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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte HAO A. CHEN and
NATHAN W. EASTERDAY

Appeal 2012-000574
Application 11/827,897
Technology Center 1700

Before BRADLEY R. GARRIS, CHUNG K. PAK, and
DONNA M. PRAISS, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134, Appellants appeal from the Examiner's rejection under 35 U.S.C. § 103(a) of claims 1-12, 14, 15, and 17-39 as unpatentable over Hansson (US 6,465,046 B1 issued Oct. 15, 2002) in view of Casto (US 1,947,459 issued Feb. 20, 1934) and further in view of Wiley (US 4,675,212 issued June 23, 1987). We have jurisdiction under 35 U.S.C. § 6.

We AFFIRM.

Appellants claim a surface covering panel comprising a support layer 1 with or without texturing, a base coating 2 of about 1 mil to about 30 mils thickness on the support layer and having a mechanically embossed textured surface 3, a printed pattern 4 on the textured surface and in register with the textured surface to within about 1 mm or less, and a protective layer 5 on the printed pattern and having a top surface with the textured pattern that corresponds to the textured surface (independent claim 1; *see also* independent claims 30 and 39). Appellants also claim a method of making the surface covering panel of claim 1 (claim 18).

Representative claim 1 reads as follows:

1. A surface covering panel comprising:

at least one support layer with or without texturing; at least one base coating located on top of said support layer having a mechanically embossed textured surface; at least one printed pattern located on said textured surface and in registered with said textured surface; and at least one protective layer located on the printed pattern, wherein said at least one base coating, having a thickness of from about 1 mil to about 30 mils, is a polymeric coating and the printed pattern is applied to the base coating with a printer that prints the printed pattern directly on said base coating, and said printed pattern is applied

after the textured surface is present, and the printed pattern and textured surface are in register to within about 1 mm or less, wherein said protective layer has a top surface with a textured pattern that corresponds to said textured surface.

We will sustain the above rejection for the reasons expressed in the Examiner's Answer (mailed June 3, 2011) and in the Decision (dated June 13, 2007) for prior appeal 2007-1262 in parent application 10/697,532. The following comments are added for emphasis.

Appellants characterize the appealed claims as being directed to a product and method which involve a printed-in-register technique as opposed to the embossed-in-register technique of Hansson (*see, e.g.*, App. Br. para. bridging 15-16). As pointed out in the Answer (Ans. 8) and the prior Decision (Dec. 4), the product made by a printed-in-register technique appears to be indistinguishable from the Hansson product made by an embossed-in-register technique. Although Appellants state that their printed-in-register technique yields product advantages (e.g., improved registry) compared to the conventional embossed-in-register technique (*see, e.g.*, App. Br. 16-17), this statement is not supported by evidence comparing their printed-in-register technique with Hansson's embossed-in-register technique as correctly noted by the Examiner (Ans. 7).

Regardless, we agree with the Examiner that it would have been *prima facie* obvious, in view of Casto, to modify Hansson's method so as to first mechanically emboss a textured surface onto the base coating and then to print a pattern directly onto and in register with this textured surface, thereby yielding a printed-in-register method and corresponding product.

In support of their contrary view, Appellants reiterate the prior-appeal argument that their claimed registry (e.g., within about 1 mm or less) would

not be obtained with the random matching tolerance of up to ± 5 mm disclosed in column 1, lines 25-28, of Hansson (*see, e.g.*, App. Br. para. bridging 18-19). As pointed out multiple times in the record, the above tolerance disclosure relates to a prior art technique over which Hansson's digitally controlled technique is an improvement. Appellants' argument concerning this tolerance disclosure remains unpersuasive for the several reasons given in the Answer (Ans. para. bridging 6-7) and the prior Decision (Dec. para. bridging 6-7). Furthermore, the Examiner's proposed combination of prior art teachings would result in a method identical to Appellants' claimed method and therefore would necessarily produce the degree of registry claimed by Appellants.

Appellants also reiterate the prior-appeal argument that a prima facie obviousness conclusion is contrary to Casto's teaching of filling the embossed surface indentations with pigment to create a smooth surface (*see, e.g.*, App. Br. para. bridging 23-24). However, as in the prior Decision (Dec. 6), we continue to find that Casto teaches, or at least would have suggested, a non-smooth surface such as mortar joints represented by depressed fillings (Casto 3:34-41; *see also* Casto sentence bridging 2-3, claims 5-6). In response to our finding in the prior Decision, Appellants argue that Casto's "depressed fillings" disclosure "is not referring to literally forming 'depressed fillings'" (App. Br. para. bridging 24-25). We find no convincing merit in this argument particularly since it is contrary to Casto's teaching of using an engraved plate or roll to create a second grain outline on a surface containing previously filled depressions (*see again* Casto sentence bridging 2-3, claims 5-6).

Appellants further argue that the applied references contain no teaching or suggestion of the claim feature wherein the top surface of the protective layer has a textured pattern corresponding to the textured surface below (*see, e.g.*, App. Br. 25). We agree with the Examiner that Hansson's disclosure of a protective layer having a texture corresponding to the textures below would have suggested preserving this protective layer texture in combining the teachings of Hansson and Casto (Ans. para. bridging 8-9). In addition, since these combined teachings would result in a method identical to Appellants' claimed method, this resulting method would necessarily produce the protective layer textured surface of the claimed method. In this regard, we observe that Appellants' disclosed method causes a textured surface to be eventually reflected on the protective coating/layer (Spec. 16:5-8) without practicing any specific step to create the textured surface.

In addition, Appellants contend that the applied references contain no teaching or suggestion of the claim feature wherein the base coating has a thickness of about 1 mil to about 30 mils (*see, e.g.*, App. Br. 29). We do not agree. Both Hansson and Wiley evince that base coating thickness is an art-recognized, result-effective variable, thereby evincing obviousness for the thickness feature of claims 1, 18, and 30.¹ *See In re Woodruff*, 919 F.2d 1575, 1578 (Fed. Cir. 1990).

Finally, Appellants argue that no apparent reason exists for combining the applied references in such a manner as to produce the independent claim 30 requirement for a support layer having a mechanically embossed textured

¹ Independent claim 39 contains no such limitation.

surface with a base coating thereon which has a textured pattern corresponding to the textured surface (*see, e.g.*, App. Br. 37). The Examiner makes the undisputed finding that Hansson discloses a core layer (i.e., a support layer) coated with an acrylic layer (i.e., a base coating) (Ans. 5). We agree with the Examiner that mechanically embossing these layers would necessarily yield a support layer having a textured surface with an overlying base coating having a corresponding textured pattern as required by claim 30 (*id.* at 12).

For the reasons stated in the Answer, in our prior Decision, and above, we sustain the Examiner's § 103 rejection of the appealed claims as unpatentable over Hansson, Casto, and Wiley.

The decision of the Examiner 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.

AFFIRMED

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