

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.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD H. PUCKETT,
DREW S. BEHM and DONALD P. MARRIOTT

Appeal No. 1997-3096
Application 08/391,407¹

ON BRIEF

Before WARREN, OWENS and TIMM, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 16 through 19 and 31 through 35. Claims 16, 31, 32 and 35² are illustrative of the claims on appeal:

¹ Application for patent filed February 16, 1995. This application is a division of application 08/160,375 ('375 application), filed November 30, 1993, now United States Patent 5,409,799 ('799 patent), issued April 25, 1995, which application is a continuation of application 07/652,021 ('021 application), filed February 7, 1991, now abandoned. Application 08/803,985 ('985 application) was filed on February 21, 1997, by Michael C. Restaino and Richard H. Puckett as a continuation-in-part of the present application, and is now United States Patent 6,045,921 ('921 patent), issued April 4, 2000. Application 09/542,601, filed April 4, 2000, is a continuation of the '985 application.

16. A deflector for application to the inner panel of a vehicle to reduce the intrusion of water and sound past said vehicle panel, said deflector comprising a flat and flexible material having a peripheral shape generally matching the peripheral configuration of the inner panel, characterized in that said material is a thermoplastic elastomer substantially filled with an inorganic filler.

31. A deflector for application to the inner panel of a vehicle to reduce the intrusion of water and attenuate sound through an opening comprising:

a sheet of material having a peripheral shape generally matching the peripheral configuration of said opening in said panel wherein said material comprises a thermoplastic elastomer substantially filled with an inorganic filler.

32. The deflector of claim 31 wherein said thermoplastic elastomer further comprises from about 2% to about 20% of polyethylene selected from the group consisting of low density polyethylene, linear low density polyethylene, ultra low density polyethylene and said inorganic filler further comprises a thermoplastic elastomer substantially filled with from about 50% to about 95% of an inorganic filler.

34. The deflector of Claim 33 wherein said sheet is selectively deformed to conform to surface irregularities on said door.

35. The deflector of Claim 31 further comprising a layer of adhesive selectively applied about the periphery of the sheet for adhering the sheet to said door.

The appealed claims as represented by claims 16, 31, 32 and 34³ are drawn to a deflector for application to the inner panel of a vehicle to reduce the intrusion of water and sound, or attenuating sound, past said vehicle panel or through an opening, said deflector comprising at least a flat and flexible material or a sheet of material having a peripheral shape generally matching the peripheral configuration of the inner panel (claim 16) which would cover “an opening” (claim 31). The sheet of material comprises at least a thermoplastic elastomer substantially filled with an inorganic filler (claims 16 and 31), and the thermoplastic elastomer can further comprise at least from about 2% to about 20% of polyethylene selected from the group consisting of low density polyethylene, linear low density polyethylene, ultra low density polyethylene and said inorganic filler be filled with from about 50% to about 95% of an

² We have copied these claims as they stand of record, including the last two lines of claim 32, which claim was presented in the preliminary amendment of February 16, 1995 (Paper No. 3).

³ Appellants take the position in their brief (pages 4-5) that the grounds of rejections of claims 16 through 19 and 31-33 under § 102(b) and § 102(e), and the ground of rejection of appealed claims 34 and 35 under § 103, can each be considered on the basis of a “representative” claim.

inorganic filler (see claim 32). The sheet of elastomeric material can be selectively deformed to fit the shape of an inner panel of a door (claim 34) as long as it remains generally flat (claim 33). The sheet of elastomeric material can still further comprise a layer of adhesive selectively applied about the periphery of the sheet for adhering the sheet to a door (claim 35).

According to appellants, “a suitable barrier against water, sound, dust and air comprises a mixture of an inorganically filled thermoplastic elastomer intimately blended with a suitable polyethylene, such as . . . low density polyethylene . . . , or a linear low density polyethylene . . . , or an ultra-low density polyethylene . . . ,” wherein “ the composite sheet is relatively flexible, . . . [but] is still sufficiently rigid to function as a barrier” (page 2, lines 10-15 and 23-24).

Appellants further discloses that, with respect to “barrier **16**” for a “vehicle door” having a “trim panel **14**” in specification Figure **1**, the “thickness of the sheet is minimized and the flexibility maximized by the inorganic filler,” the “[s]ound deadening benefits . . . are achieved by the . . . thermoplastic elastomer” and the “water, wind, air and dust benefits . . . are achieved through the ability of the low density polyethylene to impart flexibility, high tear strength and stretch characteristics to the sheet” (*id.*, page 4, line 10, to page 5, line 13).

The references relied on by the examiner are:

Baxmann et al. (Baxmann)	4,049,945	Sep. 6, 1977
Kosaka et al. (Kosaka)	4,483,958	Nov. 20, 1984
Nakamura et al. (Nakamura)	4,613,643	Sep. 23, 1986
Ito et al. (Ito)	4,623,587	Nov. 18, 1986
Sezaki et al. (Sezaki)	4,728,692	Mar. 1, 1988
Kawai et al. (Kawai)	4,734,450	Mar. 29, 1988
Komatsu et al. (Komatsu ‘651)	4,801,651	Jan. 31, 1989
Komatsu et al. (Komatsu ‘796)	4,871,796	Oct. 3, 1989
Abe et al. (Abe)	4,891,392	Jan. 2, 1990
Komatsu et al. (Komatsu ‘683)	4,906,683	Mar. 6, 1990 (filed Nov. 2, 1987)
Adur et al. (Adur ‘127)	4,918,127	Apr. 17, 1990 (filed May 4, 1983)
Adur et al. (Adur ‘968)	4,957,968	Sep. 18, 1990 (filed Aug. 9, 1988)

Thus, we decide this appeal based on appealed claims 16, 31, 32, 34 and 35, which we find to be representative of the issues involved on appeal. 37 CFR § 1.192(c)(7) (1995).

