

# PRECEDENTIAL OPINION

Pursuant to Board of Patent Appeals and Interferences Standard Operating Procedure 2, the opinion below has been designated a precedential opinion.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MAGNUS QUIST,  
PETER MILLER, and JAN ERICSSON<sup>1</sup>

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Appeal 2008-001183  
Application 10/471,865  
Technology Center 1700

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Decided: June 2, 2010

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Before MICHAEL R. FLEMING, *Chief Administrative Patent Judge*,  
JAMES T. MOORE and ALLEN R. MACDONALD,  
*Vice Chief Administrative Patent Judges*, LINDA E. HORNER,  
CHARLES F. WARREN, JEFFREY T. SMITH, and LINDA M. GAUDETTE,  
*Administrative Patent Judges*.

PER CURIAM

DECISION ON REQUEST FOR REHEARING

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

## I. Procedural Background

A panel consisting of Judges Warren, Smith and Gaudette entered a decision on appeal on April 30, 2008. The panel affirmed a non-final § 103 rejection made by the Examiner.

The Appellants filed a Request for Rehearing pursuant to 37 C.F.R. § 41.52 (2008) on June 30, 2008. The Request included a request for an expanded panel to reconsider the appeal. In view of issues raised in the rehearing request, an expanded panel has been designated to decide the request for rehearing.

## II. Principles of Law

### A. Rehearing Requests

Requests for rehearing must comply with 37 C.F.R. § 41.52(a)(1), and “must state with particularity the points believed to have been misapprehended or overlooked by the Board.” Moreover, requests must specifically recite “the points of law or fact which appellant feels were overlooked or misapprehended by the Board.” (MPEP § 1214.03.) Arguments raised by Appellants for the first time in a Request for Reconsideration are waived if the arguments were required to have been made in the Briefs, unless good cause is shown. *Cf. Hyatt v. Dudas*, 551 F.3d 1307, 1313-14 (Fed. Cir. 2008).

### B. Standard of Review

The examiner has an initial burden to set forth the basis for a rejection, so as to put a patent applicant on notice of the reasons why the applicant is not entitled to a patent on the claim scope sought. This “prima facie case” is a procedural mechanism that shifts the burden of going forward to the applicant, who must then produce argument, with or without evidence, rebutting the initial case of

unpatentability. The applicant's rebuttal evidence may relate to any of the *Graham*<sup>2</sup> factors including the so-called secondary considerations. "The examiner then determines patentability 'on the totality of the record, by a preponderance of the evidence with due consideration to the persuasiveness of argument.'" *Ex Parte Frye*, Appeal 2009-006013, 2010 WL 889747 \*3-4 (BPAI Feb. 26, 2010) (Precedential).

An appellant may attempt to overcome an examiner's obviousness rejection on appeal to the Board by submitting arguments and/or evidence to show that the examiner made an error in either (1) an underlying finding of fact upon which the final conclusion of obviousness was based, or (2) the reasoning used to reach the legal conclusion of obviousness. Similarly, the appellant may also submit evidence of secondary considerations of nonobviousness. The panel then reviews the obviousness rejection for error based upon the issues identified by appellant, and the particular findings and conclusions in light of the arguments and evidence presented. *See id.*

### III. Issues Raised

A. The issues presented on rehearing are:

(1) Did the Board misapprehend the subject matter sought to be patented?

(2) Did the Board misconstrue the evidence submitted in the declaration

found in the Evidence Appendix?

and

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<sup>2</sup> *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

(3) Did the panel properly evaluate the evidence supporting the prima facie case with any rebuttal argument and/or evidence in reaching the final conclusion of obviousness and affirming the obviousness rejection? (Req. for Reh'g 2.)

#### IV. Discussion

##### A. *Arguments Raised Concerning the Claimed Invention and the Prior Art*

##### Additional Findings of Fact

FF 1. Claim 1 reads as follows:

1. A process for the manufacturing of decorative boards with an abrasion resistant surface and edges with joining functionality, the process comprising the steps:

a) in a first step, cutting a carrier board having an upper surface to the desired dimension and making edges with at least one joining element, thereafter

b) applying radiation curable dry acrylic lacquer powder to the upper surface of the board,

c) heating the acrylic lacquer so that it melts,

d) curing the acrylic lacquer by means of radiation, the radiation being selected from the group consisting of UV-radiation and electron beam radiation.

FF 2. Claim 1 recites the transitional term “comprising.”

FF 3. Claim 1 recites a first step of cutting a “carrier board.”

