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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JAMIE B. PELTZ and ROBERT F. GOLOWNIA

Appeal 2017-000970
Application 14/143,653
Technology Center 2800

Before CHUNG K. PAK, LINDA M. GAUDETTE, and
MERRELL C. CASHION, JR., *Administrative Patent Judges*.

CASHION, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134 from a final rejection of claims 28–41. We have jurisdiction under 35 U.S.C. § 6.

We AFFIRM.

Appellant's¹ invention is best illustrated by independent claim 28, reproduced below:

28. A combination comprising a wall and a transparent or translucent sheet, the sheet being located adjacent the wall, the sheet being provided with a paint coating, the combination further comprising a plurality of different primer coating patches located between the wall and the paint coating, the plurality of different primer coating patches being selected from the group consisting of patches of white and gray primer coatings.

Appellant (*see generally* Appeal Brief) appeals the following rejections:

(a) claims 32, 33, 36, and 40 rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement;

(b) claims 28–41 rejected under 35 U.S.C. § 103(a) as unpatentable over the combined teachings of Winter (US 2006/0257609 A1, published November 16, 2006) and Cojic (US 7,014,466 B2, issued March 21, 2006).

OPINION

Rejection under 35 U.S.C. § 112, first paragraph (written description requirement)

Our reviewing court stated in *In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983):

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language.

¹ Appellant is the Applicant, TRUE HUE, LLC. TRUE HUE, LLC is also identified as the real party in interest. App. Br. 1.

See also Ariad Pharms., Inc. v. Eli Lilly & Co., 598 F.3d 1336, 1351 (Fed. Cir. 2010).

This inquiry . . . is a question of fact. . . . [T]he level of detail required [in the Specification as originally filed] to satisfy the written description requirement varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology.

Id.

Original claims are also part of the original disclosure. *In re Gardner*, 475 F.2d 1389, 1391 (CCPA 1973); *In re Benno*, 768 F.2d 1340, 1346 (Fed. Cir. 1985). Whether the written description requirement is complied with is a question of fact, judged from the perspective of one of ordinary skill in the art as of the relevant filing date. *See Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991).

Claims 32 and 33

The Examiner contends that the sheets recited in claims 32 and 33 are not the same as the substrate recited in claim 28, from which these claims depend. Final Act. 8. According to the Examiner, the sheet recited in claim 28 has a paint coating on it and there is nothing in the original disclosure to support the size of the primer patches covering at least 80% or no more than 50% than a front or back surface of a sheet provided with a paint coating of claim 28. *Id.*

We disagree with the Examiner's interpretation of the claims for the reasons given by Appellant. App. Br. 2. The Examiner does not question that there is written descriptive support for providing primer patches over translucent or transparent sheets. Ans. 8. Instead, the Examiner asserts that

there is no written descriptive support for providing primer patches over a painted sheet as recited in claim 28. *Id.* First, claim 28 recites that the sheet is provided with a paint coating. There is no language in the claim that requires the paint to be applied directly onto the sheet. Second, the language of the claim provides for the different primer coating patches be located between the wall and the paint coating. Third, the Examiner has not identified, nor do we discern, any basis for according a more narrow interpretation to claim 28 as excluding the embodiments described on pages 6 to 7 of the Specification and illustrated by Figures 2 and 4. *See App. Br. 2.* On this record, the Examiner has not adequately explained why this portion of the Specification is insufficient to provide adequate descriptive support for the subject matter of claims 32 and 33.

Claims 36 and 40

The Examiner also contends there is nothing in the original disclosure to support different primer coating patches printed or coated on the sheets as recited in claims 36 and 40. Final Act 8–9.

We disagree. As noted by Appellant, the Specification discloses that primer patches may be deposited or coated onto the top surface of substrate (sheet) using application methods such as roll coating, rotogravure, screen printing, lithography, or other processes known in the art. App. Br. 2–3; Spec. 12. The Examiner has not adequately explained why this portion of the Specification is insufficient to provide written descriptive support for the subject matter of claims 36 and 40.