The examiner has advanced the following grounds of rejection on appeal:

claims 16 through 19 and 31 through 33 stand rejected under 35 U.S.C. § 102(b) as anticipated by Nakamura;

claims 16 through 19 and 31 through 33 stand rejected under 35 U.S.C. § 102(e) as anticipated by Adur '968;

claims 16, 19, 31 and 33 stand rejected under 35 U.S.C. § 102(b) as anticipated by any of Komatsu '651, Komatsu '796, Sezaki, Kosaka, Baxmann, Abe, Kawai, or Ito;

claims 16, 19 and 31 through 33 stand rejected under 35 U.S.C. § 102(e) as anticipated by either Adur '127 or Komatsu '683; and

claims 34 and 35 stand rejected under 35 U.S.C. § 103 as being unpatentable over any of Nakamura, Adur '968, Komatsu '651, Komatsu '796, Sezaki, Kosaka, Baxmann, Abe, Kawai, Ito, Adur '127 or Komatsu '683 in view of appellants' discussion of the prior art at page one, second paragraph, of the specification.⁴

We affirm the ground of rejection § 102(b) over Nakamura with respect to claims 16 through 19, 31 and 33 and the ground of rejection of claims 34 and 35 under § 103, and reverse all other grounds of rejection under § 102(b) and § 102(e). We also remand this application to the examiner for consideration of other issues with respect to the appealed claims as set forth below (*see below* p. 18).

Rather than reiterate the respective positions advanced by the examiner and appellants, we refer to the examiner's answer and supplemental answer and to appellants' brief and reply brief for a complete exposition thereof.

Opinion

It is well settled that in order to properly compare the claimed invention encompassed by the appealed claims with the prior art applied by the examiner, we must first interpret the claim language, and in doing so, give the terms the broadest reasonable interpretation consistent with the written description in appellants' specification as it would be interpreted by one of ordinary skill in this art. *See generally, In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *Gechter v. Davidson*, 1165 F.3d 1454, 1457, 43 USPQ2d 1029, 1032 (Fed. Cir. 1997); *In re Paulsen*, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994); *In re Zletz*,

⁴ The examiner has withdrawn the ground of rejection 35 U.S.C. § 112, second paragraph (answer, page 2).

893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Whether a statement of purpose or intended use in the preamble of a claim and/or in the body of the claim constitutes a limitation or limitations that are necessary to give meaning to the claim and properly define the invention is “determined on the facts of each case in view of the claimed invention as a whole.” *In re Stencel*, 828 F.2d 751, 754-55, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987); *see also Paulsen*, 30 F.3d at 1478-79, 31 USPQ2d at 1673-74; *Corning Glass Works v. Sumitomo Elect. U.S.A., Inc.*, 868 F.2d 1251, 1256-57, 9 USPQ2d 1962, 1965-66 (Fed. Cir. 1989). The transitional term “comprising” in the preamble and the further presence of this open-ended term in the body of the claim opens the claim to the inclusion of additional ingredients and other elements. *See Exxon Chemical Patents Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1555, 35 USPQ2d 1801, 1802 (Fed. Cir. 1995) (“The claimed composition is defined as comprising - meaning containing at least - five specific ingredients.”); *In re Baxter*, 656 F.2d 679, 686-87, 210 USPQ 795, 802-03 (CCPA 1981) (“As long as one of the monomers in the reaction is propylene, any other monomer may be present, because the term ‘comprises’ permits the *inclusion* of other steps, elements, or materials.”).

The claimed article comprises at least “a flat and flexible material” (claim 16) or “a sheet of material” (claims 31 and 32) which must act as a “deflector” “to reduce the intrusion of water and sound” (claim 16) or “to reduce the intrusion of water and attenuate sound” (claims 31 and 32) either “past” an “inner panel of a vehicle” (claim 16) or “through an opening (claims 31 and 32), wherein the material or sheet of material has “a peripheral shape generally matching the peripheral configuration of the inner panel,” and in doing so would cover an “opening” (claim 16 and claims 31 and 32). The ingredients making up the material or sheet comprise at least “a thermoplastic elastomer substantially filled with an inorganic filler” (claims 16 and 31), or a “thermoplastic elastomer” that “further comprises” at least “from about 2% to about 20% of polyethylene selected from the group consisting of low density polyethylene, linear low density polyethylene, ultra low density polyethylene” and “said inorganic filler further comprises a thermoplastic elastomer substantially filled with from about 50% to about 95% of an inorganic filler” in claim 32 which we read for purposes of this appeal as “said thermoplastic elastomer is

filled with about 50% to about 95% inorganic filler.”⁵ Thus, each of claims 16, 31 and 32 define a deflector in one set of terms regarding the two dimensional shape thereof and in another set of terms regarding the elastomeric material of which it is made.

