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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/320,483	06/30/2014	Brian J. Wimer	05-0612-US-DIV (800-244)	2817
107112	7590	12/17/2019	EXAMINER	
The Small Patent Law Group LLC 225 S. Meramec, Suite 725 St. Louis, MO 63105			MUSSER, BARBARA J	
			ART UNIT	PAPER NUMBER
			1746	
			NOTIFICATION DATE	DELIVERY MODE
			12/17/2019	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* BRIAN J. WIMER and JOHN C. WILDE<sup>1</sup>

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Appeal 2019-000847  
Application 14/320,483  
Technology Center 1700

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Before BEVERLY A. FRANKLIN, MARK NAGUMO, and  
N. WHITNEY WILSON, *Administrative Patent Judges*.

NAGUMO, *Administrative Patent Judge*.

DECISION ON APPEAL

Boeing (“Wimer”) timely appeals under 35 U.S.C. § 134(a) from a Non-Final Rejection<sup>2</sup> of all pending claims 1, 3, 5–8, 11, 13, and 16–27. We have jurisdiction. 35 U.S.C. § 6. We affirm.

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<sup>1</sup> The applicant under 37 C.F.R. § 1.46 (Application Data Sheet, filed 30 June 2014), and hence the appellant under 35 U.S.C. § 134, is the real party in interest, identified as The Boeing Company (“Boeing”). (Appeal Brief, filed 27 June 2018 (“Br.”), 4.)

<sup>2</sup> Office Action mailed 7 February 2019 (“Office Action”; cited as “OA”); a Request for Continued Examination under 37 C.F.R. § 1.114 was filed on 01 May 2017.

## OPINION

### A. Introduction<sup>3</sup>

The subject matter on appeal relates to methods of making laminates having a textured surface. Such laminates are said to be useful for “providing ornamentation of the interior panels of aircrafts.” (Spec. 1 [0003].) According to the '483 Specification, “[t]he textured surface not only enhances the appearance of the laminate, but may also provide other benefits, such as the ability to hide scuff marks.” (*Id.*) Prior art methods of texturing laminates are said to include using steel rolls or plates, which are said to be expensive to manufacture and not easy to customize. (*Id.* at [0004].) The embossing resins, which are textured by the tools, are said to increase the amount of material needed for the part, and they may increase the heat release rating of the laminate. (*Id.* at 2 [0005].)

Wimer seeks patent protection for a process that comprises forming a texture pattern **22**<sup>4</sup> on a first major surface of a conformable film **24**, as shown in Modified<sup>5</sup> Figure 3A, reproduced on the next page. (Spec. 9 [0035].)

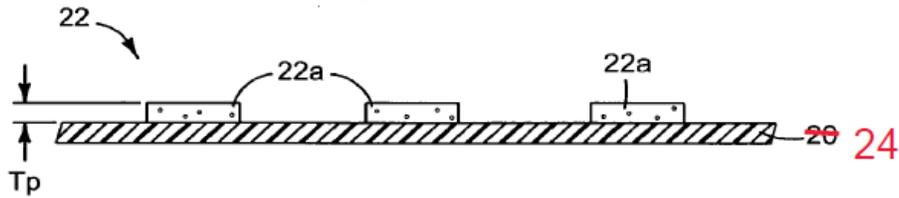
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<sup>3</sup> Application 14/320,483, *Textured structure and method of making a textured structure*, filed 30 June 2014 as a division of 11/317,843, filed 23 December 2005, now U.S. Patent No. 8,801,887. We refer to the “'483 Specification,” which we cite as “Spec.”

<sup>4</sup> Throughout this Opinion, for clarity, labels to elements are presented in bold font, regardless of their presentation in the original document.

<sup>5</sup> In the modified versions of Figures 3A and 3B, we have altered the labelling of film **20** to **24** to better conform the labelling to the description in the Specification.