FF 4. The term “carrier board” is not defined in the claim.

FF 5. The term “carrier board” is not defined in the Specification.

FF 6. The term “carrier board” is not defined as including only uncoated wood.

FF 7. Any board, including a coated board, can be a “carrier board.”

Arguments Raised

The Appellants argue that “[t]he Board misapprehended the subject matter sought to be patented vis-à-vis the teachings of the prior art.” (Req. for Reh’g at 8:12-13.)

The Appellants urge that the Board did not distinguish between the various claimed steps, specifically, “cutting a carrier board having an upper surface to the desired dimension”; “making edges with at least one joining element”; and “thereafter,” “applying radiation curable dry acrylic lacquer powder” (claim 1, steps a) and b)). (Req. for Reh’g at 4, 8.)

The Appellants further argue that “[w]hat the claimed process has, as an advantage over all the applied prior art, is that the coating material, and hence the costs of material, is not needlessly wasted, by subsequently milling it away to form the joining elements.” (Req. for Reh’g at 8:18-20.)

Issue

Did the Board misapprehend the subject matter of the claim?

Discussion

First, we observe that the Appellants make a new argument on rehearing concerning the advantages of the claimed process. The Appellants have not pointed out where the argument above concerning the asserted advantage was made in the Appeal Brief or the Reply Brief, and we have not found the argument in our review of the record. Accordingly, the Board could not have overlooked or misapprehended an argument which was not before it. As such, the argument relating to the advantage of the process is improper and untimely when made for the first time in a request for reconsideration. *See Hyatt*, 551 F.3d at 1313-14.

Second, the argument is without persuasive effect. The Appellants seek a broad process claim. The Board's initial decision noted that the claims encompass a process where the carrier board may already have a coating on its upper surface at the time it is milled. When the carrier board of claim 1 step a) is a pre-finished board, the claimed process offers no advantage as described.

We observe that the previous panel's claim construction in this regard is not unreasonable. The claim is written in open-ended "comprising" language and recites, generally speaking, two complete steps – cutting a board to form a joining element, and then coating the board in a particular way. The claim does not exclude other coating or processing steps at any point in the process or restrict the starting material to uncoated wood. In sum, we agree with the initial panel that the claim as written includes the cited prior art combination of Moriau and Biller.

The Appellants have not persuaded us by this first argument that the initial panel overlooked or misapprehended the scope of the claim.

### *B. The Applied References*

#### Arguments Raised

The Appellants urge that the Board interpreted the references incorrectly and at odds with the interpretation of the Examiner. (Req. for Reh'g 4-6.) They argue that the references, especially Biller, do not solve the problem of the disadvantageous process of removing costly coating material from a coated product in order to later form a joining functionality. (Req. for Reh'g 6.)

#### Issue

Did the panel err in its findings as to the prior art and the differences between the claimed subject matter and the prior art?

Discussion

As noted above, the Appellants' arguments focus on their narrow reading of the claims as excluding a milling step which would remove a finish or coating from a pre-finished piece being processed. Although the combination of Biller and Moriau teaches a step of removing finish, Appellants' argument is unpersuasive because claim 1 does not exclude removal of finish. Moreover, the argument regarding wasted coating material is again made by the Appellants for the first time in the Request for Rehearing, which is untimely.

The Appellants interpret claim 1 as requiring raw or unfinished wood, but no such limitation is present. Consequently, the instant claims cover processes which do not cure the disadvantageous process.

*C. The Eriksson Declaration*

Argument Raised

The Appellants urge that the initial panel decision also misconstrued the evidence submitted in the Eriksson declaration. (Req. for Reh'g 6-7.)

Issue

Did the panel misconstrue the Eriksson declaration?

Discussion

The declaration must have a sufficient nexus to the claimed subject matter to be given substantial weight.

“All evidence bearing on the issue of obviousness, as with any other issue raised in the conduct of the judicial process, must be considered and evaluated before the required legal conclusion is reached.” *Simmons Fastener Corp. v. Illinois Tool Works, Inc.*, 739 F.2d 1573, 1575 (Fed. Cir. 1984). However, “[a]

nexus between the merits of the claimed invention and evidence of secondary considerations is required in order for the evidence to be given substantial weight in an obviousness decision.” *Id.*

Put another way, commercial success or other secondary considerations may presumptively be attributed to the patented invention only where “the marketed product embodies the claimed features, and is coextensive with them.”

