

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES B. SCOTT

Appeal No. 98-0605
Application 08/383,191¹

ON BRIEF

Before CALVERT, COHEN and MEISTER, **Administrative Patent Judges**.

MEISTER, **Administrative Patent Judge**.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-12, 14, 16, 19, 20 and 27.² Claims 13, 15, 17 and 18 have

¹ Application for patent filed February 3, 1995.

² Claims 1, 16 and 27 have been amended subsequent to final rejection by an amendment filed on November 5, 1996 (Paper No. 13). Although the examiner has indicated that this amendment "has been entered" (see answer, page 2), we note that no clerical entry thereof has in fact been made.

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been indicated as being allowable subject to the requirement that they be rewritten to include all the subject matter of the claims from which they depend. Claims 21-26, the only other claims present in the application, stand withdrawn from further consideration under the provisions of 37 CFR § 1.142(b) as being directed to a nonelected invention.

The appellant's invention is directed to a method and apparatus for renewing a roof system. Independent claims 1, 16 and 27 are further illustrative of the appealed subject matter and copies thereof may be found in the appendix to the appellant's brief.

The references relied on by the examiner are:

Ohlsson	3,633,659	Jan. 11, 1972
Whitman	5,176,316	Jan. 5, 1993
Pigg 1996	5,487,247	Jan. 30,

(Filed June 11, 1994)

Claims 1-3, 5, 7-10, 16, 19, 20 and 27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Whitman.

Claims 4, 6 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Whitman in view of Ohlsson.

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Claims 11 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Whitman in view of Pigg.

The examiner's rejections are explained on pages 2-4 of the final rejection. The arguments of the appellant and examiner in support of their respective positions may be found on pages 5-13 of the brief, pages 1-6 of the reply brief and pages 4-8 of the answer.

OPINION

Having carefully considered the respective positions advanced by the appellant in the brief and reply brief and the examiner in the answer, it is our conclusion that none of the above-noted rejections are sustainable.

Considering first the rejection of claims 1-3, 5, 7-10, 16, 19, 20 and 27 under 35 U.S.C. § 102(b) as being anticipated by Whitman, we initially note that in order to establish anticipation, a prior art reference must disclose every feature of the claimed invention, either explicitly or inherently. **See *In re Schreiber***, 128 F.3d 1473, 1477, 44

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USPQ2d 1429, 1431 (Fed. Cir. 1997) and *Hazani v. Int'l Trade Comm'n*, 126 F.3d 1473, 1477,

44 USPQ2d 1358, 1361 (Fed. Cir. 1997). Here, the apparatus claims (independent claims 1 and 16) and the method claim (independent claim 27) require that the apparatus for, or step of, blowing air (1) be "substantially free of conduits which are internal to the roof system" and (2) that "substantially all" of the quantity of the blown air be forced "directly into the roof system at a location in the roof system immediately adjacent either "the exhaust port seal" (claim 1), "the housing seal" (claim 16) or the "the area from which insulation was removed" (claim 27). With respect to these limitations it is the examiner's position that:

If one of ordinary skill in the art of roof renewal, were to take away the conduits of Whitman, one would expect the same results as in amended claim 1. Furthermore, figure 3 of Whitman shows that substantially all of the quantity of air forced into the roof system passes directly into the roof system at a location in the roof system immediately adjacent the exhaust port seal. Therefore the features of "substantially free of conduits" and "substantially all of the air passes directly to the roof system" are anticipated by Whitman. (Answer, page 6).

We are at a loss to understand the examiner's position.

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If the artisan were to "take away" the conduits of Whitman as the examiner suggests, a **modification** of Whitman's apparatus and method would result. Thus, Whitman cannot be considered to either explicitly or inherently disclose such an arrangement.

As to the examiner's reliance upon Fig. 3 of Whitman, even if we were to agree with the examiner that substantially all of the quantity of air passes directly into the roof system at a location immediately adjacent either "the exhaust port seal" (claim 1), "the housing seal" (claim 16) or the "the area from which insulation was removed" (claim 27), Fig. 3 plainly shows conduits 400 extending into the roof system. Thus, Whitman cannot be considered to teach a method and apparatus which are "substantially free of conduits internal to the roof system" as claimed.

Since each and every feature set forth in independent claims 1, 16 and 27 cannot be found either explicitly or inherently in Whitman, we will not sustain the rejection of claims 1-3, 5, 7-10, 16, 19, 20 and 27 under 35 U.S.C. § 102(b) based on this reference.