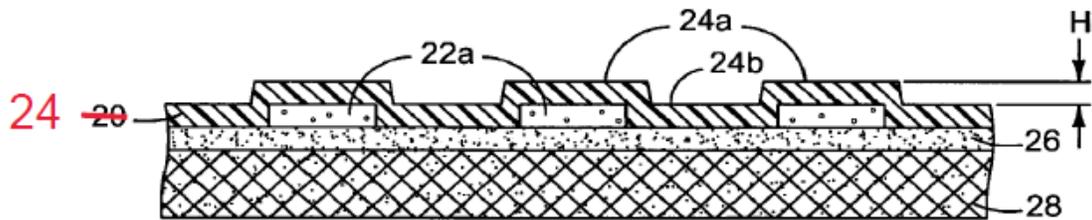
{ Modified Figure 3A is shown below }



{ Modified Figure 3A shows conformable film 24 with texture 22a }

Next, the Specification teaches, “both textured pattern 22 and the first major surface of conformable film 24 are bonded to a desired substrate 28, as illustrated in FIG. 3B”. (Spec. 10 [0040].) The Specification continues, “[i]n the illustrated embodiment, bonding is accomplished using a bonding adhesive 26.” (*Id.* at [0041].)

{ Modified Figure 3B is shown below }



{ Modified Figure 3B shows the laminate after adhesion to substrate 28 and subsequent heating and pressure to deform conformable film 24<sup>6</sup> around texture structures 22a and to adhere the first major surface of conformable film 24 to substrate 28 }

In the claimed embodiment, “conformable film 24 is subjected to temperature and pressure conditions during the bonding process which are sufficient to cause the conformable film 24 to deform around structures 22a to form a textured surface comprising raised surface portions 24a and lower surface portions 24b of conformable film 24.” (*Id.*)

<sup>6</sup> We have relabeled layer 20 as “24” to conform the drawing to the text of the Specification. This does not result in a substantive change to the description.

Claim 1 is representative and reads:

A method of forming a laminate having a textured surface,  
wherein the laminate includes

a substrate,

a texture pattern, and

a conformable film having a first major surface and  
an opposing second major surface,

the method comprising:

depositing the texture pattern *as an ink* on the first major  
surface of the conformable film *by a printing process*;

*applying an adhesive*

on the first major surface of the conformable film *and*  
on the deposited texture pattern;

*positioning the adhesive on the first major surface of the*  
*conformable film*

*on a surface of the substrate*; and

*performing a bonding process, after positioning the*  
*adhesive, by subjecting the conformable film to a*  
temperature and pressure sufficient to:

cause the conformable film to deform around the  
texture pattern to form the textured surface comprising

raised surface portions and

lower surface portions of the opposing second major  
surface of the conformable film; and

simultaneously cause the adhesive to bond the texture  
pattern and the first major surface to the substrate.

(Claims App., Br. 31; some formatting, and emphasis added.)

Remaining independent claims 11 and 21 recite the same “applying  
the adhesive” and the immediately following “positioning” and “performing  
a bonding” steps, including the final “simultaneously cause” condition.<sup>7</sup>

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<sup>7</sup> It should be noted that claims 16 and 17 depend from now-canceled  
claim 15 (which depended from claim 11).

The Examiner maintains the following grounds of rejection<sup>8, 9</sup>:

- A. Claims 1, 3, 5–8, 11, 13, and 16–27 stand rejected under 35 U.S.C. § 112(1) for lack of adequate written description.
- B. Claims 1, 8, 11, 19, 21, and 23 stand rejected under 35 U.S.C. § 102(b) in view of Bomboire<sup>10</sup> and Merriam-Webster Dictionary.<sup>11</sup>
- B1. Claims 3, 7, 13, 18, and 24–27 stand rejected under 35 U.S.C. § 103(a) in view of Bomboire.
- B2. Claims 5, 6, 16, and 17 stand rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Bomboire and Condon.<sup>12</sup>
- B3. Claims 22 stands rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Bomboire and Courtoy.<sup>13</sup>

It should be noted that claim 20 is rejected solely for lack of written description.

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<sup>8</sup> Examiner’s Answer mailed 24 September 2018 (“Ans.”).

<sup>9</sup> Because this application claims the benefit of an application filed before 16 March 2013, the effective date of the America Invents Act, we refer to the pre-AIA version of the statute.

<sup>10</sup> Rene F. Bomboire, *Textured sheet material and method of preparation thereof*, U.S. Patent No. 3,905,849 (1975).

<sup>11</sup> <https://www.merriam-webster.com/dictionary/ink> (last visited 2 February 2018) (definition of “ink”).

