

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MICHAEL WILLIAM LUKA and MICHAEL WILLIAM MIKS

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Appeal 2008-5309  
Application 10/891,606  
Technology Center 1700

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Decided: November 26, 2008

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Before EDWARD C. KIMLIN, JEFFREY T. SMITH, and  
CATHERINE Q. TIMM, *Administrative Patent Judges*.

KIMLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 25-56.

Claim 25 is illustrative:

25. A method for preparing a fiberglass binder composition comprising:

(a) delivering a formaldehyde-free resin slurry contained in a vessel to a facility, the resin slurry being delivered at or above a minimum

temperature sufficient to maintain the viscosity of the resin slurry at a level sufficiently low to permit flow through the system;

(b) unloading the resin slurry from the vessel using an unload line while maintaining the resin slurry in the unload line at or above the minimum temperature;

(c) transporting the resin slurry in the unload line to a storage tank while maintaining the resin slurry in the storage tank at or above the minimum temperature;

(d) unloading the resin slurry from the storage tank using an unload line while maintaining the resin slurry in the unload line at or above the minimum temperature; and

(e) transporting the resin slurry in the unload line to a make up site while maintaining the resin slurry in the unload line at or above the minimum temperature,

(f) converting the resin slurry into a fiberglass binder composition; wherein the viscosity of the resin slurry at the minimum temperature is less than or equal to about 300 centipoise.

The Examiner relies upon the following references as evidence of obviousness:

Di Battista	US 1,575,152	Mar. 2, 1926
Cuschera	US 4,856,910	Aug. 15, 1989
Taylor	US 6,331,350 B1	Dec. 18, 2001

Appellants' claimed invention is directed to a method for preparing a fiberglass binder composition comprising the recited steps. According to the Appellants, "[t]he concept of heating these slurries to maintain a sufficiently low viscosity is contrary to the excepted wisdom in the art" (Page 12 of principal Brief, last sentence). Appellants have cited a publication entitled

*HANDLING AND STORAGE OF WATER-SOLUBLE POLYMERS* for the proposition that “the best way to handle these slurries when they become viscous is to use more powerful pumps, not to heat the slurry” (Page 13 of principal Brief, first paragraph).

Appealed claims 25-45 stand rejected under 35 U.S.C. § 112, second paragraph.<sup>1</sup> Claims 25-33, 35-46, and 48-51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Di Battista in view of Taylor. Claims 34, 47, and 52-56 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Di Battista in view of Taylor and Cuschera.

Appellants do not set forth separate arguments for the separately rejected groups of claims under 35 U.S.C. § 103. Accordingly, 25-33, 35-46, and 48-51 stand or fall together, as do claims 34, 47, and 52-56.

We have thoroughly reviewed each of Appellants’ arguments for patentability. However, we are in full agreement with the Examiner that the claimed subject matter would have been obvious to one of ordinary skill in the art within the meaning of § 103 in view of the applied prior art. Accordingly, we will adopt the Examiner’s reasoning as our own in sustaining the rejections under 35 U.S.C. § 103. We will not, however, sustain the Examiner’s § 112, second paragraph rejection.

We consider first the Examiner’s rejection of under § 112, second paragraph. It is the Examiner’s position that “[t]he language ‘converts’ ‘converting’ and ‘converted’ render [sic: renders] the claims indefinite because it is unclear what is intended by this language, i.e., conversion of

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<sup>1</sup> The Examiner has withdrawn the rejections of claims 25-39 under 35 U.S.C. § 112, first paragraph.

resin into final product, or heated liquid to cooled solid ... and what role the claimed apparatus has in said ‘converting’ process” (Page 3 of Answer, first paragraph). However, we agree with Appellants that when the claim language is read in light of the Specification, as it must, one of ordinary skill in the art would readily understand that the formaldehyde-free resin slurry is converted into a fiberglass binder composition in manner that was known to the skilled artisan at the time of filing the present application. As noted by Appellants, the Taylor reference cited by the Examiner evidences that one of ordinary skill in the art understands how to convert a polymer slurry into a fiberglass binder system. As has often been said, claim language is not to read in a vacuum but in light of the Specification as it would be interpreted by one of ordinary skill in the art. *In re Sneed*, 710 F.2d 1544, 1548 (Fed. Cir. 1983); *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971).

