

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRIEDHELM STEFFEN

Appeal No. 99-0210
Application 08/732,285¹

ON BRIEF

Before McCANDLISH, **Senior Administrative Patent Judge**, MEISTER
and ABRAMS, **Administrative Patent Judge**.

ABRAMS, **Administrative Patent Judge**.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 13-33, which constitute all of the claims remaining of record in the application.

¹ Application for patent filed October 28, 1996.

Appeal No. 99-0210
Application 08/732,285

The appellant's invention is directed to an elastic sealing apparatus for use in mounting a window glass or the like. The

invention is illustrated by reference to claim 13, which reads as follows:

13. An elastic sealing apparatus comprising an anchoring wedge, a profiled base connected to the anchoring wedge, a sealing pad provided on the profiled base, and a sealing lip adjacent the sealing pad and the profiled base.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Kautschuk (German Patent)	8534283.1	Mar. 4, 1986
Frisoplast (German Patent)	9207608.4	Aug. 10, 1992

THE REJECTIONS

Claims 13-33 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Appeal No. 99-0210
Application 08/732,285

Claims 13 and 15-26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by German '283.

Claim 14 stands rejected under 35 U.S.C. § 103 as being unpatentable over German '283.

Claims 27-33 stand rejected under 35 U.S.C. § 103 as being unpatentable over German '283 in view of German '608.

The rejections are explained in the Examiner's Answer.

The opposing viewpoints of the appellant are set forth in the Brief and the Reply Brief.

OPINION

The Rejection Under 35 U.S.C. § 112, Second Paragraph

The first portion of this rejection is directed to claims 13-33 and states, in its entirety (Answer, page 4):

Sufficient structure of the various elements has not been provided. The elements have merely been listed in the claims.

We do not agree with the examiner's conclusion. From our perspective, the structure and interrelationship of structure are sufficient to define the invention. The claims may be broad, but broadness does not, in and of itself, constitute

Appeal No. 99-0210
Application 08/732,285

indefiniteness. We will not sustain this portion of the Section 112 rejection.

The examiner also holds claim 15 to be indefinite because "it cannot be determined whether appellant intends to claim the subcombination of a sealing apparatus, or a sealing apparatus in combination with a closure" (Answer, page 4). We see no reason why including in the elastic sealing apparatus a semi-finished enclosure having a groove causes the claim to become indefinite, for it simply adds structure and therefore narrows the scope. From our perspective, the scope of the claim is clear. This portion of the rejection is not sustained.

We also will not sustain the portion of this rejection that is applied against claim 22. The appellant has defined element 3 as a profile[d] base and element 11 as a ridge. In Figure 1 the base is horizontal. In Figure 2 it is bent outward (downward, as shown) in the direction of the anchoring wedge, which enlarges the two chambers at the expense of the hollow portion of the anchor. We do not agree that this language cannot be understood.

Appeal No. 99-0210
Application 08/732,285

As for claim 23, we agree with the examiner that "the nose strip" lacks antecedent basis, and therefore we will sustain the Section 112 rejection against this claim.

We find ourselves in agreement with the appellant, however, that the "cores" recited in claim 30 are different from the reinforced walls of claim 28, as explained on pages 10 and 11 of the specification, and therefore this is not a valid ground for a rejection on the basis of indefiniteness. This portion of the rejection is not sustained.

In summary, only the rejection of claim 23 under Section 112 is sustained.

The Rejection Under 35 U.S.C. § 102(b)

Claims 13 and 15-26 stand rejected as being anticipated by German '283. Anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See *In re Paulsen*, 30 F.3d 1475, 1480-81, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994) and *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

Anticipation by a prior art reference does not require either

Appeal No. 99-0210
Application 08/732,285

the inventive concept of the claimed subject matter or recognition of inherent properties that may be possessed by the reference. See **Verdegaal Bros. Inc. v. Union Oil Co. Of California**, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.) cert. denied, 484 U.S. 827 (1987). The law of anticipation does not require that the reference teach what the applicant is claiming, but only that the claim on appeal "read on" something disclosed in the reference, *i.e.*, all limitations of the claim are found in the reference. See **Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984). It is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of the claim. See **In re Mott**, 557 F.2d 266, 269, 194 USPQ 305, 307 (CCPA 1977).

It is our view that the subject matter of claims 13, 15, 17-21 and 26 is anticipated by the seal disclosed in this reference, while that of claims 16, 22-25 is not. In this regard, we consider that in Figure 2 the reference shows an anchoring wedge 7, a profiled base 5, a sealing pad 6 separate from and parallel to a sealing lip 11 (claims 13 and 20), a

Appeal No. 99-0210
Application 08/732,285

closure having a groove 9 (claim 15), a separate hollow chamber in the sealing pad (the unnumbered lower chamber; claims 17, 19 and 21), a separate hollow chamber in the sealing lip (the unnumbered upper chamber; claims 18, 20 and 21), and a foot 8 in the anchoring wedge (claim 26).

