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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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**CENTRAL REEXAMINATION UNIT**

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/009,533.

PATENT NO. 6,895,881.

ART UNIT 3993.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,533	08/26/2009	6895881		4731

23717            7590            01/29/2010

LAW OFFICES OF BRIAN S STEINBERGER  
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COCOA, FL 32922

EXAMINER

ART UNIT            PAPER NUMBER

DATE MAILED: 01/29/2010

Please find below and/or attached an Office communication concerning this application or proceeding.



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<b>Office Action in Ex Parte Reexamination</b>	<b>Control No.</b> 90/009,533	<b>Patent Under Reexamination</b> 6,895,881	
	<b>Examiner</b> PETER C. ENGLISH	<b>Art Unit</b> 3993	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

- a  Responsive to the communication(s) filed on \_\_\_\_\_.      b  This action is made FINAL.  
c  A statement under 37 CFR 1.530 has not been received from the patent owner.

A shortened statutory period for response to this action is set to expire 2 month(s) from the mailing date of this letter. Failure to respond within the period for response will result in termination of the proceeding and issuance of an *ex parte* reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).** If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

- |  |   |
|--|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 3. <input type="checkbox"/> Interview Summary, PTO-474. |
| 2. <input type="checkbox"/> Information Disclosure Statement, PTO/SB/08.     | 4. <input type="checkbox"/> _____.                      |

**Part II SUMMARY OF ACTION**

- 1a.  Claims 1 are subject to reexamination.  
1b.  Claims \_\_\_\_\_ are not subject to reexamination.  
2.  Claims \_\_\_\_\_ have been canceled in the present reexamination proceeding.  
3.  Claims \_\_\_\_\_ are patentable and/or confirmed.  
4.  Claims 1 are rejected.  
5.  Claims \_\_\_\_\_ are objected to.  
6.  The drawings, filed on \_\_\_\_\_ are acceptable.  
7.  The proposed drawing correction, filed on \_\_\_\_\_ has been (7a)  approved (7b)  disapproved.  
8.  Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).  
    a)  All    b)  Some\*    c)  None      of the certified copies have  
    1  been received.  
    2  not been received.  
    3  been filed in Application No. 10/018,316.  
    4  been filed in reexamination Control No. \_\_\_\_\_.  
    5  been received by the International Bureau in PCT application No. \_\_\_\_\_.  
\* See the attached detailed Office action for a list of the certified copies not received.  
9.  Since the proceeding appears to be in condition for issuance of an *ex parte* reexamination certificate except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte* Quayle, 1935 C.D. 11, 453 O.G. 213.  
10.  Other: \_\_\_\_\_

cc: Requester (if third party requester)

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Kemerer et al. (US 4,290,248).

Kemerer et al. discloses a process and apparatus for producing large area thermoplastic sheet/panel products having three-dimensional patterns and surface textures (see column 1, lines 14-32; column 5, lines 50-68). The large area sheet/panel products are economically and rapidly produced so as to be widely available to consumers at a competitive cost (see column 5, lines 56-59), and possess desirable durability, low cost maintenance, weight savings, and attractive appearance (see column 6, lines 1-8). As shown in Fig. 1A, a heated ribbon of thermoplastic 30 is produced by an extruder 20, and then shaped by mold belts 36, 38 to provide the desired three-dimensional patterns and surface textures (see column 11, line 62 to column 12, line 19). At a treatment station 54 (see Fig. 1B), various other operations may be performed such as trimming, shaping, forming tongues and grooves, and painting (see column 18, lines 29-32).

A variety of thermoplastic polymeric materials, including polystyrene, polyvinyl chloride, polyethylene, polyurethane and acrylonitrilebutadiene-styrene copolymers, may be used to produce the thermoplastic sheet/panel products (see column 14, lines 43-57). These thermoplastic polymeric materials inherently possess a certain degree of flexibility and therefore are capable of being laid in curved formations, as broadly claimed. The third party requester has provided the Affidavit of Adel F. Halasa, PhD to establish the facts that (1) at least one of the thermoplastic materials disclosed in Kemerer et al. are inherently flexible at room temperature, (2) the flexibility of the thermoplastic material used by Kemerer et al. results in a panel product that is inherently capable of being laid in curved formations, and (3) the longitudinal slots formed in the bottom surface of the product, as shown in Fig. 18 of Kemerer et al., inherently

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facilitate the formation of curved coverings and would inherently act as a base for adhesive. The examiner agrees with these assertions made by Dr. Halasa.

A flexible surface ply 136 or backing sheet 140 may be laminated onto the thermoplastic ribbon 30 (see column 17, lines 1-17). As shown in Fig. 18, the thermoplastic ribbon 30a may be formed with a three-dimensional pattern and surface texture simulating a brick and mortar construction. In this embodiment, the mold belt 36 has a three-dimensional pattern 120 including ridges 304 and a rough surface texture 306 which form a first pattern of slots 302 and a brick-like texture on the top/exposed surface of the ribbon 30a (see column 25, lines 44-65). Further, the other mold belt 38 has a three-dimensional pattern 120A of ridges and recesses which form a second pattern of slots (unnumbered in Fig. 18) on the bottom/mounting surface of the ribbon 30a (see column 15, lines 20-26; column 25, line 66 to column 26, line 4). The slots shown on the bottom surface in Fig. 18 weaken the panel due to the reduced cross section and therefore inherently facilitate the formation of curved coverings. Further, the slots shown on the bottom surface in Fig. 18 are capable of serving as a base for a mounting adhesive. In the embodiment of Fig. 19, the thermoplastic sheet/panel product P is formed of a series of interconnected planks 310 having a wood-grain texture (see column 26, lines 5-17). The bottom/mounting surface of the sheet/panel product P is formed with longitudinal ribs 314 separated by longitudinal slots (see Figs. 19 and 20; column 26 line 17-32). Like the slots in Fig. 18, the bottom slots in Figs. 19 and 20 inherently facilitate the formation of curved coverings and are capable of serving as a base for adhesive. As shown in Figs. 23 and 24, edge belt molds 340, 341 are used to form tongues 364 and grooves 366 in the edges of the sheet/panel products for interconnecting the sheets/panels aside of each other (see column 27, lines 5-49).

