

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DOUGLAS S. NORDGREN and JOHN W. LUBKER, II

Appeal No. 2004-2244
Application No. 10/208,906

ON BRIEF

Before GARRIS, PAK, and DELMENDO, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 42-71.

The subject matter on appeal relates to a sheathing adapted to be fastened to a wall supporting structure which comprises a first layer comprising a polymeric foam and a second layer comprising a woven polymeric scrim having means for reinforcing its periphery so as to inhibit failure of the scrim. This appealed subject matter is adequately represented by independent claim 42 which reads as follows:

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42. A sheathing adapted to be fastened to at least one wall supporting structure, comprising at least two layers:

(a) a first layer comprising a polymeric foam layer; and

(b) a second layer comprising a woven polymeric scrim, said second layer being located adjacent to and capable of contacting said first layer, said second layer having means for reinforcing its periphery so as to inhibit failure of the scrim.

The references set forth below are relied upon by the examiner as evidence of obviousness:

Holtrop et al. (Holtrop)	4,621,013	Nov. 4, 1986
Van Auken et al. (Van Auken)	5,251,415	Oct. 12, 1993

All of the appealed claims are rejected under 35 U.S.C. § 103(a) as being unpatentable over Holtrop in view of Van Auken. According to the examiner, Holtrop discloses all aspects of the appealed claim 42 invention except for a reinforcing means at the scrim periphery, and Van Auken discloses a polymeric scrim mesh having reinforcing means in the form of a selvedge tuck around the periphery. Based on these disclosures, the examiner concludes that "[i]t would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the scrim cloth of Holtrop so as to employ a selvedged periphery as taught by Van Auken because this arrangement would provide Holtrop's scrim with reinforced edging (see col. 3,

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lines 17-18 of Van Auken) as is conventionally known in the scrim cloth/fabric art" (answer, page 3; emphasis deleted).

We refer to the brief and reply brief and to the answer for a complete exposition of the opposing viewpoints expressed by the appellants and by the examiner concerning the above noted rejection.

OPINION

We cannot sustain this rejection.

On pages 5-7 of their brief, the appellants have presented a thoroughly persuasive argument that the Holtrop reference is from a non-analogous art. We will not burden the record with a reiteration of the very capable presentation made by the appellants. Suffice it to say, therefore, that Holtrop is non-analogous art because it is not from the field of the inventor's endeavor and because it is not reasonably pertinent to the particular problem with which the inventor was involved.

See In re Clay, 966 F.2d 656, 658, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). Thus, the reference is not "prior art" with respect to the here claimed invention and accordingly can not be applied in the context of the Section 103 rejection advanced by the examiner. Id.

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This rejection still would be improper even if Holtrop were assumed to be analogous art. In this regard, it is well settled that, when a rejection depends on a combination of prior art references (as here), there must be some teaching, suggestion or motivation to combine the references. In re Rouffet, 149 F.3d 1350, 1355-56, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). In accordance with the aforequoted obviousness conclusion from page 3 of the answer, the examiner contends that it would have been obvious "to modify the scrim cloth of Holtrop so as to employ a selvedged periphery as taught by Van Auken because this arrangement would provide Holtrop's scrim with reinforced edging (see col. 3, lines 17-18 of Van Auken) as is conventionally known in the scrim cloth/fabric" (emphasis deleted).

The examiner's contention is deficient in that no reason has been given as to why an artisan would have been motivated to "provide Holtrop's scrim with reinforced edging" (id.) From our perspective, there is simply no reason to believe that the

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laminated of Holtrop, which is used in preparing headliners for automobiles, would have any need for a selvedged periphery of the type taught by Van Auken as useful in a roofing system for supporting a fallen object such as a 200-300 pound man (e.g., see the paragraph bridging columns 1 and 2 as well as the first paragraph in column 3 of Van Auken).

For at least the reasons set forth above, it is apparent that the examiner has failed to carry his burden of establishing a prima facie case of obviousness. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). It follows that we cannot sustain his section 103 rejection of all appealed claims as being unpatentable over Holtrop in view of Van Auken.

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The decision of the examiner is reversed.

REVERSED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHUNG K. PAK)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
ROMULO H. DELMENDO)	
Administrative Patent Judge)	

BRG/hh

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