

**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(2) is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** RICHARD J. MORRIS

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Appeal No. 96-3771  
Application 08/127,005<sup>1</sup>

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ON BRIEF

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

MEISTER, **Administrative Patent Judge**.

**DECISION ON APPEAL**

Richard J. Morris (the appellant) appeals from the final rejection of claims 2-5 and 11. Claims 6-10, the only other claims remaining in the application, have been indicated as being allowable subject to the requirement that they be

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<sup>1</sup> Application for patent filed September 24, 1993.

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rewritten to include all the subject matter of the claims from which they depend.

We AFFIRM.

The appellant's invention pertains to the combination of an air deflector and a roof ventilator system. Independent claim 5 is further illustrative of the appealed subject matter, a copy of which may be found in the appendix to the supplemental brief.

The references relied on by the examiner are:<sup>2</sup>

Smith	3,185,070	May 25, 1965
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<sup>2</sup> The examiner's answer failed to include a listing of the prior art being relied on as expressly required by the **Manual of Patent Examining Procedure (MPEP)** § 1208 (6th ed., Rev. 3, Jul. 1997). Although the final rejection (to which the answer refers for a statement of the rejection) sets forth the ground of rejection as Waggoner in view of Smith, there are two patents to "Smith" of record, thus leaving doubt as to which "Smith" patent is being relied on. The appellant, however, on page 2 of the supplemental brief under the heading of "ISSUES" states that the principal issue on appeal is whether the claims on appeal are unpatentable over "U.S. Patent No. 5,022,146 to Waggoner in view of U.S. Patent No. 3,185,070 to Smith," and the examiner on page 2 of the answer states that "[t]he appellant's statement of the issues in the brief is correct." Accordingly, we presume that the "Smith" reference being relied on is Patent No. 3,185,070.



The examiner's rejection is explained on page 2 of the final rejection. The arguments of the appellant and examiner in support of their respective positions may be found on pages 3-5 of the supplemental brief<sup>3</sup> and pages 3-5 answer.

#### **OPINION**

As a preliminary matter, we base our interpretation of the appealed subject matter upon the following interpretation of the terminology appearing in the claims. In line 1 of claim 5 we interpret "[a]n air deflector and roof ventilator system" to be --a roof ventilator system-- inasmuch as line 2 of this claim further recites that the **system** comprises "an **air deflector** and a roof ventilator" (emphasis ours). Similarly, in line 1 of claims 2-4 and 11 we interpret "[t]he air deflector" to be --the roof ventilator system--.

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<sup>3</sup> In passing, we note that page 4 of the supplemental brief refers to a rejection of "claims 1-19 under § 102(b) and § 103 based upon Brown '549, Orr '760, Radencic '582 and Butzmer '572." We observe, however, no such rejection is before us for consideration.

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Next, we note that the appellant has not separately argued the patentability of dependent claims 2-4 and 11. Accordingly, these claims will stand or fall with representative claim 5.

37 CFR § 1.192(c)(7).

We have carefully reviewed the appellant's invention as described in the specification, the appealed claims, the prior art applied by the examiner and the respective positions advanced by the appellant in the supplemental brief and by the examiner in the answer. This review leads us to conclude that the prior art relied on by the examiner establishes the obviousness of representative claim 5 within the meaning of 35 U.S.C. § 103. Accordingly, we will sustain the above noted rejection.

According to the examiner:

[i]t would have been obvious to one skilled in the art to provide Waggoner's air deflector with a leg member extending an acute angle of less than 90° or approximately 75° from the base member to deflect air upwardly, and a lip member extending at an obtuse angle of approximately 135° from the leg member thereof to deflect air outwardly at the tops of the air deflector member, and to secure the leg member at a distance from the exterior edge of the vent part to keep the air deflector in place as taught by Smith.

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As for the limitation on lines 24-30 of claim 5 of the instant application, the examiner takes the position that the air deflector of Waggoner is inherently freely adjustable by sliding the air deflector to the desired position with respect to the

vent part (58) and it is obvious to one skilled in the art that the air deflector of Waggoner would be secured in place at the desired location once the ventilator is installed on the roof. [Final rejection, page 3.]

The main thrust of the appellant's position is that the base support member of Waggoner cannot be considered adjustable in the manner claimed. In support of this position the supplemental brief states that:

Applicant does not believe that support member 56 is inherently adjustable since the "mating" function described would not allow the adjustability claimed by the Examiner while still performing the function discussed in the quoted language. Claim 5 is therefore believed allowable over the prior art.

The components of Waggoner '146 [sic, '314] are not adjustable by installers in the field because the roof ventilator is fabricated as a single unit. A person of ordinary skill would not consider that Waggoner '314 teaches or suggests an adjustable air deflector. The patent does not talk about adjustability and it implies that the air deflector is integral with the roof ventilator. [page 4.]

We are unpersuaded by the appellant's arguments.

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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 a reference, 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, 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).

Here, the only embodiment of Waggoner wherein the base member, leg member and ventilating member are stated (and illustrated) to be of a single or one-piece construction is

the alternative embodiment of Figs. 12-15 (see column 5, lines 39

**et seq.**). The examiner, however, has relied on the embodiment of Figs. 8-10 and in this embodiment the ventilator system, including the (1) base member 56 and attached leg member 66 (collectively an air deflector), (2) ventilator member 58, (3) filter 62, and (4) top panel 62, are clearly depicted in Fig. 10 as **separate** members (as distinguished from the above-noted arrangement in the embodiment of Figs. 12-15 wherein the base member and attached leg member, ventilator member and top panel are clearly depicted as being of one-piece construction). Moreover, Waggoner expressly states that the "ridge cap ventilator<sup>4</sup> may be a single unit **or an assembly of several pieces**" (column 2, lines 11 and 12; emphasis ours; footnote added). In our view, the arrangement depicted by Waggoner in Fig. 10, in conjunction with the above-quoted portion of column 2, teaches (or at least fairly suggests) that the air deflector (i.e., base member 56 and attached leg

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<sup>4</sup> Waggoner states that "the ridge cap ventilator **50** comprises support members **56**, ventilating members **58**, a cover member **60** and a filter **62**" (column 4, lines 51-53).

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66), ventilator 58 and top panel or cover member 60 are formed of separate pieces which are subsequently installed on the roof. As the examiner has noted, when these separate pieces are assembled on the roof, the air deflector of Waggoner is of necessity "adjusted" in the claimed manner.

As to Waggoner's use of the terminology "mating," the artisan would reasonably infer that Waggoner is simply referring to the roof ridge ventilator 50 in its assembled state, i.e., once the separate pieces are assembled together and fastened to a roof (just as the appellant's separate pieces are assembled together and fastened to a roof).

Insofar as the limitations of representative claim 5 are concerned, the examiner has apparently additionally relied on Smith for a teaching of securing the leg member 66 of Waggoner at a spaced distance from the exterior edge of the ventilator member 58. This feature, however, is clearly taught by Waggoner in Fig. 8. In any event, the appellant has presented no arguments as to why the examiner's proposed combination of Waggoner and Smith might be in error.

In view of the foregoing, we will sustain the rejection

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of claims 2-5 and 11 under 35 U.S.C. § 103.

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

**AFFIRMED**

	IRWIN CHARLES COHEN	)	
	Administrative Patent Judge	)	
		)	
		)	
	JAMES M. MEISTER	)	BOARD OF
PATENT		)	
	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
	MURRIEL E. CRAWFORD	)	
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