rejected claims 20-23 and 25 under 35 U.S.C. § 103(a) as unpatentable over Mangold, Brown, and Goodson.

The Examiner rejected claim 24 under 35 U.S.C. § 103(a) as unpatentable over Mangold, Brown, Chao, Goodson, and Platek.

The Examiner rejected claim 56 under 35 U.S.C. § 103(a) as unpatentable over Mangold, Brown, Chao, and Kaufmann.

SUMMARY OF DECISION

We AFFIRM-IN-PART and ENTER A NEW GROUND OF REJECTION PURSUANT TO OUR AUTHORITY UNDER 37 C.F.R. § 41.50(b).

ANALYSIS

The anticipation rejection based upon Mangold

The Examiner found that Mangold's colored wood product has the same structure as the claimed treated landscaping material, as called for by independent claim 67. Ans. 4, 13. Appellants argue that, "the product produced by a process that includes the step of foaming the colorant versus one that does not include the foaming step [as per Mangold] was found to be quite different." Br. 14. According to Appellants:

The "unobvious differences" between a product made by the process of claim 67 and the prior art [Mangold] product include a drier product with less water content, a superior color intensity and uniformity that does not bleed in comparison to a colored wood product made by the process taught by Mangold.

Br. 14-15.

The patentability of a product does not depend on its method of production. If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process. *In re Thorpe*, 777 F.2d 695, 697 (Fed. Cir. 1985). Once the PTO has made out a prima facie case that the applicant's claimed product and the product of the prior art reasonably appear to be the same, the burden shifts to the applicant to prove otherwise. *Id.* The burden of proof on the PTO in making out a case of prima facie obviousness for product-by-process claims is less than when a product is claimed in the more conventional fashion. *In re Fessman*, 489 F.2d 742, 744 (CCPA 1974).

Mangold teaches a dried colored wood product that has “intense color and which is substantially more uniform.” Mangold, col. 1, ll. 45-46. However, Mangold’s colored wood product is not produced by foaming the colorant. Rather, in Mangold, the wood chips are sprayed with a colorant solution in a first step, and then, in a second step, immersed in a bath of colorant solution to produce a colored wood product. Mangold, col. 1, ll. 55-62 and col. 3, ll. 35-38. Appellants allege that a wood chip product colored by a foam treatment is drier, does not bleed after treatment, and uses half to one-fifth the amount of water that non-foaming systems use to treat similar quantities of wood chips with a similar amount of pigment, and furthermore, requires a fraction of the drying time. Hesse Declaration, paras. 8-11; *see also* Br. 40, Evidence App’x, Exhibits A-C. We are not persuaded by the Hesse Declaration because an applicant relying on comparative tests to rebut a prima facie case of obviousness must compare his claimed invention to the closest prior art. *In re De Blauwe*, 736 F.2d

699, 705 (Fed. Cir. 1984). In this case, the Hesse Declaration compares the claimed wood colored product produced by foaming the colorant with a wood colored product produced by immersion in a bath of colorant solution, and not to Mangold's colored wood product that is produced in a two-step process which includes a colorant spray and a colorant bath to deliver the colorant to the wood chips. Thus, Appellants have not provided any persuasive evidence to show that the dryness, color intensity and uniformity of the claimed wood colored product produced by foaming the colorant are patentably distinct from Mangold's colored wood product. Moreover, we note that independent claim 67 does not include any limitations drawn to the dryness, color intensity and uniformity of the claimed wood colored product produced by foaming the colorant. As such, Appellants have not provided any persuasive evidence that establishes that foaming the colorant, per se, yields a structure that differs from that of Mangold's colored wood product.

For the above reasons, we find that (1) the evidence of record is sufficient to establish a prima facie case that Mangold's colored wood product and the claimed treated landscaping material produced by foaming the colorant appear to be the same, so as to shift the burden to Appellants to prove otherwise, and (2) Appellants have not come forth with any persuasive evidence to show that Mangold's colored wood product is not the same as a colored wood product produced by foaming the colorant.

Thus, for the foregoing reasons, the rejection of claim 67 under 35 U.S.C. § 102(b) as anticipated by Mangold is sustained.

With respect to the rejection of claims 69, 70, 82, and 86, Appellants do not present any other substantive arguments. Br. 15. Accordingly, we

shall also sustain the rejection of claims 69, 70, 82, and 86 under 35 U.S.C. § 102(b) as anticipated by Mangold.

