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14/945,165	11/18/2015	ERIC ROSEN	EROSN-002GC4	9442
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STETINA BRUNDA GARRED & BRUCKER 75 ENTERPRISE, SUITE 250 ALISO VIEJO, CA 92656			LE, NINH V	
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**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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* ERIC ROSEN and JOEL STEARNS

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Appeal 2019-005735  
Application 14/945,165  
Technology Center 1700

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Before JOSEPH L. DIXON, DONNA M. PRAISS, and BRIAN D. RANGE,  
*Administrative Patent Judges.*

RANGE, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner’s decision to reject claims 24–28. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> 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 Terraboard, Inc. Appeal Br. 3.

## CLAIMED SUBJECT MATTER<sup>2</sup>

Appellant describes the invention as relating to a building material that eliminates deficiencies of prior art options and may be used in a wide variety of applications. Spec. ¶ 8. Claim 24 is illustrative:

24. A process for forming and packaging an architectural building material for subsequent use by consumers comprising the steps:

- a) combining paper with water to form an admixture and allowing said admixture and allowing said admixture [sic] to remain at rest for at least eight hours;
- b) blending said admixture in step a) from about thirty seconds to one minute;
- c) straining said admixture produced in step b) to produce a strained admixture comprising paper and water present in a ratio of approximately 3:16 by weight;
- d) forming a bonding agent, said bonding agent comprising white glue and a thickening agent wherein said thickening agent comprises com starch and water such that the ration of water to com starch is approximately 8:1 by weight, said bonding agent further including an additive selected from the group consisting of a preservative and an antioxidant;
- e) mixing said bonding agent with said strained admixture, wherein the ratio of strained admixture to bonding agent will range from 14:2 to 1.0:1.5, said bonding agent and admixture defining a material having a wet dough-like consistency; and
- f) packaging said material produced in step e) and assigning a color and texture to said packaged material; and
- g) repeating steps a)-f).

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<sup>2</sup> In this Decision, we refer to the Final Office Action dated February 20, 2018 (“Final Act.”), the Appeal Brief filed October 18, 2018 (“Appeal Br.”), the Examiner’s Answer dated May 20, 2019 (“Ans.”), and the Reply Brief filed July 22, 2019 (“Reply Br.”).

## REFERENCES

The Examiner relies upon the prior art below in rejecting the claims on appeal:

<u>Name</u>	<u>Reference</u>	<u>Date</u>
Sekiguchi et al. ("Sekiguchi")	US 3,604,197	Sept. 14, 1971
Breedlove	US 7,887,738 B2	Feb. 15, 2011
Genzo et al. ("Genzo")	JP 2000-192002	July 11, 2000
HOW TO, <a href="http://users.belgacom.net/papier-mache/pm/howto.htm">http://users.belgacom.net/papier-mache/pm/howto.htm</a> (2003) (as archived by web.archive.org) ("Belgacom").		

## REJECTIONS

The Examiner maintains the following rejections on appeal:

- A. Claims 24–28 under 35 U.S.C. § 112 based upon the written description requirement. Ans. 3.
- B. Claims 24–28 under 35 U.S.C. § 112 as indefinite. Ans. 4.
- C. Claims 24–28 under 35 U.S.C. § 103 as obvious over Belgacom in view of Genzo and further in view of Breedlove or Sekiguchi. *Id.* at 5.

## OPINION

We review the appealed rejections for error based upon the issues identified by Appellant and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential), (cited with approval in *In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011) (“[I]t has long been the Board’s practice to require an applicant to identify the alleged error in the examiner’s rejections.”)). After considering the evidence presented in this Appeal and each of Appellant’s arguments, we are

not persuaded that Appellant identifies reversible error. Thus, we affirm the Examiner's rejections for the reasons expressed in the Final Office Action and the Answer. We add the following primarily for emphasis.

Rejection A and Rejection B, § 112. Appellant does not dispute the Examiner's rejections pursuant to 35 U.S.C. § 112. Appeal Br. 4 (identifying only the obviousness rejection as on appeal). We summarily sustain these rejections. *Ex parte Frye*, 94 USPQ2d at 1075.

