

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALLAN KAYE

Appeal 2008-1192
Application 10/362,748
Technology Center 1700

Decided: December 18, 2008

Before THOMAS A. WALTZ, ROMULO H. DELMENDO, and
MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

WALTZ, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

This is a decision on Appellant's Request for Rehearing (hereafter "Request" or "Req.") under 37 C.F.R. § 41.52(a)(1), timely filed on July 21, 2008, requesting rehearing of the Decision dated May 19, 2008 (hereafter "Decision" or "Dec."), where this merits panel affirmed the rejection of claims 1, 3, 5, and 7 under 35 U.S.C. § 103(a) over Bolukbasi (US

6,620,484) in view of Skoien (US 5,670,220) and Forsch (US 4,299,871).¹

Appellant requests rehearing based on “clearly erroneous statements of fact” and misinterpretations of the *KSR Int'l Co. v. Teleflex Inc.* decision,² “as well as a failure to apply . . . the requirements of that decision.” Req. 1.

Specifically, Appellant first contends that Factual Finding (4) in the Decision is clearly erroneous since it states that Skoien “uses an adhesive to join the upstanding webs together” (Req. 2, emphasis omitted). Appellant contends that Skoien does not teach joining of any upstanding webs together, but instead only teaches joining webs to the insulating sheets (Req. 3).

Secondly, Appellant contends that Factual Finding (5) in the Decision is clearly erroneous since it states that “Forsch discloses an integrated composite structure made by orienting two webs in adjacent upstanding portions and joining them via a stitcher” (Req. 5). Appellant contends that a detailed review of Forsch shows that the webs or upstanding portions of the beam caps 34 and 36 are never joined together via a stitcher, but the stitcher is only used to attach the beam caps to the panel 32 (Req. 6, citing dash lines 38 in Figs. 2-3 of Forsch).

In view of these contentions regarding Factual Findings (4) and (5), Appellant contends that the Board’s statements based on these findings are also erroneous (Req. 8-9).

¹ Dec. 4. We note that the other rejections on appeal, namely the rejection of claims 1-7 under 35 U.S.C. § 112, second paragraph, and the rejection of claims 1-4, 6, and 7 under 35 U.S.C. § 103(a) over Forsch, were not sustained. *Id.*; Req. 2.

² 127 S. Ct. 1727 (2007).

We are not persuaded of error in our Decision regarding these points contended by Appellant. First, we determine that the bonding means for upstanding portions, as disclosed and suggested by Skoien and Forsch, are not controlling to our Decision. As shown by Factual Findings (1) and (2), Bolukbasi discloses a structural stiffening article made of a plurality of U-shaped webs which have upstanding portions stitched together, with teachings of the advantageous results from the use of stitching to join or bond the composite materials (Dec. 7). Therefore, even assuming *arguendo* that Factual Findings (4) and (5) were in error, we determine that the conclusion reached by this merits panel in the Decision that “it was well known in the art of stiffening structures to employ stitching as a means of bonding two adjacent webs, and the advantages of stitching were well known in the art” (Dec. 9) was based on a preponderance of evidence in the appeal record.

Furthermore, we do not agree that Factual Findings (4) and (5) in the Decision were erroneous. With regard to Factual Finding (5), we agree with Appellant that Forsch discloses the well known use of stitching to bond two structures together, although Forsch does not show the upstanding adjacent webs bonded together by stitching. Factual Finding (5) states this disclosure from Forsch, but does not clearly state what the upstanding webs are joined *to* via the stitcher (Dec. 8). This is more clearly set forth in the Answer, where the Examiner found that Forsch discloses joining two upstanding webs “to a supporting material via a stitcher” (Ans. 5, as cited at Dec. 8). Accordingly, Factual Finding (5) was merely relied upon as evidence that joining webs to composite materials by stitching, and the advantage of

stitching regarding structural strength as compared to mechanical fasteners and adhesive bonding, was well known in this art (Dec. 9).

