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ADE & COMPANY INC. 2157 Henderson Highway WINNIPEG, MANITOBA R2G1P9 CANADA			WIECZOREK, MICHAEL P	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID LANGTRY

Appeal 2019-006822
Application 15/232,362
Technology Center 1700

Before TERRY J. OWENS, MICHAEL P. COLAIANNI, and
JAMES C. HOUSEL, *Administrative Patent Judges*.

HOUSEL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 12–14 under 35 U.S.C. § 103 as unpatentable over Tyler² in view of Barry³ and Nakashima.⁴ We have jurisdiction under 35 U.S.C. § 6(b).

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 the Inventor, David Langtry. Appeal Brief (“Appeal Br.”) filed April 29, 2019, at 1.

² Tyler, GB 2 357 985 A, published July 11, 2001.

³ Barry, GB 2 324 325 A, published October 21, 1998.

⁴ Nakashima, US 4,082,427, issued April 4, 1978.

We REVERSE.⁵

CLAIMED SUBJECT MATTER

The invention relates to luminescent markings including luminescent glass material which can be used for roadways or on signs, such as road and commercial signs. Spec. 1:8–9.

Claim 12, reproduced below from the Claims Appendix to the Appeal Brief, is illustrative of the claimed subject matter:

12. A method for providing markings on a road surface comprising:

applying onto the road surface a marking material containing visibly distinguishing markings;

applying onto the marking material on the road surface a base material which is liquid in an initial state for application and sets or cures to form a solid layer after application;

the base material being colorless to allow viewing of the marking material;

and applying a material onto a surface of the base material so as to be adhered thereto, where the material comprises:

transparent ground glass particles formed by grinding glass so that the particles have an irregular outer surface;

wherein the ground glass particles are impregnated or coated with a coating material comprising a luminescent material and a binder;

⁵ This Decision also cites to the Specification (“Spec.”) filed August 9, 2016, the Final Office Action (“Final Act.”) dated August 28, 2018, the Examiner’s Answer (“Ans.”) dated July 22, 2019, and the Reply Brief (“Reply Br.”) filed September 19, 2019.

and wherein the coating material is free from colorant so that glass particles and the coating material are transparent.

OPINION

We review the appealed rejections for error based upon the issues Appellant identifies, 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 argued claims and each of Appellant’s arguments, we are persuaded of reversible error in the pending rejections.

In particular, Appellant argues, among other things, that Barry fails to teach that the glass beads or powder have irregular surfaces and that these beads or powder are coated with a transparent coating material comprising a luminescent material and a binder. Appeal Br. 7–8. Appellant asserts that Tyler and Barry fail to teach or suggest use of ground glass having an irregular surface and a luminescent material free of colorant so as to be transparent. *Id.* at 8–9. Appellant also asserts that Nakashima fails to disclose use of ground glass with an irregular surface, but instead heats and suspends glass particles in air such that the glass particles become spheroids before use. *Id.* at 10. Although the Examiner determines that claim 12 does not require that the luminescent material is transparent (Ans. 3–4), Appellant contends that the luminescent material must be transparent because claim 12 recites that the coating material is transparent and includes the luminescent material. Reply Br. 2. In addition, although the Examiner determines that

claim 12 does not require that the glass particles comprise an irregular outer surface throughout the process (Ans. 4), Appellant contends that the coated ground glass particles must have irregular surfaces because claim 12 recites a material comprising transparent ground glass particles having an irregular outer surface “wherein the ground glass particles are impregnated or coated with a coating material.” Reply Br. 2.

Appellant’s arguments are persuasive. As Appellant contends, claim 12 requires that the material applied to the base material comprises “transparent ground glass particles formed by grinding glass so that the particles have an irregular outer surface.” Further, although Nakashima teaches producing, as an intermediate, powdered glass particles, Nakashima teaches that these particles are heated and suspended in air to form them into spheroids prior to use. Nakashima 4:29–44. Thus, contrary to the Examiner’s determination, claim 12 requires use of ground glass particles having irregular surfaces, whereas Nakashima teaches spheroidizing such particles prior to use.

Moreover, as Appellant contends, claim 12 requires that the coating material is free from colorant, is transparent, and comprises a luminescent material and a binder. The Examiner finds that Barry teaches “applying material comprising transparent elements in the form of retro-reflective glass particles and luminescent material.” Final Act. 5. However, Barry teaches that the retro-reflective glass particles are transparent, but does not teach that the luminescent material is transparent. Barry 2:1–5. Nor does Barry teach that the coating material comprising the luminescent material and a binder is transparent. Thus, contrary to the Examiner’s finding, Barry does not teach a

coating material comprising a luminescent material and a binder that is color-free and transparent.

The Examiner has the initial burden of establishing a *prima facie* case of obviousness based on an inherent or explicit disclosure of the claimed subject matter under 35 U.S.C. § 103. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992) (“[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.”). To establish a *prima facie* case of obviousness, the Examiner must show that each and every limitation of the claim is described or suggested by the prior art or would have been obvious based on the knowledge of those of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). Here, the Examiner erred in finding that the applied prior art taught or suggested the use of ground glass particles having irregular surfaces and coated with a color-free, transparent coating material comprising luminescent material and a binder. Under these circumstances, we cannot conclude that the Examiner has met the minimum threshold of establishing obviousness. *See also KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”)).

Accordingly, we cannot sustain the Examiner’s obviousness rejection of claim 12, nor of claims 13 and 14 dependent thereon over the combination of Tyler, Barry, and Nakashima.

CONCLUSION

Upon consideration of the record and for the reasons set forth above and in the Appeal and Reply Briefs, the Examiner's decision to reject claims 12–14 under 35 U.S.C. § 103 is *reversed*.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
12–14	103	Tyler, Barry, Nakashima		12–14

REVERSED