*Muniauction, Inc. v. Thomson Corp.*, 532 F.3d 1318, 1328 (Fed. Cir. 2008) (citing *Ormco Corp. v. Align Tech., Inc.*, 463 F.3d 1299, 1311-12 (Fed. Cir. 2006) and quoting *Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.*, 229 F.3d 1120, 1130 (Fed. Cir. 2000)).

In the declaration, Declarant Eriksson attests, in pertinent part:

6. No commercial laminate flooring manufacturer, today or at any time, has manufactured laminate flooring elements by forming joining elements on boards *prior* to applying coatings.

7. Thus, it is neither “recognized” nor “conventional” to form joining elements on laminate floor board *prior* to applying coatings.

Upon our expanded panel consideration, we conclude that these statements, and the broad conclusions reached, are not coextensive with the elements of the claim as written. In other words, the evidence is not entitled to substantial weight because the Appellants have not established a sufficient nexus between the merits of the claimed invention and the objective evidence of nonobviousness, i.e. Declarant Eriksson’s statements. As noted above, the claim, construed reasonably broadly, does not exclude forming joining elements on boards either after applying coatings or before applying coatings.

The testimony of Declarant Eriksson is therefore not particularly probative of nonobviousness of the claimed subject matter as a whole.

Reweighting the evidence as a whole, and taking into account that the evidence of nonobviousness is not given substantial weight, we conclude that a preponderance of the evidence of record supports the Examiner's conclusion that one of ordinary skill in this art would have found in Moriau the suggestion to apply a decorative layer to the board, then mill the board to form the joining elements, and thereafter coat the formed board and joining elements with a protective top lacquer layer using Biller's process for applying a radiation curable dry acrylic lacquer powder. (Dec. 6-7 and 8-9.)

*D. Reviewing Evidence Relevant to Obviousness*

Arguments Raised

Appellants submit that the prior panel "utilized an improper legal standard in considering whether to affirm the Examiner" because the panel did not reach the final determination of patentability under 35 U.S.C. § 103(a) based on the entire record by a preponderance of the evidence by weighing "evidence supporting patentability . . . against evidence supporting [the] *prima facie* case." (Req. for Reh'g 2-3.) Appellants specifically identify two statements in the Decision for their contention:

- (1) The issues in this appeal are whether the Examiner has carried the burden of establishing a *prima facie* case of obviousness in the grounds of rejection advanced on appeal.
- (2) Upon further reconsideration of the record as a whole in light of Appellants' contentions, we are of the opinion that Appellants have not successfully rebutted the *prima facie* case based on the combined teachings of Moriau, Biller, and Iverson.

(Req. for Reh'g at 2-3.)

Appellants argue that these statements hold the “Appellants to an improper standard which is neither supported by the courts, nor by the PTO’s own instruction manual to the examining core [*sic*] (MPEP). While Appellants do not clearly specify the “improper standard” applied by the panel, their argument appears to be that the panel improperly weighed the rebuttal arguments/evidence for its ability to “knock down” the *prima facie* case, instead of considering the record as a whole. (Req. for Reh’g 3, quoting MPEP §716.01(d)).

Issue

Did the panel properly evaluate the evidence supporting the *prima facie* case with any rebuttal argument and/or evidence in reaching the final conclusion of obviousness and affirming the obviousness rejection?

Discussion

The recently published precedential *Frye* decision specifically describes the role of the Board as that of “[reviewing] the obviousness rejection for error based upon the issues identified by appellant, and in light of the arguments and evidence thereon.” (Slip. Op. 9.) “Specifically, the Board reviews the particular finding(s) contested by an appellant anew in light of all the evidence and argument on that issue.” (*Id.* at 10.)

Secondary considerations, including objective evidence relevant to the issue of obviousness, must be considered by the Examiner. *Graham* at 17-18. The *Graham* factors (determining the scope and content of the prior art, ascertaining the differences between the prior art and the claims at issue, and resolving the level of ordinary skill), including secondary considerations when present, are the controlling inquiries in any obviousness analysis. *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 406-7 (2007). “[P]atentability is determined on the totality of the

record, by a preponderance of evidence with due consideration to persuasiveness of argument.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

On Board review, if the appellant raises the issue as to whether the examiner’s conclusion of obviousness was in error, based in part on the proffered evidence of secondary considerations, the panel must consider if the examiner erred in determining patentability, based upon the totality of the record. In such instances, the Board panel must consider anew all the relevant evidence of obviousness, both for and against, in view of the argument on the issue. One such instance requiring a reweighing is seen in the present appeal – if the Appellants argue that the Examiner erred in determining that the weight of the evidence supports a conclusion of obviousness, the Board must review that conclusion of obviousness anew to see if the preponderance of relevant evidence properly before the Office supports that conclusion.

