

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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte R. BRENT WILLIAMS, KENNETH L. WHITE  
and GREGORY L. CLARK

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Appeal No. 2002-2271  
Application No. 09/304,019

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ON BRIEF

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Before ABRAMS, STAAB, and NASE, Administrative Patent Judges.  
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 5, 8, 9, 12, 13, 16 and 19, which are all of the claims pending in this application.

BACKGROUND

The appellants' invention relates to a material for sealing around electrical conductors passing into a housing (claims 1, 2 and 5) and to a method for sealing around such conductors or conduits (claims 8, 9, 12, 13, 16 and 19). An understanding of the invention can be derived from a reading of exemplary claim 1, which has been reproduced below.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Isgur <u>et al.</u> (Isgur)	4,182,649	Jan. 8, 1980
Lux, Jr.	4,267,399	May 12, 1981

Claims 1, 2, 5, 8, 9, 12, 13, 16 and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lux in view of Isgur.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the Answer (Paper No. 18) and the final rejection (Paper No. 15) for the examiner's complete reasoning in support of the rejection, and to the Brief (Paper No. 17) and Reply Brief (Paper No. 19) for the appellants' arguments thereagainst.

respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The problem to which the appellants have directed their inventive efforts is preventing insects from entering housings such as those containing transformers through openings in the base that accommodate electrical conductors or conduits. The appellants' invention is directed generally to a sealant for sealing around the electrical conductors or conduits that extend into a housing through an opening in a pad, and more particularly to a foam sealing material comprising a contact insecticide and a fire retardant dispersed therein.

The invention is set forth in claim 1 in the following manner:

1. A sealant for sealing around one or more electrical conductors or conduits extending into a housing through an opening in a pad, comprising:

a foam sealing material which expands in an unset state and which is flexible in a final set state, the foam being suitable for being positioned in the pad opening and sealing around a perimeter of the pad opening and around the conductors or conduits extending through the pad opening into the housing;

a contact insecticide dispersed in the flexible foam sealing material for killing insects attempting to enter the housing, wherein the insecticide is selected from the group consisting of acephate, carbaryl, pyrenone,

All of the claims stand rejected as being unpatentable over Lux in view of Isgur. Looking first to claim 1, it is the examiner's view that Lux discloses all of the subject matter except for the foam sealing material with the insecticide and fire retardant dispersed therein. However, the examiner has taken the position that it would have been obvious to provide the Lux system with such a foam in view of the teachings of Isgur. The examiner admits that Isgur does not suggest the claimed insecticides, but takes Official Notice that they are old and well known, and concludes that it therefore would have been obvious to incorporate them into the Isgur product.

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from

Applying this guidance of our reviewing court to the situation at hand, we find ourselves in agreement with the appellants that the combined teachings of Lux and Isgur fail to establish a prima facie case of obviousness with regard to the subject matter recited in claim 1 or in the other claims on appeal, and we therefore will not sustain the rejection. Our reasoning follows.

Lux discloses a transformer housing 16 mounted on a pad 10 through which there is a cable opening 20. The problem to which this invention is directed is protecting the cables that extend through the opening from being contacted by objects inserted beneath the bottom edge of the housing (column 1, lines 25-34). Lux accomplishes this by installing a sleeve 12 in opening 20. The sleeve extends above the surface of the pad, and includes a lip extending around its upper edge, as is shown in Figures 2 and 3. The sleeve and the lip act to prevent objects inserted under the edge of the housing from being pushed into contact with the cables. The examiner points out that the reference teaches that the transformer pad can be formed of a shell filled with foam plastic. However, absent from Lux is any teaching of closing the opening in the sleeve around the cables by any means, much less a foam sealing material containing an insecticide and a fire retardant.

teaching that it is flexible in its final set state, as is required by claim 1, or that it is suitable for being positioned in an opening to seal around objects extending therethrough. Isgur does, however, teach that flame retardants and insecticides may be combined into the sheet (column 6, lines 9-14).

We fail to perceive any teaching, suggestion or incentive in either Lux or Isgur which would have led one of ordinary skill in the art to place sealing material in the opening in the Lux protective sleeve, much less a sealing material having the features recited in claim 1. Neither reference recognizes the problem solved by the appellants. Neither reference teaches the use of the claimed foamed material. The examiner's reliance upon the teaching in Lux that the pad is of foamed material as a suggestion that a foamed material be placed in the opening of the sleeve is misplaced, and even if some credence were to be accorded to that theory, the composite sheet disclosed by Isgur does not meet the requirements in the claim for the foamed sealing material. Finally, the fact that insecticides and flame retardants are among a number of additives mentioned by Isgur as being suitable to add to the foamed sheet would not, in our view, have suggested to one of ordinary skill in the art that these two particular additives be placed in a foamed sealing material used to close the opening in the base of a

discussed above with regard to claim 1. In addition, these method claims recite steps for making the material, and the examiner has not pointed out where the claimed steps are disclosed or taught by the references. We have not found them in our own inspection of the references.



The decision of the examiner is reversed.

NEAL E. ABRAMS  
Administrative Patent Judge

LAWRENCE J. STAAB  
Administrative Patent Judge

JEFFREY V. NASE  
Administrative Patent Judge

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APPEAL NO. 2002-2271 - JUDGE ABRAMS  
APPLICATION NO. 09/304,019

APJ ABRAMS

APJ NASE

APJ STAAB

DECISION: **REVERSED**

Prepared By: LESLEY BROOKS

GAU: 3600

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**DRAFT TYPED:** 28 Jan 04

**FINAL TYPED:**