

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* RALPH BERRYMAN SMITH, DONALD OTIS McCLESKEY,  
NORMAN F. MANNING and RALPH L. SMITH

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Appeal 2007-2771  
Application 10/418,661  
Technology Center 1700

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Decided: September 24, 2007

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Before EDWARD C. KIMLIN, CHUNG K. PAK, and  
LINDA M. GAUDETTE, *Administrative Patent Judges*.

PAK, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 3, and 5 through 27, all of the claims pending in the above-identified application. We have jurisdiction pursuant to 35 U.S.C. § 6.

*STATEMENT OF THE CASE*

The subject matter on appeal is directed to a roofing method and system involving the use of a flexible mat as an underlayment for a single-ply roofing membrane (Specification 1). Further details of the appealed subject matter are recited in representative claims 19, 22, 23, 25, 26, and 27 reproduced below:

19. A method of protecting a waterproof roofing membrane component comprising selecting a flexible mat component comprising synthetic material that is compatible with the waterproof roofing membrane component and unrolling the flexible mat between the waterproof roofing membrane and a roof deck, wherein the waterproof roofing membrane is a single ply membrane, and wherein the mat is non-perforated.

22. A roofing method comprising unrolling a flexible mat component onto a roof deck and installing a waterproof membrane component over the flexible mat, wherein the waterproof roofing membrane is a single ply membrane, and wherein the mat separates the roof deck and the single ply membrane such that the roof deck does not contact the single ply membrane.

23. A roofing system comprising:

(a) a single ply waterproof roofing membrane component selected from the group consisting of synthetic rubber, polyvinyl chloride, and chlorinated polyethylene; and

(b) a flexible underlayment mat component for unrolling between a roof deck and the waterproof membrane, wherein the flexible mat (i) comprises synthetic material compatible with the waterproof membrane such that the membrane is not damaged by contact with the flexible mat, (ii)

is rolled into a roll to facilitate handling, and (iii) has an effective thickness and density for protecting the waterproof membrane from puncture by irregular surfaces on the roof deck; and

wherein the single ply waterproof roofing membrane is not adhered to the roof deck.

25. The method of claim 19 wherein the waterproof membrane is not adhered to the roof deck.

26. The roofing method of claim 22 wherein the mat is non-perforated.

27. The roofing system of claim 23 wherein the mat separates the roof deck and the single ply membrane such that the roof deck does not contact the single ply membrane.

The Examiner has rejected claims 3 and 5 through 27 under 35 U.S.C. § 112, first paragraph, as failing to provide written descriptive support for the presently claimed subject matter in the application disclosure, as originally filed.

The Appellants appeal from the Examiner's decision rejecting the claims on appeal under 35 U.S.C. § 112, first paragraph.

## *ISSUES*

1. Has the Examiner demonstrated that the negative limitations "the mat is non-perforated" and "deck does not contact the single ply membrane" recited in claims 3, and 5 through 22 and/or 26 introduce a new concept not provided in the application disclosure, as originally filed, in violation of the first paragraph of 35 U.S.C. § 112?

2. Has the Examiner demonstrated that the negative limitation "membrane is not adhered to the roof deck" recited in claims 23 through 25

and 27 introduces a new concept not provided in the application disclosure, as originally filed, in violation of the first paragraph of 35 U.S.C. § 112?

*PRINCIPLES OF LAW, FACTS, and ANALYSES*

According to *In re Wertheim*, 541 F.2d 257, 262-265, 191 USPQ 90, 96-98 (CCPA 1976):

The function of the description requirement is to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him; how the specification accomplishes this is not material. . . . It is not necessary that the application describe the claim limitations exactly....but only so clearly that persons of ordinary skill in the art will recognize from the disclosure that appellants invented processes including those limitations. [Citations omitted.]

....If lack of literal support alone were enough to support a rejection under 112, then the statement of In re Lukach [442 F.2d 967, 969, 169 USPQ 795, 796 (CCPA 1971)] that “the invention claimed does not have be described in *ipsis verbis* in order to satisfy the description requirement of [§]112,” is empty verbiage. The burden of showing that the claimed invention is not described in the specification rests on the PTO in the first instance, and it is up to the PTO to give reasons why a description not in *ipsis verbis* is insufficient.