With respect to the shape and dimensions of the claimed “flat and flexible material” or “sheet of material” articles, we find from the record on appeal that while the terms “deflector for application to the inner panel of a vehicle” with respect to the “intrusion of water and sound” or “attenuate sound” “past said vehicle panel” or “through an opening,” and the requirements that “the flat and flexible material” or “sheet of material” must have “a peripheral shape generally matching the peripheral configuration of the inner panel” constitute an intended purpose or use for the articles, as the examiner points out (answer, page 6), the terms must nonetheless be given weight with respect to the two dimensional shape of the claimed article in order to give meaning to the claims and properly define the invention. *See generally, Corning Glass Works; cf. Loctite Corp. v. Ultraseal, Ltd.*, 781 F.2d 861, 868, 228 USPQ 90, 94 (Fed. Cir. 1985), *overruled on other grounds, Nobelpharma AB v. Implant Innovations*, 141 F.3d 1059, 1068, 46 USPQ2d 1097, 1104 (Fed. Cir. 1998) (The claim language “adapted to remain in a liquid, nonpolymerizing state for prolonged periods of time while in contact with air and to polymerize to the solid state in the absence of air and upon contact with metal surfaces . . .” was interpreted by the court “as merely language of intended use, not a claim limitation. [Citation omitted.]”).

However, with respect to appellants’ argument that the cited language of claims 16, 31

⁵ We note that claim 31 provides in part that “said material comprises a thermoplastic elastomer substantially filled with an inorganic filler” while claim 32, dependent on claim 31, provides in part that “said inorganic filler further comprises a thermoplastic elastomer substantially filled with from about 50% to about 95% of an inorganic filler.” It is readily apparent that the cited phrase in claim 32 is indefinite under 35 U.S.C. § 112, second paragraph, in defining “an inorganic filler” as comprising the organic “thermoplastic elastomer” which further contains an inorganic filler. In order to avoid piecemeal appellate review, we find that a reasonable, conditional interpretation of claim 32 based on the specification (e.g., pages 4-5) that is adequate for purposes of resolving prior art issues can be made without unsupported speculative assumptions, and thus, for purposes of this appeal, we have arrived at this interpretation. *Cf. In re Steele*, 305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962); *Ex parte Saceman*, 27 USPQ2d 1472, 1474 (Bd. Pat. App. & Int. 1993). However, while we have so considered claim 32, the matter of whether this claims complies with § 112, second paragraph, should be addressed by the examiner upon any further consideration of claim 32 subsequent to this appeal.

and 32 would require the “application” of the “flat and flexible material” and “sheet of material” article “to the inner panel of a vehicle” (brief, e.g., pages 6-7), we do not interpret these claims to be so limited. To the extent that the cited language of claims 16, 31 and 32, which are drawn to a *product*, is intended by appellants as a method or process of *use* limitation of that product, such a limitation has no place in a product claim, and indeed, none of the appealed claims specify that the “flat and flexible material” or “sheet of material” is *attached* to the “inner panel of a vehicle,” and the claimed “sheet” article is disclosed to “be used to advantage in non-automotive applications” (specification, page 8, lines 7-8). *Cf. In re Wiggins*, 397 F.2d 356, 359 n.4, 158 USPQ 199, 201-02 n.4 (CCPA 1968), and cases cited therein (“[A]ppellant’s discovery of the analgesic properties of ‘O₂’ and of a composition containing it could properly be claimed only as a method or process of using that compound or composition in accordance with the provisions of 35 U.S.C. 100(b) and 101.”).

In giving the claim terms the broadest reasonable interpretation consistent with the written description in appellants’ specification as it would be interpreted by one of ordinary skill in this art, we find that the language “a deflector for application to the inner panel of a vehicle to reduce the intrusion of water and sound” or “attenuate sound” would include a “barrier . . . [for] inhibiting passage of water, sound” which can be attached to an “inner panel” that can be part of a “door” or of another part of the “vehicle” (e.g., page 4, lines 10-19). The “deflector” as claimed is a “flat and flexible material” or a “sheet of material” which can be “a generally thin planar sheet” (*id.*, page 4, lines 20-21). We find no disclosure in appellants’ specification with respect to the claim language requiring that the “sheet” of material has “a peripheral shape generally matching the peripheral configuration of the inner panel.”

In the absence of a stated meaning by appellants, we give the modifying terms “generally” and “peripheral” their common dictionary meaning which most fits the facts of this case, that is, “[i]n disregard of particular instances and details; *generally speaking*,” and, “[p]ertaining to, located on or comprising the periphery” which is “[t]he region or area immediately beyond a precise boundary,” respectively.⁶ *See, e.g., Morris*, 127 F.3d at 1055-56, 44 USPQ2d at 1029 (“It

⁶ *The American Heritage Dictionary, Second College Edition*, pages 552 and 923 (Boston, Houghton Mifflin Company, 1982).

