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BARNES & THORNBURG LLP P.O. Box 2786 CHICAGO, IL 60690-2786			TRIGGS, ANDREW J	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STEVEN J. TENUTE

Appeal 2011-000035
Application 11/768,492
Technology Center 3600

Before: WILLIAM V. SAINDON, SCOTT A. DANIELS, and JILL D. HILL, *Administrative Patent Judges*.

DANIELS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Steven J. Tenute (Appellant) appeals under 35 U.S.C. § 134 from a rejection of claims 1-11. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

THE INVENTION

Appellant's invention is directed to a rain gutter protection device which prevents debris from infiltrating the gutter, and the gutter protection device has a roof-matching coating on the upper surface. Spec. 1. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A rain gutter protecting device, comprising
 - a. an elongated, continuous body adapted to be affixed proximate a roof and to extend outwardly from the roof over a rain gutter secured along one edge of the roof, and including an apertured trough oriented downwardly into the rain gutter, said body having an upper surface, and
 - b. a roof-matching coating said upper surface of said body, said coating comprising granules embedded in a substrate secured to said body, said coating extending into said trough, said granules slowing flow of water, allowing higher flows of water into said trough, and diverting flowing water to promote a more uniform flow of water into said trough.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Tenute	US 5,457,916	Oct. 17, 1995
Neimann	US 7,119,135	Oct. 10, 2006

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How Products Are Made: Volume 3- Shingle (2006) (found at: <http://www.madehow.com/Volume-3/Shingle.html>) (hereafter “How Products Are Made: Volume 3”).

REJECTIONS

The Examiner made the following rejections:

Claims 1-6 and 8-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Tenute in view of How Products Are Made. Ans. 3.

Claims 7 and 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Tenute, How Products Are Made, and Neimann. Ans. 7.

ANALYSIS

Claims 1-6 and 8-10 as unpatentable over Tenute in view of How Products Are Made.

The Examiner found that Appellant’s claimed rain gutter protector was disclosed in Appellant’s own prior patent (Tenute). Ans. 3. The Examiner also found that Tenute specifically disclosed “[r]oofing material, shown generally at 36, may then be applied over the main body 12 to at least partially cover the protecting device 10, providing a more aesthetic appearance to the invention.” *Id.* (citing Tenute, col. 3, ll. 44-47). The Examiner determined that it would have been obvious to one of skill in the art “to take the ‘partially covered’ device to be covered in the trough portion in order to provide a uniform aesthetic appearance to the device.” *Id.* at 4. The Examiner further determined that based on How Products are Made, one of skill in the art would also have been motivated to modify the device “with a roofing like coating and more specifically, one like a roofing shingle in order to provide a more aesthetic appearance to the gutter protector.” *Id.*

Appellant argues that it would not have been obvious to coat the entire surface of the gutter protection device based on the partially overlapping roofing material disclosed in Tenute in order to provide a uniform aesthetic appearance to the device. App. Br. 3. Appellant also contends that the Examiner's reasoning for coating the entire upper surface of the gutter protection device (including the trough 14) with a substrate coating *secured* to the device and embedded granules in the coating, is based upon hindsight taken from the teachings of Appellant's present Application. *Id* (emphasis added).

Appellant's prior patent teaches the following application of the gutter protection device 10 over the gutter 28:

Roofing material, shown generally at **36**, may then be applied over the main body **12** to at least partially cover the protecting device **10**, providing a more aesthetic appearance to the invention. The roofing material **36** may extend as far as desired along the main body **12**, up to the edge region **14**.

Tenute, col. 3, ll. 44-47. Figure 1 of Tenute discloses the partial overlapping of roof material, e.g., the lower portion of a shingle, over a portion of the body 12 of gutter protection device 10. What is not disclosed by Tenute is *securing* of a substrate and embedded granules to, or on, an upper surface of the body 12 of the device 10 as recited in Appellant's claims 1 and 9. The Examiner turns to How Products Are Made, which explains the structure and manufacture of asphalt roofing shingles, and reasons that it would be aesthetically pleasing to coat the entire upper surface of the gutter protection device with "a roofing like coating." Ans. 4. Tenute however already indicates that it is aesthetically pleasing to overlay, or overlap, the main body 12 of the gutter protection device 10 with the roofing material. For its part, How Products Are Made merely explains the composite structure of

asphalt shingles. Indeed, such shingles are already disclosed, generally speaking, in Tenute as roofing material overlapping the gutter protection device. With the known roofing material 36 as shown in Tenute's Figure 1 overlapping the main body 12, (as it must) so that water is appropriately directed over the intersection of the device 10 and the roof 22 into the trough 20 and gutter 28, and with the overlapping roofing material 36 hiding the main body 12 of the gutter protector for purposes of aesthetic appearance, we can discern no apparent reason why one of ordinary skill in the art would have considered it obvious to coat the gutter protection device itself with additional substrate and granules for reasons of aesthetic appearance. The reasons proffered by the Examiner "that a shingle is a coating material since shingles coat a roof" (Ans. 9) appears to be already accomplished by Tenute where the shingles are "applied over the main body **12** to at least partially cover the protecting device **10**, providing a more aesthetic appearance to the invention." Tenute, col. 3, ll. 45-47. The Examiner has not provided any evidence or offered any technical reasoning explaining that replacing the overlapping roofing material with a coating *secured* directly on the upper surface of the gutter protection device would provide an improved aesthetic appearance to the gutter protection device beyond that already accomplished by the overlapping roofing material which "may extend as far as desired along the main body **12**, up to the edge region **14**." Tenute, col. 3, ll. 47-48. In other words, we fail to see how, in this case, "aesthetics" explains a proposed modification of directly coating a material, instead of having the existing aesthetic covering. Thus, the Examiner's rejection is insufficient to explain why a person having ordinary skill in the art would have considered it obvious to replace the overlapping roofing material from Tenute with a

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coating directly on the upper surface of the gutter protection device as claimed.

Accordingly, for the foregoing reasons, we cannot sustain the rejection of independent claim 1 and its dependent claims 2-6 and 8.¹ Independent claim 9 includes the same structure as recited in claim 1 and therefore we also cannot sustain the obviousness rejection of claims 9 and 10.

Claims 7 and 11 as being unpatentable over Tenute in view of How Products Are Made, and further in view of Niemann.

With respect to the rejections of dependent claims 7 and 11 under 35 U.S.C §103(a), Niemann is directed to a seed oil based coating for application to building materials such as roofing, wood, metals and stucco. The coating provides a desired amount of solar reflectivity to reduce heat developed in the building materials and hence lowers the heat in the building. Niemann, col. 1, ll. 5-30. Niemann's disclosure relates specifically to the chemical composition of such coatings and thus does not remedy the deficiencies of Tenute and How Products Are Made, as described above. Thus, we likewise cannot sustain the rejection of claims 7 and 11 over the combined teachings of Tenute, How Products Are Made and Niemann.

¹ Dependent claims subject to the same rejection are nonobvious under section 103 if the independent claims from which they depend are nonobvious. *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988).

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DECISION

For the above reasons, the Examiner's rejection of claims 1-11 is reversed.

REVERSED

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