Accordingly, we reverse the Examiner's rejection of claims 32, 33, 36, and 40 under 35 U.S.C. § 112, first paragraph, as lacking written descriptive support for the reasons presented by Appellant and given above.

Prior Art Rejection under 35 U.S.C. § 103(a)

In arguing claims 28–41, Appellant does not initially argue any claim separate from the other. App. Br. 3–6. Appellant then presents separate arguments for claims 32, 36, and 39, and relies on the arguments presented for claims 36 and 39 to address claim 40. *Id.* at 6–7. Accordingly, we select independent claim 28 as representative of the subject matter before us for review on appeal. Claims 29–31, 33–35, 37, 38, and 41 stand or fall with claim 28. We address the arguments presented for claims 32, 36, and 39 separately. Claim 40 stands or falls with claims 36 and 39.

We have reviewed each of Appellant's arguments for patentability. However, a preponderance of the evidence supports the Examiner's position that the subject matter of claims 28–41 is unpatentable. Accordingly, we AFFIRM the Examiner's prior art rejection for the reasons explained in the Answer, and we add the following for emphasis.

Independent claim 28 is directed to a combination comprising a wall and a transparent or translucent sheet.

The Examiner finds Winter discloses a structure comprising a transparent/translucent sheet having a paint coating that can be placed on a wall for the comparative illustration of paint color. Final Act. 10; Winter Figure 4a, ¶¶ 10, 36, 44. The Examiner acknowledges that Winter does not disclose the use of a plurality of different primer coating patches as claimed. Final Act. 10. The Examiner finds Cojic teaches a primer selection system

that uses a plurality of different primer coating patches arranged behind a paint coating on a transparent sheet. *Id.* at 10–11; Cojic, Figure 1, col. 2, ll. 5–29, col. 3, ll. 48–66. The Examiner determines that it would have been obvious to one of ordinary skill in the art to modify the structure of Winter by incorporating Cojic’s primer patches behind Winter’s painted transparent sheet for the purpose of allowing the viewer to choose a primer which affords the intended topcoat the optimal color development. Final Act. 11; Cojic, col. 2, ll. 20–39, col. 3, ll. 48–66.

Alternatively, the Examiner finds Cojic discloses a primer selection system comprising all limitations of claim 28 (a transparent or translucent sheet, the sheet being provided with a paint coating, a plurality of different primer coating patches adjacent to the sheet, the plurality of different primer coating patches consisting of patches of white and gray primer coatings) except for placement on a wall. Ans. 11; Cojic, col. 3, ll. 60–65. The Examiner relies on Winter as teaching the combination of a paint swatch with a wall and concludes it would have been obvious to one skilled in the art to combine these teachings to get an idea of how a paint color of Cojic may appear on a wall without actually applying paint to it. Ans. 11; Winter ¶ 44.

Claim 28

Appellants argue Winter teaches a conventional paint chip which must be opaque in order to do its job because, otherwise, the underlying wall color can bleed through the chip and alter the visualized color, so that the viewer no longer sees the standard color, but sees something different. App. Br. 3; Winter ¶ 44. Thus, Appellant asserts, because the paint chip of Winter is

opaque, the grayscale panel of Cojic behind the Winter paint chip would not show or bleed through the Winter paint chip and would not alter the paint chip color. App. Br. 4.

We are unpersuaded by this argument. As noted by the Examiner, Winter does not mention or disclose the opacity of the paint used in the chip. Ans. 6. Nor does Appellant direct us to any portion of Winter or other evidence that supports its assertion. Appellant, at most, has provided mere attorney arguments and such arguments of counsel cannot take the place of evidence. *See In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984); *In re Payne*, 606 F.2d 303, 315 (CCPA 1979). Moreover, the Examiner's rejection is based on a combination of teachings and these arguments do not address the Examiner's reasons for combining the cited art.

Appellant argues Cojic does not teach anything attached to or displayed on a wall. App. Br. 4. According to Appellant, Cojic teaches against placing the grayscale primers against the wall for visualization because it is not used in any way to compare paint on a wall against paint on the primer panel. App. Br. 5.