is the applicants' burden to precisely define the invention, not the PTO's. See 35 U.S.C. § 112 ¶ 2 [statute omitted.]; *York Prods., Inc. v. Central Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1572-73, 40 USPQ2d 1619, 1622 (Fed. Cir. 1996), and cases cited therein (a claim term will be given its ordinary meaning unless appellant discloses a novel use of that term); *Zletz, supra* ("During patent prosecution the pending claims must be interpreted as broadly as their terms reasonably allow. When the applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art."). Thus, the "sheet" of material acting as a "deflector" can be of a shape which may generally fit and indeed, overlap the area of an "inner panel" to the extent desired, and, as appellants disclose with respect to a "vehicle door," "[t]he arrangement and shape of the frame, panel and barrier would change, according to the vehicle model" (specification, page 4, lines 18-19). Indeed, we take notice that at the time the '021 application was filed, there was a vast assortment of new, continued and discontinued models of "vehicles" on the market, e.g., from automobiles to buses to earth-moving equipment, with "inner panels" that collectively amount to innumerable outer or peripheral shapes and dimensions.

Accordingly, we interpret the claim requirement that the "sheet" of material has "a peripheral shape generally matching the peripheral configuration of the inner panel" to include within its scope such a vast range of shapes and dimensions as to be almost limitless for all practical intents and purposes.

Turning now to the terms regarding the material from which the "sheet" of "deflector" material is made in claims 16 and 31, we interpret the claim language "comprising" at least "a thermoplastic elastomer substantially filled with an inorganic filler" to include within its scope *any* thermoplastic elastomer that is substantially filled with *any* inorganic filler which can function as a "deflector" for water and sound when formed into a "sheet," with respect to claims 16 and 31. We find that claim 16 further specifies that the "sheet" material must be "flat and flexible," while claim 31 would encompass flexible to inflexible, flat to non-flat "sheet" material since this claim contains no limitations in this regard. It is apparent from the written description in the specification (e.g., page 4, lines 21-22, and page 5, lines 4-8) that the term "substantially,"

a term of degree, must be interpreted to require that the content of inorganic filler is at least about 50% by weight of the thermoplastic elastomer. *See York Prods.*, 99 F.3d at 1572-73, 40 USPQ2d at 1622-23 (“In this case, the patent discloses no novel use of claim words. Ordinarily, therefore, ‘substantially’ means ‘considerable in . . . extent,’ *American Heritage Dictionary Second College Edition* 1213 (2d ed. 1982), or ‘largely but not wholly that which is specified,’ *Webster’s Ninth New Collegiate Dictionary* 1176 (9th ed. 1983).”); *Seattle Box Co., Inc. v. Industrial Crating & Packing Inc.*, 731 F.2d 818, 826, 221 USPQ 568, 573-74 (Fed. Cir. 1984) (“Definiteness problems arise when words of degree are used. That some claim language may not be precise, however, does not automatically render a claim invalid. When a word of degree is used . . . [it] must [be determined] whether the patent’s specification provides some standard for measuring that degree.”).

We find that the claim language “comprising . . . a thermoplastic elastomer” in claims 16 and 31 would include within their scope the thermoplastic elastomer blended with “from about 2% to about 20% of polyethylene selected from” the Markush group of low density polyethylenes specified in claim 32, wherein these amounts are based on the mixture of thermoplastic elastomer and low density polyethylene (see specification, page 5, lines 2-4). Indeed, appellants disclose in the written description in the specification that “a suitable barrier against water, sound, dust and air comprises a mixture of an inorganically filled thermoplastic elastomer intimately blended with a suitable polyethylene such as” a “low density” polyethylene (page 2, lines 10-15, and page 4, line 22, to page 5, line 1) and that the “water, wind, air and dust benefits . . . are achieved through the ability of the low density polyethylene to impart flexibility, high tear strength and stretch characteristics to the sheet” (page 5, lines 10-13). However, we will not read into claims 16 and 31 the limitation that a “thermoplastic elastomer” must be any thermoplastic elastomer blended with a “low density” polyethylene as in claim 32. *See Paulsen*, 30 F.3d at 1480, 31 USPQ2d a 1674; *Zletz, supra*; *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969); *cf. E.I. du Pont de Nemours v. Phillips Petroleum Co.*, 849 F.2d 1430, 1433, 7 USPQ2d 1129, 1131 (Fed. Cir. 1988).

Accordingly, we interpret the claim requirement that the “sheet” comprises at least “material is a thermoplastic elastomer substantially filled with an inorganic filler” to encompass

at least any thermoplastic elastomer that is substantially filled with any inorganic filler which can function as a “deflector” for water and sound when formed into a flat and flexible “sheet,” and with respect to claim 16, must be flat and flexible, wherein this language is not limited in scope to any thermoplastic elastomer blended with a “low density” polyethylene that is substantially filled with any inorganic filler.

