

The opinion in support of the decision being entered today is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte BENEDICT F. CRAMER, III

Appeal No. 2007-0048
Application No. 10/234,608
Technology Center 3600

Decided: September 11, 2007

Before HUBERT C. LORIN, CAROL A. SPIEGEL, and SALLY G. LANE,
Administrative Patent Judges.

LORIN, Administrative Patent Judge.

DECISION ON REQUEST FOR REHEARING

INTRODUCTION

Appellant filed a Request for Reconsideration (Mar. 9, 2007) contending that the Board, in the Decision on Appeal (mailed Jan. 12, 2007), “erred in rejecting all pending Claims and reversal of all grounds of rejection is again solicited” (p. 1).

In the Decision on Appeal the Board affirmed a rejection of claims 1-10 under 35 U.S.C. § 103 (a) over Lowry and Gibson and entered a new ground of rejection of claims 11 and 12 under 35 U.S.C. § 103(a) over Martin in view of Gray or Kim.

DISCUSSION

Claims 1-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lowry in view of Gibson.

In the Decision on Appeal, we found the “Examiner’s findings [] sufficient to support a prima facie conclusion of obviousness” (p. 7). Those findings included finding that Lowry discloses a door comprising a slat assembly having a void and filling that void with a thermally insulative material and that Gibson discloses using aerogel in making a panel of microporous thermal insulation. We agreed with the Examiner’s conclusion that “[o]ne of ordinary skill in the art would have been motivated to modify the door of Lowry by using an aerogel as the thermal insulation material within the void of Lowry’s slat assembly” (Decision on Appeal 7). We found that “one of ordinary skill in the art would have reasonably expected that selecting Gibson’s aerogel to fill the void within the slat assembly of Lowry would provide the Lowry assembly with a thermal insulation performance corresponding to the incorporated aerogel” (Decision on Appeal 7).

Appellant argues that “[t]he claimed use of aerogel as an insulation material in an overhead door has two advantages over mere insulation effectiveness for the aerogel component: light weight ... and exceptional

sound deadening . . .” (Request for Reconsideration 1.) Appellant does not dispute that it would have been obvious to use aerogel in an overhead door for the purpose of giving the door thermal insulation. Appellant is arguing that the use of aerogel in the overhead door would have been nonobvious because it makes the door light weight and gives it a sound deadening property. In other words, Appellant is arguing that the Examiner has used a rationale different from that of Appellant’s in combining aerogel with the slat assembly to reach the claimed invention. However, “[o]ne of ordinary skill in the art need not see the identical problem addressed in a prior art reference to be motivated to apply its teachings.” *Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1323, 76 USPQ2d 1662, 1685 (Fed. Cir. 2005). “[T]he law does not require that the references be combined for the reasons contemplated by the inventor.” *In re Beattie*, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992).

We are not persuaded that we erred in affirming the rejection of claims 1-10 under 35 U.S.C. § 103 (a) over Lowry and Gibson.

Claims 11-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Martin in view of Gray or Kim.

In the Decision on Appeal, we found ”it would have been obvious to one of ordinary skill in the art to include at least one perforation in Martin’s body (web) because, as Gray suggests, the perforation would have been expected to facilitate tearing Martin’s body into multiple units or, in the language of the claims, to facilitate tearing the web into individual panels,

thereby providing an alternative means to separate panels from the web,” and, alternatively, “it would have been obvious to one of ordinary skill in the art to provide Martin’s web with “at least one perforation,” because as Kim suggests, it would facilitate separating the web into panels of desired size” (p. 7).

Appellant argues that Gray and Kim would *not* suggest modifying Martin to reach the claimed invention because neither reference, though teaching perforations, teach perforations in a “dual web/aerogel-filled panel construct.” Appellant concedes that Gray and Kim disclose perforations in a unitary panel but not in a “dual web/aerogel-filled panel construct.” However, it is Martin which shows the “dual web/aerogel-filled panel construct.” We note that Appellant does not traverse our findings in our Decision on Appeal regarding Martin. The decision (p. 10) clearly states that “Martin discloses a web comprising a plurality of aerogel-filled vacuum insulated panels which can be cut into individual units as claimed.” In arguing that Gray and Kim do not specifically apply perforations to a “dual web/aerogel-filled panel construct,” without taking into consideration that Martin teaches the “dual web/aerogel-filled panel construct,” Appellant fails to consider the combined teachings of the references.

The test for obviousness is what the *combined* teachings of the references would suggest to those of ordinary skill in the art. *In re Young*, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Whether or not an individual reference teaches a specific element of the claimed product is not dispositive of the question of obviousness. Non-obviousness cannot be

established by attacking references individually where the rejection is based upon the teachings of a combination of references. *In re Merck*, 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986); *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Appellant also argues that “Kim does not appear to suggest or require that the holes be a series of perforations that would be capable of dividing the material into which they are punched.” (Request for Reconsideration, pp. 2-3.) The argument that the perforations for the claimed web distinguishes over Kim’s perforations because the claimed perforations are “capable of dividing the material” is not commensurate in scope with what is claimed. “Many of appellant’s arguments fail from the outset because, . . . they are not based on limitations appearing in the claims . . .” *In re Self*, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982). The claim describes the perforations as “allowing for separation” of the panels from each other. The claim does not require the perforations to be capable of dividing the material but only that they “allow” for separation of the panels. In that regard, as we stated in the Decision on Appeal (p. 11), “[i]n disclosing an insulated door material provided with punched holes to facilitate cutting the material into separate panels, Kim is in effect disclosing an insulated web with at least one perforation (punched hole) *allowing for the web to be cut into separate panels.*” (Emphasis added.)

We are not persuaded that we erred in entering a new ground of rejection of claims 11 and 12 under 35 U.S.C. § 103(a) over Martin in view of Gray or Kim.

CONCLUSION

Appellant's arguments have been considered but we find them unpersuasive as to error in affirming the rejection of claims 1-10 under 35 U.S.C. § 103 (a) over Lowry and Gibson and in entering a new ground of rejection of claims 11 and 12 under 35 U.S.C. § 103(a) over Martin in view of Gray or Kim.

DENIED

vsh

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