

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 40

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

AUG 27 1996

PAT & TM OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte JAIME A. GARCIA

Appeal No. 94-2008  
Application 07/902,483<sup>1</sup>

HEARD: August 5, 1996

Before CALVERT, Administrative Patent Judge, McCANDLISH, Senior Administrative Patent Judge and LYDDANE, Administrative Patent Judge.

CALVERT, Administrative Patent Judge.

---

<sup>1</sup> Application for patent filed June 23, 1992. According to appellant, this application is a continuation of Application 07/656,102 filed February 11, 1991, now abandoned, which is a continuation of Application 07/325,101 filed March 13, 1989, now abandoned, which is a continuation of Application 07/065,382 filed July 28, 1987, now abandoned, and which is a division of Application 06/807,818 filed December 11, 1985, issued September 15, 1987 as U.S. Patent No. 4,692,975.

Appeal No. 94-2008  
Application 07/902,483

**DECISION ON APPEAL**

This is an appeal from the final rejection of claims 28 and 29, all of the claims remaining in the application.

Claims 28 and 29 are reproduced in the appendix hereto.

The prior art relied upon by the examiner in the final rejection is:

Wood	3,401,073	Sep. 10, 1968
Biancamaria (French Patent)	2,093,060	Jan. 28, 1972 <sup>2</sup>

Claims 28 and 29 stand finally rejected under 35 U.S.C. 103 as (1) unpatentable over Wood in view of Biancamaria, or (2) as unpatentable over Biancamaria alone.

After fully considering the record in light of the arguments presented in appellant's brief and the examiner's answer, we conclude that the appealed claims are patentable over the applied prior art.

---

<sup>2</sup> References herein to pages and lines of this reference are to pages and lines of the accompanying translation.

Appeal No. 94-2008  
Application 07/902,483

The method disclosed by Wood is similar to that disclosed and claimed by appellant, except that the roller core is made of heavy paperboard or fiberboard, and the fabric is attached thereto with adhesive (col. 1, lines 35-39); no heating is involved. Biancamaria, on the other hand, discloses a method of making a paint roller in which the roller core is extruded from a thermoplastic, and, while hot, the outer covering, such as "synthetic fur" 7 (p. 5, line 25), is wound onto the core and becomes "welded" thereto.

The examiner's position with regard to rejection (1) is that  
(answer, pp. 4-5):

It would have been obvious to one of ordinary skill in the art to have used a piece of pre-formed, pre-hardened, initially cold, plastic tubular core stock in the invention of Woods [sic: Wood] and to also incorporate the radial surface heater of the French Patent into the invention of Woods [sic: Wood] between the cold end of the core stock and the junction of the core stock and pile fabric to soften the bar stock surface to afford bonding between the pile fabric and said core stock. This is so because both references are bonding pile fabric to a tubular core stock by helical winding of said pile fabric to make paint rollers, and, adhesion by 'glue' and by thermoplastic softening fusion are recognized as functionally alternative bonding means in the art.

Appeal No. 94-2008  
Application 07/902,483

We do not agree with this reasoning. Even accepting that adhesion by glue and by thermal fusion are functionally alternative bonding means, we do not consider that the process disclosed by Biancamaria would suggest modifying the Wood process to result in the claimed method. Biancamaria's process is an integrated one in which a hot core emerges from an extruder, is "overheated" on its outer surface by heaters 4, and then the covering material 7, preheated by 11, is applied as the core is rotated and moves past "welding area" 10. At the same time, the interior of the core is cooled. By contrast, in the Wood process, an unheated roller core is rotated but does not move laterally, the adhesive is applied to the core by hand, and the cover applicator 12 traverses the length of the core. Given the dissimilarity in operation between the methods of Woods and Biancamaria, it appears that the only suggestion or motivation to modify the Wood method as proposed by the examiner would be derived from appellant's own disclosure, rather than from the references. Thus, any conclusion that the claimed subject matter would have been obvious would be improperly based on hindsight

Appeal No. 94-2008  
Application 07/902,483

from appellant's own teachings. In re Deminski, 796 F.2d 436, 443, 230 USPQ 313, 316 (Fed. Cir. 1986).

As for rejection (2), the examiner asserts that, in view of the Biancamaria disclosure of the conventional use of cold plastic roller cores (p. 3, lines 12-17) and of heating the exterior of a plastic core to adhere fabric thereto (p. 4, third full paragraph (lines 15-21)), it would have been obvious "to fabricate paint rollers of the French patent on a batch basis instead of continuously" (answer, p. 6). However, we note that in the page 4 paragraph referred to, Biancamaria states that (emphasis added):

Depending on the type of product extruded, its extruding temperature, the preparation of the surfaces and the affinity of the covering for the molten plastic, the weld obtained can be perfect, and the tubular laminated plastic obtained in this manner very homogeneous.

Thus, this paragraph, and the other disclosure in Biancamaria concerning attachment of the cover, is limited to application of the cover to a core which is hot, as it comes from the extruder;

Appeal No. 94-2008  
Application 07/902,483

we find no suggestion in this reference of heating a "cold" core and then applying the fabric.

We conclude that neither rejection (1) nor rejection (2) makes out a prima facie case of obviousness. It is therefore unnecessary to consider the statements (affidavits) of Burns.