With respect to claims 34 and 35, each of these claims depends directly or ultimately on claim 31, the language of which we interpreted above. Claim 34 depends on claim 33, which in turn depends on claim 31. Claim 33 specifies that the “sheet of elastomeric material is generally flat,” wherein the term “generally” would have its customary meaning that we found above (see above pp. 7-8). Claim 34 adds the limitation that “said sheet is selectively deformed to conform to surface irregularities on said door,” which we read for purposes of this appeal as “said sheet is selectively deformed to conform to surface irregularities on the inner panel of a vehicle door.”⁷ As set forth above, we interpret the language the “sheet” of material has “a peripheral shape generally matching the peripheral configuration of the inner panel” in claim 31 to include within its scope such a vast range of shapes and dimensions as to be almost limitless for all practical intents and purposes, and the “sheet” of elastomeric material can be flexible. With respect to the interpretation to be made of claim 34 in this context, we find that while this claim is directed to the intended use of the “sheet” of elastomeric material, the language of this claim must be given weight in order to give meaning to the claim and properly define the invention, but the claimed article is not limited to such “application” (*see above* pp. 6-7). Thus, we interpret claim 34 to encompass a sheet of elastomeric material which can function as a “deflector” for water and sound, that has been flexed, stretched, compressed or otherwise shape-altered to fit an inner panel for a vehicle door as desired, to the extent that the sheet of elastomeric material remains “generally flat” as required by claim 33.

In similar manner to claim 34, we read claim 35 for purposes of this appeal as a “sheet”

⁷ Claim 31 as amended in the amendment of October 27, 1995 (Paper No. 6) does not provide antecedent basis for “said door” in claim 34. Thus, claim 34 is indefinite under § 112, second paragraph. In the same manner as above (*see above* note 6), we avoid piecemeal appellate review by arriving at a reasonable, conditional interpretation of claim 34 based on the specification (e.g., page 4) in order to resolve prior art issues without unsupported speculative assumptions.

of elastomeric material “further comprising a layer of adhesive selectively applied about the periphery of the sheet for adhering the sheet to the inner panel of a vehicle door” (*see above* note 7);⁸ find claim 35 to be directed to the intended use of the “sheet” which is given weight but does not limit the claimed article to such “application” (*see above* pp. 6-7); and interpret the language “sheet” of material having “a peripheral shape generally matching the peripheral configuration of the inner panel,” which language is found in claim 31, to include within its scope such a vast range of shapes and dimensions as to be almost limitless for all practical intents and purposes. Thus, we interpret claim 35 to encompass a sheet of elastomeric material which can function as a “deflector” for water and sound, that has “adhesive” at one or more points, if not completely around, its “periphery.”

It is well settled that the examiner has the burden of making out a *prima facie* case of anticipation under § 102(b) and § 102(e) in the first instance by pointing out where each and every element of the claimed invention, arranged as required by the claim, is described identically in a single reference, either expressly or under the principles of inherency, in a manner sufficient to have placed a person of ordinary skill in the art in possession thereof. *See generally, In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); *In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). It is also well settled that if a reference does not disclose a specific embodiment which satisfies all of the claim limitations, the reference will nonetheless describe the claimed invention within the meaning of § 102(e) if it “clearly and unequivocally . . . [directs] those skilled in the art to [the claimed invention] without *any* need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference.” *In re Arkley*, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972).

We find that Nakamura discloses soft, porous, flat sheets comprising at least thermoplastic elastomers with 40 to 80 % by weight of inorganic filler which is disclosed to be resistant to, and thus a “deflector” for, water such that the sheets of elastomeric material can be

⁸ We leave the matter of whether claims 34 and 35 comply with § 112, second paragraph, to be addressed by the examiner upon any further consideration of these claims subsequent to this

used for, *inter alia*, “various waterproof covers” (abstract and col. 1, lines 4-35, and col. 3, lines 45-61). The thermoplastic elastomers can be mixed with polyolefin type thermoplastic elastomer, including ethylene homopolymers, in amounts up to 50% by weight (col. 3, lines 5-44). We further find in Nakamura Examples 1 through 7, 9 and 10 that the amount of calcium carbonate is 50% by weight based on the combined weight of the thermoplastic elastomer and inorganic filler (Nakamura Tables 1-3). The shape and dimensions of the elastomeric sheets formed in these Examples are not fully disclosed as the reference teaches, as seen with respect to Examples 1 through 3, for example, that the elastomeric material was “press-formed into a sheet having a thickness of 0.3 mm” (col. 7, lines 3-4), that is, a flat sheet. We find that in Nakamura Examples 11-14, the thermoplastic elastomer is blended with linear low density polyethylene, in weight ratios of elastomer:ethylene of 25/15 and 30/20 and the amount of inorganic filler is 50% by weight based on the combined weight of the thermoplastic elastomer:linear low density polyethylene and inorganic filler. The amount of linear low density polyethylene blended with the thermoplastic elastomer in these Examples is 37.5% and 40% by weight. Nakamura teaches that “a thermoplastic synthetic resin (plastomer) may be mixed with the polyolefin type thermoplastic elastomer . . . in an amount of up to 50% by weight” (col. 3, lines 34-43).

In comparing claims 16 and 31 with the teachings of Nakamura, we find that the specific embodiments of Examples 1 through 7 and 9 through 14 satisfy the limitations of claims 16 and 31 with respect to a “sheet” material which resists or deflects water, that comprises at least a flexible thermoplastic material substantially filled with an inorganic filler and is flat as well as flexible. The reference is silent with respect to the reduction or attenuation of sound by the soft, porous sheets and does not specify the shape and dimensions of the sheets formed in the Examples thereof. However, we are of the opinion that the soft, porous sheets of Nakamura reasonably appear to satisfy these limitations as well. We find that the claims do not specify the extent to which sound must be reduced or attenuated by the “sheet” material and the sheets of the reference would reasonably appear to interfere with the transmission of sound, thus reducing it or attenuating it as required by the claims. Furthermore, while the shape and dimension of the sheets formed in the reference Examples is not fully disclosed, we find that the reference

appeal.

provides clear and unequivocal direction that flat sheets can be prepared in desired shapes and dimensions that would reasonably appear to fall within the vast range of shapes and dimensions encompassed by the claims.