Measured against this background, Appellants’ allegation that the panel applied an improper standard fails. The panel addressed arguments reasonably raised by Appellant on the obviousness rejection, and, as applicable, evidence relied thereon. The panel Decision’s analysis of these issues reflects application of the correct standard and procedure, as recently reiterated in *Frye* and summarized above.

For example, a review of the full analysis underlying the second statement relied upon by Appellants for the allegedly incorrect standard - the Board’s observation “Appellants have not successfully rebutted the prima facie case based on the combined teachings of Moriau, Biller, and Iverson” - demonstrates that the panel properly weighed the relevant arguments for and against the obviousness of claim 5. Regarding claim 5, Appellants argued 1) that the Iverson reference taught

away from the claimed invention, that one of ordinary skill in this art would not have been led to this claimed invention by the teachings of Moriau and Iverson, and 2) that the combination of references would not have suggested the claimed invention reflected in claim 5. (Dec. 10-11(citing App. Br. 5)).

The panel considered evidence demonstrating obviousness (Dec. 10) in conjunction with these countervailing arguments (Dec. 11), ultimately concluding that the obviousness rejection should be affirmed based upon the “record as a whole”: “**Upon further reconsideration of the record as a whole in light of Appellants’ contentions**, we are of the opinion that Appellants have not successfully rebutted the prima facie case based on the combined teachings of Moriau, Biller, and Iverson.” (Dec. at 11; emphasis added); see Frye, 2010 WL 889747, at \*4 (“[T]he Board reviews the particular finding(s) contested by an appellant anew in light of all the evidence and argument on that issue.”).

The panel’s analysis of Appellants’ Eriksson declaration further demonstrates application of the proper standard. Appellants offered that evidence to establish that no commercial manufacturer formed, and that it was neither “recognized” nor “conventional” to form, joining elements on laminate floor board prior to applying coatings. (Decl., ¶¶ 4, 6, and 7). The panel weighed the evidence in the Eriksson Declaration as presented by the Appellants’ briefing arguments, in conjunction with contrary evidence in the record, including Moriau. Based “[o]n this record,” the panel gave the declaration very little weight. (Dec. 9).

Ultimately, the panel made eminently clear that it had utilized the correct procedure in its summation of the patentability of Appellants’ claims:

Accordingly, based on our consideration of the totality of the record before us, **we have weighed the evidence of obviousness** found in the combined teachings of Moriau and Biller alone and as further

combined with each of Buckley, Iverson, Chen, Duffy, Krebsbach, and Mårtensson **with Appellants' countervailing evidence of and argument for nonobviousness** and conclude that the claimed invention encompassed by appealed claims 1 through 28 and 30 through 34 would have been obvious as a matter of law under 35 U.S.C. § 103(a).

(Dec. 13; emphasis added.) Appellants' allegations that a different and improper procedure was applied, based upon piecing together isolated sound-bites from the Decision, are not evidence to the contrary. *See Black v. Cutter Labs.*, 351 U.S. 292, 297 (1956) ("This Court, however reviews judgments, not statements in opinions."); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1540 (Fed. Cir. 1983) ("We sit to review judgments, not opinions.").

Accordingly, we conclude that the panel utilized the proper standard in its ultimate conclusion of patentability of the claimed invention encompassed by the appealed claims.

We have granted Appellants' request to the extent that we have reconsidered our decision entered April 30, 2008, but we deny the request with respect to making any changes therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(v)(2009).

DENIED

WARREN, *Administrative Patent Judge*, Concurring:

I concur with the decision of the majority of this panel to grant Appellants' request to the extent of reconsidering the decision of the original merits panel and to deny the request with respect to making any changes therein. I do so for the following reasons.

Appellants principally contend that the original panel (I) "misconstrued the evidence submitted in the declaration found in the Evidence Appendix based on the Examiner's newly minted arguments in the Examiner's Answer," and (II) "utilized an improper legal standard in considering whether to affirm the Examiner." Req. 2.<sup>3</sup>

I.