We now turn to the § 103 rejection of claims 25-33, 35-46, and 48-51 over Di Battista in view of Taylor. Di Battista, like Appellants, discloses a method of transporting resinous, viscous material from a storage tank through an unload line to a make up site, and providing heat to the storage tank and unload line to lower the viscosity of the resinous composition. As acknowledged by the Examiner, Di Battista does not specifically disclose that the resinous composition is a formaldehyde-free resin slurry for making a fiberglass binder composition. However, we concur with the Examiner that Taylor evidences the obviousness of using such formaldehyde-free resin slurries for making a fiberglass binder composition, and Appellants do not contest this point. Accordingly, we agree with the Examiner that it would have been *prima facie* obviousness for one of ordinary skill in the art to

transport Appellants' formaldehyde-free resin slurry in a system of the type disclosed by Di Battista.

As further acknowledged by the Examiner, Di Battista does not expressly disclose delivering the resin composition to the storage tank from vessel via another unload line. However, the Examiner has set forth a reasonable rationale that "Di Battista does not teach the insufficiently fluid material is fabricated in the storage tank, therefore one of ordinary skill in the art would have understood that resin present in Di Battista is delivered from **a source other than the storage tank of Di Battista**" (sentence bridging pages 7-8 of Answer). Indeed, we have no doubt that one of ordinary skill in the art would have found it obvious to prepare the resin composition in a vessel before supplying it via a heated unload line to the storage tank of Di Battista.

We are not persuaded by Appellants' argument that heating the transported slurry would have been unobvious to one of ordinary skill in the art because it is contrary to the accepted wisdom in the art. While the *HANDLING* publication cited by Appellants discloses that the **best way** to handle such slurries is to use more powerful pumps, such a reported preference does not render a non-preferred method unobvious. In our view, one of ordinary skill in the art would have found it obvious to weigh the advantages and disadvantages, including cost, of employing various known ways of transporting a resin slurry from a storage tank to a make up site. Significantly, De Battista evidences that heating the storage tank and unload line was a known way of making a resin slurry less viscous and easier to transport. It is well settled that non-preferred embodiments, as well as

preferred ones, must be taken into consideration in determining obviousness under § 103.

Regarding separately argued claim 52, Appellants contend that the claimed storage tank is not the same as the heated delivery receptacle disclosed by Di Battista. Appellants maintain that the receptacle of Di Battista is disclosed as having capacity of 18 gallons, which “is a far cry from a storage tank used in conjunction with the production of fiberglass binder composition [which] tanks typically have a volume of over 6500 gallons” (Page 16 of principal Brief, first paragraph). However, as properly explained by the Examiner, the appealed claims do not define a specific size for the storage tank and, therefore, Appellants’ arguments are not commensurate in scope with the degree of protection sought by the appealed claims. It is fundamental that limitations disclosed in the Specification are not to be read into the claims during ex parte prosecution. We find no structural distinction between storage tanks within the scope of the appealed claims and vessel 8 of De Battista.

As a final point, we note Appellants base no argument upon objective evidence of nonobviousness, such as unexpected results. For example, Appellants have not established on this record that their asserted proceeding contrary to the accepted wisdom in the art results in a process that does not experience the taught disadvantages, i.e., Appellants have not demonstrated that they have unexpectedly avoided any disadvantage taught by the prior art. By way of analogy, it is axiomatic that the omission of a feature disclosed by the prior art along with its attendant function is a matter of

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obviousness for one of ordinary skill in the art. *In re Kuhle*, 526 F.2d 553, 555 (CCPA 1975); *In re Marcocchi*, 456 F.2d 790, 793 (CCPA 1972).

In conclusion, based on the foregoing and the reasons well stated by the Examiner, the Examiner's rejection of the appealed claims under 35 U.S.C. § 103(a) is affirmed. The Examiner's § 112, second paragraph rejection is reversed. The Examiner's decision to reject the appeal claims is, accordingly, affirmed.

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).

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