



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/042,094	02/11/2016	Brian Eugene Sheehan	PRIME1.024A	9602
20995	7590	12/16/2019	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			SHAFI, LEITH S	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			1744	
			NOTIFICATION DATE	
			DELIVERY MODE	
			12/16/2019	
			ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

efiling@knobbe.com

jayna.cartee@knobbe.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BRIAN EUGENE SHEEHAN and
EDWARD DANIEL FITZGERALD

Appeal 2019-001839
Application 15/042,094
Technology Center 1700

Before MICHAEL P. COLAIANNI, GEORGE C. BEST, and
DEBRA L. DENNETT, *Administrative Patent Judges*.

COLAIANNI, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) the final rejection of claims 1–25. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Prime Forming & Construction Supplies, Inc., d/b/a Fitzgerald Formliners (Appeal Br. 3).

STATEMENT OF THE CASE

Appellant's invention is directed to a formliner for creating a pattern in concrete (Spec. ¶ 2). The Specification describes that concrete is poured onto the formliner's interior surface, thereby transferring a desired pattern or shape to cured concrete (*id.* ¶ 7). According to the Specification, lining up a plurality of formliners facilitates the transfer of such patterns over a wide area of concrete (*id.*).

Claim 1 is illustrative (emphasis added):

1. A formliner for use with a framework to create a decorative pattern on curable material, the formliner comprising:

a cell comprising a base configured to face the curable material in use, wherein the base extends along a backing of the framework and at least a part of the base contacts the backing of the framework when the formliner is in use with the framework, wherein the framework is configured to support the formliner in a desired position; and

a rib system comprising a plurality of ribs extending along the cell and forming at least a part of a boundary of the cell, the plurality of ribs comprising:

an overlapping section connected with the cell and comprising a first rib edge, the overlapping section configured to face the curable material in use, the first rib edge being a free end of the overlapping section; and

an overlapped section connected with the cell and comprising a second rib edge, at least a portion of the overlapping section configured to overlay onto at least a portion of the overlapped section,

wherein an inner periphery is formed where the overlapped section connects with the base of the cell, the

inner periphery extending generally along the boundary of the cell and extending generally along the framework when the formliner is in use with the framework,

wherein *the first rib edge extends along the boundary of the cell without contacting the inner periphery of the cell* when the at least a portion of the overlapping section overlays onto the at least a portion of the overlapped section, and

wherein the second rib edge extends along the boundary of the cell, the second rib edge extending toward the backing of the framework such that the second rib edge provides structural support to the overlapped section and the overlapping section when the at least a portion of the overlapping section overlays onto the at least a portion of the overlapped section and when the formliner is in use with the framework.

Appeal Br. 26–27 (Claims App.).

Appellant appeals the following rejection:

1. Claims 1–25 are rejected under 35 U.S.C. § 103 as unpatentable over Fitzgerald et al. (WO 2010/036971 A1; published April 1, 2010, “Fitzgerald”) (Final Act. 3–12).

Claims 1, 9, and 22 are independent; Appellant’s arguments focus solely on claim 1 (*see, e.g.*, Appeal Br. 16–23). We select claim 1 as representative. Appellant offers separate arguments in support of dependent claims 4, 6, 8, and 25. Accordingly, claims 1–3, 5, 7, and 9–24 will stand or fall with our analysis of claim 1. The remaining claims will be discussed separately.

FINDINGS OF FACT & ANALYSIS

After review of the respective positions provided by Appellant and the Examiner, we AFFIRM the Examiner's prior art rejection under 35 U.S.C. § 103. We add the following for emphasis.

The Examiner's findings and conclusions regarding Fitzgerald are located on pages 3–12 of the Final Office Action.

The Examiner finds that Fitzgerald teaches each component and limitation of the formliner recited in independent claim 1, except Fitzgerald does not explicitly disclose that a rib's overlapping section comprises "a first rib edge," which is "a free end" (Final Act. 3–5; claim 1). The Examiner, however, finds Fitzgerald teaches that interlocking or overlapping adjacent "formliners can be accomplished by complete or partial surface contact between the external and internal surfaces of overlapping rib portions" (Final Act. 4 (citing Fitzgerald ¶ 207)). The Examiner determined that it would have been obvious for one of ordinary skill in the art at the time of the invention to modify Fitzgerald's overlapping rib section as a free end by reducing this section's length (Final Act. 4–5).

Appellant argues that the Examiner has not established a prima facie case of obviousness because the motivation to modify Fitzgerald's overlapping rib portion is deficient (Appeal Br. 17). Appellant contends, *inter alia*, that the Examiner erred in taking Fitzgerald's isolated disclosure out of context (*id.*).

Fitzgerald discloses

that in some embodiments, the *overlapped* portion of the rib (such as the rib of the formliner 120) *can contact* only a portion of the internal surface of the *overlapping* portion of the rib (such as the rib of the formliner 122). *In this regard*, some embodiments can be configured such that the interlocking or

overlapping of the formliners can be accomplished by complete or *partial surface contact* between the external and internal surfaces of overlapping rib portions.

(Fitzgerald ¶ 207; *see also id.* at Fig. 3) (emphasis added).