Our reviewing Court in *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1560-64, 19 USPQ2d 1111, 1114-17 (Fed. Cir. 1991) also stated:

....drawings alone may be sufficient to provide the “written description of the invention” required by § 112, first paragraph.

Therefore, it is incumbent upon the Examiner to demonstrate that the application disclosure, including the drawings, as originally filed, does not provide written descriptive support for the concept of what is later claimed.

*In re Anderson*, 471 F.2d 1237, 1242, 176 USPQ 331, 336 (CCPA 1973); *Ex parte Parks*, 30 USPQ2d 1234 (BPAI 1993); *Ex parte Grasselli*, 231 USPQ 393 (BPAI 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984).

Here, we determine that the Examiner has not demonstrated that the negative limitations “the mat is non-perforated” and “deck does not contact the single ply membrane” recited in claims 3, and 5 through 22 and/or 26 introduce a new concept not provided in the application disclosure, as originally filed, in violation of the first paragraph of 35 U.S.C. § 112. In this regard, we note that the application disclosure, including the drawings, as originally filed, reasonably convey to one of ordinary skill in the art that the inventors of the present invention had possession of rolling out a non-perforated flexible mat in the claimed method prior to cutting (perforating) and fitting it around roof penetrations at the time of the invention (See Figure 4, together with Specification 5, 9, and 10). We also share the Appellants’ view at page 10 of the Brief that:

Page 2 of the [S]pecification expressly teaches that the conventional board stock insulation separates the single-ply membrane from the roof deck. Page 5 of the [S]pecification teaches that the underlayment mat replaces the conventional board stock insulation. If the underlayment mat replaces the conventional board stock insulation, then the underlayment mat must separate the single-ply membrane from the roof deck.

Accordingly, we are constrained to agree with the Appellants that the subject matter recited in claims 3, and 5 through 22 and 26 does not contain a concept not reasonably conveyed in the application, as originally filed, in violation of the first paragraph of 35 U.S.C. § 112.

However, we determine that the Examiner has demonstrated that the negative limitation “membrane is not adhered to the roof deck” recited in claims 23 through 25 and 27 introduces a new concept not provided in the application disclosure, as originally filed, in violation of the first paragraph of 35 U.S.C. § 112. In this regard, we note that the negative limitation in question precludes any membrane from either directly or *indirectly* adhering to the roof deck. Nowhere does the application disclosure, as originally filed, preclude the membrane from indirectly adhering to the roof deck. As such, we concur with the Examiner that the negative limitation in question introduces a new concept not found in the written description of the application disclosure, as originally filed, within the meaning of the first paragraph of 35 U.S.C. § 112.

#### *OTHER ISSUE*

The Appellants acknowledge that in commercial roof structures, it is common to cover the roof deck with an insulation material, a protective material, a support material and then with a roof membrane (Specification 1-2). The Appellants also appear to acknowledge that various coverings, including a layered flexible base web, a fibrous sheet, a multi-layered insulation, were known to be used prior to applying a single ply roofing membrane (Specification 4). According to the Appellants, the claimed flexible mat embraces any “mat...similar to the type of mat commonly used in, but not limited to mattress construction, furniture padding, carpet underlayment, and sound and fire proofing in vehicles” (Specification 5).

Thus, upon return of this application and prior to issuance of the above-identified application, the Examiner is advised to carefully review the admitted prior art and determine whether the admitted prior art affects the patentability of the claimed subject matter.

#### *CONCLUSION*

In view of the forgoing, we affirm the Examiner's decision rejecting claims 23 through 25 and 27 under 35 U.S.C. § 112, first paragraph, reverse the Examiner's decision rejecting claims 3, and 5 through 22 and 26 under 35 U.S.C. § 112, first paragraph, and remand the application to the Examiner to consider the admitted prior art referred to at pages 2-4 of the Specification to determine their effect on the claims on appeal.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a remand. 37 CFR § 41.50(e) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) provides that

[w]henever a decision of the Board includes a remand, that decision shall not be considered final for judicial review. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board may enter an order otherwise making its decision final for judicial review.

Regarding any affirmed rejection, 37 CFR § 41.52(a) (1) provides "[a]ppellant may file a single request for rehearing within two months from the date of the original decision of the Board." The effective date of the affirmation is deferred until conclusion of the proceedings before the examiner unless, as a mere incident to the limited proceedings, the affirmed

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rejection is overcome. If the proceedings before the examiner do not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART/REMANDED

tc/ls

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