

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM W. BARTON, BRUCE C. POLZIN,
KENNETH L. SHEHOW AND JAIME ALVAREZ GARCIA

Appeal No. 1997-0566
Application 08/344,345

ON BRIEF

Before GARRIS, KRATZ, and LIEBERMAN, Administrative Patent
Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection
of claims 1 through 23 which are all of the claims in the
application.

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The subject matter on appeal relates to a method of producing a paint roller, to the paint roller product produced by this method and to an apparatus for manufacturing a paint roller. Rather than reproduce the appealed claims, we refer to the application file record for a review of the here-claimed subject matter.

The following references are relied upon by the examiner as evidence of obviousness:

Grodberg et al. (Grodberg) 1966	3,226,799	Jan. 4,
Morrison 1969	3,457,130	July 22,
Sekar 23, 1993	5,195,242	Mar.

(parent filed Aug. 15,
1989)

The admitted prior art

Claims 1 through 5, 7 through 9 and 11 through 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sekar in view of Grodberg and Morrison, and claims 6 and 10 stand correspondingly rejected over these references and further in view of the admitted prior art described in the

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background section of the appellants' specification.¹

¹The claims on appeal have been separately grouped as indicated on pages 4 and 5 of the brief. Accordingly, we will separately consider these claims as appropriate in our opinion below.

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We refer to the brief and to the answer for a complete discussion of the opposing viewpoints expressed by the appellants and by the examiner concerning the above-noted rejections.

OPINION

For the reasons which follow, we will sustain the examiner's Section 103 rejection of claims 13 through 23 but not his rejection of claims 1 through 12.

As correctly argued by the appellants in their brief, the here-applied references contain no teaching or suggestion of the appealed claim 1 method features relating to providing an adhesive substance in strip form that is composed solely of the adhesive substance and heating this strip form adhesive substance to a temperature at which it will bond to the paint roller core. From our perspective, none of the applied references even discloses the here-claimed strip form adhesive substance, much less contains any teaching or suggestion of substituting this strip form adhesive substance for the spray adhesive step used in Sekar's method. As a consequence, it is quite clear that we cannot sustain the examiner's Section 103 rejection of independent claim 1 or of claims 2 through 6

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which depend therefrom as being unpatentable over Sekar in view of Grodberg and Morrison alone or further in view of the admitted prior art.

Analogously, the prior art applied by the examiner contains no teaching or suggestion of the appealed claim 7 method feature directed to an adhesive substance being in a hot, extruded condition in the form of an envelope which envelopes the paint roller core and which envelope is composed solely of the adhesive substance. Indeed, we find nothing in the here-applied references which would have suggested anything that could be rationally considered an envelope form adhesive substance of the type defined by appealed claim 7. Further, the examiner in his answer has not even responded to the appellants' argument concerning this claim 7 feature. It follows that we also cannot sustain the rejection of independent claim 7 or of claims 8 through 12 which depend therefrom as being unpatentable over Sekar in view of Grodberg and Morrison alone or further in view of the admitted prior art.

We will sustain, however, the examiner's Section 103 rejection of method claims 13 through 18. In our view, these

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claims contain nothing which even distinguishes over the method of Sekar. It is here appropriate to emphasize that the appellants' arguments concerning these claims are simply not relevant to the features recited therein. For example, the argued distinctions presented regarding independent claim 13 do not relate to the features thereof but instead are directed to the strip form adhesive substance feature of appealed claim 1. Similarly, the argued distinction presented concerning independent claim 16 relates not to the features thereof but instead to the envelope form adhesive substance feature of appealed claim 7.

The examiner's Section 103 rejection of product claims 19 through 22 will also be sustained. It is well settled, of course, that the patentability determination of such product-by-process claims is based upon the product itself rather than upon the process by which it is made. In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). With this in mind, we fail to discern any distinction between the paint roller product of appealed claims 19 through 22 and the paint roller product of Sekar. More specifically, while the products of appealed claims 19 and 20 are made by methods

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which patentably distinguish over Sekar's method as explained above, the ultimate products formed by these respective methods are indistinguishable from Sekar's product.

Concerning the appealed product claims, it appears to be the appellants' position that the paint roller product of these claims may differ from the paint roller product of Sekar "in the case of a manufacturing malfunctioning. . ." (brief, page 16). This position is not only speculative, but is based upon features to which the claims under review are not limited and thus cannot be regarded as well founded.

Finally, the apparatus defined by appealed claim 23 is indistinguishable from the apparatus disclosed by Sekar. According to the appellants, "[n]one of Sekar, Grodberg et al nor Morrison disclose apparatus 'for producing a structurally integral composite structure consisting of an adhesive free self-sustaining paint roller core' (emphasis ours), and hence the cited references whether viewed individually or in any combination do not disclose or suggest the claimed combination of features." (Brief, page 17). We perceive no merit in the appellants' view of this matter. Specifically, the appellants are incorrect in their apparent belief that Sekar's apparatus

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does not produce a self-sustaining paint roller core which is free of adhesive. With reference to Figure 4 of Sekar's drawing, for example, it is clear that core 18 is adhesive free upstream of adhesive applicator 40 (see lines 3 through 53 in column 5 of Sekar). Under these circumstances, it is clear that the Section 103 rejection of claim 23 as being unpatentable over Sekar in view of Grodberg and Morrison also should be sustained.

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In summary, we have sustained the examiner's rejection of claims 13 through 23 but not his rejection of claims 1 through 12.

The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
PETER F. KRATZ)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
)	
PAUL LIEBERMAN)	
Administrative Patent Judge)	

BRG:svt

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