Therefore, we find as a matter of fact that, *prima facie*, Nakamura reasonably appears to describe all of the elements of the invention encompassed by claims 16 and 31 in a manner sufficient to have placed a person of ordinary skill in the art in possession thereof, and thus reasonably appears to describe the claimed invention within the meaning of § 102(b). *Spada, supra*. Accordingly, because the sheet materials disclosed by Nakamura reasonable appear to be identical to the sheet materials of claims 16 and 31, the burden falls upon appellants to establish by effective argument and/or objective evidence that the claimed invention patentably distinguishes over this reference. *See Spada*, 911 F.2d at 708-09, 15 USPQ2d at 1657-58; *In re Best*, 562 F.2d 1252, 1254-56, 195 USPQ 430, 432-34 (CCPA 1977).

In view of the *prima facie* case of anticipation made out over Nakamura, we have again evaluated all of the evidence of anticipation and non-anticipation based on the record as a whole, giving due consideration to the weight of appellants' arguments in the brief. *Spada*, F.2d at 708, 15 USPQ2d at 1657. Appellants submit, with respect to all of the applied references, that "none . . . [apply] to vehicle use for *deflectors*, nor suggest their use as sound deadening *barriers* for vehicular uses as claimed by Appellants" and that "[t]here is a positive edge feature recited, namely, that it be matched to the panel or an opening in the panel" that are "not taught or suggested" by the references (brief, pages 6-7; emphasis supplied; see also reply brief, pages 1-2). Appellants present no argument specific to Nakamura. The examiner responds that the intended purpose for the claimed "deflector" does not "differentiate the claimed product from the prior art product satisfying the claimed structural limitation," and that "there is no positive structural limitation which distinguishes from the prior art" as "[a]n inner door panel can have any desired shape and/or size" (answer, pages 6-7; see also supplemental answer, page 1).

Upon reconsideration of the issue in view of appellants' arguments and the examiner's response thereto, we agree with the examiner because we remain of the view expressed above that while the claim language must be given weight to give meaning to the claim terms even though it is a statement of intended use, such language does not function as a method or process

of *use* limitation of the claimed article (*see above* pp. 6-7). Thus, we cannot agree with appellants that the vast range of the shapes and dimensions of the claimed “sheet” of elastomeric material that can function as a “deflector” for water and sound as claimed distinguish the “sheet” of elastomeric material shown in Nakamura.

Accordingly, based on our consideration of the totality of the record before us, we have weighed the evidence of anticipation found in Nakamura with appellants’ countervailing evidence of and argument for no anticipation in fact and find that the claimed invention encompassed by appealed claims 16 through 19, 31 and 33 are anticipated as a matter of fact under 35 U.S.C. § 102(b).

We cannot, however, arrive at the same finding with respect to the application of Nakamura to appealed claim 32 under § 102(b). We found above that the amount of linear low density polyethylene blended with the thermoplastic elastomer is 37.5% and 40% by weight in Nakamura Examples 11-14 and that Nakamura teaches that, if present, the thermoplastic synthetic resin can be mixed in an amount of up to 50% by weight (*see above* p. 12). Thus, we find that the embodiments of these Nakamura Examples fall outside of the claimed limitations of “from about 2% to about 20%” linear low density polyethylene specified in claim 32, and the generic disclosure in the reference with respect to such subject matter does not clearly and unequivocally direct those skilled in the art to the claim limitations without the need for judicious selection. Accordingly, we are of the opinion that Nakamura does not *prima facie describe* the claimed invention encompassed by claim 32 within the meaning of § 102(b). *See Arkley, supra; cf. In re Sivaramakrishnan*, 673 F.2d 1383, 213 USPQ 441 (CCPA 1982) (“[T]he fact remains that one of ordinary skill informed by the teachings of [the reference] would not have had to choose judiciously from a genus of possible combinations of resin and salt to obtain the very subject matter to which appellant’s composition per se claims are directed.”). Accordingly, we reverse this ground of rejection.

We turn next to the grounds of rejection based on any of Adur ‘968, Komatsu ‘651, Komatsu ‘796, Sezaki, Kosaka, Baxmann, Abe, Kawai, Ito, Adur ‘127 or Komatsu ‘683 as applied by the examiner to combinations of claims 16 through 19 and 31 through 33 under § 102(b) or § 102(e) (*see above* p. 4). The examiner has not carried his burden of making out a

prima facie case of anticipation by *identifying* wherein *each and every* limitation of the claimed invention, arranged as required in these claims, is described in *each* of these applied references, either expressly or under the principles of inherency, in a manner sufficient to have placed a person of ordinary skill in the art in possession thereof, without the need for judicious selection. *See King, supra; Lindemann Maschinenfabrik, supra.* Indeed, unlike the disclosure of Nakamura, it is not readily apparent that the cited portion of each of the references considered here to which the examiner invites us to “Refer to,” contains a description of each and every limitation of the claimed invention, arranged as required in claims. Thus, an explanation of how each of the references describes the claimed invention within the meaning of § 102 is required to make out a *prima facie* case of anticipation. We note that *one* of the elements of the claims to which the references do not clearly and unequivocally direct those skilled in the art, is the required presence of an inorganic filler in the specified amounts, and in the absence of an explanation, it would reasonably appear that judicious selection within the teachings of the references is required to arrive at this claim limitation.⁹ Accordingly, in the absence of such explanations, we are constrained to reverse all of these grounds of rejection under § 102.