The obviousness rejection based upon Mangold, Brown, and Chao

The Examiner found that Mangold discloses all the limitations of each of independent claims 1, 48, and 57, but “is silent on a foaming agent and foaming delivery medium for the treatment.” Ans. 5. The Examiner further found that Brown describes a foaming agent treatment of a fibrous substrate, *i.e.*, paper. Ans. 5-6; *see also* Brown, col. 3, ll. 38-53. Hence, according to the Examiner, modifying Mangold according to Brown “is merely the selection of a known alternate delivery medium *i.e.* a known coloring technique.” Ans. 14-15. However, according to the Examiner, “Mangold as modified by Brown teaches applying the [foaming] treatment to paper, which is a wood product, but is silent on explicitly teaching wood chips.” Ans. 6. Thus, the Examiner turned to Chao to show that “treatment via a foaming agent is a notoriously well-known application to both paper and wood.” *Id.* (citing to Chao, col. 2, l. 34 and col. 10, Example 20). The Examiner concluded that “[i]t would have been obvious to one of ordinary skill in the art to further modify the teachings of Mangold as modified by Brown with the teachings of Chao as a teaching of general knowledge in the art that paper and wood are interchangeable recipients of foamed treatment coatings.” *Id.*

Appellants argue that because (1) each of independent claims 1, 48, and 57 requires that, “the delivery medium has a degree of stability such that the delivery medium does not persist as a foam on the wood chips” and (2) Chao discloses the use of a stable foam to paper and wood surfaces, “Chao

et al. teach away from non-stable foams.” Br. 15, 16, and 17; *see also* Br., Claims App’x. We agree.

Chao describes the “application of a stable foam.” Br. 18; *see also* Chao, Abstract. Specifically, Chao discloses that in contrast to conventional foam coatings which exhibit a quick collapse upon application to an absorbing surface, the foams “formed in accordance with the present invention have excellent foam stability on absorbing surfaces.” *Id.*, col. 10, ll. 46-54. Although we appreciate the Examiner’s position that “Chao was not cited to teach the components and ingredients of the foaming system,” Ans. 16, nonetheless, because Chao does not describe the use of a non-stable (collapsible) foam treatment (as the foam treatment of Brown) for both paper and wood products, we do not agree with the Examiner’s determination that Chao is “evidence of general knowledge of one of ordinary skill in the art that paper and wood are interchangeable recipients of foamed treatment coatings.” Ans. 15-16. At most, the teachings of Chao are limited to the application of a *stable* foam treatment to paper and wood products. Thus, because the treated material in Mangold, *i.e.*, wood chips, is different from the treated material in Brown, *i.e.*, paper, and the foam of Chao is not a collapsible (non-stable) foam, we do not agree with the Examiner that it would have been obvious for a person of ordinary skill in the art to use the foaming agent treatment of Brown to treat the wood chips of Mangold.² The Examiner has not shown by a preponderance of the

² Although we appreciate the Examiner’s position that Ashmus (US 4,023,526, iss. May 17, 1977) “teaches that paper and wood are alternate substrates for receiving a foamed colorant treatment,” we note that the teachings of Ashmus were not used in this rejection. *See* Ans. 16 (citing to Ashmus, col. 6, l. 9).

evidence that the foaming agent treatment of Brown can be applied to any other types of materials in order to suggest that it is capable of being applied to the wood chips of Mangold as an alternative delivery medium, as the Examiner proposes.

Although we appreciate that obviousness does not require absolute predictability, at least some degree of predictability is required. The Examiner has not made the initial factual findings required to demonstrate a prima facie case of obviousness of independent claims 1, 48, and 57. *See In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967) (the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions, or hindsight reconstruction to supply deficiencies in the factual basis).

In conclusion, for the foregoing reasons, we cannot sustain the rejection of independent claims 1, 48, and 57, and their respective dependent claims 2-11, 13, 16-21, 49, 50, 53-55, 77-81, 83-85, 87-89, 92-94, 97-99, and 102-104 under 35 U.S.C. § 103(a) as unpatentable over Mangold, Brown, and Chao. *See In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988).

With respect to the rejection of claims 67, 69, 82, and 86 over the combined teachings of Mangold, Brown, and Chao, we note that a disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for “anticipation is the epitome of obviousness.” *Jones v. Hardy*, 727 F.2d 1524, 1529 (Fed. Cir. 1984). *See also In re Fracalossi*, 681 F.2d 792, 794 (CCPA 1982); *In re Pearson*, 494 F.2d 1399, 1402 (CCPA 1974). Thus, we shall sustain the rejection of claims 67, 69, 82, and 86 under 35 U.S.C. § 103(a) as unpatentable over Mangold, Brown,

and Chao. For the same reasons, we shall also sustain the rejection of claim 70 as unpatentable over the combined teachings of Mangold, Brown, Chao, and Ceaser.