We find these arguments also unavailing. As noted by the Examiner, Cojic's primer selection system is used to determine color development as a function of underlying primer. Ans. 8; Colic, col. 1, ll. 14–23. Appellant has not adequately explained why one skilled in the art would not have been capable of adapting Colic's primer selection system for use in the structure of Winter if one skilled in the art is desirous of viewing how the paint is affected by a diversity of primers. Appellant has not adequately explained why one skilled in the art would not have been capable of providing the structure of the combined teachings on a wall when both Winter and Cojic

disclose placing the respective devices on a surface for evaluation by the viewer. Winter ¶ 44 (disclosing application of the structure on a wall); Colic, col. 3, ll. 48–53 (discussing application of the primer selection system on a panel). Again, Appellant’s arguments do not address the combination of references as presented by the Examiner.

Appellant argues that combining the teachings of the cited art would destroy the utility of each reference and frustrate their respective purposes. App. Br. 5–6. Specifically, Appellant argues that using Cojic’s grayscale panel with Winter’s opaque paint chip would destroy the utility of the Cojic panel of visualizing a selected paint at less than half the film thickness of complete hide. App. Br. 5; Cojic col. 1, ll. 14–17. On the other hand, Appellant argues inserting the grayscale panel of Cojic between the Winter device and the wall would prevent the Winter device from adhesively attaching to the wall, thus destroying its utility. App. Br. 5; Winter ¶¶ 10, 44.

We also find these arguments unavailing for the reasons provided by the Examiner. Ans. 9–10.

Appellant’s arguments above are premised on Winter’s paint being opaque. We have addressed the issue of the opaqueness of Winter’s paint above.

Appellant’s arguments are also premised on bodily incorporation and are not focused on the Examiner’s reason for combining the cited art. “The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference. . . . Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.” *In re Keller*, 642 F.2d 413,

425 (CCPA 1981); *see also In re Sneed*, 710 F.2d 1544, 1550 (Fed. Cir. 1983) (“[I]t is not necessary that the inventions of the references be physically combinable to render obvious the invention under review.”); *In re Nievelt*, 482 F.2d 965, 968 (CCPA 1973) (“Combining the *teachings* of references does not involve an ability to combine their specific structures.”).

As noted by the Examiner, both Winter and Cojic disclose the use of a transparent/translucent layer which is painted on one side. Final Act. 10–11; Winter Figure 4a, ¶¶ 10, 36, 44; Cojic col. 3, ll. 48–66. The Examiner finds it would have been obvious to one of ordinary skill in the art to modify the structure of Winter by incorporating Cojic’s primer patches behind Winter’s painted transparent sheet for the purpose of allowing the viewer to choose a primer which affords the intended topcoat the optimal color development. Final Act. 11; Cojic, col. 1, ll. 14–17. Thus, the Examiner provided a reasonable basis for one skilled in the art to arrive to the claimed invention from the cited art. Appellant has not adequately explained how combining the teachings would destroy the purpose of both Winter and Cojic of assisting a viewer in selecting the appropriate shade of paint. Winter ¶ 2; Cojic, col. 1, ll. 18–23.

While Appellant argues the transparent plastic film of Winter is to permit the observer to view the glossy finish of the paint through the transparent film, Winter also contemplates alternatively directly viewing the surface of the paint. App. Br. 6; Winter ¶¶ 36, 37.

Claim 32

Claim 32 requires that the plurality of different primer coating patches of a size to cover at least 80% of a front or back surface of the transparent or translucent sheet.

The Examiner contends that Appellant has not shown the criticality of covering a surface of the translucent/transparent sheet as claimed. Ans. 12.

Appellant argues the size of Cojic's primer patches is irrelevant because Winter's paint chip is opaque and the viewer would be unable to see Cojic's primer patches through the opaque paint chip of Winter. App. Br. 6.

We again refer Appellant to our previous discussion regarding the issue of opaqueness. We further note Winter recognizes that color swatches should be large enough for the viewer to readily evaluate and appreciate from a distance. Winter ¶ 3. Thus, one skilled in that art would have been capable of determining the size of the viewing area that would be best to visually determine the desired color development.

