The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HAROLD W. BENEDICT, DIANA D. ZIMNY
and DONNA W. BANGE

Appeal No. 1998-2614
Application No. 08/731,713

ON BRIEF

Before PAK, WALTZ, and DELMENDO, Administrative Patent Judges.

PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 34 through 50 and 52 through 58, which are all of the claims pending in the above-identified application.[1]

[1] Appellants have not identified related Application 08/733,706, Appeal No. 98-2546, in their Brief under the heading "RELATED APPEALS AND INTERFERENCES". In spite of the similarity between the inventions and issues involved in the present appeal and the appeal in related Application 08/733,706, appellants assert that "[t]here are no appeals or interferences known to Appellant's Representatives which will

Claims 34, 45 and 52 are representative of the claimed subject matter and read as follows:

Claim 34. A method for preparing a coated abrasive belt having an endless, seamless backing; the method comprising:

(a) preparing a loop of liquid organic polymeric binder material having fibrous reinforcing material engulfed therein, in extension around the outer periphery of a support structure;

(b) solidifying the liquid organic polymeric binder material to form a flexible, solidified, endless, seamless loop having about 70-85 wt-% solidified organic polymeric binder material with fibrous reinforcing material engulfed therein, generally parallel side edges, and inner and outer surfaces having generally no fibrous reinforcing material protruding therefrom;

(c) applying an abrasive coating to the backing loop; and

(d) removing the backing loop from the support structure.

Claim 45. A method for preparing a coated abrasive belt having an endless, seamless backing; the method comprising:

(a) preparing a loop of liquid organic polymeric binder material having fibrous reinforcing material engulfed therein, in extension around the outer periphery of a support structure;

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directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal." See Brief, page 2. We note that appellants' representative in this appeal is the same individual who is representing the same applicants in the appeal of the final rejection of substantially the same subject matter in Application 08/733,706.

(b) solidifying the liquid organic polymeric binder material to form a flexible, solidified, endless, seamless loop having solidified organic polymeric binder material with fibrous reinforcing material engulfed therein, generally parallel side edges, and inner and outer surfaces having generally no fibrous reinforcing material protruding therefrom; wherein the liquid organic polymeric binder material is a thermosetting resin selected from the group consisting of phenolic resins, amino resins, polyester resins, aminoplast resins, urethane resins, melamine-formaldehyde resins, epoxy resins, acrylated isocyanurate resins, urea-formaldehyde resins, isocyanurate resins, acrylated urethane resins, acrylated epoxy resins and mixtures thereof;

(c) applying an abrasive coating to the backing loop; and

(d) removing the backing loop from the support structure.

Claim 52. A method for preparing a coated abrasive belt having an endless, seamless backing; the method comprising:

(a) preparing a loop of liquid organic polymeric binder material having fibrous reinforcing material engulfed therein, in extension around the outer periphery of a collapsible drum;

(b) solidifying the liquid organic polymeric binder material to form a flexible, solidified, endless, seamless loop having solidified organic polymeric binder material with fibrous reinforcing material engulfed therein, generally parallel side edges, and inner and outer surfaces having generally no fibrous reinforcing material protruding therefrom;

(c) applying an abrasive coating to the backing loop; and

(d) removing the backing loop from the collapsible drum.

In support of his rejections, the examiner relies on the following prior art references:

Freedlander	1,924,355	Aug. 29, 1933
Kremer et al. (Kremer)	2,356,249	Aug. 22, 1944
Waugh	2,773,540	Dec. 11, 1956
Marzocchi	3,607,502	Sep. 21, 1971
Dyer	4,018,574	Apr. 19, 1977
Rausch	4,681,558	Jul. 21, 1987
Benedict et al. (Benedict)	5,573,619	Nov. 12, 1996 (Filed Oct. 29, 1993)
Cooper (Published Canadian Patent Application)	1023563	Jan. 3, 1978
Shaw (Published English Patent)	1 475 986	Jun. 10, 1977
Hansen et al. (Hansen) (Published International Application)	WO 86/02306	Apr. 24, 1986

The appealed claims stand rejected as follows:

1) Claims 34 through 41 and 43 through 47 and 52 through 55 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Shaw, Dyer and either Freedlander, Waugh, Marzocchi or Kremer[2];

