

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BOARD OF PATENT APPEALS  
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte DENNIS E. DECKER

Appeal No. 94-1833  
Application 07/651,860<sup>1</sup>

BRIEF

Before KIMLIN, TURNER and OWENS, Administrative Patent Judges.  
OWENS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the primary examiner's rejection of claims 12 and 14-28, which are all of the claims pending in the application. Claim 23 is illustrative and reads as follows:

23. A laminated board having decorative design debossed into the surface of said board, comprising:

a gypsum material forming a core of said laminated

<sup>1</sup> Application for patent filed February 7, 1991.

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board, the gypsum core having two opposed flat sides;

a paper layer coated on said two opposed flat sides of the core;

a wood veneer laminate bonded to said paper layer on one of said two sides;

decorative designs simultaneously debossed into said wood veneer laminate, through said paper, and into said gypsum core,

wherein said wood laminate comprises a wood veneer bonded to a metal foil, said metal foil preventing wood from cracking or breaking during debossment of said decorative design.

#### THE REFERENCES

Hansen	1,433,077	Oct. 24, 1922
Ericson	1,871,843	Aug. 16, 1932
Burch	3,480,501	Nov. 25, 1969
Veschuroff et al. (Veschuroff)	3,694,298	Sep. 26, 1972
Mitsumata	4,865,912	Sep. 12, 1989

#### THE REJECTION

Claims 12, 14-17 and 22-24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Veschuroff in view of Burch, Ericson and Mitsumata. Claims 18-21 and 25-28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Veschuroff in view of Burch, Ericson, Mitsumata and Hansen.

#### OPINION

We have carefully considered all of the arguments advanced by appellant and the examiner and agree with appellant that the examiner's rejections should not be sustained.

The subject matter on appeal is directed toward a laminated gypsum board having a decorative design debossed into

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its surface. The laminated board has a gypsum core with a paper layer on both sides, and a metal foil-backed wood veneer layer bonded to one or both of the paper layers. The decorative design is debossed into the wood veneer and penetrates into the gypsum core (specification, page 3).

Veschuroff teaches in the discussion of the prior art that it was known in the art to laminate a thin wood veneer to a paper-coated gypsum board (col. 1, lines 55-62). The examiner relies only upon the prior art portion of Veschuroff in his rejections.

Mitsumata discloses a gypsum board covered with a decorative wood veneer laminate having a metal foil layer which prevents warpage of the wood veneer and crack formation in the wood veneer surface (col. 2, lines 17-32 and 54-56; col. 5, lines 31-34).

Burch discloses a method for manufacturing a panel wherein wood having an overlay which can be wood veneer or metal foil is pressed into a mold such that the wood veneer or metal foil forms the upper surface of a shaped, decorative panel (col. 1, lines 36-50; col. 2, lines 13-52).

Ericson discloses pressing grooves into one surface of a paper-covered gypsum board which has been moistened and softened by a method such as exposure to steam, in order to form tile board (page 1, lines 7-9, 29-32, and 57-78).

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The examiner argues that it would have been obvious to one of ordinary skill in the art to apply the Mitsumata wood veneer/metal foil laminate to a paper-covered gypsum board, rather than applying the prior art wood veneer disclosed by Veschuroff, in order to prevent warpage (answer, page 3). We agree.<sup>2</sup>

The examiner argues that "Burch teaches the ability to deboss wood veneers and metal foils that serve decorative purposes on wood board substrates" (answer, page 4). We do not agree that Burch discloses debossing. If a laminate comprised of a wood veneer layer, metal foil layer, paper layer and gypsum board, formed according to the teachings of Veschuroff and Mitsumata, were pressed into a mold according to the teaching of Burch, portions of the wood veneer and metal foil, which initially would be flat as shown in Fig. 3 (numeral 15), would be forced outward as shown in Fig. 4. The surface would not be debossed.

