

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(2) is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHANDR SEKAR

Appeal No. 1997-0870
Application No. 08/333,416

ON BRIEF

Before JOHN D. SMITH, WALTZ, and LIEBERMAN, Administrative
Patent Judges.

WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the
examiner's refusal to allow claims 11 through 22, 28 through
34, and 36 through 44, as amended subsequent to the final

Appeal No. 1997-0870
Application No. 08/333,416

rejection (see the amendment dated Feb. 20, 1996, Paper No. 10, entered as per the Advisory Action dated April 5, 1996, Paper No. 11). These are the only claims remaining in this application.

According to appellant, the invention is directed to a method and apparatus for making a reusable paint roller consisting of an inner core and an outer cover, wherein the core is formed from thermoplastic strips and bonded with liquid thermoplastic material to the fabric cover (Brief, pages 2-5). Illustrative independent claims 11 and 28, directed to an apparatus and a method, are reproduced and attached as an Appendix to this decision.

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

Stahl	2,789,075	Apr. 16, 1957
Grodberg et al. (Grodberg)	3,226,799	Jan. 4, 1966
Burns et al. (Burns)	3,518,970	Jul. 7, 1970
Hielema	3,700,520	Oct. 24, 1972
Garcia	5,137,595	Aug. 11, 1992

(effective filing date of Dec. 11, 1985)

Claims 11-22, 28-34, 36, 37, 39 and 41 stand rejected under 35 U.S.C. § 103 as unpatentable over Grodberg in view of Hielema and Garcia (Answer, page 3). Claims 38, 40 and 42-44

Appeal No. 1997-0870
Application No. 08/333,416

stand rejected under 35 U.S.C. § 103 as unpatentable over the references as applied above further in view of either one of Stahl or Burns (Answer, page 4).¹ We reverse the examiner's rejections for reasons which follow.

OPINION

The examiner finds that Grodberg discloses an apparatus for producing paint rollers having means for winding a plurality of core-forming strips coated with adhesive and means for applying a cover strip to the core, with the adhesive being of any type capable of withstanding paint solvents (Answer, page 3). The examiner finds that Hielema discloses an apparatus for forming a polypropylene core where thermoplastic adhesive is applied to the overlapping strip material using a nozzle (Answer, sentence bridging pages 3-4). The examiner further finds that Garcia teaches that it is known to use preformed polypropylene core tubing in the

¹ As noted by the examiner on page 5 of the Answer, claims 43 and 44 were finally rejected over Grodberg, Hielema and Garcia but in the Answer these claims are grouped in the second rejection involving Grodberg, Hielema, Garcia, and Stahl/Burns. Appellant contends that this rejection of claims 43 and 44 based upon the additional references to Stahl/Burns constitutes a new ground of rejection (Reply Brief, pages 1-2). In view of our decision below, this issue is moot.

Appeal No. 1997-0870
Application No. 08/333,416

production of paint rollers (Answer, page 4).

From the foregoing findings, the examiner makes the following conclusions:

[i]t would have been obvious to one having ordinary skill in the art to substitute Hielema's polypropylene core-forming strip material and corresponding adhesive application means for Grodberg et al's cardboard core-forming strip material precoated with adhesive, because Garcia shows that it is known to use polypropylene core stock for producing paint rollers, and because of the similarity in operation of the Grodberg et al and Hielema winding devices. (*Id.*).

"[W]hen determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.' [Citations omitted]." *In re Rouffet*, 149 F.3d 1350, 1356, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The examiner has concluded that it would have been obvious to substitute the polypropylene core-forming strip material of Hielema for the cardboard core-forming strip material of Grodberg (Answer, page 4). However, Grodberg specifically desires to make a *disposable* paint roller which necessarily

Appeal No. 1997-0870
Application No. 08/333,416

must be made of inexpensive materials such as cardboard (see Grodberg, col. 1, ll. 10-11; ll. 42-44; and col. 2, ll. 13-19). The examiner has failed to identify any suggestion in the prior art as a whole to substitute the expensive, reusable polypropylene of Hielema for the inexpensive, disposable cardboard of Grodberg.