[2] The examiner improperly states at page 4 of the Answer that the § 103 rejection based on Shaw, Dyers and any one of

2) Claim 39 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Shaw, Dyer, Rausch and either Freedlander, Waugh, Marzocchi or Kremer;

3) Claim 42 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Shaw, Dyer, Hansen and either Freedlander, Waugh, Marzocchi or Kremer;

4) Claims 48 through 50 and 56 through 58 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Shaw, Dyer, Cooper and either Freedlander, Waugh, Marzocchi or Kremer; and

5) Claims 34 through 50 and 52 through 58 under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1 through 32 of U.S. Patent 5,573,619 issued to Benedict.

Having carefully reviewed the claims, specification and applied prior art, including all of the arguments advanced by both the examiner and appellants in support of their

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Freedlander, Waugh, Marzocchi and Kremer extends to claims “34-40, 42-46, 48-53 and 55-66". As is apparent from page 2 of the final Office action and pages 2 and 4-10 of the Answer, this rejection only extends to “claims 34-41, 43-47 and 52-55".

respective positions, we reverse all the aforementioned rejections, except for the aforementioned obviousness-type double patenting rejection. Our reasons for this determination follow.

The examiner asserts that Shaw teaches by implication a coated abrasive belt having an endless, seamless backing. See Answer, pages 4 and 5. However, the examiner admits (Answer, page 5) that

> [Shaw] fails to teach how those skilled in the art would have provided for the fibers extending longitudinally lengthwise of the belt (having fibers extending lengthwise of the belt would have implied that the fibers were continuous and unbroken lengthwise of the belt) and further fail to express the amount of resin used to embed the fibers.

To remedy these deficiencies in Shaw, the examiner relies on Dyers and any one of Freedlander, Waugh, Marzocchi and Kremer. Although Dyers is the only one directed to a process for making a coated endless, seamless abrasive article, the examiner asserts that one of ordinary skill in the art would have looked to the industrial drive belt making processes described in either Freedlander, Waugh, Marzocchi or Kremer to make the backing layer of the coated endless, seamless abrasive article taught by Shaw. The examiner further asserts

that one of ordinary skill in the art would have looked to Dyers[3] only for the amount of resin binder employed per the amount of reinforcement materials used in making the coated endless, seamless abrasive article described in Shaw.

On the appeal record before us, we find that it is only appellants' own specification which discloses the desirability of using the above-mentioned features in combination. There is no evidence that one of ordinary skill in the art would have employed the less relevant industrial belt making processes described in either Freedlander, Waugh, Marzocchi or Kremer over the more relevant coated abrasive endless, seamless belt making process described in Dyers. Nor is there any evidence that one of ordinary skill in the art would have looked to only one section of Dyers at the exclusion of its remaining teachings to arrive at the claimed invention. The examiner's position to the contrary is not supported by any objective evidence. Thus, we are convinced that the examiner's § 103 rejections are fatally premised upon

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[3] The examiner states at page 20 of the Answer that "it cannot be disputed that Dyers employed a different manufacturing technique (other than that which is claimed by appellant[s] for forming an endless seamless backing)..."

impermissible hindsight. *See W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). The remaining prior art references relied on by the examiner for the features recited in certain dependent claims do not remedy the deficiencies indicated above.

Under these circumstances, we are constrained to agree with appellants that the examiner has not established a *prima facie* case of obviousness regarding the claimed subject matter within the meaning of 35 U.S.C. § 103. Accordingly, we reverse all the examiner's § 103 rejections.

However, the obviousness-type double patenting rejection of all of the claims on appeal stands on a different footing. Inasmuch as appellants have not disputed the propriety of the obviousness-type double patenting rejection of record, we summarily affirm this rejection.

Accordingly, the decision of the examiner is affirmed.

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

AFFIRMED

CHUNG K. PAK Administrative Patent Judge	)	
THOMAS A. WALTZ Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
ROMULO H. DELMENDO Administrative Patent Judge	)	

CKP:lp

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Appeal No. 1998-2614
Application No. 08/731,713

APJ PAK

APJ WALTZ

APJ DELMENDO

DECISION: AFFIRMED
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s):

Prepared: July 16, 2002

Draft Final

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OB/HD GAU

PALM / ACTS 2 / BOOK
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