Appellants submit that the original panel did not consider the evidence in the Eriksson Declaration on the basis of the Examiner's position in the Office Action mailed January 27, 2006 (Office Action), to which the evidence in the Eriksson Declaration is addressed, because of the Examiner's different position in the Answer. Req. 4 and 7-8. Appellants point out that the Examiner stated, with respect to Moriau, that "one of ordinary skill would have reasonably gleaned that the board panel is shaped PRIOR to coating, a first step followed by treating, coating, and curing the upper

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<sup>3</sup> Appellants also submit that the original panel "misapprehended the subject matter sought to be patented vis-a-vis [sic] the teachings of the prior art." Req. 2. Appellants' contentions with respect to the advantages of the claimed process over the applied prior art, and that the claimed process does not involve coating milled joining elements or the wood product as a whole, were not submitted in the Briefs and thus are deemed waived. Req. 8-10. 37 C.F.R. § 41.52(a)(1) (2006).

surface of the floor panel.” Req. 7-8, citing Office Action 6:14-16. Appellants argue that in the appealed claims, “the coating claimed is not for the joining elements, but for the ‘upper surface of the board,” and “Declaration Ericsson’s [sic] evidence is to this exact point.” Req. 7, citing Eriksson Decl. ¶ 2. Appellants contend that in the Answer, the Examiner “successfully [misled] the Board in the Examiner’s Answer” with respect to Declarant Eriksson’s intention, arguing “the [Office Action] has nothing to do with ‘coating joining elements.’” Req. 7, citing Office Action 14:1-3. I note here that in the Office Action, the Examiner stated that “[w]hat is significant is they claim no one else had made laminate flooring by forming joining elements prior to applying coatings because Moriau in 1997 clearly formed tongue and groove coupling parts which are then coated (figure 22 and col. ,13, [sic] 15-25.), i.e. forming followed by coating. Hence the Declaration is not persuasive.” Office Action 13:20 to 14:3.

Thus, Appellants argue that the original panel was misled by the Examiner’s different position in the Answer and thus made the “assertion that the Ericsson [sic] evidence is limited to ‘coating the joining elements’,” which is “contrary to Moriau” and “taken out of context with the statements of the Examiner in the [Office Action] to which [the Eriksson evidence] was addressed.” Req. 8.

Appellants further submit, in these respects, that the original panel misconstrued the claimed invention encompassed by claim 1, thus misapplying the combined teachings of Moriau and Biller. Req. 4-8. Appellants also argue that the Eriksson Declaration contains “uncontroverted evidence [that] carries the burden of preponderance of the evidence that no one has done, indeed, no one has even recognized the need to do, what Appellants have done.” Req. 7.

In my view, contrary to Appellants' arguments, the original panel properly interpreted claim 1, properly applied the teachings of Moriau and Biller thereto, and properly considered the evidence in the Eriksson Declaration. Indeed, the original panel interpreted claim 1 as specifying a process for manufacturing decorative boards that requires the step of milling a carrier board, which includes both cutting the board and making edges with at least one joining element in the board, before the steps of applying a radiation curable dry acrylic lacquer powder coating to an upper surface of the board. Original Dec. 3-4. The original panel also recognized that, as claimed, the carrier board can have a decorative coating on its upper surface when it is milled by cutting and forming the joining element on an edge, and that the subsequent acrylic lacquer coating steps can top coat the decorative upper surface of the board as well as coat the joining element(s) on the edges of the board. Original Dec. 4. Appellants do not argue that the disclosure in the Specification requires a different interpretation of claim 1. *See, e.g., In re Suitco Surface, Inc.*, 2010 WL 1462294, at \*3 (Fed. Cir. 2010) ("During reexamination, as with original examination, the PTO must give claims their broadest reasonable construction consistent with the specification.") (quoting *In re ICON Health & Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (citing *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004))).

The original panel considered the teachings of Moriau and Biller with respect to the claimed process encompassed by claim 1 as so interpreted. I find no inconsistency between the Examiner's factual findings in the Answer considered by the original panel and the limitations of claim 1. Original Dec. 6-7. Contrary to Appellants' contentions, the Examiner's consideration of Moriau was not limited to the statement at page 6 of the Answer quoted by Appellants at page 5

of the Request, wherein the Examiner recognized that the specific disclosure at column 9, lines 10-28, of Moriau “appears” to teach a process in which a board, with the decorative layer directed downward, was milled to form joining functionality. Req. 5. *See* Original Dec. 4-5. Indeed, the Examiner recognized that Moriau teaches a floor panel that can have a protective transparent resinous top layer, such as melamine resin, over a decorative layer as well as a coating, such as a lacquer or resins, on the joining functionality. Ans. 4; *see* Original Dec. 4-5 and 6-7. On this basis, the Examiner found that one of ordinary skill in this art would have made this inference:

It is noted top surfaces are coated with decorative, protective and intermediate layers 55-57. Col. 9, 5 teaches a “protective **top** layer” (emphasis added); edges and joining elements are not so coated. Therefore, one of ordinary skill would have reasonably gleaned that the board panel is shaped PRIOR to coating, a first step followed by treating, coating, and curing the upper surface of the floor panel.

