

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD J. SMITH

Appeal No. 2000-0165
Application No. 08/783,693

ON BRIEF

Before HAIRSTON, BARRETT, and GROSS, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 2, 4 through 15, 17 through 19 and 21 through 37.

The disclosed invention relates to a composite for forming a fluid-tight seal between two separate objects. The composite comprises a substantially non-adhesive, resilient and yieldable sealant, and an adhesive non-releasably adhering to and in combination with the sealant.

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Claims 1 and 5 are illustrative of the claimed invention,
and they read as follows:

1. A composite for forming a fluid-tight seal between two separate objects when said objects are joined into a protective closure and also for allowing said protective closure to be readily and repeatedly disassembled into said two separate objects, said composite comprising:

a. a substantially non-adhesive, resilient and yieldable sealant; and

b. an adhesive non-releasably adhering to and in combination with said sealant; the adhesive contacting and adhering to only the sealing interfaces of one of the two objects at the time of installation with the non-adhesive sealant contacting the sealing interfaces of the other of the two objects, so that when the two objects are joined to form the protective closure the composite sealant forms a fluid-tight seal between them while allowing the protective closure to be readily and repeatedly disassembled into said two separate objects and reassembled back into said fluid-tight protective closure.

5. A process for making a composite for forming a fluid-tight seal between two separate objects when said objects are joined into a protective closure and also for allowing said protective closure to be readily disassembled into said two separate objects, said process comprising the steps of:

a. selecting a substantially non-adhesive, resilient and yieldable sealant;

b. selecting an adhesive; and

c. non-releasably connecting together said

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yieldable sealant and said adhesive to form said
composite.

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The references relied on by the examiner are:

Smith	3,337,681	Aug. 22, 1967
Beinhaur	4,451,696	May 29, 1984
Hasan	5,711,116	Jan. 27, 1998

(filed Aug. 14,
1995)

Claims 1, 2, 4 through 15, 17 through 19, 21 through 29, 31, 32 and 34 through 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of Hasan.

Claims 30 and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of Hasan and Beinhaur.

Reference is made to the briefs (paper numbers 18 and 20) and the answer (paper number 19) for the respective positions of the appellant and the examiner.

OPINION

We have carefully considered the entire record before us, and we will reverse the obviousness rejection of claims 1, 2, 4 and 28 through 30, and sustain the obviousness rejection of claims 5 through 15, 17 through 19, 21 through 27 and 31 through 37.

In the obviousness rejection of claims 1, 2, 4 through 15, 17 through 19, 21 through 29, 31, 32 and 34 through 37,

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the reference to Hasan was combined with the teachings of Smith because of the lack of a separator located on the adhesive in Smith. Since none of the independent claims on appeal claims a separator located on an adhesive, it follows that the examiner implicitly considered all of the limitations of each of the independent claims on appeal to be found in Smith. With the exception of independent claim 1, and the claims that depend therefrom, we agree with the examiner that all of the limitations of each of the independent claims on appeal would have been obvious over the sole teachings of Smith.

The 35 U.S.C. § 103(a) rejection of claim 1 is reversed because the adhesive in Smith is located over the entire inner surface and the flange of each of the tubular members 14, and is not "contacting and adhering to only the sealing interfaces" between the two separate objects (brief, pages 3 and 4) (emphasis added). The 35 U.S.C. § 103(a) rejection of claims 2, 4 and 28 through 30 is likewise reversed because the teachings of Hasan and Beinhaur do not cure the noted shortcoming in the teachings of Smith.

Inasmuch as the placement of the composite in the

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remainder of the independent claims on appeal is not limited to "only" the sealing interfaces between the two separate objects, we find that independent claims 5, 7, 11, 15, 19, 23 and 27 read on the teachings of Smith. Appellant's arguments (brief, pages 3 and 4; reply brief, page 1) to the contrary notwithstanding, the noted independent claims on appeal do not preclude forming the composite of the adhesive and the sealant "at the factory" as opposed to at a "repair" site. Stated differently, the referenced claims are not limited to a "repair" process after disassembly of the protective closure. Thus, the 35 U.S.C.

§ 103(a) rejection of independent claims 5, 7, 11, 15, 19, 23 and 27 is sustained. In a multiple reference rejection under 35 U.S.C. § 103(a), the Board may rely on one reference alone without designating it as a new ground of rejection. In re Bush, 296 F.2d 491, 496, 131 USPQ 263, 266-67 (CCPA 1961); In re Boyer, 363 F.2d 455, 458 n.2, 150 USPQ 441, 444 n.2 (CCPA 1966). In view of the lack of separate patentability arguments for the claims that depend from these independent claims, the 35 U.S.C.

§ 103(a) rejection of dependent claims 6, 8 through 10, 12

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through 14, 17, 18, 21, 22, 24 through 26 and 31 through 37 is
sustained.

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DECISION

The decision of the examiner rejecting claims 1, 2, 4 through 15, 17 through 19 and 21 through 37 under 35 U.S.C. § 103(a) is affirmed as to claims 5 through 15, 17 through 19, 21 through 27 and 31 through 37, and is reversed as to claims 1, 2, 4 and 28 through 30. Accordingly, the decision of the examiner is affirmed-in-part.

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

AFFIRMED-IN-PART

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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KWH:hh

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