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Turning to the rejections under 35 U.S.C. § 103 of claims 4, 6 and 14 as being unpatentable over Whitman in view of Ohlsson and claims 11 and 12 as being unpatentable over Whitman in view of Pigg, we have carefully reviewed the teachings of Ohlsson and Pigg but find nothing therein which would overcome the above-noted deficiencies in the examiner's position in regard to the teachings of Whitman. This being the case, we will not sustain the rejections under 35 U.S.C. § 103 of claims 4, 6 and 14 based on the combined teachings of Whitman and Ohlsson and of claims 11 and 12 based on the combined teachings of Whitman and Pigg.

Under the provisions of 37 CFR § 1.196(b)³ we make the following new rejections.

Claims 1-20 and 27 are rejected under 35 U.S.C. § 112, first paragraph, as being based upon an original disclosure which fails to provide descriptive support for the subject matter now being claimed. We initially observe that the description requirement found in the first paragraph of 35 U.S.C. § 112 is separate from the enablement requirement of

³ Revised as of December 1, 1997.

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that provision. **See Vas-Cath, Inc. v. Mahurkar**, 935 F.2d 1555, 1560-64, 19 USPQ2d 1111, 1114-17 (Fed. Cir. 1991) and **In re Barker**, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977), **cert. denied**, 434 U.S. 1238 (1978). With respect to the description requirement, the court in **Vas-Cath, Inc. v. Mahurkar** at 935 F.2d 1563-64, 19 USPQ2d 1117 stated:

35 USC 112, first paragraph, requires a "written description of the invention" which is separate and distinct from the enablement requirement. The purpose of the "written description" requirement is broader than to merely explain how to "make and use"; the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession **of the invention**. The invention is, for purposes of the "written description" inquiry, **whatever is now claimed**.

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

It is also well settled that the question of whether a modification is an obvious variant of that which is originally disclosed is irrelevant insofar as the written description requirement is concerned. **See, e.g., Lockwood v. American Airlines Inc.**, 107 F.3d 1565, 1571-72, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997) and **In re Wohnsiedler**, 315 F.2d 934, 937, 137

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USPQ 336, 339 (CCPA 1963). See also *In re Barker*, 559 F.2d at 593, 194 USPQ at 474, wherein the court, in quoting with approval from *In re Winkhaus*, 527 F.2d 637, 640, 188 USPQ 129, 131 (CCPA 1975) set forth: "That a person skilled in the art might realize from reading the disclosure that such a step is **possible** is not a sufficient indication to that person that the step is part of appellants' invention." Moreover, negative limitations which do not appear in the specification as filed, may introduce new concepts and hence violate the description requirement of the first paragraph of § 112. *Ex parte Grasselli*, 231 USPQ 393, 394 (Bd. App. 1983), *aff'd. mem.*, 738 F.2d 453 (Fed. Cir. 1984).

With these authorities in mind, we have carefully reviewed the original disclosure and fail to find descriptive support therein for the recitations in independent claims 1, 16 and 27 that apparatus for, or step of, blowing air (1) be "**substantially** free of conduits which are internal to the roof system" (emphasis ours) and (2) that "**substantially** all" (emphasis ours) of the quantity of the blown air be forced "directly into the roof system." By setting forth

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"substantially" in recitation (1), the appellant implies the permissible inclusion of **some** conduits in the roof system. Similarly, with respect to recitation (2), the appellant implies the permissible exclusion of **some** of the air being forced directly into the roof system. Clearly, there is no descriptive support in the original disclosure for the inclusion of some conduits in the roof system and the exclusion of some of the air being forced directly into the roof system. According to the original disclosure, there are **no** conduits in the roof system and **all** of the air is forced directly into the roof system.

With respect to independent claim 1, there is additionally no descriptive support for the recitation of "the blower having a seal" (line 10) or "the exhaust port seal" (line 22). According to the original disclosure, the blower 14 and housing 12 are separate, distinct elements (see specification, page 1; Figs. 1 and 2) and the "seal" is effected by "flashing 84 which is bonded to the lower edges of the housing 12 and extends beneath the covering 36 adjacent the housing . . ." (specification, page 12, lines 4-6). Thus,

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the seal is between the housing 12 and the covering 36 and there is no descriptive support for the limitations of "the blower having a seal" and "the exhaust port seal."

Claims 1-20 and 27 are rejected under 35 U.S.C. § 112, second paragraph. In order to satisfy the requirements of the second paragraph of § 112, a claim must accurately define the invention in the technical sense. *See In re Knowlton*, 481 F.2d 1357, 1366, 178 USPQ 486, 492-93 (CCPA 1973). Here, independent claims 1, 16 and 27 do not accurately define the invention in the technical sense since, as we have noted above with respect to the rejection under the first paragraph of § 112, there are **no** conduits in the roof system (rather than the roof system being "substantially free" from conduits) and **all** (rather than "substantially all") of the air is forced directly into the roof system.