Appellant argues that the Examiner’s findings erroneously ignore the first sentence, which allegedly limits what rib portions and surfaces are in contact in the second sentence (Appeal Br. 17; Reply Br. 2–3). In particular, Appellant contends that “[t]he sentence introduced by ‘[i]n this regard’ refers to the overlapped portion [of the previous sentence] *contacting* all or a portion of the internal surface of the overlapping portion” (Reply Br. 3 (citing ¶ 207)) (emphasis added). Appellant essentially interprets paragraph 207 as describing that only an overlapped ribbed portion can be configured to provide the portion *contacting* the internal surface of the overlapping rib portion (Appeal Br. 17; *see also* Reply Br. 2). According to Appellant, Fitzgerald does not teach that overlapping rib portions are amenable to modification because the initial sentence in the disputed passage fails to disclose that these portions are actively *contacting* the external surface of the overlapped portion (Appeal Br. 17).

We, however, find that Fitzgerald generally describes which portions and surfaces “can contact” each other (Fitzgerald ¶ 207). In other words, Fitzgerald’s disputed passage does not limit the rib sections that are amenable to configuration to only those that are actively *contacting* another surface. Rather, Fitzgerald describes that any rib portion that “*can contact*” a corresponding surface in an interlocked or overlapped arrangement can be configured (*id.*) (emphasis added). *See In re Burckel*, 592 F.2d 1175, 1179 (CCPA 1979) (“[A] reference must be considered not only for what it expressly teaches, but also for what it fairly suggests.”). Thus, we agree

with the Examiner that “[i]n this regard’ applies to both the coverage of the overlapped portion with respect to the overlapping portion and the overlapping portion with respect to the overlapped portion” (Ans. 18 (citing Fitzgerald ¶ 207)).

The Examiner finds that Fitzgerald would have motivated the ordinarily skilled artisan to create a rib edge *via* a shortened overlapping section for the benefit of reduced costs, which results from using less formliner material (Final Act. 4–5 (citing Fitzgerald ¶ 283)).

Appellant argues that the Examiner’s relied upon disclosure merely provides that a reduction in costs stems from using already lightweight formliners, which have not been configured to possess less formliner material (Appeal Br. 18 (citing Fitzgerald ¶ 283)). Appellant proffers the Declaration of named-inventor Edward Fitzgerald under 37 C.F.R. § 1.132, which asserts that the Examiner’s proposed modification would have instead “result[ed] in an increase in excess material (that is trimmed and discarded) without cost savings” (Appeal Br. 19).² Appellant thus concludes that the Examiner’s “motivation of cost savings to modify Fitzgerald is deficient” (*id.*; *see also* Reply Br. 5).

Even assuming, however, that the Examiner erred in finding that Fitzgerald’s alleged benefit of reduced costs would have motivated the proposed modification, Fitzgerald already provides the requisite motivation. For the reasons set forth above, Fitzgerald teaches or suggests that overlapping rib portions are amenable to configuration as a first rib edge,

² We, however, note that a mold already configured to have less thermoformed formliner material would have precluded allegedly undesirable production, trimming, and discarding of excess material.

which is a free end of the overlapping section (i.e., partial surface contact between the overlapping and overlapped ribs) (Fitzgerald ¶ 207).

When the Examiner establishes a prima facie case of obviousness, “[t]he burden then shifts to the applicant, who then can present arguments and/or data to show that what appears to be obvious, is not in fact that, when the invention is looked at as a whole.” *In re Dillon*, 919 F.2d 688, 696 (Fed. Cir. 1990) (en banc); *see also In re Skoner*, 517 F.2d 947, 950 (CCPA 1975) (“Expected beneficial results are evidence of obviousness of a claimed invention. Just as unexpected beneficial results are evidence of unobviousness.”). Appellant’s briefs and declaration, however, do not provide any evidence showing that the claimed overlapping section comprising a first rib edge is critical and thereby yields unexpected benefits over the prior art’s formliner. Therefore, in light of Appellant’s evidence and argument of nonobviousness considered in combination with the Examiner’s evidence of obviousness, we determine that the subject matter of claim 1 would have been obvious over Fitzgerald. Thus, based on this record, we sustain this rejection as to claims 1–3, 5, 7, and 9–24.

Appellant separately argues for reversal of the Examiner’s rejection of claims 4, 6, and 8 based on the same contention (Appeal Br. 23–24). In particular, Appellant contends that each of these claims are patentable because the Examiner concedes “that Fitzgerald does not disclose ‘the first rib edge being a free end of the overlapping section’ and further deficiencies discussed” in the brief (*id.*).

Appellant also argues that paragraph 207 of Fitzgerald fails to render obvious the limitations recited in claim 25 for the reasons provided in support of independent claim 1 (Appeal Br. 24).

Appellant's arguments, however, do not adequately rebut the Examiner's findings that Fitzgerald teaches or suggests that overlapping rib portions can be configured as a first rib edge, which is a free end of the overlapping section. An appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. *See Ex parte Yamaguchi*, 88 USPQ2d 1606, 1614 (BPAI 2008) (on appeal, applicant must show examiner erred). The Federal Circuit, moreover, has held that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art. *See In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011). Thus, in this instance, Appellant has not met his burden of identifying error in the rejections of claims 4, 6, 8, and 25 on appeal, as they have not identified reversible error in the Examiner's reasons for finding that Fitzgerald renders these claims obvious.

Thus, based on this record, we sustain this rejection as to claims 4, 6, 8, and 25.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1-25	103	Fitzgerald	1-25	
Overall Outcome			1-25	

Appeal 2019-001839
Application 15/042,094

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)(iv).

AFFIRMED