Rejections Under 37 CFR 1.196(b)

Pursuant to 37 CFR 1.196(b), we enter the following rejections: (1) Claims 28 and 29 are rejected for failing to comply with the first paragraph of 35 U.S.C. 112, in that:

(a) There is no written description in the application as filed<sup>3</sup> for the recitation in these claims that the fabric is "thermo-plastic." The specification states only that the fabric is "a conventional cover material for a paint roller" (p. 5, lines 5-6), and although appellant's counsel requested at the oral hearing that we take judicial notice that paint roller covers are thermoplastic, we have no basis for doing so. Also, even if some

---

<sup>3</sup> It is noted that when the instant application was filed on June 23, 1992 under 37 CFR 1.62, the "original claims" were claims 22 and 23, the only claims then present in parent application 07/656,102 (together with unentered claim 24).

Appeal No. 94-2008  
Application 07/902,483

roller covers are made of thermoplastic material, that fact would still not support a specific recitation of such material. Watson v. Bersworth, 251 F.2d 898, 900, 116 USPQ 79, 80 (D.C. Cir.), cert. den., 356 U.S. 972 (1958) (generic disclosure does not support a specific claim). (b) There is no written description in the application as filed for the last four lines of claim 28 ("cutting a piece...cut off piece"). We find nothing in appellant's disclosure to the effect that after the fabric 3 is bonded to core 2, a piece is cut off the core. To the contrary, in fact, it is stated on page 6, lines 14-21 (emphasis added):

...the surface of the core 2 in the zone of winding is heat-softened to the point that the fabric strip 3 is fused thereto upon being wound over the core 2. The resulting structure 8, illustrated in Figure 5, is a paint roller in which the fabric strip and the plastic core have in effect been fused into an integral unitary body.

The paint roller 8 of Figure 5 may be used as a replacement element or it may be provided with end pieces and a handle to form a complete roller assembly.

(2) Claims 28 and 29 are rejected under 35 U.S.C. 112, second paragraph. Claim 28 is indefinite in that lines 8-12 are repeated in lines 13-17, making the bounds of these claims

Appeal No. 94-2008  
Application 07/902,483

unclear. Appellant acknowledges in a note on page 2 of Attachment 1 to his brief that the recitation in lines 11-12 ("said cold...finite length") appears twice in the claim, but we note that the recitation in lines 8-10 ("said cold...unitary body") appears twice also.

#### Conclusion

The examiner's decision to reject claims 28 and 29 is reversed.

Claims 28 and 29 are rejected pursuant to 37 CFR 1.196(b).

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date of the decision (37 CFR 1.197). Should appellant elect to have further prosecution before the examiner in response to the new rejection under 37 CFR 1.196(b) by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision.

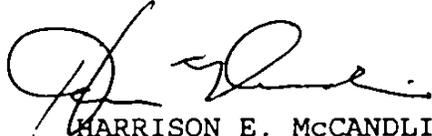
Appeal No. 94-2008  
Application 07/902,483

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

REVERSED: 37 CFR 1.196(b)

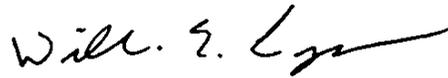


IAN A. CALVERT )  
Administrative Patent Judge)



HARRISON E. McCANDLISH )  
Senior )  
Administrative Patent Judge)

BOARD OF PATENT  
APPEALS AND  
INTERFERENCES



WILLIAM E. LYDDANE )  
Administrative Patent Judge)

Appeal No. 94-2008  
Application 07/902,483

James G. Staples  
Baker & McKenzie  
One Prudential Plaza  
130 East Randolph Drive  
Chicago, IL 60601

APPENDIX

28. A cold core method of making a paint roller from a cold, hard, pre-formed hollow core of thermoplastic material of a predetermined length in which the cold hard hollow core and its associated fabric cover are forged together to form a single unitary body comprising the steps of

providing a hard hollow core,

said hard hollow core being cold,

said cold hard hollow core being composed of a thermoplastic material capable of being fused to a fabric cover of a compatible thermoplastic material to form a single unitary body,

said cold hard hollow core further having a predetermined, finite length,

said cold hard hollow core being composed of a thermoplastic material capable of being fused to a fabric cover of a compatible thermoplastic material to form a single unitary body,

said cold hard hollow core further having a predetermined, finite length,

providing a mandrel having an external diameter which slidably receives and makes contact with the cold hard hollow core throughout its length so as to thereby enable the cold hard hollow core to rotate with a mandrel,

rotating a mandrel and thereby the cold hard hollow core which has been received thereon and is in contact therewith,

heating, by application of a single source of heat, the exterior surface of the cold hard hollow thermoplastic rotating core to a temperature high enough to cause subsequently applied thermoplastic fabric to adhere to said exterior surface,

Appeal No. 94-2008  
Application 07/902,483

applying a thermoplastic fabric to the heated exterior  
of the hard hollow thermoplastic rotating core,  
bonding the thermoplastic fabric to the heated exterior  
surface of the hard hollow thermoplastic core, and  
cutting a piece from the fabric bonded predetermined  
length core desired for a paint roller  
whereby the predetermined length hard core is non-  
replaceably reduced in length by the length of the cut off piece.

29. The method of Claim 28 further characterized by and  
including the step of  
applying pressure to the unheated thermoplastic fabric  
as the fabric is applied to the heated exterior of the cold hard  
hollow thermoplastic core.