

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(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAMELA H. MARTIN,
WILLIAM J. KAUFFMAN AND
BRUCE F. DIETRICH

Appeal No. 96-3723
Application 08/136,939¹

ON BRIEF

Before RONALD H. SMITH, HANLON and PAK, Administrative Patent
Judges.

RONALD H. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims
1-12, 21 and 22, all the pending claims in the application.

¹ Application for patent filed October 18, 1993. According to
appellants, this application is a continuation of Application 07/500,552,
filed March 28, 1990, now Patent No. 5,256,465, issued October 26, 1993.

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The subject matter relates to resilient tension floor structures. Claims 1 and 2, the only independent claims, are illustrative of the appealed claims and read as follows:

1. A floor covering comprising a resilient tension floor structure including an upper foamed thermoplastic layer, a lower foamed thermoplastic layer, and an unfoamed plastic inner layer disposed between the upper and the lower foamed thermoplastic layers, the floor covering having a structural stability such that the floor covering is capable of shrinking at least 0.1%, the upper foamed thermoplastic layer being foamed throughout.

2. A floor covering comprising a resilient tension floor structure including an upper foamed thermoplastic layer, a lower foamed thermoplastic layer, and an unfoamed thermoplastic inner layer disposed between the upper and the lower foamed thermoplastic layers, the upper foamed thermoplastic layer being foamed throughout.

The references relied on by the examiner are:

Witman et al. (Witman)	3,870,591	Mar. 11, 1975
Herr, Jr. et al. (Herr)	4,699,820	Oct. 13, 1987
Wang et al. (Wang)	4,863,782	Sep. 5, 1989
Martin et al. (Martin)	5,256,465	Oct. 26, 1993

Claims 1 and 22 stand rejected under 35 U.S.C. § 112, first paragraph. Claims 10-12 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 2-4 of Martin. Claims 1-4, 10-12 and 21 stand rejected under 35 U.S.C. § 103 as unpatentable over Witman. Claim 5 stands rejected under 35 U.S.C. § 103 as unpatentable over Witman in view of Herr. Claims 6-9 stand rejected under 35 U.S.C. § 103

as unpatentable over Witman in view of Herr and Wang. We have carefully considered the entire record, including the positions of the appellants as set forth in their briefs and the positions of the examiner as set forth in the answers, and we have decided that we will not sustain these rejections.

I.

In the rejection under 35 U.S.C. § 112, the examiner contends that there is no support for the limitation "capable of shrinking at least 0.1%" in claim 1. We disagree. As noted by appellants on page 47 of their substitute brief, there is express support for the limitation on page 6 of the specification, lines 4-7. The amendment filed with the application on October 18, 1993 (Amendment B), which changed "0.01%" to "0.1%", merely corrected an obvious error in the decimal point placement and does not constitute new matter for the reasons adequately set forth by appellants on page 49 of their substitute brief.

The examiner contends that there is no support in the specification for the language in claim 22 "the inner layer is uncrosslinked". We agree with appellants, however, that there is adequate support for the phrase on page 8, lines 16-20, where it is disclosed that the "unfoamed inner layer is preferably a thermoplastic, and most preferably a vinyl. However, it may be a

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slightly crosslinked vinyl...". We fully agree with appellants position as set forth on pages 48-49 of their substitute brief.

II.

In the double patenting rejection of claims 10-12 over claims 2-4 of Martin, the examiner urges that "both sets of claims are drawn to resilient tension floor covering comprising two foamed thermoplastic layers and an unfoamed thermoplastic layer between the foamed layers." The examiner's position is erroneous. As noted by appellants, claims 2-4 of Martin are not directed to resilient "tension" floor coverings. Claims 2-4 of Martin do not teach or suggest "tension" floor coverings. We agree with appellants that the term "tension" floor covering is entitled to be given patentable weight because it "breathes life and meaning into the claim." In the supplemental examiner's answer, the examiner states in response to appellants' arguments that "the phrase "resilient tension floor is literally recited in claims 1 and 2" of Martin. As noted, supra, claim 2 of Martin is not directed to resilient "tension" floors. It is manifestly improper for the examiner to rely on a limitation in claim 1 of Martin in an effort to buttress a double patenting rejection over claims 2-4 of Martin. If it is the examiner's position that

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claim 1 of Martin raises an issue of double patenting, a new ground of rejection is required.

III.

The rejections pursuant to 35 U.S.C. § 103 all rely on Witman as the primary reference. The rejection is untenable. As noted by appellants, Witman does not teach or suggest a tension floor structure. To the contrary, Witman teaches a "dimensionally stable plastic surface covering" which resists stretch. The Witman floor covering is the antithesis of the claimed tension floor covering. Since we are in substantial agreement with appellants' position with respect to the rejections over Witman, we adopt that position as our own.

The decision of the examiner is reversed.

REVERSED

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RONALD H. SMITH)	
Administrative Patent Judge)	
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ADRIENE LEPIANE HANLON)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
CHUNG K. PAK)	
Administrative Patent Judge)	

Douglas E. Winters
ARMSTRONG WORLD INDUSTRIES, INC.
Patent Department
P. O. Box 3001
Lancaster, PA 17604

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