As we have also noted above with respect to the rejection of claims 1-15 under the first paragraph of § 112, the seal is between the housing 12 and the covering 36, rather than "the blower having a seal" and an "exhaust port seal" as set forth

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in independent claim 1. We also observe that in line 22 of independent claim 1, "the exhaust port seal" has no clear antecedent basis.

Claims 1-10, 16, 19 and 20 are rejected under 35 U.S.C. § 103 as being unpatentable over Whitman.⁴ Initially, we note that all of the disclosures in a reference must be evaluated for what they fairly teach one having ordinary skill in the art (*In re Boe*, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966)) and, in evaluating such references, it is proper to take into account not only the specific teachings of the references, but also the inferences which one skilled in the art would reasonably be expected to draw therefrom (*In re Preda*, 401 F.2d 825, 826,

⁴ In rejecting independent claim 1 (and the claims which depend therefrom) under § 103, we base our understanding of the subject matter set forth in independent claim 1 upon the following interpretation of the terminology appearing therein. In line 10 (as it appears in the appendix to the brief) we interpret "the blower having a seal" to be -- a housing surrounding the blower and the housing having a seal --. Additionally, in line 22, we interpret "the exhaust port seal" to be -- the housing seal --.

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159 USPQ 342, 344 (CCPA 1968)). Moreover, the issue of obviousness is not only determined by what the references expressly state, but also is determined by what they would fairly suggest to those of ordinary skill in the art. **See, e.g., *In re Delisle***, 406 F.2d 1386, 1389, 160 USPQ 806, 808-09 (CCPA 1969) and ***In re Bozek***, 416 F.2d 1385, 1390, 163 USPQ 545, 549-50 (CCPA 1969).

Whitman discloses a method and apparatus for renewing or drying a roof system (column 1, lines 66-68) having a deck 30, insulation material 25 and a roof covering comprising a rubber sheath 10 (column 3, lines 54 and 55). To this end, Whitman provides a housing (elements 100,105 - see Fig. 3), a blower fan 120 for exhausting substantially all of the air blown thereby into the roof system between the roof covering and the insulation, and vents 800A-D. Viewing Figs. 3 and 7, and taking into consideration the nature of Whitman's method and apparatus, the artisan would reasonably infer that the roof covering 10 is sealed to the housing 100,105. The method and apparatus of Whitman are not "substantially free of conduits which are internal to the roof system" as claimed. However,

in discussing the prior art, Whitman states that it is known to provide "simple ventilating systems that do nothing more than direct air currents over a portion of the insulation layer" (column 1, lines 37 and 38). In light of this prior art teaching, the artisan would have found it obvious as a matter of "common sense" (*see In re Bozek, supra*) to omit the conduits in the method and apparatus of Whitman (where the size and nature of the roof permits) in order to achieve the advantage of simplicity as taught by the prior art.

Claim 14 is rejected under 35 U.S.C. § 103 as being unpatentable over Whitman in view of Ohlsson. Whitman does not teach a heater for heating the quantity of air that is forced into the roof system. Ohlsson, however, teaches that in roof ventilating systems the air being circulated should be heated for the "reason it has a low relative moisture content" (column 2, lines 15 and 16). Notwithstanding the appellant's arguments that the teachings of Ohlsson are only applicable to "new" roof construction as opposed to "renewing" roofs, we are of the opinion that a combined consideration of Whitman and Ohlsson would have fairly suggested to one of ordinary skill in this art to provide the method and apparatus of Whitman

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with a heater as taught by Ohlsson in order to achieve Ohlsson's expressly stated advantage of providing air with a "low relative moisture content."

In summary:

The rejection of claims 1-3, 5, 7-10, 16, 19, 20 and 27 under 35 U.S.C. § 102(b) as being anticipated by Whitman is reversed.

New rejections of claims 1-20 and 27 under 35 U.S.C. § 112, first and second paragraphs, have been made.

New rejections of claims 1-10, 14, 16, 19 and 20 under 35 U.S.C. § 103 have been made.

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR

§ 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, ***WITHIN TWO MONTHS FROM THE DATE OF THE DECISION***, must exercise one of the following two options with respect to the new

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grounds of rejection to avoid termination of proceedings

(§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

REVERSED
37 CFR § 1.196(b)

	IAN A. CALVERT)	
	Administrative Patent Judge)	
)	
)	
	IRWIN CHARLES COHEN)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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