

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JAMES M. SHEPPARD, JR.

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Appeal 2009-001515  
Application 10/314,794  
Technology Center 2800

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Decided:<sup>1</sup> June 30, 2009

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Before JOSEPH F. RUGGIERO, MAHSHID D. SAADAT,  
and ROBERT E. NAPPI, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL

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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 decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Appellant appeals under 35 U.S.C. § 134(a) from a Final Rejection of claims 21-30. Claims 1-20 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

#### STATEMENT OF THE CASE

Appellant's invention relates to a method for making a textile article comprising providing a two-sided Jacquard woven textile and transferring a graphic impression on the textile. The first embodiment has a dark color border with a light color central section. (Spec. 4.) Claim 21, which is representative of the claims on appeal, reads as follows:

21. The method of making a printed textile article comprising: providing a two-sided Jacquard woven fibers textile, said textile having a border and a central area within said border, on both sides of said textile, wherein said textile has a dark color border and a light color central area on one side, and a light border and a dark color central area on the other side, and transferring a graphic impression in said central area on said one side on said textile; wherein said border on said one side is capable of masking said graphic impression that may overlap onto said border from said central area on said one side, eliminating the need for precise alignment of said graphic impression within said central area of said one side; and wherein said central area on said other side is capable of masking any potential bleed through of said graphic impression from said central area of said one side.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Terrasse	US 2,163,769	Jun. 27, 1939
Stark	US 3,669,818	Jun. 13, 1972
Otto	US 4,769,879	Sep. 13, 1988

Appellant's Admitted Prior Art (AAPA), Spec. 2:9-22.

Claims 21 and 25 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over Terrasse and Stark.

Claims 22, 23, 26-28, and 30 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over Terrasse and Stark, and further in view of AAPA.

Claims 24 and 29 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over Terrasse, Stark, and AAPA, further in view of Otto.

We refer to the Briefs (Appeal Brief filed Apr. 2, 2008 and Reply Brief filed Jul. 29, 2008) and the Answer (mailed Jun. 30, 2008) for their respective details.

#### ISSUE

Appellant argues that one of ordinary skill in the art would not have found it obvious to print a graphic impression onto the textile of Terrasse according to the teachings of Stark (App. Br. 8). The Examiner responds that the border area in Terrasse is capable of masking the overlapped color, whether the print is out of register with the central area or not (Ans. 8). Therefore, the issue before us is as follows:

Has Appellant shown error in the Examiner's conclusion that substantial evidence before us shows that under 35 U.S.C. § 103, the combination of Terrasse and Stark or the combination of Terrasse and Stark with AAPA or Otto teaches or suggests the claimed subject matter? Specifically, whether one of ordinary skill in the art would have combined the reference teachings to show a border having a first darker color woven on one side leaving a lighter color central area wherein the border on said one side is capable of masking said graphic impression that may overlap onto said border and the darker central area on the back is capable of

masking any potential bleed through from the lighter color central area, as recited in claim 21.

### FINDINGS OF FACT

The following findings of fact (FF) are relevant to the issue involved in the appeal.

#### *Terrasse*

1. Terrasse relates to a woven fabric of a reversible pattern. (Col. 1, ll. 1-8.)
2. Terrasse shows in Figures 1 and 2 the two sides of the fabric having a pattern forming a border and a central area.
3. Terrasse discloses a reverse pattern as areas of white and blue color where each color on one side is matched to the other color on the other side for each pattern area. (Col. 2, ll. 49-55.)

#### *Stark*

4. Stark relates to textile products where various patterns may be produced in the surface of the fabric itself by varying the construction of the pile surface of the fabric. (Col. 1, ll. 26-31.)
5. Stark discloses color printing superimposed on the fabric in registry with sections of existing pattern in the surface of the fabric. (Col. 1, ll. 43-47; col. 2, ll. 22-25.)
6. Stark describes constructing the surface pattern of the fabric by using high or low loop pile yarns as well as cut pile yarns. (Col. 2, ll. 28-31.)

7. Stark further describes one of the possible print designs as superimposed on the pattern pile fabric, so long as the pile pattern and the printed design are out of registry with one another. (Col. 2, ll. 39-46.)

#### PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966) (stating that 35 U.S.C. § 103 leads to three basic factual inquiries: the scope and content of the prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the art). “[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.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. *See In re Kahn*, 441 F.3d 977, 987-88 (Fed. Cir. 2006); *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

Section 103 forbids issuance of a patent when “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.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007).

A step in the obviousness analysis is to “determine whether there was an apparent reason to combine the known elements in the fashion claimed.”

*KSR*, 550 U.S. at 418. A rejection for obviousness must include “articulated reasoning with some rational underpinning to support the legal conclusion.” *Id.*, quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

## ANALYSIS

### *Claim Rejection over Terrasse and Stark*

The Examiner proposed combining the reverse border/central area pattern of Terrasse with the printed pattern of Stark (Ans. 3-5). The Examiner found that Terrasse teaches a woven fabric of a reversible pattern composed of two colors forming a border and central area having opposite colors (FF 1-3). The Examiner, however, did not identify any teaching in Terrasse that would provide a reason to one of ordinary skill in the art to combine such pattern with the printed pattern of Stark. The Examiner characterized the limitation of “capable of masking the graphic impression” as a functional limitation and stated that such recitation does not delimit the claim since the claim does not require that the printed pattern actually overlap the border area (Ans. 4). The Examiner asserted that even if such limitation is considered a process requirement of the claim, the claimed article would not function differently from the article of Terrasse (Ans. 4-5).

We disagree with the Examiner’s reasoning and find that neither reference is concerned with masking the overlap or bleed through of the printed graphic impression by the darker border and the darker central area on the back. We also agree with Appellant (App. Br. 9) that the only relationship between the woven and the printed patterns required in Stark is an out of registry design (FF 7). Additionally, we find that Stark’s woven patterns (FF 4) and the color print superimposed on the fabric (FF 5-6) are

positioned intentionally out of registry with no regard for placing the print on the dark area in contrast to the light area (FF 7). On the other hand, while Terrasse discloses a woven border and central area in two different colors (FF 1-3), no indication is made in the reference that any color printing is done on the lighter color central area.

In that regard, we find that the Examiner has not identified any disclosure that the cited references selected the dark and light colors for the woven border and the central area in order to mask the transferred graphic impression by the dark color border or to mask the bleed through by any dark area on the back. In fact, as argued by Appellant (App. Br. 9-10), the only reasoning provided by the Examiner is tainted with impermissible hindsight rather than supported by articulated reasoning that the claimed relationship between the woven and printed areas would have been obvious. Neither Terrasse, nor Stark gives any direction as to how the many possibilities of placing printed designs over woven patterns would have resulted in the claimed requirement for the colored woven pattern on two sides of the towel and the specific relational positioning of the border and the central area. We conclude that a prima facie case for obviousness with respect to the rejection of claims 21 and 25 over Terrasse and Stark was not made on this record.

*Claim Rejection over Terrasse and Stark, in view of AAPA and Otto*

The Examiner cited AAPA for disclosing jacquard weaving and cited Otto for disclosing a method of shearing and blooming the woven textile (Ans. 5-7). However, the Examiner did not point to any specific teachings in the applied art, nor set forth an articulated reasoning that would provide a rationale for combining Terrasse and Stark. For the reasons discussed

above, we conclude that a prima facie case for obviousness with respect to the rejection of claims 22, 23, 26-28, and 30 over Terrasse, Stark, and AAPA, or of claims 24 and 29 over Terrasse, Stark, AAPA, and Otto was not made on this record.

### CONCLUSION

The record does not establish that there was a reason for a person of ordinary skill in the art, informed by the reference disclosures and their own knowledge of the art, to combine the references to arrive at the subject matter of independent claims 21, 22, and 27. In that regard, the combination does not teach or suggest how to make a printed textile article in which a border having a first darker color is woven on one side leaving a lighter color central area wherein the border on said one side is capable of masking a transferred graphic impression that may overlap onto said border and the darker central area on the back is capable of masking any potential bleed through from the lighter color central area. We, therefore, will not sustain any of the 35 U.S.C. § 103 rejections of claims 21, 22, and 27, as well as claims 23, 25-26, and 28-30 dependent thereof.

### ORDER

The decision of the Examiner rejecting claims 21, 22, and 24-27 is reversed.

Appeal 2009-001515  
Application 10/314,794

REVERSED

ELD

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