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baldwin (US 329,616) in view of Stucky et al. (US 6,344,268) and Muller et al. (US 6,527,532)

Baldwin discloses a surface covering including a plank (A) made of wood (see page 1, lines 8-15) which inherently possesses a wood grain texture. The plank (A) is formed with a tongue (b) and groove (c) for interconnecting adjacent planks (see Fig. 2; page 1, lines 73-77). The plank (A) is also formed with longitudinal slots (e) at the underside thereof (see Figs. 2-4; page 1, lines 77-104). The slots (e) are capable of acting as a base for an adhesive.

Baldwin fails to teach a plank made of a flexible material such that the plank is capable of being laid in curved formations.

Stucky et al. teaches a plank made of a foamed polymer-fiber composite (see column 3, lines 22-34) which inherently possesses a certain degree of flexibility. The composite plank can be formed into a complex cross-sectional shape by extrusion (see column 3, lines 57-61). The composite plank can also be provided with a simulated wood-grain texture (see column 4, lines 55-58). The polymer-fiber composite is preferred over wood because it is weather resistant, maintenance free, less subject to splintering and warping, does not require painting, never includes knots, and does not shed sap (see column 1, lines 12-45).

Muller et al. teaches a plank made of a thermoplastic composite (see column 3, lines 54-58) which inherently possesses a certain degree of flexibility. The composite plank can be formed into a complex cross-sectional shape by extrusion (see column 8, lines 28-30).

From these teachings of Stucky et al. and Muller et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Baldwin by forming the plank from a polymer composite material because such a material is preferred over wood because it is weather resistant, maintenance free, less subject to splintering and warping, does not require painting, never includes knots, and does not shed sap.

Accordingly, Baldwin teaches a surface covering including a plank made of wood, provided with a tongue and groove for interconnecting adjacent planks, and formed with longitudinal slots at the underside thereof which are capable of acting as a base for an adhesive. Further, Stucky et al. and Muller et al. teach forming the plank of Baldwin from a polymer composite which inherently possesses a certain degree of flexibility and which can be formed

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with a simulated wood-grain texture. Due to its flexibility, the polymer composite plank is capable of being laid in curved formations. It is noted that claim 1 does not specify the degree of curvature required. Therefore, a plank with even a small degree of flexibility, enabling the plank to be laid with only a relatively small degree of curvature, meets the broad recitation in the claim.

***Remarks***

5. Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that *ex parte* reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extensions of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

6. Responses to this Office action may be submitted by facsimile and should be directed to the Central Reexamination Unit using facsimile number 571-273-9900. A confirmation of receipt will be generated automatically for all papers transmitted via this facsimile number.

All responses to be delivered by the United States Postal Service (USPS) should be addressed as follows:

Mail Stop Ex Parte Reexam  
Central Reexamination Unit  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Hand-delivered responses should be labeled "Attn: Central Reexamination Unit" and delivered to:

Customer Service Window  
Randolph Building, Lobby Level  
401 Dulany Street  
Alexandria, VA 22314

Submissions for reexamination proceedings may also be submitted through EFS-Web (the USPTO's web-based document submission system).

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7. In order to ensure full consideration of any amendments, affidavits or declarations, or other documents as evidence of patentability, such documents must be submitted in response to this Office action. Submissions after the next Office action, which is intended to be a final action, will be governed by the requirements of 37 CFR 1.116, which will be strictly enforced.

8. Any proposed amendment filed in this reexamination proceeding must be made in accordance with 37 CFR 1.530(d)-(j) and comply with the formal requirements of 37 CFR 1.52(a) and (b). See MPEP 2250.

9. Any document filed by either the patent owner or third party requester *must be served* on the other party (or parties in a merged proceeding) in the reexamination proceeding in the manner provided by 37 CFR 1.248. See 37 CFR 1.550(f) and MPEP 2266.03.

10. The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving the patent throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

11. Any inquiry concerning this communication or earlier communications from the Reexamination Examiner should be directed to Peter English whose telephone number is (571)272-6671. The examiner can normally be reached on Monday through Thursday (7:00 AM - 5:00 PM). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andres Kashnikow, can be reached at 571-272-4361.

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For general information regarding reexamination proceedings please call the Central Reexamination Unit at 571-272-7705. For guidance on reexamination practice and procedure please call the Office of Patent Legal Administration at 571-272-7703.



Peter C. English  
Primary Examiner  
Central Reexamination Unit

1/20/10

Conferees: *BKYZ*  
*M/L*

pe  
20 January 2010