Finally, we reach the ground of rejection of claims 34 and 35, as we have interpreted these claims above, under § 103(a) wherein the examiner has applied each of the references as discussed in all of the grounds of rejection under § 102 in view of the knowledge in the prior art as discussed at page one, second paragraph, of appellants’ specification (*see above* p. 4), which reads as follows:

It was known that surface protectors or deflectors are particularly suited for shielding the inner panels of vehicles against infiltration of water or dust. In general, the deflectors comprise a thin, flexible sheet of a plastic material having a peripheral shape to overlie a predetermined portion of the inner door sheet metal. Typically, the deflectors are joined to the door sheet metal by pressure sensitive adhesive applied in a band around the peripheral edge of the deflectors.

We will consider this ground of rejection with respect to Nakamura as representative of the

⁹ The matter of the optional presence of inorganic filler in the articles of the references was raised in the preliminary amendment of November 30, 1993 in the ‘375 application (Paper No. 16; page 2).

applied references.¹⁰

We found above that Nakamura provides clear and unequivocal direction that soft, porous, flat sheets, which can deflect water and sound and be used for, *inter alia*, “various waterproof covers,” can be prepared in desired shapes and dimensions that would reasonably appear to fall within the vast range of shapes and dimensions encompassed by claim 31 and would be “generally flat” as required by claim 33, wherein claim 34 directly or ultimately depends on both of these claims and claim 35 depends on claim 31. We agree with the examiner that, *prima facie*, one of ordinary skill in this art would have found in the admitted knowledge of the prior art set forth in appellants’ specification, the reasonable suggestions that thin, flexible sheets of flexible material resistant to the infiltration of water, such as the sheet of elastomeric material of Nakamura, can be flexed, stretched, compressed or otherwise shape-altered to successfully fit an object such as the inner panel of a vehicle door as desired and remain “generally flat,” as required by claim 34, and that “adhesive” can be applied at one or more points, if not completely around, the “periphery” of such sheets as those of Nakamura, in order to successfully attach the sheets to an object such as the inner panel of a vehicle door, as required by claim 35. Thus, on this record, the examiner has established that, *prima facie*, one of ordinary skill in this art would have been motivated to construct soft, porous, generally flat sheets of elastomeric material useful as deflectors for water and sound as taught by Nakamura in acknowledged prior art design, construction and composition, including applying adhesive thereto, with the reasonable expectation that such sheets of flexible material can be applied to the inner panel of a vehicle door, thus arriving at the here claimed invention without recourse to appellants’ specification. *See, e.g., Pro-Mold & Tool Co. v. Great lakes Plastics Inc.*, 75 F.3d 1568, 1573, 37 USPQ 1626, 1629-30 (Fed. Cir. 1996) (“In this case, the reason to combine [the

¹⁰ A discussion of the remaining applied references is not necessary to our decision with respect to this ground of rejection. We note here that while we have reversed the grounds of rejection under § 102 which are based on the remaining applied references, that fact does not prevent the application of the same references to the claims under § 103(a) because a reference that does not anticipate the claimed invention under § 102(b) can still be applied thereto “as evidence of obviousness under § 103 for all it fairly suggests to one of ordinary skill in the art.” *See In re Wiggins*, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973).

references] arose from the very nature of the subject matter involved, the size of the card intended to be enclosed.”); *In re Gorman*, 933 F.2d 982, 986-87, 18 USPQ2d 1885, 1888-89 (Fed. Cir. 1991) (“The extent to which such suggestion [to select elements of various teachings in order to form the claimed invention] must be explicit in, or may be fairly inferred from, the references, is decided on the facts of each case, in light of the prior art and its relationship to the applicant’s invention.”); *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)(“The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.”).

Accordingly, since a *prima facie* case of obviousness has been established over the applied prior art and admitted knowledge in the art, we have again evaluated all of the evidence of obviousness and nonobviousness based on the record as a whole, giving due consideration to the weight of appellants’ arguments. *See generally, In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). We cannot agree with appellants (brief, page 7) that one of ordinary skill in this art would not have combined the teachings of Nakamura with the knowledge in the art acknowledged in appellants’ specification and thus obtained the claimed articles as “deflectors on vehicles.” As we pointed out above, while the claims may describe the encompassed claimed article with respect to the intended use as covering for an inner panel of a vehicle door, such use *per se* is not a limitation of the claims. Furthermore, it is clear that Nakamura teaches that the disclosed sheet material resists water and is useful for “waterproof covers,” and thus the reference is clearly applicable prior art with respect to a “deflector” that reduces “the intrusion of water,” and therefore to the “deflector” arts. *See In re Clay*, 966 F.2d 656, 658, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). Accordingly, on this evidence, we must conclude that the examiner has appropriately combined Nakamura with the admitted knowledge in the prior art without recourse to appellants’ disclosure.