Ans. 12 (emphasis original). The Examiner further found that “Moriau in 1997 clearly formed tongue and groove coupling parts which are then coated (figure 22 and col., 13, 15-25.), i.e. forming followed by coating.” Ans. 13-14.

Appellants did not dispute these findings and inferences by the Examiner in the Reply Brief. *See generally* Reply Br. Appellants also did not argue that Biller’s methods of applying a top coating to wood products “still require[s] removing portions of the coated surface previously coated by Biller in order to form the joining functionality” in the Briefs. Req. 6; *see* App. Br., e.g., 3, 4, and 5; *see* Reply Br., e.g., 4. Thus, Appellants’ arguments in the Request in these two respects are also deemed waived. 37 C.F.R. § 41.52(a)(1) (2006). I note that Appellants do not submit specific arguments with respect to Iverson and Chen. Req. 6.

The difficulty I have with Appellants' position is that the portion of Moriau asserted by Appellants as controlling sets forth a process in which the board to be milled has a decorative layer on its upper surface, and claim 1 encompasses processes in which the carrier board can have a decorative layer applied to its upper surface before milling. Thus, as the Examiner pointed out, one of ordinary skill in this art would have found in the combined teachings of Moriau and Biller the suggestion to apply a protective top coat layer to the decorative layer on the upper surface of the board as well as the joining functionality on the edges of the board using Biller's process for applying a radiation curable dry acrylic lacquer powder as the top coat layer. *See* Original Dec. 6-7 and 8-9.

I have reconsidered the Eriksson Declaration along with claim 1 as interpreted and the facts in Moriau in light of Appellants' arguments in the Request. Appellants submitted the Eriksson Declaration as "evidence that no one has done, indeed, no one has even recognized the need to do, what Appellants have done." Req. 7. Appellants argue that the evidence in the Eriksson Declaration is "factual, not opinion," pointing out the original panel accorded "little, if any, weight" to the factual evidence, and that "[e]ven opinion evidence is entitled to some weight." Req. 7. Appellants further argue that the Eriksson Declaration was submitted in response to the Examiner's position in an Office Action that forming joining elements prior to coating a board would have been "conventional" to one of ordinary skill in the art. Req. 7-8, citing Eriksson Decl. ¶ 2.<sup>4</sup> Appellants argue the

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<sup>4</sup> 2. I am aware of the statement made in the Office Action of January 27, 2006 that "one of ordinary skill would have formed the joining elements prior to applying the coating because the level of ordinary skill is such that such a step would have been recognized to be conventional."

original panel misconstrued the evidence in the Eriksson Declaration with respect to the “coating on the board,” pointing out that “the coating claimed is not for the joining elements, but for the ‘upper surface of the board.’” Req. 7.

I am not persuaded by Appellants’ position that the original panel was misled by the Examiner’s different position in the Answer to make the “assertion that the Eriksson evidence is limited to ‘coating the joining elements.’” Req. 8.

The original panel considered the evidence in the Eriksson Declaration in light of Appellants’ arguments in the Briefs that it is not “‘common sense or ‘common knowledge to do what no commercial manufacturer has done.’” Original Dec. 9. *See, e.g., In re Hedges*, 783 F.2d 1038, 1041 (Fed. Cir. 1986) (quoting *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1552 (Fed. Cir. 1983) (proceeding “contrary to the accepted wisdom . . . is ‘strong evidence of unobviousness.’”). The original panel found the testimonial evidence in the Eriksson Declaration to be entitled to little, if any, weight for several reasons. First, Declarant Eriksson’s opinion in paragraph 6 that “[n]o commercial laminate flooring manufacturer” ever formed “joining elements on boards *prior* to applying coatings,” is unsupported by testimonial or documentary evidence. Original Dec. 10. Second, Declarant Eriksson’s description of the commercial process lacked specificity with respect to “applying coatings” on a board. Original Dec. 10; Eriksson Decl. ¶ 6. Third, with respect to “applying coatings,” as the Examiner pointed out, Moriau established that at least coating joining elements with a lacquer after formation on a board having a decorative coating was known in the art. Original Dec. 10.

