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FAY SHARPE / SHURTECH 1228 Euclid Avenue, 5th Floor The Halle Building Cleveland, OH 44115			THOMAS, ALEXANDER S	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOHN E. SCHNOEBELEN, JR.

Appeal 2012-000090
Application 12/362,521
Technology Center 1700

Before BRADLEY R. GARRIS, RICHARD TORCZON, and
BEVERLY A. FRANKLIN, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134, Appellant appeals from the Examiner's rejection under 35 U.S.C. § 103(a) of claims 78, 80-85, 87-89, and 91-93 as unpatentable over Goltz (G 9418708 U1, published July 13, 1995; as translated) in view of Alef (US 3,752,304, issued Aug. 14, 1973), Jones (US 4,420,520, issued Dec. 13, 1983), and Griffin (US 4,696,706, issued Sept. 29, 1987). We have jurisdiction under 35 U.S.C. § 6.

We AFFIRM-IN-PART.

Appellant claims a paint mask package comprising a plurality of paint mask sheets with each sheet having an adhesive area and a non-adhesive area, the plurality of paint mask sheets being stacked to form a pad which in turn forms the package, and the pad or package presenting each uppermost sheet for grasping between a thumb and fingers by the non-adhesive area for removing the uppermost sheet from the pad or package (independent claim 78; *see also* independent claims 81, 83, 84, 85, 87, and 91). In a broader embodiment, the paint mask package presents individual sheets "for removing from said package by grasping said non-adhesive area" (independent claim 93).

Representative claim 78 reads as follows:

78. A paint mask package for masking corner areas of a window adjacent work pieces to be painted, comprising:

said paint mask package including a plurality of paint mask sheets, wherein each of said plurality of paint mask sheets comprises:

opposite bottom and top faces and at least a first and a second outer edge, said at least first and second outer edges intersecting at an angle of 90°;

said sheets include an inner edge;

said sheet includes a non-adhesive area on said bottom face along said inner edge;

said sheet includes an adhesive on said bottom face wherein said adhesive includes an area extending completely from said first and second outer edges toward said non-adhesive area;

said non-adhesive area extends completely from said inner edge towards said adhesive area wherein said sheet includes a single line of demarcation between said adhesive area and said non-adhesive area;

said non-adhesive area includes at least two non-adhesive outside corners;

said plurality of paint mask sheets comprising a stack of paint mask sheets wherein individual paint mask sheets having said non-adhesive area along said inner edge being releasably oriented one directly on top of another to form a pad;

a first said pad and a second said pad nestled together to provide said paint mask package; and,

said pad presents each uppermost said sheet for grasping and wherein said non-adhesive outside corners facilitate said grasping between a thumb and fingers by said non-adhesive area on said bottom face and said top face for removing from said package.

The Examiner concludes that it would have been prima facie obvious to provide the L-shaped paint mask sheets of Goltz with a non-adhesive area in view of Alef, to stack the resulting sheets in pad form in view of Jones, and to provide the resulting pad(s) in a package in view of Griffin (Ans. 4-6).

Further, the Examiner indicates (1) that the claim recitation of grasping the non-adhesive area with one hand and/or with a thumb and fingers constitutes a statement of intended use rather than an additional structural feature and, in any event, (2) that the paint mask package resulting from the combined prior art would possess the capability of being grasped in the manner recited by the rejected claims (*id.* at 6).

Appellant argues that the applied references contain no teaching or suggestion of the claim feature wherein the package presents the non-adhesive area of an uppermost sheet for grasping between a thumb and fingers for removing the sheet (*see, e.g.*, App. Br. 14, 15, 16, 18, 19). Correspondingly, Appellant argues that the claim recitation concerning this feature is not merely intended use but in fact lends an additional structural feature to the claimed package (*id.* at para. bridging 18-19) and that the combined references would not result in this claim feature except by impermissible hindsight (*id.* at 15).

We agree with Appellant that representative independent claim 78 requires a structural limitation in the form of a package which presents the non-adhesive area of an uppermost sheet for grasping between a thumb and fingers for removing the sheet from the package. The claim language describing this limitation is not merely a statement of intended use as the Examiner believes. Rather, this claim language defines a functional capability of the package (i.e., the capability of being grasped between a thumb and fingers in the recited manner).

Moreover, the record of this appeal supports Appellant's argument that the applied references contain no teaching or suggestion of this argued claim feature. As previously indicated, the Examiner states that "the sheets in the

combined prior art product, wherein the adhesive covers only a portion of the sheets, are capable of being removed by one hand and thus meet the instant claim limitations" (Ans. 6). However, the Examiner has not embellished this statement with any specific explanation of how and why the applied references would have been combined so as to result in a package having the functional capability under consideration. Based on the record before us, the Examiner's unembellished statement is conclusory and therefore unconvincing.

For the above stated reasons, we will not sustain the Examiner's § 103 rejection of claims 78, 80-85, 87-89, 91, and 92.

However, we will sustain the § 103 rejection of independent claim 93. As conceded by Appellant (*see* App. Br. 14), claim 93 does not require the above discussed functional capability wherein the package presents the non-adhesive area of an uppermost sheet for grasping between a thumb and fingers for removing the sheet from the package. Instead, claim 93 defines a broader requirement wherein the package presents individual sheets "for removing from said package by grasping said non-adhesive area." Appellant has not provided this appeal with any reasonably specific argument concerning claim 93 and therefore has failed to reveal error in the Examiner's rejection of this claim.

The decision of the Examiner is affirmed-in-part.

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

Appeal 2012-000090
Application 12/362,521

ORDER
AFFIRMED-IN-PART

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