

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL J. BELANGER

Appeal No. 2002-1002
Application No. 08/820,506

ON BRIEF

Before WILLIAM F. SMITH, KRATZ and POTEATE, Administrative Patent Judges.

POTEATE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 14-19, which are all of the claims pending in the application.

Claims 14 and 16 are representative of the subject matter on appeal and are reproduced below:

14. A surface contacting element for use in constructing a vehicle laundry implement comprising first and second parallel and substantially uniform layers of physically integrated non-woven fibrous cloth-like material of contrasting colors made according to the process which comprises the steps of:

(a) providing a first quantity of fibrous non-woven material of a first color;

(b) providing a second quantity of fibrous material of a second contrasting color;

(c) needle punching the first and second quantities for a sufficient time to create physically but non-adhesively integrated sheet-like layers of readily distinguishable contrasting colors; and

(d) cutting the resulting integrated material into a desired shape for use in the manner set forth above.

16. A multiple layer, pliable, sheet-like carwash brush element comprising at least first and second layers of contrasting colors which are non-adhesively integrated by needle punching to create an essentially unitary structure while preserving the distinct colors of said layers;

said body¹ having at least one attachment structure formed therein.

The references relied upon by the examiner are:

McCord	3,725,166	Apr. 13, 1970
Pecora	4,377,878	Mar. 29, 1983
Lochner	3,705,064	Dec. 05, 1972

¹Appellant may wish to amend this claim to provide antecedent basis for the term "body", which also appears in dependent claim 17.

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Grounds of Rejection

1. Claim 14 stands rejected under 35 U.S.C. § 102(b) as anticipated by McCord.

We affirm.

2. Claims 14 and 16 stand rejected under 35 U.S.C. § 103 as unpatentable over McCord.

We affirm as to claim 14 and reverse as to claim 16.

3. Claim 17 stand rejected under 35 U.S.C. § 103 as unpatentable over McCord in view of Pecora.

We reverse.

4. Claims 14-16 and 18-19 stand rejected under 35 U.S.C. § 103 as unpatentable over Lochner.

We affirm as to claim 14 and reverse as to claims 15, 16, 18 and 19.

Background

The invention relates to a car washing element of the type used in circular and cylindrical brushes as well as hanging strip "Mitter Curtain" devices. Appeal brief², page 1, Summary of the Invention. According to appellant, "[t]he claimed device is distinguished from all other car wash elements by the fact that

² All references herein refer to appellants' twice amended Appeal brief, paper no. 24, filed March 21, 2001.

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it comprises layers 22, 24 and 26 of different colors. . . .
Cutting the element from the material after it is formed by
needle punching, exposes the intermediate layer 26 as a
peripheral edge stripe.” Id., page 2.

Discussion

1. Rejection of claim 14 under 35 U.S.C. § 102 as anticipated by McCord.

According to appellant, “[p]atentability in this case is a question of whether the preamble recitations are mere statements of intended use or are legitimate limitations.” Id., page 3. The language of a preamble is considered a claim limitation if it is “necessary to give life, meaning and vitality” to the claim. Pitney Bowes v. Hewlett Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999).

The examiner takes the position that the claim 14 preamble language is merely a recitation of intended use and does not recite a structural difference between the claimed invention and the prior art. Examiner’s answer, page 7, last paragraph. In general, a statement of intended use or purpose will not limit the scope of the claim since such statement merely defines the context in which the invention operates. Rowe v. Dror, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997).

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Appellant maintains that the claim 14 preamble "define[s] the essential character of the invention." Appeal brief, page 4. Specifically, the language limits claim 14 to "the car wash implement art" and because of the preamble, claim 14 does not read on the construction of outdoor carpeting or any other devices in non-analogous art. Reply brief, paper no. 29, received July 31, 2001, page 1. Appellant argues that there is little question that the preamble would be considered a limitation in any litigation. See Appeal brief, page 5, first paragraph.

We are in agreement with the examiner that the preamble does not limit the scope of claim 14. It is well established that during prosecution, claims are given the broadest reasonable interpretation possible, consistent with the specification. In re Yamamoto, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984). The body of claim 14 defines a complete method of making a surface contact element, such that the preamble language "for use in . . ." is not necessary to give meaning to the claim. See Rowe, 112 F.2d at 478, 42 USPQ2d at 1553 (preamble is not a limitation where the body defines the complete subject matter of the claimed invention).

Appellants do not dispute the examiner's findings that

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McCord teaches the invention as claimed with the exception of the preamble language (see, e.g., Appeal brief, page 3, first paragraph and Reply brief, page 1, second paragraph).

Accordingly, the rejection of claim 14 under 35 U.S.C. § 102 as anticipated by McCord is affirmed.

2. The rejection of claims 14 and 16 under 35 U.S.C. § 103 as unpatentable over McCord.

Claim 14

Having found that claim 14 is anticipated by McCord, the claim is also necessarily obvious. See In re Baxter Travenol Labs., 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991). Accordingly, the rejection is affirmed as to claim 14.

Claim 16

Turning to claim 16, the examiner found that McCord differs from the claimed invention because the reference does not disclose incorporating an attachment structure within the disclosed nonwoven. According to the examiner, "[o]ne of ordinary skill in the art would have been motivated to incorporate an attachment structure such as an opening in order to allow the nonwoven to be fitted into a particularly shaped space." Examiner's answer, page 4.