Rejection C, § 103. The Examiner rejects claims 24–28 under 35 U.S.C. § 103 as obvious over Belgacom in view of Genzo and further in view of Breedlove or Sekiguchi. Ans. 5. Appellant argues all claims as a group. Appeal Br. 5. We therefore limit our discussion to claim 24. All other claims stand or fall with that claim. 37 C.F.R. § 41.37(c)(1)(iv)(2018).

The Examiner finds that Belgacom teaches a process for forming and packaging an architectural building material and teaches most steps recited in claim 24. Ans. 5–11 (citing Belgacom). The Examiner finds that Belgacom does not teach step d). The Examiner finds, however, that the bonding agent / wallpaper paste of step d) was well-known. *Id.* at 9. The Examiner finds that Genzo teaches such a paste and determines it would have been obvious to incorporate Genzo's wallpaper adhesive to be used as wallpaper adhesive/paste as desired by Belgacom's process. *Id.* at 9–10 (citing Genzo). With regard to step g), the Examiner finds that Breedlove or Sekiguchi teach that it was well-known to form a mash of first and second colors (*id.* at 10 (citing Breedlove and Sekiguchi)), and determines that it would have been obvious to modify the combined Belgacom and Genzo process to repeat steps a) to f) to form such a mash.

Appellant argues that the cited art does not teach the ratio of the recitation “mixing said bonding agent with said strained admixture, wherein the ratio of strained admixture to bonding agent will range from 14:2 to 1.0:1.5.” Appeal Br. 6–7, 10 (Claims App.). The Examiner, however, relies on a result effective variable rationale to reach this recitation. Ans. 13.

It has long been held that “where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456 (CCPA 1955); *see also In re Boesch*, 617 F.2d 272, 276 (CCPA 1980) (“[D]iscovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art.”). Here, the Examiner finds that Belgacom teaches that the variable (adding more glue or water) achieves a recognized property (lessening the toughness of the pulp). Ans. 13. The Examiner’s finding is supported by a preponderance of the evidence (Belgacom 2:21–26), and Appellant does not persuasively dispute this finding. “A recognition in the prior art that a property is affected by the variable is sufficient to find the variable result-effective.” *In re Applied Materials, Inc.*, 692 F.3d 1289, 1297 (Fed. Cir. 2012). Discovery of the optimum amount of glue relative to water to appropriately lessen the toughness of the pulp would have been within the skill of the art and would have been discovered by routine optimization. Appellant does not present persuasive evidence or argument to the contrary.

Appellant also argues that the cited references do not teach forming the bonding agent prior to mixing with the strained admixture. Appeal Br. 7–8; Reply Br. 3. A method claim, however, is *prima facie* obvious where the art teaches or suggests the method’s recited steps even if the order of the

steps is different absent evidence of criticality of step order. *Ex parte Rubin*, 128 USPQ 440 (Bd. App. 1959) (prior art reference disclosing process of making laminated sheet wherein a base sheet is first coated with a metallic film and thereafter impregnated with thermosetting material was held to render prima facie obvious claims directed to process of making a laminated sheet by reversing order of prior art process steps.); *see also In re Burhans*, 154 F.2d 690 (CCPA 1946) (selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results).

Here, Appellant argues certain advantages to pre-formulating the bonding agent. Appeal Br. 7–8. Appellant, however, does not present evidence that the ordering is critical or provides unexpected results. “[A]rguments of counsel argument cannot take the place of evidence lacking in the record.” *Estee Lauder Inc. v. L’Oreal, S.A.*, 129 F.3d 588, 595 (Fed. Cir. 1997) (internal quotes and citation omitted). Absent such evidence, any reordering of prior art steps here is merely “predictable use of prior art elements according to their established functions.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007).

Because Appellant’s arguments do not establish harmful Examiner error, we sustain the Examiner’s obviousness rejection.

#### DECISION SUMMARY

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
24–28	112	written description	24–28	
24–28	112	definiteness	24–28	
24–28	103	Belgacom, Genzo, Breedlove, Sekiguchi	24–28	

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
<b>Overall Outcome</b>			<b>24–28</b>	

TIME PERIOD FOR RESPONSE

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. § 1.136(a)(1)(iv).

AFFIRMED