<sup>12</sup> Robert R. Condon et al., *Method for making architectural signs with raised graphics*, U.S. Patent No. 5,346,571 (1994).

<sup>13</sup> Jean-Francois Courtoy and Daniel Marchal, *Process for obtaining areas of distinctive appearance on synthetic coverings and the product derived therefrom*, U.S. Patent No. 4,608,294 (1986).

B. Discussion

The Board’s findings of fact throughout this Opinion are supported by a preponderance of the evidence of record.

*Rejection A: § 112(1) lack of written description*

The inquiry into whether the written description requirement has been met is one of fact. *Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010)(en banc). As our reviewing court has held, “[o]ne shows that one is ‘in possession’ of *the invention* by describing *the invention*, with all its claimed limitations, not that which makes it obvious.” *Lockwood v. American Airlines*, 107 F.3d 1565, 1572 (Fed. Cir. 1997) (emphasis original). The court continued, “the specification must contain an equivalent description of the claimed subject matter. . . . It is not sufficient for purposes of the written description requirement of § 112 that the disclosure, when combined with the knowledge in the art, would lead one to speculate as to modifications that the inventor might have envisioned, but failed to disclose.” *Id.*, citations omitted.

The Examiner finds that the originally filed Specification does not describe “applying the adhesive to the conformable film and textile pattern but rather indicate[s] it is applied to the substrate.” (FR 2, ¶ 3, citing Figures 2A–2C.) The Examiner also finds that the Specification “also discloses pulling the conformable film into contact with the adhesive for Figures 3A–3C [sic: 3B], but not applying the adhesive to the conformable film. [0042].” (*Id.*)

Wimer urges that, in going from the structure in Figure 3A to the structure in Figure 3B, “adhesive **26** is necessarily applied to both the

film **20** and to the texture pattern **22**. Otherwise the adhesive would not be able to contact the film **20** or the texture pattern **22**.” (Br. 12.)

The Examiner finds that the Specification, in paragraph [0041] (cited *supra* in the introduction), does teach using an adhesive to bond the textured film to a substrate. (Ans. 7, 1st full para.) But, the Examiner also finds that the next paragraph (i.e., Spec. [0042]) describes the process as applying a vacuum, which pulls the conformable film down onto the adhesive. In the Examiner’s words, “If the conformable film is pulled onto the adhesive, the adhesive cannot already be on the conformable film.” (*Id.*)

The Examiner appears to have conflated the teachings of paragraphs [0040] and [0041], which, together with Figures 3A and 3B, show that adhesive has been applied between the textured surface of the textured conformable film show in Figure 3A and the substrate **28**, with the teachings associated with Figures 2A–2C, which relate to an entirely distinct process of lamination in which the back-side of the laminate (opposite the textured side) is adhered to the substrate.

