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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SALVATORE C. IMMORDINO JR., RONALD E. SCHENCK,
and CHARLES MILLER

Appeal 2012-00308
Application 11/639,793
Technology Center 1700

Before TERRY J. OWENS, PETER F. KRATZ, and
ROMULO H. DELMENDO, *Administrative Patent Judges*.

KRATZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-4, 7, 8, and 10-12. We have jurisdiction pursuant to 35 U.S.C. § 6.

Appellants' claimed invention is directed to a method of making a joint compound wherein a water soluble synthetic wax dedusting agent is presolubilized in water only so as to form a pre-solubilized dedusting agent that can be used in forming the joint compound (Spec. 6). The joint compound that is formed can be typically used in wall repairs and for finishing the joints between sheets of drywall (*id.* at 1-3).

Claim 1 is illustrative and reproduced below:

1. A method of making a joint compound comprising:

selecting a dedusting agent which is a solid at room temperature but which liquefies under friction of sanding, cutting or abrading, wherein the dedusting agent is a water-soluble synthetic wax.;

presolubilizing the dedusting agent in water only to make a presolubilized dedusting agent;

combining dry components, including at least one filler, to make a dry mixture;

pumping process water into a vessel;

introducing the presolubilized dedusting agent to the vessel;

adding the dry mixture to the vessel; and

blending the dry mixture, water and presolubilized dedusting agent to make a homogeneous product.

The Examiner relies on the following prior art references as evidence in rejecting the appealed claims:

Ball	US 3,650,785	Mar. 21, 1972
Langford	US 2001/0011112 A1	Aug. 2, 2001
Immordino, Jr.	US 6,673,144 B2	Jan. 6, 2004

Claims 1-3, 7, 8, and 10-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Langford in view of Immordino. Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Langford in view of Immordino and Ball.

We affirm the stated rejections. Our reasoning follows.

Concerning the first stated rejection, Appellants argue claims 1, 7, 8, and 10-12 as a group. Accordingly, we select claim 1 as the representative claim on which we decide this appeal as to this claim grouping. We consider dependent claims 2 and 3 separately to the extent separately argued.

The Examiner relies on Langford for teaching a method of making a low dust joint compound by combining water, a dust reducing additive such as Carbowax¹ synthetic wax, a binder, filler, etc. (Ans. 4, 5, and 7). The Examiner notes that Langford discloses that Carbowax is soluble or miscible in water (*id.* at 4; Langford, para. 0080).

The Examiner relies on Immordino for teaching, *inter alia*, a method of making a low dust joint compound wherein the dry ingredients can be combined in a mixer (Ans. 5; Immordino, col. 8, ll. 50-52).

Based on the combined teachings of the applied references, the Examiner basically maintains that it would have been obvious for one of ordinary skill in the art to combine dry ingredients of Langford's joint compound formula, as taught by Immordino, in forming the joint compound of Langford. Moreover, the Examiner indicates that the rejection is further founded on an assertion to the effect that employing a pre-solubilizing step for the dust reducing agent of Langford in water only for forming a

¹ Carbowax 540 is a polyethylene glycol synthetic wax available from Union Carbide Corp., Danbury, Conn. (Langford, paras. 0047 and 0080).

homogenous joint compound product would have been an obvious arrangement of the order of the steps for bringing together Langford's joint compound ingredients to one of ordinary skill in the art seeking to make the desired product mixture (joint compound) of Langford given the disclosures of Langford (Ans. 8).

Appellants do not challenge the Examiner's rejection based on an argued lack of combinability of Langford and Immordino, as proposed by the Examiner (*see generally* App. Br.). Rather, Appellants urge that Langford does not teach or suggest pre-solubilizing dedusting agent in water only, as required by representative claim 1 (*id.* at 10-15: Reply Br. 2 and 3). In this regard, Appellants correctly observe that neither of Langford's Examples 2 and 3 describe the claimed pre-solubilizing of a synthetic wax dedusting agent in water only, as required by appealed claim 1 (App. Br. 11-13).

While the Examiner may have erred by categorically stating that "Langford teaches . . . presolubilizing Carbowax 540 in water only (Table 2, Formulation 3, para 0079)" (Ans. 4), Appellants' argument to this effect does not indicate that the Examiner was mistaken in concluding that the applied prior art would have led one of ordinary skill in the art to a method embraced by representative claim 1; that is, a method that includes such a presolubilizing step, by exercising routine skill in arranging the bringing together of the product joint compound ingredients of Langford and with a reasonable expectation of success in so doing (App. Br. 11-14).

