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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TIMOTHY M. PIERZYNSKI and ERIK SKOV

Appeal 2011-000155
Application 11/668,134
Technology Center 3600

Before JAMES P. CALVE, WILLIAM A. CAPP, and
JEREMY M. PLENZLER, *Administrative Patent Judges.*

CAPP, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 1, 2, 4-6, 8, 12 and 17-19. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM and ENTER A NEW GROUND OF REJECTION UNDER 37 C.F.R. § 41.50(b).

THE INVENTION

Appellants' invention places a three-dimensional pattern on a building panel. Spec. 1, paras. [0001] and [0003]. Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A plastic material panel comprising:

a primary pattern molded into the plastic panel having a plurality of raised areas and a plurality of recessed areas said raised areas and said recessed areas defining said primary pattern in relief and being arranged such that said raised areas and said recessed areas are visible when the panel is mounted on a roof;

a first secondary pattern molded into the plastic panel comprising a first configuration of raised areas and a second secondary pattern molded into the plastic panel comprising a second configuration of raised areas where said first configuration is different than said second configuration, the first secondary pattern located in selected ones of said plurality of raised or recessed areas and the second secondary pattern located in other selected ones of said plurality of raised or recessed areas different than the selected ones of said plurality of raised or recessed areas.

EVIDENCE RELIED UPON AND THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Felton	US 6,983,571	Jan. 10, 2006
Morse	US 2006/0026919 A1	Feb. 9, 2006

The following rejections are before us for review:

1. Claims 1, 2, 4-6, 8, 17 and 19 are rejected under 35 U.S.C. § 102(b) as being anticipated by Morse.¹
2. Claim 12 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Morse and Felton.
3. Claim 18 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Morse.

OPINION

Anticipation by Morse

Claims 1, 17 and 19

Appellants challenge the Examiner's anticipation rejection of independent claims 1, 17 and 19, respectively, on essentially the same, single ground. Appellants do not deny that Morse discloses a textured building panel with a primary pattern having raised and recessed areas. However, they assert that Morse's panel has its first "secondary pattern" in a raised area of the primary pattern and has its second "secondary pattern" in a recessed area of the primary pattern. App. Br. 5. Appellants argue that claims 1, 17 and 19, respectively, do not read on such an embodiment and that, therefore, Morse does not anticipate.

¹ Claim 3 is listed in the Claims Appendix as Cancelled.

The Examiner responds that Morse teaches two secondary patterns within a primary pattern as claimed. Ans. 4-6, 8.

The first secondary pattern is the texture of the stones and the second secondary pattern is the texture of the mortar. Each one of these secondary patterns would have raised and recessed areas as an inherent characteristic of being a texture. If these patterns did not have raised areas, the pattern would be a smooth surface. These two textures are not the same because they represent different materials. The first secondary pattern (stone texture) is placed on the raised sections of the primary pattern (stones) and the second secondary pattern (mortar texture) is placed on the recessed sections of the primary pattern (mortar lines). Each of the secondary patterns are a texture and are not necessarily tied to a specific location in the primary pattern.

Ans 8.

In reply, Appellants argue that Morse's recessed area is smooth, thus lacking a secondary pattern, and, even if Morse's recessed area is patterned:

the panel of Morse would not anticipate Applicants' claims because one secondary pattern would occur only in the raised areas of Morse, and the other only in the recessed areas.

Reply 2. Appellants assert that claims 1, 17 and 19 require the differing secondary patterns to occur in the raised areas of the primary pattern. *Id.*

We begin with Appellants' argument that Morse's recessed, mortar area is smooth and, therefore, lacks a secondary pattern. Appellants raise this argument, for the first time, in their Reply Brief. Appellants were on notice that this was a potential issue in the Final Rejection. *See* Final Rejection 7.² Nevertheless, it was not raised in the Appeal Brief and no reason is given for failing to raise the issue earlier and, consequently, the

² "The second secondary pattern is the texture of the grout . . . grout is not perfectly smooth like glass." *Id.*

argument is untimely and we decline to consider it. *See Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010).³

Next, we consider Appellants' argument that two different secondary patterns must reside in the raised areas of the primary pattern. The plain and literal reading of claim 1 allows that the first secondary pattern can reside in a raised area "or" a recessed area of the primary pattern. App. Br., Clms. App'x. The claim language further provides that the second secondary pattern may be located in "other" either raised "or" recessed areas of the primary pattern. *Id.* The claim language does not preclude one secondary pattern from residing in a raised area of the primary pattern and a second secondary pattern from residing in a recessed area of the primary pattern.