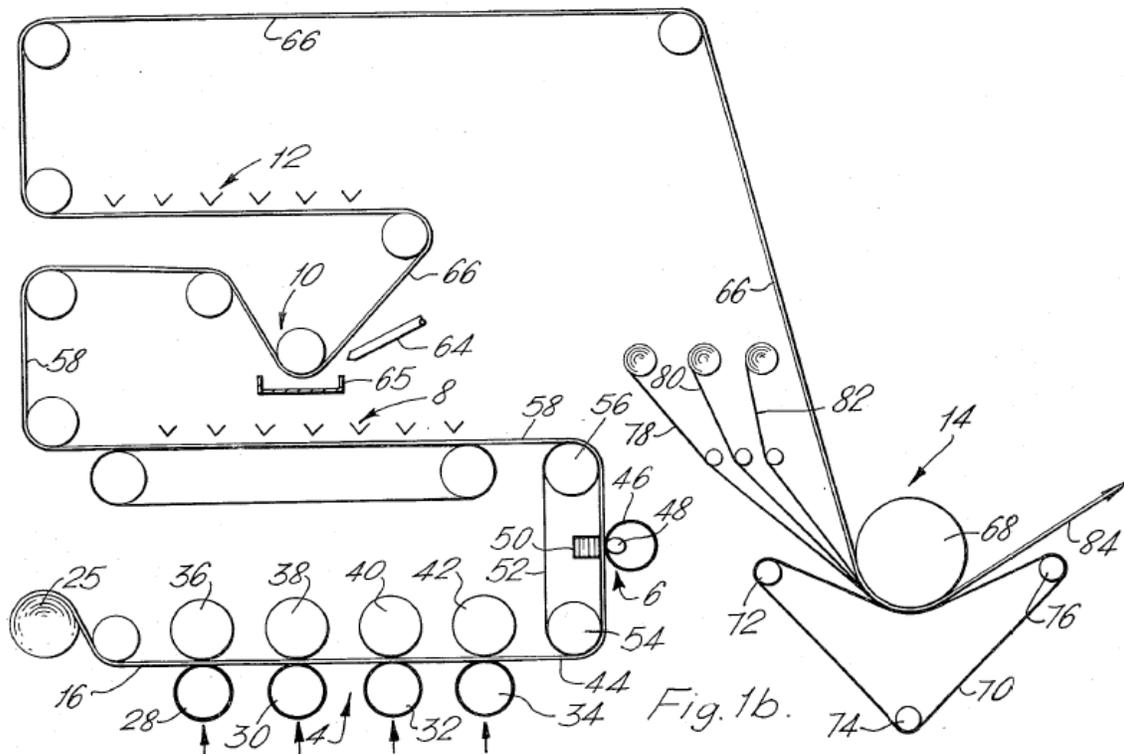
Nonetheless, it is true, as the Examiner finds, that the Specification does not state explicitly that the adhesive, when applied, contacts both the first main surface of the conformable film as well as the deposited texture pattern. While that result seems likely, at least when the viscosity of the adhesive is sufficiently low, Wimer has not come forward with evidence indicating that it is either “necessary” or inevitable that such contact occurs between the adhesive and the first major surface of the conformable film. Thus, we have not been put into a position that we can find, on the present

record, that persons having ordinary skill in the art would have understood that such contact is inherent, and that the written description is satisfied.

Accordingly, we affirm Rejection A of all claims for lack of an adequate written description in the originally filed Specification.

*Prior Art Rejection B (anticipation) and B1–B3 (obviousness)*

The Examiner finds that Bomboire discloses a process of preparing a textured sheet material that meets the limitations of the independent claims as well as several of the dependent claims. (FR 3–4.) Bomboire, Figure 1b, is shown below.



{Bomboire Figure 1b shows a texture patterning process}

Bomboire teaches the deposition of an ink pattern at step 4 (lower left), deposition at step 6 of a plastisol paste, which may be colored (Bomboire col. 5, ll. 66–67), in registry with the ink pattern, followed by gelling of the

paste pattern at step **8** to generate the desired texture pattern (*id.* at col. 7, ll. 61–64). In certain embodiments, Bomboire teaches that the plastisol paste may be colored, and that the ink pattern need not be applied. (*Id.* at col. 5, l. 65, to col. 6, l. 3.) An opaque and uniform background layer is applied at step **10** (*id.* at col. 8, ll. 8–16), and gelled at step **12** (*id.* at ll. 16–20). As the Examiner finds (FR 3, ¶ 6), Bomboire teaches that “the material employed for the opaque coating may be formulated so as to obtain adhesion between the printed transparent sheet and a suitable support layer.” (Bomboire col. 5, ll. 60–64.) The thus-prepared film **66** is then laminated with support layers **78**, **80**, and **82** by application of heat and pressure (“thermo-welding”) at step **14**. (*Id.* at col. 8, ll. 55–59.)

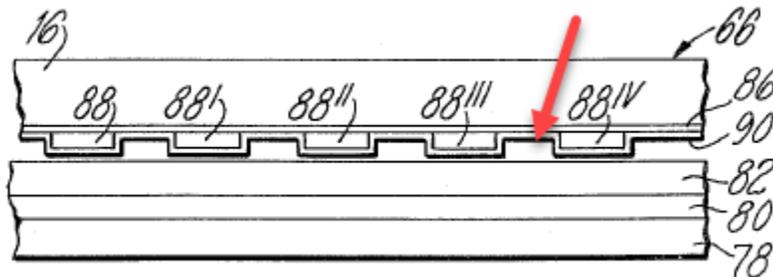
The Examiner interprets the colored paste as an ink (FR 3, ¶ 6, citing Bomboire col. 5, ll. 9–15 and 66–68), and finds that the bonding occurs only on application of heat and pressure, not instantaneously (*id.* at 4).