Claim 36

Claim 36 requires that the plurality of different primer coating patches are printed or coated on the sheet. Claim 39 requires that the primer coating patches are fixed on the transparent or translucent sheet (note that claim 40, dependent from claim 39, indicates that the language of claim 39 includes coating).

We have considered Appellant's arguments presented with respect to claims 36 and 39 (App. Br. 7) but do not find them persuasive of reversible error. Appellant's arguments do not address the reasons presented by the Examiner for combining the teachings of the cited art. Moreover, Cojic

discloses coating the primer material on a surface. Cojic, col. 3, ll. 48–53. Given that Cojic discloses placing the painted translucent sheet over the primer material (*id.* at col. 3, ll. 64–65), Appellant has not adequately explained why one skilled in the art, using no more than ordinary creativity, would not have been capable of coating the primer material onto a surface of the translucent material. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007) (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”); *see In re Sovish*, 769 F.2d 738, 743 (Fed. Cir. 1985) (skill is presumed on the part of one of ordinary skill in the art); *In re Bozek*, 416 F.2d 1385, 1390 (CCPA 1969).

Accordingly, we affirm the Examiner’s prior art rejection of claims 28–41 under 35 U.S.C. § 103(a) for the reasons presented by the Examiner and given above.

Alternative Reasoning in Support of the Rejection

In addition to the above, the Examiner presents alternative reasoning for determining claims 28–41 are unpatentable over the combination of Winter and Cojic. *See* Ans. 11. The portion of Cojic relied upon by the Examiner in support of this alternative reasoning was pointed out to Appellant in the Final Action. *Compare* Final Act. 11 (citing to Cojic, col. 3, ll. 48–66) *with* Ans. 11.

Appellant does not dispute the merits of the alternative reasoning advanced by the Examiner. *See* Reply Brief dated October 11, 2016. Instead, Appellant argues this is a new issue raised for the first time by the Examiner because the only stated ground of rejection in the final rejection is based on Winter in view of Cojic, not Cojic in view of Winter. Reply Br. 4.

Thus, Appellant contends it is not proper to insert a new argument at this stage of the proceedings. *Id.* We take this to mean that Appellant considers the Examiner's alternative reasoning to be a new ground of rejection.

An obviousness analysis based on the collective teachings of the references does not depend on the order in which the references are listed in the statement of the rejection. *See In re Bush*, 296 F.2d 491, 496 (CCPA 1961):

In a case of this type where a rejection is predicated on two references each containing pertinent disclosure which has been pointed out to the applicant, we deem it to be of no significance, but merely a matter of exposition, that the rejection is stated to be on A in view of B instead of on B in view of A, or to term one reference primary and the other secondary.

We detect no error, nor does Appellant point to any error, in the Examiner's position that one skilled in the art would have modified Cojic's primer selection system by placing it on a wall to get an idea of how a paint color of Cojic may appear on a wall. Ans. 11; Reply Br. 4.

While Appellant argues that the Examiner's alternative reasoning is a new issue (new ground), Appellant did not avail itself of the provision set forth in 37 C.F.R. § 41.40 (a), which states:

Any request to seek review of the primary examiner's failure to designate a rejection as a new ground of rejection in an examiner's answer must be by way of a petition to the Director under § 1.181 of this title filed within two months from the entry of the examiner's answer and before the filing of any reply brief. Failure of appellant to timely file such a petition will constitute a waiver of any arguments that a rejection must be designated as a new ground of rejection.

Instead, Appellant filed a Reply Brief in timely fashion without presenting substantive arguments addressing the disputed new issue (rejection).

Therefore, Appellant waived any arguments that the Examiner's alternative line of reasoning in support of the rejection based on the combination of Colic and Winter is a new ground of rejection.

Accordingly, we affirm the Examiner's rejection claims 28–41 under 35 U.S.C. § 103(a) over the combined teachings of Winter and Cojic for the alternative reasons presented by the Examiner.

DECISION

The Examiner's rejection under 35 U.S.C. § 112, first paragraph is reversed.

The Examiner's prior art rejection of claims 28–41 under 35 U.S.C. § 103(a) over Winter and Cojic is affirmed.

TIME PERIOD

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).

AFFIRMED