

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LARRY J. GRANT and CLARKE BERDAN II

Appeal No. 1997-1491
Application 08/478,167

ON BRIEF

Before KIMLIN, JOHN D. SMITH and KRATZ, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 3-16, 19-25, 35 and 36. Claims 2, 17 and 18 stand objected to as being dependent upon a rejected claim. Claims 26-34, the other claims remaining in the present application, have been allowed by the examiner. Claim 1 is illustrative:

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1. An insulation of low dimensional stability blanket comprising at least one mineral fiber batt of low dimensional stability being comprised of a binderless fibrous material of substantially long fibers, said batt remaining uncut during its formation and shaping, said substantially long fibers enabling said batt to expand and conform its shape to an area into which said mineral fiber batt has been installed including abnormal voids in building spaces.

In the rejection of the appealed claims, the examiner relies

upon the following references:

Saborsky	2,160,001	May 30, 1939
Irwin et al. (Irwin)	3,338,777	Aug. 29, 1967
Sens	3,546,846	Dec. 15,
1970		

Appellants' claimed invention is directed to an insulation of low dimensional stability comprising mineral fiber batt of binderless, fibrous material having substantially long fibers. Independent claims 1 and 16 recite that the "batt remaining uncut during its formation and shaping." According to pages 9 and 10 of the present specification, the advantageous results of appellants' invention are obtained from a combination of two key features:
(1) binderless insulation that is capable of much greater

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movement than the more rigid bindered fibers, (2) the use of substantially long fibers.

Appealed claims 1, 3, 4 and 7 stand rejected under 37 U.S.C. § 102(b) as being anticipated by Saborsky. In addition, the appealed claims stand rejected under 35 U.S.C. § 103 as follows:

(1) claims 6, 8-13, 15 and 35 over Saborsky in view of Sens,

(2) claims 14-16, 19-25, 35 and 36 over Sens in view of Saborsky,

(3) claim 18 over Sens in view of Saborsky, and

(4) claim 5 over Saborsky in view of Irwin.

Appellants submit at page 5 of the brief that, with respect to the examiner's § 102 rejection over Saborsky, "claims 3-5 and 7 will stand or fall with claim 1." Also, appellants' have not set forth separate arguments for appealed claims 8, 11-14 and 19-24.

We consider first the examiner's rejection of claims 1,

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3, 4 and 7 under 35 U.S.C. § 102(b) as anticipated by Saborsky. As explained by the examiner, Saborsky discloses insulation comprising binderless, mineral fiber batt having substantially long fibers. Appellants' specification discloses that "long" fibers are longer than 2 inches, preferably 7 inches and more preferably 12 inches (specification page 10, lines 23-26). On the other hand, Saborsky discloses that "[i]n the formation of mats of this type, the fibers may be made long and fine, the actual length being of many inches, feet or even miles, in accordance with the conditions of operation" (page 2, column 1, lines 49-52, reference numeral omitted). Hence, since Saborsky discloses insulation of binderless fibrous material of substantially long fibers, we concur with the examiner that there is no patentable, structural distinction between the insulation of Saborsky and the claimed insulation wherein the batt remains uncut during its formation and shaping. Since the claim recitation "batt remaining uncut during its formation and shaping" is product-by-process in nature, it is

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appellants' burden to establish on this record that there is a patentable distinction between insulation within the scope of the appealed claims and the insulation of Saborsky that is cut into strips. However, appellants have not advanced any objective evidence or compelling line reasoning which establishes that there is a meaningful difference between cut and uncut insulation which both comprise binderless fibrous material of substantially long fibers. We find no factual support in the Saborsky

disclosure for appellants' argument that Saborsky's fibers are "long" only before they are cut (page 13 of brief).

Accordingly, we will sustain the examiner's rejection under 35 U.S.C. § 102.

We will also sustain the examiner's rejection of claim 6, 8-13, 15 and 35 under 35 U.S.C. § 103 over Saborsky in view of Sens for essentially those reasons expressed by the examiner. We agree with the examiner that it would have been a matter of obviousness for one of ordinary skill in the art to select the density of the insulation based upon its ultimate use.

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Furthermore, we find that Saborsky's disclosure bridging columns 1 and 2 at page 2 would have suggested a density of less than 0.6 p.c.f., particularly Saborsky's disclosure of extremely light density of about 1 pound per cubic ft.

Regarding appellants' exterior layer of polyethylene, in addition to the reference disclosures of Saborsky and Sens cited by the examiner, we note that appellants' specification acknowledges that it was known in the art to enclose a fiber batt with an exterior plastic covering (paragraph bridging pages 4 and 5). Also, while appellants maintain at page 12 of the brief that the references do not teach

the features of claims 6, 9-10, 15 and 35, appellants fail to present a substantive argument why such features would have been unobvious for one of ordinary skill in the art. See 37 CFR 1.192 (c)(8) iv.

As for the examiner's rejection of claims 14-16, 19-25, 35 and 36 under § 103 over Sens in view of Saborsky, appellants only make reference to claims 19, 20, 21-23, 25 and

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36 (paragraph bridging pages 13 and 14 of brief). Again, although appellants point out that the references do not teach the claimed features, appellants have not presented substantive arguments why the claimed features would have been unobvious to one of ordinary skill in the art. Also, from the Grouping of Claims set forth at page 5 of the brief, it can be seen that appellants have not separately grouped claims 19, 20 and 21-23. In any event, for the reasons given by the examiner, we find that the claimed features would have been obvious to one of ordinary skill in the art in view of the state of the prior art of record.

Concerning the new ground of rejection of claim 18 under § 103 over Sens in view of Saborsky, we agree with the examiner's

reasoning at pages 5 and 6 of the answer that the claimed subject matter would have been obvious to one of ordinary skill in the art in view of the collective teachings of the applied

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references.¹

Finally, we will sustain the examiner's new ground of rejection of claim 5 under § 103 over the collective teachings of Saborsky and Irwin. We find no error in the examiner's reasoning that, based on Irwin, it would have been obvious for one of ordinary skill in the art to use irregularly-shaped fibers in the insulation of Saborsky. Significantly, as noted above, appellants state at page 5 of the brief that claim 5 stands or falls together with claim 1, and appellants' brief does not present a separate argument for claim 5. Also, appellants have not responded to the examiner's new ground of rejection of claim 5. Furthermore, it would appear from page 11 of appellants' specification that irregularly-shaped glass fibers were known in the art at the time of filing the present application (see page 11, first paragraph).

As a final point, we note that appellants base no

¹ This new ground of rejection changed the status of claim 18, which was objected to by the examiner. Appellants have not responded to this rejection.

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argument upon objective evidence of nonobviousness, such as unexpected results.

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is affirmed.

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

AFFIRMED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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JOHN D. SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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)	
PETER F. KRATZ)	
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