We do not find Wimer’s arguments that the Examiner erred harmfully in interpreting a colored plastisol as an ink persuasive. The ‘483 Specification does not define the term “ink” with specificity. Paragraph [0020] and (identical) paragraph [0038] provide a functional description (“any suitable printing process may be employed”), and the following paragraphs indicate that inks used to provide the texture may include a viscosity modifying additive, as well as “toners, hardeners, and fillers” (Spec. 5 [0021] and 10 [0039].) As the Examiner points out, Bomboire teaches that, “[i]n the case of a simple decoration, a single color pattern for example, the paste which defines the relief pattern may be colored and the printing of the decoration is not required.” (Bomboire col. 5, ll. 65–68.) The colored paste that is deposited in a pattern performs

the same functions as the “inks” described by the '483 Specification, and appears to be made of comparable materials. What Bomboire calls it is not dispositive: what matters is whether the routineer would have recognized Bomboire’s colored plastisol as a material usable as a texture-defining “ink” as that term is used in the claims. The weight of the evidence persuades us that Wimer has not demonstrated harmful error in this aspect of the Examiner’s analysis.

Wimer argues further that the limitation, common to each of the independent claims, “*positioning the adhesive on the first major surface of the conformable film on a surface of the substrate; and performing a bonding process, after positioning the adhesive, by subjecting the conformable film to a temperature and pressure sufficient to . . .*” is not met by Bomboire. (Br. 18, last para.; emphasis added.) Specifically, Wimer urges that, “[a]s shown in Figure 2e, which is *before* ‘passage between a cylinder **68** and resilient belt **70**,’ none of the background layer **90** that is on the vinyl film **16** touches the surface of the layer **82**.” (*Id.*, 2d para.; emphasis omitted.)

{Bomboire Figure 2e is shown below (arrow added)}



{Bomboire Figure 2e “depicts the product immediately before . . . passage between heated cylinder **68** and the resilient belt **70**.” (Bomboire col. 8, ll. 57–59.) Adhesive **90** on the first major surface (arrow) of conformable film **66** does not touch a surface of the substrate **82**}

The Examiner characterizes this argument in the following words: “Regarding appellant’s argument that before passage through the cylinder and belt the conformable film and the substrate are not touching, Figure 1b shows they contact each other before passing through the nip.” (Ans. 8, ll. 3–5.) This characterization is inaccurate, and it misapprehends or overlooks the requirement recited in the independent claims that the adhesive on the first major surface of the conformable film **16**—i.e., the adhesive at the arrow (modified Figure 2e, *supra*), between the “ink” texture portions **88**—must be positioned on substrate **82** before the bonding process is performed. According to Figure 2e, which shows textured film **66** and substrate film **82-80-78** immediately before passage between heated cylinder **68** and resilient belt **70**, which subject the films to heat and pressure to perform the bonding, adhesive on the first major surface does not contact the substrate film. The Examiner’s citation of Figure 1b is not persuasive because it does not show the details of the adhesive on the textured film. Moreover, the Examiner has not explained why Figure 2e should be disregarded.

We conclude that not every limitation of the independent claims 8, 11, and 21 is described by Bomboire. It follows that all the limitations of the dependent claims are not met by Bomboire. Accordingly, we reverse Rejection B for anticipation.

The Examiner does not make findings regarding the further limitations addressed by obviousness Rejections B1–B3 that cure the noted deficiency. Accordingly, we reverse Rejections B1–B3 as well.

C. Conclusion

The rejection of claims 1, 3, 5–8, 11, 13, 16–27 is affirmed.

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1, 3, 5–8, 11, 13, 16–27	112(1)		1, 3, 5–8, 11, 13, 16–27	
1, 8, 11, 19, 21, 23	102(b)	Bomboire, Merriam-Webster Dictionary		1, 8, 11, 19, 21, 23
3, 7, 13, 18, 24–27		Bomboire		3, 7, 13, 18, 24–27
5, 6, 16, 17		Bomboire and Condon		5, 6, 16, 17
22		Bomboire and Courtoy		22
<b>Overall Outcome</b>			1, 3, 5–8, 11, 13, 16–27	

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a) (*See* 37 C.F.R. § 1.13(a)(1)(iv)).

**AFFIRMED**