

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD ARTHUR REYNOLDS

Appeal No. 2005-1484
Application 09/486,875

ON BRIEF

Before KIMLIN, WARREN and JEFFREY T. SMITH, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellant, in the brief¹ and reply brief, and based on our review, find that we cannot sustain the rejection of appealed claims 1, 9, 11 and 12,² all of the claims in the application, under 35 U.S.C. § 103(a) as being unpatentable over Eagles in view of Mathellier.³

It is well settled that in order to establish a *prima facie* case of obviousness under § 103(a), the examiner must show that some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill

¹ We consider the brief filed July 27, 2004.

² See the appendix to the brief and the amendment filed July 27, 2004.

in this art would have led that person to the claimed invention as a whole, including each and every limitation of the claims arranged as required by the claims, without recourse to the teachings in appellant's disclosure. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) ("The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that [the claimed process] should be carried out and would have a reasonable likelihood of success viewed in light of the prior art. [Citations omitted] Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure."); *see also In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)("The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.").

We have carefully considered the record before us and based on our review, find that we agree with appellant's argument that neither reference evinces removing a portion of the rear surface of each of the two plastic extrusions at the miter joint and then "restoring," in claim 9, or "rebuilding," in claim 11, the portion of each of the extrusions that was removed (brief, unnumbered page 4).

We are mindful that in this respect, the examiner finds that "[t]o rebuild the removed portion, Eagles inserts element 24 into the void left by the removed portion" and that "Mathellier shows that it is known to carry out a method of rebuilding a removed back corner of an extrusion" (answer, pages 4-5). However, we find that in Eagles **Fig. 4**, after the mitered gasket sections from which a portion of base **20** and retaining portion **21** have been removed and a piece of uncured or vulcanizable rubber **26** has been inserted therebetween in mold female part **23**, L-shaped mold male part **24** is inserted into such areas of the mitered gaskets for the purpose of

³ The examiner states that the ground of rejection is set forth in the Office action mailed

holding the gaskets in place during the curing or vulcanizing process forming the completed joint with uncured or vulcanizable rubber **26** which bonds the gasket sections (page 1, second col., l. 32, to page 2, first col., l. 32). Thus, Eagles would not have taught one of ordinary skill in this art to rebuild the removed portions of the gasket sections, and we find no teaching or suggestion in the teachings in Mathellier to rebuild the outer face or surface of sealing portion **4** of the disclosed sealing strip as shown in Mathellier **Fig. 1** (e.g., col. 3, l. 57, to col. 4, l. 4) which would have led this person to rebuild the interior or back portion of the gasket sections of Eagles.

Accordingly, we are of the opinion that at best, the combined teachings of Eagles and Mathellier would have reasonably suggested to one of ordinary skill in this art to inject the bonding material **26** rather than insert a piece of such material between the two gasket sections in the mold of Eagles which, of course, would not have resulted in the claimed method encompassed by the appealed claims. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-54, 5 USPQ2d 1434, 1438-41 (Fed. Cir. 1988).

The examiner's decision is reversed.

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Reversed

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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CHARLES F. WARREN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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JEFFREY T. SMITH)	
Administrative Patent Judge)	

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Howard & Howard Attorneys, P.C.
The Pinehurst Office Center, Suite # 101
39400 Woodward Avenue
Bloomfield Hills, MI 48304-5151