Accordingly, based on our consideration of the totality of the record before us, we have weighed the evidence of obviousness found in the references applied by the examiner combined with knowledge in the prior art discussed in appellants’ specification with

appellants' countervailing evidence of and argument for nonobviousness and conclude that the claimed invention encompassed by appealed claims 34 and 35 would have been obvious as a matter of law under 35 U.S.C. § 103.

In summary, we have affirmed the ground of rejection of claims 16 through 19, 31 and 33 under 35 U.S.C. § 102(b) as anticipated by Nakamura and the ground of rejection of claims 34 and 35 under 35 U.S.C. § 103, and we have reversed the ground of rejection of claim 32 under 35 U.S.C. § 102(b) as anticipated by Nakamura as well as all other grounds of rejection under 35 U.S.C. § 102(b).

The examiner's decision is affirmed-in-part.

Remand

We decline to exercise our authority under 37 CFR § 1.196(b) (1997) to enter new grounds of rejection and instead remand the application to the examiner for consideration of issues raised by the record. 37 CFR §1.196(a) (1997); Manual of Patent Examining Procedure (MPEP) § 1211 (7th ed., Rev. 1, Feb. 2000; 1200-24).

The examiner should consider the issue of whether claims 32, 34 and 35 comply with the provisions of § 112, second paragraph (*see above* notes 5 and 8).

The examiner should consider the issue of whether claims 16 through 19, 31 and 33 through 35 comply with the provisions of 35 U.S.C. § 112, first paragraph, written description requirement, because the scope of these claims appears to be greater than the scope of the invention disclosed in appellants' specification in the absence of a requirement that a low density polyethylene be combined with the thermoplastic elastomer as in claim 32 (*see above* pp. 7 and 9). *See generally, In re Wertheim*, 541 F.2d 257, 262, 264, 191 USPQ 90, 96, 98 (CCPA 1976).

The examiner should consider and provide an explanation with respect to the issue of whether any of Adur '968, Komatsu '651, Komatsu '796, Sezaki, Kosaka, Baxmann, Abe, Kawai, Ito, Adur '127 or Komatsu '683 describe the invention encompassed by one or more of claims 16 through 19 and 31 through 33 within the meaning of § 102(b) or § 102(e) (*see above* pp. 14-15).

The examiner should consider the issue of whether one or more of claims 16 through 19

and 31 through 33 would have been obvious to one of ordinary skill in this art over one or more of Nakamura, Adur '968, Komatsu '651, Komatsu '796, Sezaki, Kosaka, Baxmann, Abe, Kawai, Ito, Adur '127 or Komatsu '683. In this respect, the examiner should consider, for example, whether the amount of linear low density polyethylene taught to be combined with the thermoplastic elastomer taught in Nakamura (*see above* p. 14) and whether the amount of inorganic filler which can be optionally added to the thermoplastic elastomer taught in the cited references (*see above* pp. 14-15) would have reasonably provided some objective teaching, suggestion or motivation leading one of ordinary skill in the art to the claimed articles, including the limitations on the amounts of these ingredients, without recourse to the teachings in appellants' disclosure. *See generally, In re Geisler*, 116 F.3d 1465, 1470, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997), citing, *inter alia, In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974); *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775,783, 227 USPQ 773, 779 (Fed. Cir. 1985); *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980); *Wertheim*, 541 F.2d at 271, 191 USPQ at 103-04.

The examiner should consider the issue of whether the ground of rejection under § 103 (*see above* pp. 15-18) should be applied to one or more of claims 16 through 19 and 31 through 33 which encompass the same subject matter as claims 34 and 35 in view of the transitional term "comprising." *See Exxon Chemical Patents, supra; Baxter, supra.*

The examiner should consider the issues of whether one or more of claims 16 through 19 and 31 through 35 constitute double patenting, under 35 U.S.C. § 101 and/or under the judicially created doctrine of obviousness-type double patenting, with respect to one or more claims of the '799 patent and one or more claims of the '921 patent (*see above* note 1). We find that the claims of these patents are drawn to a "barrier" and a "barrier device" constructed from the identical or substantially identical material in order to obstruct the passage of water and sound in the identical or substantially identical manner to the "deflector" encompassed by the appealed claims, and thus a "barrier" and a "barrier device" specified in the claims of the patents reasonably appear to be identical or substantially identical to a "deflector" as specified in the appealed claims. Indeed, it is apparent from such disclosure in the specification as "the barrier can form a deflector against sound and water" (page 2, last sentence) and the description of

“Barrier **16**” for “an inner trim panel **14**” of “a vehicle door” in Figure **1** (pages 4-5) (also *see above* pp. 3, 7 and 9), that the terms “barrier” and “deflector” are synonymous, and the examiner has taken the position that the recitation of the intended use in the appealed claims “does not differentiate the claimed product from the prior art product satisfying the claimed structural limitations” (answer, page 6), which issue would also arise with respect to the issue of double patenting. See the Office actions of August 27, 1998 (page 2), March 4, 1999 (pages 2, 3 and 5) in the ‘985 application (Papers No. 6 and 9) where such issues were raised with respect to the present application.

Appeal No. 1997-3096
Application 08/391,407

P.O. Box 828
Bloomfield Hills, MI 43303