Furthermore, the examiner has failed to identify any convincing evidence or reasoning why one of ordinary skill in the art would have substituted the system of core material and adhesive in Hielema for the corresponding system in Grodberg. The examiner's only reasoning is "because of the similarity in operation of the Grodberg et al and Hielema winding devices." (Answer, page 4). Although the methods of operation of the winding devices in Grodberg and Hielema are similar, the examiner has not identified any reason or suggestion as to why one of ordinary skill in the art would have substituted means and a method for applying corrosion and mechanical protective coatings to a pipe as taught by Hielema in the paint roller system and method of Grodberg. See Hielema, col. 1, ll. 30-36. There must be a suggestion of desirability in the prior

Appeal No. 1997-0870
Application No. 08/333,416

art as a whole to make the proposed combination. See *Rouffet*, *supra*. Any showing of a suggestion, teaching or motivation to combine must be clear and particular. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

The examiner also states that "Garcia shows that it is known to use polypropylene core stock for producing paint rollers" (Answer, page 4). However, considering the teachings of Garcia as a whole, this reference teaches the disadvantages of using "a tubular plastic or cardboard core" with an adhesive (col. 1, ll. 21-41). Garcia teaches heat bonding the fabric strip to the tubular plastic core without the use of adhesives to form a single unitary body (col. 1, ll. 44-59). Accordingly, Garcia teaches away from the use of an adhesive with a plastic tubular core. A reference which teaches away is a significant factor to be considered in determining unobviousness. *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994).

For the foregoing reasons, we determine that the examiner has failed to establish a *prima facie* case of obviousness in view of the reference evidence of Grodberg, Hielema and

Appeal No. 1997-0870
Application No. 08/333,416

Garcia. The examiner has cited and applied Burns or Stahl to "teach applying paint roller fibers to an adhesively coated core to form a cover layer." (Answer, page 4). Therefore Burns and Stahl do not remedy the deficiencies discussed above.² Accordingly, the examiner's rejections of the claims on appeal are reversed.

OTHER ISSUES

Upon the return of this application to the jurisdiction of the examiner, the examiner and appellant should consider the patentability of the subject matter of at least claims 43 and 44 under the judicial doctrine of obviousness-type double patenting over the claims of appellant's U.S. Patent Nos. 5,195,242, 5,398,409, and 5,572,790. It should be noted that appellant has not contested the applicability of Burns/Stahl for the teaching of applying a cover by blowing fibers onto a core coated with adhesive (Answer, page 4; see Brief and Reply Brief in entirety).

² Since we determine that the examiner has not properly identified any suggestion, motivation or teaching to combine the references as proposed in the rejections, we need not discuss the further limitations of various claims, e.g., the first applying means of claim 34 or applying the cover by blowing fibers as in claim 43.

Appeal No. 1997-0870
Application No. 08/333,416

SUMMARY

The rejection of claims 11-22, 28-34, 36, 37, 39 and 41 under 35 U.S.C. § 103 over Grodberg in view of Hielema and Garcia is reversed. The rejection of claims 38, 40 and 42-44 under 35 U.S.C. § 103 over Grodberg in view of Hielema and Garcia further in view of either Stahl or Burns is reversed.

The decision of the examiner is reversed.

REVERSED

JOHN D. SMITH)
Administrative Patent Judge)

Appeal No. 1997-0870
Application No. 08/333,416

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PAUL LIEBERMAN))
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Appeal No. 1997-0870
Application No. 08/333,416

CLAIM 11

An apparatus for making paint rollers comprising:

Appeal No. 1997-0870
Application No. 08/333,416

a mandril;

means for winding a plurality of strips of thermoplastic material onto said mandril in overlapping relation;

means for advancing said wound strips in a direction coaxial with said mandril;

a supply of thermoplastic material;

means for liquefying said supply of thermoplastic material;

first means for applying said liquid thermoplastic material to said strips before said strips are wound on said mandril for bonding said strips to each other to form an endless core;

second means for applying an adhesive to the outer surface of said core; and means for applying a cover onto said adhesive on the outer surface of said core for bonding said cover to said core to form an endless roller.

CLAIM 28

28. A method for making a paint roller comprising:

providing a stationary mandril to which liquefied thermoplastic does not adhere;

providing an applicating means composed of a material to which liquefied thermoplastic does not adhere;

liquefying a supply of thermoplastic material;

applying the liquified thermoplastic material to the applicating means;

transferring the liquefied thermoplastic material from the applicating means to the mandril for even distribution

Appeal No. 1997-0870
Application No. 08/333,416

thereabout, whereupon the liquefied thermoplastic material rapidly sets forming a core;

providing means for advancing the core away from the applying means;

applying an adhesive to the outer surface of said core;

applying a cover about said core over said adhesive for bonding said cover to said core to form an endless roller; and

cutting said endless roller into usable lengths.