

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM M. STECKER

Appeal No. 98-1001
Application No. 08/505,455

ON BRIEF

Before GARRIS, OWENS and LIEBERMAN, Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner refusing to allow claims 1 through 4, 6 through 14 and 16 through 21 as amended subsequent to the Final Rejection, which are all of the claims pending in this application.

THE INVENTION

The invention is directed to a process for making a decorative article by sequentially providing two curable thermosetting resins such that the second curable thermosetting resin is cast onto the face layer of the first cured resin to follow the relief thereof. Additional limitations are disclosed in the following illustrative claim.

THE CLAIM

Claims 1 is illustrative of appellant's invention and is reproduced below.

1. A process for making a decorative article of manufacture, the process comprising:
 - (a) forming a first lamina having a face layer with a relief and a substantially planar back layer, said first lamina formed from a first curable thermosetting resin;
 - (b) curing the first curable thermosetting resin;
 - (c) casting a second curable thermosetting resin onto the face layer of the first lamina to follow the relief thereof and to form a second lamina having a face layer and a back layer, said second lamina formed substantially from said second curable thermosetting resin;
 - (d) curing the second curable thermosetting resin; and
 - (e) removing a portion of the first lamina face layer and the second lamina face layer to provide a decorative article of manufacture having a substantially planar face layer.

THE REFERENCES OF RECORD

As evidence of obviousness, the examiner relies upon the following references:

Edge	298,358	May 13, 1884
Kawasaki	4,889,666	Dec. 26, 1989

THE REJECTIONS

Claims 1 through 4, 6 through 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kawasaki.

Claims 10 through 14, and 16 through 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kawasaki in view of Edge.

OPINION

We have carefully considered all of the arguments advanced by the appellant and the examiner and agree with the appellant that the rejections of claims 1 through 4, 6 through 14 and 16 through 21 are not well founded. Accordingly, we reverse these rejections.

The Rejections under § 103(a)

"[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," whether on the grounds of anticipation or obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). On the record before us, the examiner respectively relies upon Kawasaki alone or in view of Edge to reject the claimed subject matter and establish a prima facie case of obviousness.

Kawasaki discloses a method for producing a concrete product by casting concrete into a waste mold and solidifying the concrete to produce a concrete block on the waste mold. See column 1, lines 56-58. After removal of the waste mold, a coloring material is filled into the recessed patterns on the surface of the concrete block followed by grinding of the surface of the concrete block to produce a concrete product. See column 1, lines 61-65. The term "concrete" is defined as "cement, mortar or plastic or the mixture thereof which become solidified or hardened by hydration." See column 3, lines 66-68. Furthermore, the, "concrete may include a material made of thermosetting resin such as unsaturated polyester to which pulverized aggregate is added." See column 4, lines 3-6.

However, as stated by the examiner, Kawasaki, "does not teach the curing of the second curable thermosetting resin; the sanding of the first and second layers of lamina; and the heating and curing temperatures claimed." See Answer, page 4. Moreover, we

find that Kawasaki not only does not teach a second layer, but also fails to specifically disclose the requirement of the claimed subject matter of, "casting a second curable thermosetting resin onto the face layer of the first lamina to follow the relief thereof." See claims 1 and 10. Accordingly, Kawasaki of record alone fails to establish a prima facie case of obviousness with respect to claims 1 through 4 and 6 through 9.

Furthermore, with respect to claims 10 through 14, and 16 through 21, the limitations of the claimed subject matter not found in Kawasaki are not disclosed by Edge. We find that Edge is directed to the production of a three-layer metal article and the filing down of the second and third layers to reveal the first and second layers. See lines 40-45 and Figure 3. Although there are elements present in common with that of the claimed subject matter, we fail to see any suggestion to the person having ordinary skill in the art to have combined the thermosetting component of Kawasaki with the metal work component of Edge to obtain the composition of the claimed subject matter.

It is well settled that it is the examiner who has the burden of establishing that one of ordinary skill in the art would have found the requisite motivation and reasonable expectation of success for the proposed modification from the applied prior art teachings. See In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); In re O'Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). The record before us has failed to provide either the requisite motivation or a reasonable expectation

of success needed to combine the references in the manner suggested by the examiner.

DECISION

The rejection of claims 1 through 4, 6 through 9 under 35 U.S.C. § 103(a) as being unpatentable over Kawasaki is reversed.

The rejection of claims 10 through 14 and 16 through 21 under 35 U.S.C. § 103(a) as being unpatentable over Kawasaki in view of Edge is reversed.

The decision of the examiner is reversed.

REVERSED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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TERRY J. OWENS)	APPEALS
Administrative Patent Judge)	AND
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