With regard to Factual Finding (4) as discussed above, we do not agree with Appellant that Skoien fails to disclose or suggest joining the upstanding adjacent portions of the web material together (Req. 3-4). Skoien discloses and suggests multiple glue bonding stations to achieve adhesive bonding of every portion of the insulating batt, including each partition strip, side margin, and connector strip everywhere they overlap, thus rendering obvious the bonding of any upstanding adjacent portions. *See* Skoien, Fig. 1; col. 2, ll. 35-44; col. 4, ll. 1-35; col. 6, ll. 29-31; and col. 8, ll. 20-49.

Appellant contends that Skoien does not disclose any aligning means falling within the properly construed scope of this claim term (Req. 9). Appellant contends that the Board incorrectly determined that “nor is there any argument that Skoien discloses aligning means within the scope of the claim term” (*Id.*). These contentions are not persuasive of error. First, we note that the Examiner stated that Skoien shows that the webs are “aligned” (Ans. 6, citing Fig. 5). Secondly, we again note that there is no argument or contention in the Appeal Brief or Reply Brief that any of the three applied references fail to show “aligning means” within the proper scope of that term, only that the references in general fail to disclose the claimed structures (App. Br. 12-14). Third, as stated in the Decision, Skoien discloses aligning means within the properly construed scope of this term (Dec. 5 and 7-8; FF (4)). *See also* Skoien, col. 3, ll. 26-29 and 54-57; and col. 7, ll. 44-47. Accordingly, we determine that Skoien teaches forming

plates, dispensers, reels or rollers, and guides within the properly construed scope of the claimed term “aligning means.”

Finally, Appellant contends that the Board “may” have improperly applied the Supreme Court decision of *KSR Int'l Co. v. Teleflex, Inc.* (Req. 11). Specifically, Appellant first contends that the Board’s conclusion that *KSR* states that any and all combinations of known elements, in which the elements operate in a known manner, are obvious is incorrect (Req. 11-12). Secondly, Appellant contends that the Board incorrectly stated that the Examiner does not have the obligation to provide an “explicit” analysis of the rationale for combining references in an obviousness rejection (Req. 11 and 13).

We do not find these contentions persuasive of error in our Decision. As stated by the Supreme Court in *KSR*:

Neither the enactment of §103 nor the analysis in *Graham* disturbed this Court’s earlier instructions concerning the *need for caution in granting a patent based on the combination of elements found in the prior art[.]* For over a half century, the Court has held that a “patent for a combination which only unites old elements with no change in their respective functions . . . obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men.” *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152 (1950). This is a principal reason for declining to allow patents for what is obvious. *The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.*

KSR, 127 S. Ct. at 1740 (emphasis added). Furthermore, as cited in our Decision, when a patent “simply arranges old elements with each performing the same function it had been known to perform’ and yields no

more than one would expect from such an arrangement,” the combination is obvious (Dec. 9, citing *id.*; Req. 11). Claim 1 on appeal only requires at least three structures, namely an aligning means, a forming means (first and second forming means), and bonding means (*see* claim 1 on appeal; Dec. 2). As shown by the Factual Findings in the Decision, all three of these means were known in the art, there is no change in their respective functions, and the combination of old elements merely yields predictable results (Dec. 8-9). In other words, the aligning means aligns the web material coming off the reels and dispenser, the forming means forms upstanding adjacent portions of the web material, and the bonding means joins the upstanding adjacent portions together. Appellant has not contended, nor shown, that any of the claimed elements perform a function different from the function of the corresponding elements known in the prior art.

With regard to Appellant’s contention that the Board concluded that the Examiner does not have the obligation to provide an “explicit analysis” of the obviousness rejection (Req. 11), we find no such statement in our Decision. We also note that Appellant has not pointed to any such statement in the Decision to support their assertion. With regard to a “rationale” or explanation of the contested obviousness rejection, we refer Appellant to pages 8-10 of the Decision, as well as pages 5-6 and 9 of the Answer.

For the foregoing reasons and those expressed in the Decision, we have reconsidered our Decision in light of Appellant’s Request for Rehearing, but find no points overlooked or misapprehended. Accordingly, Appellant’s Request is denied.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

DENIED

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