Accordingly, we sustain the Examiner's rejection of claim 1. Furthermore, with respect to claims 17 and 19, Appellants raised essentially the same issue and argument as in claim 1. The analysis is essentially the same as in claim 1 and we reach the same result, sustaining the rejection of claims 17 and 19.

Claims 2, 4-6 and 8

Claims 2, 4-6 and 8 all depend directly from claim 1. In traversing these dependent claims, Appellants raise no new arguments beyond what was previously argued with respect to claim 1. Therefore, claims 2, 4-6 and 8 fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii).

³ "The reply brief is *not* an opportunity to make arguments that could have been made during prosecution, but were not. Nor is the reply brief an opportunity to make arguments that could have been made in the principal brief on appeal to rebut the Examiner's rejections, but were not."

Rejection of Claim 12 Over Morse and Felton

Claim 12 depend directly from claim 1. In traversing the rejection of claim 12, Appellants raise no new arguments beyond what was previously argued with respect to claim 1. Therefore, claim 12 falls with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Rejection of Claim 18 Over Morse

Claim 18 is an independent claim. In traversing the rejection of claim 18, Appellants raise no new arguments beyond what was previously argued with respect to claim 1. Therefore, claim 18 falls with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii).

*New Ground of Rejection
Anticipation of Claims 1, 2, 4-6, 8 and 19 by Morse*

As discussed more fully above, Appellants' sole argument to traverse the anticipation rejection was that Morse lacked two different secondary patterns on raised portions of the primary pattern. Although we disagree with Appellants and agree with the Examiner on this point, we nevertheless find that claims 1, 2, 4-6, 8 and 19 are anticipated for an additional reason not articulated in the Final Rejection or Answer and, accordingly, we hereby designate a new ground of rejection, pursuant to our authority under 37 C.F.R. § 41.50(b).

Morse discloses a building panel where the primary pattern simulates the appearance of stone siding. Morse, para [0008]. The imitation stone is made by shaping a mold cavity with a surface that follows a topography of one or more natural stones. *Id.*, para. [0009]. That primary pattern comprises a plurality of raised areas simulating the shapes of a plurality of stones. *See* Figure 1. A person of ordinary skill in the art reading the

specification of Morse, as a whole, would understand that each of the individual, simulated stones in the primary pattern is capable of bearing a unique, three-dimensional surface texture or pattern in order to simulate the variety of natural stone shapes and textures exhibited in nature. *See, e.g.*, Morse, para [0009] (“An imitation stone material is formed in the mold cavity to replicate the topography of each natural stone on the imitation stone material . . .”). This variation in topography among the plurality of simulated stones (*i.e.*, no two stones are alike) in the raised area of the primary pattern in Morse satisfies the limitation in claim 1 directed to first and second secondary patterns located in selected ones of the plurality of raised or recessed areas.

In addition to the foregoing, we adopt the Examiner’s findings with respect to claims 1, 2, 4-6, 8 and 19 set forth on pages 4-6 of the Answer, such that all limitations of such claims are met by Morse. For the foregoing reasons, we designate a new ground of rejection under 35 U.S.C. § 102(b) of claims 1, 2, 4-6, 8 and 19 as anticipated by Morse.

DECISION

The Examiner’s decision to reject claims 1, 2, 4-6, 8, 17 and 19 under 35 U.S.C. § 102(b) as being anticipated by Morse is affirmed.

The Examiner’s decision to reject claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Morse and Felton is affirmed.

The Examiner’s decision to reject claim 18 under 35 U.S.C. § 103(a) as being unpatentable over Morse is affirmed.

We designate a NEW GROUND OF REJECTION of claims 1, 2, 4-6, 8 and 19 under 35 U.S.C. § 102(b) as anticipated by Morse.

FINALITY OF DECISION

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 the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground 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 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.

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; 37 C.F.R. § 41.50(b)

Appeal 2011-000155
Application 11/668,134

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