The initial burden of presenting a prima facie case of obviousness rests on the examiner. In re Oetiker, 977 F.2d 1443,

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1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In order to establish a prima facie case of obviousness, the examiner must identify a showing of suggestion or motivation to modify the teachings of the references to achieve the claimed invention. In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). While the suggestion or motivation to modify may be implicit from the prior art rather than expressly stated, the examiner must still provide reasons for finding a limitation to be taught or suggested in the references. Id.

As pointed out by appellant, the examiner has failed to identify (see Reply brief, page 3, third paragraph) and we do not find any disclosure in McCord relating to an attachment structure. Rather, it is readily apparent that the examiner's conclusion that it would have been obvious to have incorporated an attachment structure into McCord's nonwoven material can only be based upon improper hindsight reasoning. See W. L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrom wherein only that which the inventor taught is

used against its teacher.”) Accordingly, the rejection of claim 16 under 35 U.S.C. § 103 as unpatentable over McCord is reversed.

3. The rejection of claim 17 under 35 U.S.C. § 103 as unpatentable over McCord and further in view of Pecora.

Claim 17 depends from claim 16 and recites the additional limitation that the carwash brush element is partially divided into a plurality of parallel strip like fingers. The examiner relies on Pecora as teaching that the edges of a nonwoven material may be slit in order to form a plurality of fingers which enable the material to be used for cleaning. According to the examiner, one of ordinary skill in the art would have been motivated to slit the edges of McCord’s material in view of the teachings of Pecora in order to allow McCord’s material to be used for cleaning. Examiner’s answer, page 5.

As pointed out by appellant, the examiner fails to establish that the proposed combination teaches or suggests incorporating an attachment structure in McCord’s material as discussed above in connection with claim 16. See, supra, pages 6-8; Reply brief, page 4, issue III. Moreover, we note that the examiner has failed to establish the requisite motivation for combining the teachings of McCord and Pecora. McCord is directed to a method of making reversible, nonwoven material, in particular, carpet backing. See, e.g., column 1, lines 23-25. In contrast, Pecora is directed to a vehicle finishing device. The stated rejection

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fails to establish why one of ordinary skill in the art, in considering the McCord patent, would have been motivated to look to the teachings of Pecora which is directed to an entirely different application.

Accordingly, we conclude that the examiner has failed to establish a prima facie case of obviousness and the rejection of claim 17 as unpatentable over McCord in view of Pecora is reversed.

4. The rejection of claims 14-16, 18 and 19 under 35 U.S.C. § 103 as unpatentable over Lochner.

Claim 14

Similar to the traversal of the examiner's rejection based on McCord, appellant's arguments are limited to his contention that the preamble constitutes a claim limitation. For the reasons set forth above, we have concluded that the preamble of claim 14 does not limit the scope of the claim. Therefore, we are in agreement with the examiner that Lochner renders obvious claim 14 for the reasons set forth in the Examiner's answer (see page 5). Accordingly, the rejection of claim 14 as unpatentable over Lochner is affirmed.

Claim 15

Claim 15 requires that the claimed three layer pliable sheet like vehicle laundry element is made by cutting a sheet like body into a desired shape of the element to expose "the distinct color

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of the intermediate layer as an edge stripe." Claim 15, step e. The examiner found that "since the Lochner material has the same structure as the claimed material, presumably the Lochner [sic, material] would inherently exhibit a central intermediate layer which would show up as a stripe." Examiner's answer, page 6. We disagree.

Inherency requires that the missing descriptive material is necessarily present not merely probably or possibly present in the prior art. Trintec Indus. Inc. vs. Top-USA Corp., 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002). Lochner teaches a method wherein three fabric webs are joined by needling. See example 1. One of the webs is patterned. However, there is no indication in the reference that the intermediate layer would necessarily have a distinct color which appears as an edge stripe. Thus, we cannot agree with the examiner's conclusion that Lochner's material would inherently exhibit a central intermediate layer which would show up as a stripe.

Accordingly, the rejection is reversed as to claim 15.

Claims 16, 18 and 19

Each of claims 16, 18 and 19 includes the requirement that the claimed element includes attachment means formed therein. The examiner concedes that Lochner does not teach incorporating

an attachment structure into the nonwoven. See Examiner's answer, page 7. However, the examiner maintains that "[o]ne of ordinary skill in the art would have been motivated to incorporate the attachment structure such as an opening in order to allow the nonwoven to be fitted into a particularly shaped space."

In order to establish a prima facie case of obviousness, the examiner must make "particular findings . . . as to the reasons a skilled artisan with no knowledge of the claimed invention" would have made the proposed modification to the prior art to achieve the claimed invention. In re Kotzab, 217 F.3d at 1371, 55 USPQ2d at 1317. The examiner has again failed to make the requisite findings in support of his position that one of ordinary skill in the art would have been motivated to modify Lochner to include an attachment structure. See, supra, pages 6-8. Accordingly, the rejection of claims 16, 18 and 19 as unpatentable over Lochner is reversed.

In sum, the rejections of claim 14 as anticipated by McCord and as unpatentable over McCord and Lochner are affirmed. The rejection of claim 16 as unpatentable over McCord is reversed. The rejection of claim 17 as unpatentable over McCord in view of Pecora is reversed. The rejection of claims 15, 16 and 18-19 as unpatentable over Lochner is reversed.

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Time Period for Response

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

WILLIAM F. SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
PETER F. KRATZ)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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