Thus, the original panel found that the evidence in the Eriksson Declaration does not establish that the claimed process is contrary to the “conventional”

wisdom with respect to *every* commercial manufacturing process. The original panel further found Declarant Eriksson's description of every commercial manufacturing process practiced in the laminate flooring industry inadequate with respect to "applying coatings," particularly in light of the teachings of Moriau. Indeed, contrary to Appellants' position, the record does not support interpreting "applying coatings" as the absence of any "coating" prior to milling. This is because claim 1, as interpreted, does not exclude a "coating" on the board prior to milling, and Moriau would have established as much.

Accordingly, in my view, and contrary to Appellants' position, the original panel weighed the evidence in the Eriksson Declaration in light of the testimony therein, Appellants' arguments in the Briefs, and the prior art, without being led in a particular direction with respect thereto by the Examiner's position in the Answer. *See, e.g., Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d at 1368 ("[T]he Board is entitled to weigh the declarations and conclude that the lack of factual corroboration warrants discounting the opinions expressed in the declarations.") (citations omitted); *In re Etter*, 756 F.2d 852, 859-60 (Fed. Cir. 1985) (en banc) (opinion affidavit asserting the reference disclosed obsolete technology was correctly characterized by the board "as merely representing opinion[] unsupported by facts and thus entitled to little or no weight.") (citing *In re Piasecki*, 745 F.2d 1468, 1472-73 (Fed. Cir. 1984); *In re Rinehart*, 531 F.2d 1048, 1052 (CCPA 1976)).

Further, in my view, the issues raised by the Eriksson Declaration and considered by the original panel did not include whether "nexus" issues are raised by Declarant Eriksson's inadequate description of the commercial manufacturing processes practiced in the laminate flooring industry vis-à-vis the claimed process

encompassed by claim 1. *See generally* Original Dec., Ans., Briefs, and Req. *See* majority opinion at p. 7-9. Indeed, the evidence in the Eriksson Declaration is not directed to a showing of commercial success or other secondary consideration of a marketed invention falling within appealed claim 1, requiring that the weight accorded the evidence depends on the extent to which the features of the claimed invention effected the commercial success or other secondary consideration. *Cf., e.g., Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 669 (Fed. Cir. 2000) (quoting *In re Hedges*, 783 F.2d at 1041) (“nexus” established by evidence of commercial success of claimed method, and “expressed skepticism” of claimed method was evidence of “proceeding contrary to the accepted wisdom.”).

## II.

Appellants submit that the original panel “utilized an improper legal standard in considering whether to affirm the Examiner” because that panel did not reach the final determination of patentability under 35 U.S.C.

§ 103(a) based on the entire record by a preponderance of the evidence by weighing “evidence supporting patentability . . . against evidence supporting [sic] *prima facie* case.” Req. 2-3, quoting a portion of MPEP § 716.01(d), *Weighing Objective Evidence* (8th ed., Rev. 6, Sept. 2007). In this respect, Appellants quote these two statements in the Decision. Req. 2.

The issues in this appeal are whether the Examiner has carried the burden of establishing a *prima facie* case of obviousness in the grounds of rejection advanced on appeal.

Original Dec. 3.

Upon further reconsideration of the record as a whole in light of Appellants’ contentions, we are of the opinion that Appellants have not successfully rebutted the *prima facie* case based on the combined teachings of Moriau, Biller, and Iverson.

Original Dec. 11.

Appellants emphasize the word “successfully” in the second statement and argue that the same “holds Appellants to an improper standard which is neither supported by the courts, nor by the PTO’s own instruction manual to the examining core [sic] (MPEP),” and thus, “the Boards’ [sic] approach in affirming the rejection of the Examiner is legally flawed and cannot withstand scrutiny and thus the decision should be vacated on this point alone.” Req. 3.

Appellants’ contention thus raises the issues of whether the original panel held Appellants to an improper legal standard, and whether that panel’s ultimate determination of patentability was based on consideration of the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. Req. 2-3 (citing MPEP § 716.01(d) which cites to, among other things, *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992)). In other words, Appellants contend that the original panel erred by evaluating Appellants’ rebuttal evidence for its ability to “knock down” the Examiner’s prima facie case, rather than evaluating each piece of rebuttal evidence along with the facts upon which the conclusion of a prima facie case was based to reach the determination of obviousness. Req. 3 (citing MPEP § 716.01(d) which cites to, among other things, *In re Piasecki*, 745 F.2d 1468 (Fed. Cir. 1984)).