After all, "[a] person of ordinary skill is also a person of ordinary creativity, not an automaton." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007). In making an obviousness determination one "can take account

of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 418.

In arguing that the Examiner’s rejection was made in error, the Appellants rely on their Specification, which includes a discussion of the problems in the prior art. Spec. 4, l. 16 -5, l. 22; Reply Brief filed August 29, 2011. That discussion must be considered for all purposes in our review of the Examiner’s obviousness conclusion.² Specifically, Appellants acknowledge that water soluble synthetic waxes known to be useful as dedusting agents, such as polyethylene glycol (PEG 750), take time to dissolve in water and are known to clog dry additive transfer equipment (Spec. 4, l. 16-5, l. 6). Such facts would, of course, have been readily observable by one of ordinary skill in the art adding the known water soluble synthetic wax to a joint compound mixture by way of dry or wet addition. One of ordinary skill in the art, through no more than ordinary creativity, would have been led by Langford, taken with Immordino, to employ pre-solubilizing of the synthetic wax dedusting additive of Langford as an option in ordering the steps of bringing together the joint compound ingredients of Langford with the expectation of successfully producing a uniform product joint compound with the expected benefit of not having to wait for the dedusting agent to dissolve in water as would have been the case if a known slowly dissolvable dedusting agent was not pre-solubilized.

² *Cf. In re Hedges*, 783 F.2d 1038, 1039 (Fed. Cir. 1986) (“Hedges had relied on these references before the Board, as he does before us, for his argument that viewed as a whole the body of prior art teaches away from conducting this reaction at high temperatures. The Solicitor should not be constrained from pointing to other portions of these same references in contravention of Hedges’ position.”).

As we noted above, Langford teaches that the Carbowax 540 additive is soluble or miscible in water (para 0080). Langford's disclosure of the water miscibility properties of the synthetic wax dust reducing agent at least partially undergirds the Examiner's obviousness determination as to the obviousness of pre-solubilizing the synthetic wax dust reducing agent in forming a joint compound homogenous product. Appellants have not shown that the application of a pre-solubilizing step would be beyond the skill level of an ordinarily skilled artisan. *KSR*, 550 U.S. at 417 (“[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.”).

Moreover, Appellants have not reasonably substantiated the argument that one of ordinary skill in the art would have narrowly read and inflexibly applied paragraph 0079 of Langford as necessarily requiring that the dust reducing additive must be brought in contact with water that already has the binder and, any thickener, added thereto, as urged by Appellants (Reply Br. 3). Nor have Appellants established that one of ordinary skill in the art would have avoided pre-solubilizing the dust reducing additive in water only simply because other options may be available to try (App. Br. 15).

As a final point, Appellants have not substantiated that any reduction of a delay in producing a homogenous product joint compound by using a pre-solubilizing step, as broadly claimed, is unexpected, or that the claimed method is a method that solves a long felt need in the art which previously was continuously sought to be solved but found unresolvable, or that the

claimed process results from the discovery of a previously unrecognizable problem to one of ordinary skill in the art (Reply Br. 4).

On this record, we shall sustain the Examiner's obviousness rejection of representative claim 1.

As for separately argued dependent claim 2, the arguments Appellants present for claim 2 (claim 2 requires adding the dedusting agent to water) are unpersuasive for substantially the same reasons that we are not persuaded by the arguments presented against the Examiner's rejection of claim 1.

Similarly, the broadly recited preheating step of dependent claim 3 has not been indicated by Appellants unsubstantiated argument to be beyond the skill level of one of ordinary skill in the art seeking to solubilize the dedusting agent in water where the dedusting agent may have been kept at a relatively cold temperature (Spec. 5).

Concerning the Examiner's separate obviousness rejection of dependent claim 4, which claim requires transportation of the presolubilized dedusting agent, Appellants' arguments appear to be off the mark. The added Ball reference is merely cited by the Examiner to show that commercial processes can entail partial production at a remote facility or in transit, such as in the case of cement (Ans. 6 and 8). Here, Appellants have not persuasively indicated why the imposition of a transportation step for the presolubilized dedusting agent, (preparing same at a different location than that location of the manufacturing facility where the joint compound is prepared) represents an independent basis for the non-obviousness of dependent claim 4.

On this record, we shall likewise sustain the Examiner's separate obviousness rejection of claim 4.

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ORDER

The Examiner's decision to reject the appealed claims is affirmed.

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

AFFIRMED

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