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<sup>2</sup>The examiner's reasoning applies only to the prior art teaching of Veschuroff because the Veschuroff process comprises embossing a decorative paper layer to make it sufficiently porous to water vapor that the decorative paper layer can be applied to an aqueous calcined gypsum slurry prior to drying the slurry to form gypsum wallboard (col. 2, lines 15-20; col. 2, line 59 - col. 3, line 12; col. 4, lines 19-47). Since Mitsumata teaches that the disclosed wood veneer laminate has a metal foil layer which serves to retard diffusion of moisture (col. 4, lines 56-57), one of ordinary skill in the art would not have been motivated to replace the water vapor-porous decorative layer in the Veschuroff process with this laminate.

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The examiner argues that "Ericson teaches the decorative advantage of a debossed surface on gypsum board and the feasibility of debossing gypsum board using a softening agent" (answer, page 4). Ericson does disclose debossing, but the substrate debossed is a paper-covered gypsum board which has no wood veneer and metal foil layers.

Regarding why one of ordinary skill in the art would have combined the teachings of the references to arrive at appellant's claimed invention, the examiner argues that "[i]n view of the desirability and feasibility of debossing wood veneers it would have been obvious to one of ordinary skill to deboss a combined gypsum, veneer, and foil laminate such as that of Veschuroff et al. in view of Mitsumata in order to obtain decorative effect" (answer, page 4).

We do not find this argument to be persuasive because none of the references applied by the examiner discloses or suggests debossing wood veneers or metal foils. Neither the prior art portion of Veschuroff relied upon by the examiner nor Mitsumata mentions debossing. The debossing disclosed in the portion of Veschuroff directed toward the Veschuroff invention pertains to debossing of paper.<sup>3</sup> As discussed above, the Burch

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<sup>3</sup>Appellant argues that Veschuroff discloses embossing, wherein the surface is raised, rather than debossing, wherein depressions are made in the surface (brief, pages 7-8). This argument is not well taken because Veschuroff broadly defines "embossing" as

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method does not involve debossing and Ericson does not mention wood veneers or metal foils.

The examiner also argues, regarding motivation for combining the references, that "showing each piece of the laminate debossed by itself or on another substrate for the same reason of decorative effect and showing motivation to have all of the layers for decorative effect and to prevent warpage provides adequate motivation to make the combination and also shows the required limitations" (answer, page 6).

We are not convinced by this argument because, as discussed above, none of the references applied by the examiner discloses debossing. Further, pointing out that pieces of appellant's invention were present in the art of forming decorative effects does not indicate that one of ordinary skill in the art would have been motivated to make the particular article claimed by appellant. To establish a *prima facie* case of obviousness, it is necessary that the examiner consider the invention as a whole, and point out something in the prior art as a whole which would have suggested to one of ordinary skill in the art the desirability, and thus the obviousness, of making the particular combination claimed by appellant. *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d

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"treating the paper so as to raise and/or lower the normal surface of the paper" (col. 3, lines 52-55).

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1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984); *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). Since Mitsumata, Burch, Veschuroff and Ericson do not disclose or suggest debossing wood veneer or metal foil, these references would not have suggested such a desirability to one of ordinary skill in the art.

All of appellant's claims require that the board have a wood veneer layer bonded to a metal foil and that a decorative design be debossed through the wood veneer and into a gypsum board. Since, for the above reasons, a board having such debossing would not have been fairly suggested to one of ordinary skill in the art by the prior art teachings relied upon by the examiner, we find that the examiner has not established a *prima facie* case of obviousness as to any of appellant's claims.<sup>4</sup>

#### DECISION

The rejection of claims 12, 14-17 and 22-24 under 35 U.S.C. § 103 as being unpatentable over Veschuroff in view of Burch, Ericson and Mitsumata, and the rejection of claims 18-21 and 25-28 under 35 U.S.C. § 103 as being unpatentable over

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<sup>4</sup>Hansen was applied only to some of the dependent claims for its teaching of piercing wood veneer to prevent warping (answer, page 5).

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Veschuroff in view of Burch, Ericson, Mitsumata and Hansen, are  
reversed.

REVERSED

*Edward C. Kimlin*  
EDWARD C. KIMLIN )  
Administrative Patent Judge )  
)

*Vincent D. Turner*  
VINCENT D. TURNER ) BOARD OF PATENT  
Administrative Patent Judge ) APPEALS AND  
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*Terry J. Owens*  
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