Appellants do not explain why the statements cited from pages 3 and 11 of the Original Decision support their position. Apparently, it was the use of the phrase “prima facie case of obviousness” in both statements and the further use of the term “sufficiently” in the second statement. However, the original panel’s use of this language in the context of each of the two statements relied upon by Appellants is not improper. This is because the statements reflect language used

by our reviewing court and its predecessor court, and the original panel made the ultimate determination of patentability on the entire record. Original Dec. 13. *See, e.g., Muniauction, Inc. v. Thomson Corp.*, 532 F.3d 1318, 1327 (Fed. Cir. 2008) (“[W]e turn to Muniauction’s attempt to rebut this prima facie case with secondary considerations of nonobviousness.”); *In re Sullivan*, 498 F.3d 1345, 1353 (Fed. Cir. 2007) (“The claimed composition cannot be held to have been obvious if competent evidence rebuts the prima facie case of obviousness.”); *In re Kahn*, 441 F.3d 977, 985-86 (“On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 2006)); *In re Oetiker*, 977 F.2d at 1445 (“An observation by the Board that the examiner made a *prima facie* case is not improper, as long as the ultimate determination of patentability is made on the entire record.”) (citing *In re Piasecki*, 745 F.2d at 1472; *In re Rinehart*, 531 F.2d at 1052).

Appellants also do not point to particular portions of the Original Decision in support of their position with respect to the statements cited from pages 3 and 11 of the Original Decision. The record is clear that the original panel made the first statement with respect to all grounds of rejection on appeal, and made the second statement in considering the ground of rejection of claim 5, dependent on independent claim 1, over the combined teachings of Moriau, Biller, and Iverson. Original Dec. 3 and 10-11. With respect to claim 5, the Examiner’s evidence supporting the conclusion that the claimed invention would have been prima facie obvious was first considered, and then the record as a whole was reconsidered in light of Appellants’ two contentions in the Brief. Original Dec. 10-11; App. Br. 5.

The original panel disagreed with Appellants' arguments that Iverson contained disclosure which would have taught away from the claimed invention encompassed by claim 5, and that one of ordinary skill in this art would not have been led to this claimed invention by the teachings of Moriau and Iverson. Original Dec. 11.

The original panel recognized that consideration of the claimed invention encompassed by dependent claim 5 includes consideration of Appellants' contentions submitted in the Briefs with respect to the ground of rejection of independent claim 1 over the combined teachings of Moriau and Biller alone, including the evidence presented in the Eriksson Declaration. The Examiner's evidence supporting the conclusion the claimed invention encompassed by claim 1 would have been prima facie obvious was also considered. Original Dec. 6-8. Upon reconsideration of the record as a whole in light of Appellants' contentions in the Briefs, the original panel disagreed with Appellants that the combination of references would not have suggested the claimed invention encompassed by claim 1 to one of ordinary skill in the art. Original Dec. 8-9; App. Br. 3; Reply Br. 3-4. The original panel considered the evidence in the Eriksson Declaration in light of Appellants' arguments in the Briefs in the manner discussed above, prefacing consideration of Appellants' contentions and evidence with respect to claim 1 on page 8 of the Original Decision with essentially the same language Appellants criticize with respect to consideration of claim 5 on page 11 of that Decision.

The original panel then reached a final determination with respect to the patentability of the claimed invention encompassed by the appealed claims vis-à-vis the applied prior art by consideration of the totality of the record in the manner reflected in the statement:

Accordingly, based on our consideration of the totality of the record before us, we have weighed the evidence of obviousness found in the

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combined teachings of Moriau and Biller alone and as further combined with each of Buckley, Iverson, Chen, Duffy, Krebsbach, and Mårtensson with Appellants' countervailing evidence of and argument for nonobviousness and conclude that the claimed invention encompassed by appealed claims 1 through 28 and 30 through 34 would have been obvious as a matter of law under 35 U.S.C. § 103(a).

Original Dec. 13.

Indeed, Appellants do not acknowledge and contest the original panel's statement at page 13 of the Original Decision. *See* Req. 2-3.

Accordingly, in my view, the record does not establish that the original panel held Appellants to an improper legal standard, and indeed, ultimately determined the patentability of the claimed invention encompassed by the appealed claims based on consideration of the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence.

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