Lastly, the addition of Ceaser, Goodson, Platek, or Kaufmann does not remedy the deficiencies of Mangold, Brown, and Chao as described above. Accordingly, the rejections under 35 U.S.C. § 103(a) of claims 14, 51, and 52 as unpatentable over Mangold, Brown, Chao, and Ceaser; of claims 20-23 and 25 as unpatentable over Mangold, Brown, and Goodson; of claim 24 as unpatentable over Mangold, Brown, Chao, Goodson, and Platek; and of claim 56 as unpatentable over Mangold, Brown, Chao, and Kaufmann likewise cannot be sustained.

NEW GROUND OF REJECTION

We make the following new ground of rejection pursuant to 37 C.F.R. § 41.50(b).

Claims 1, 48, and 57 are rejected under 35 U.S.C. § 103(a) as unpatentable over Mangold, Brown, and Ashmus.

Mangold discloses a process for making a colored wood product including grinding wood in a mill, sieving the wood product, spraying the sieved wood product with an aqueous colorant solution, immersing the wood product in a bath of aqueous colorant solution, and then removing and drying the resulting colored wood product. Mangold, Abstract and col. 1, ll. 50-62. Mangold does not disclose using a foaming agent as a foaming delivery system for the colorant. Brown discloses a method for delivering a treatment to a paper substrate including: (1) providing a liquid composition of a liquid vehicle (i.e., solvent), paper treating agent (i.e., colorant), and a

foaming agent; (2) mixing the liquid composition with a gas to form a limited stability foam; and (3) applying the foam to a paper substrate that results in a treated paper free of foaming agent. Brown, col. 3, ll. 38-53; col. 4, l. 19 and 39-43. Ashmus discloses applying a coloring treatment to a surface of a porous substrate, such as paper or wood, using a limited-stability foam. Ashmus, Abstract; col. 6, ll. 7-9 and 13-14; and col. 7, ll. 1-2. Ashmus further discloses that in comparison to immersing the porous substrate in a bath containing the treating material, when using a limited-stability foam to treat the porous substrate, the amount of water and energy required is reduced. *Id.*, col. 1, ll. 6-9 and col. 6, ll. 20-29. Thus, because Ashmus teaches that it is known to apply a coloring treatment using a limited-stability foam to both paper and wood substrates, it would have been obvious for a person of ordinary skill in the art to replace the aqueous delivery system of Mangold with the foam delivery system of Brown in order to reduce the amount of water and energy required to treat and dry the wood chips of Mangold.

With respect to independent claim 48, although Brown discloses an alkyl surfactant (*see* Brown, col. 5, ll. 30-33), Brown does not specifically disclose that, “the concentration of the surfactant in the landscaping composition is at least about 300 ppm actives.” Br., Claims App’x. However, Brown discloses that the amount of foaming agent depends on a variety of factors, such as, the particular foaming agent, the particular paper treating agent, the rate of foam application, etc. Brown, col. 6, ll. 4-9. Furthermore, it is known that the purpose of the surfactant is to promote foam formation by reducing surface tension of the liquid medium. Thus, it would have been obvious for a person of ordinary skill in the art to use

routine experimentation to determine an optimum surfactant concentration of at least about 300 ppm actives in the treatment composition of Mangold, Brown, and Ashmus. *See In re Aller*, 220 F.2d 454, 456 (CCPA 1955) (“where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation” (citations omitted)); *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1368 (Fed. Cir. 2007) (“discovery of an optimum value of a result effective variable is ordinarily within the skill of the art” and thus usually obvious (citation omitted)).

Although we decline to reject every claim under our discretionary authority under 37 C.F.R. § 41.50(b), we emphasize that our decision does not mean the remaining claims are patentable. Rather, we merely leave the patentability determination of these claims to the Examiner. *See* MPEP § 1213.02.

SUMMARY

The decision of the Examiner is affirmed as to claims 67, 69, 70, 82, and 86 and reversed as to claims 1-11, 13, 14, 16-25, 48-57, 77-81, 83-85, 87-89, 92-94, 97-99, and 102-104.

We enter new grounds of rejection of claims 1, 48, and 57 under 35 U.S.C. § 103(a) as unpatentable over Mangold, Brown, and Ashmus.

Regarding the affirmed rejection(s) that have not been denominated as new grounds of rejection, 37 C.F.R. § 41.52(a)(1) provides “Appellant[s] may file a single request for rehearing within two months from the date of the original decision of the Board.”

In addition to affirming the Examiner's rejection(s) of one or more claims, this decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." 37 C.F.R. § 41.50(b) also provides that Appellants, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should Appellants elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejections, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejections are overcome.

If Appellants elect prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Patent Trial and Appeal Board for final action on the affirmed rejections, including any timely request for rehearing thereof.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)

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