The examiner has not provided us with an explanation of how the subject matter recited in claims 16 and 22-25 can be read upon the seal disclosed in German '283, and we are at a loss to determine this on our own. We therefore will not sustain the Section 102 rejection of these claims.

The Rejections Under 35 U.S.C. § 103

A *prima facie* case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art (see ***In re Bell***, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)). This is not to say, however, that the claimed invention must expressly be suggested in any one or all of the references, rather, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art (see ***Cable Elec. Prods. v. Genmark, Inc.***, 770 F.2d 1015, 1025, 226 USPQ 881,

Appeal No. 99-0210
Application 08/732,285

886-87 (Fed. Cir. 1985)), considering that a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference (see ***In re Bozek***, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)), with skill being presumed on the part of the artisan, rather than the lack thereof (see ***In re Sovish***, 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985)). Insofar as the references themselves are concerned, we are bound to consider the disclosure of each for what it fairly teaches one of ordinary skill in the art, including not only the specific teachings, but also the inferences which one of ordinary skill in the art would reasonably have been expected to draw therefrom (see ***In re Boe***, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966) and ***In re Preda***, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968)).

Claim 14 stands rejected as being unpatentable over German '283. It is the examiner's position that the use of thermoplastic rubber material for the elastic sealing apparatus, the feature added to claim 13 by claim 14, would have been obvious to one of ordinary skill in the art. We

Appeal No. 99-0210
Application 08/732,285

agree, considering that the applied reference teaches using plastic elastomers (translation, page 4) and the appellant admits on page 1 of the specification that prior art seals were made of "microcellular rubber or some similar material that when positioned against the glass pane will press against it sufficiently." We also take note that the claimed material would have suggested itself to one of ordinary skill in the art on the basis of the known advantages thereof, skill being presumed on the part of the artisan, rather than the lack thereof. See *In re Sovish, supra*.

Claims 27-33 stand rejected as being unpatentable over German '283 in view of German '608. Claim 27 adds to claim 26 (which depends from claim 13) the additional requirement that the foot recited in claim 26 is "open on a side opposite that of the profiled base." German '608 is directed to a supporting insulation for windows, doors or the like. It is the examiner's view that it would have been obvious to utilize an open foot instead of the closed one disclosed in German '283 in view of the teachings of German '608. We agree, observing that German '608 states on page 10 of the translation that the use of an opening (notch 13) in the

Appeal No. 99-0210
Application 08/732,285

anchor (foot) allows it to be "forced with relative ease into the supporting groove," which would have been explicit suggestion to one of ordinary skill in the art to make the modification. The subject matter of claims 13 and 26, from which claim 27 depends, having been disclosed in German '283, the addition of the teachings of German '608 establishes a *prima facie* case of obviousness with regard to the subject matter recited in claim 27, and we shall sustain this rejection.

Claim 28, which also depends from claim 26, states that a foot is provided on a wall of the anchoring wedge and that the wall is reinforced with a plastic having a high Shore hardness, and claim 29 further requires that the wall be of a 40 D/60 A plastic material. German '608 teaches that the legs should consist of a material that is "substantially harder" than the material of the rest of the seal, which provides several improvements (translation, pages 3 and 14). It is our view that one of ordinary skill therefore would have found it obvious to reinforce the foot with a harder material such as is recited in claim 28, and thus we will sustain the rejection of claim 28. It is our further view that it then

Appeal No. 99-0210
Application 08/732,285

follows that the selection of the particular material recited in claim 29 would have been within the purview of one of ordinary skill in the art, and we also will sustain the rejection of claim 29.

We will not, however, sustain the rejection of claim 30, which depends from claim 28, or of claims 31-33, which depend from claim 30. Claim 30 requires that there be cores in the wall and foot of hard, stretch-proof material. This structure is not taught by the applied references, and therefore they do not establish a *prima facie* case of obviousness with respect to these claims.

In arriving at the conclusions set forth above, we have carefully considered all of the arguments advanced by the appellant. However, as to those rejections that we have sustained, the appellant has not persuaded us that the positions taken by the examiner were in error. With regard to the argument suggesting that the examiner utilized hindsight in combining the references, any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill at the time the

Appeal No. 99-0210
Application 08/732,285

claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). In those cases where we have sustained the examiner's rejections, we have pointed out where suggestion was found in the references or in the skill that must be attributed to the artisan.

SUMMARY

The rejection of claim 23 under 35 U.S.C. § 112, second paragraph, is sustained.

The rejection of claims 13-22 and 24-33 under 35 U.S.C. § 112, second paragraph, is not sustained.

The rejection of claims 13, 15, 17-21 and 26 under 35 U.S.C. § 102(b) is sustained.

The rejection of claims 16 and 22-25 under 35 U.S.C. § 102(b) is not sustained.

The rejection of claim 14 under 35 U.S.C. § 103 is sustained.

The rejection of claims 27-29 under 35 U.S.C. § 103 is sustained.

Appeal No. 99-0210
Application 08/732,285

The rejection of claims 30-33 under 35 U.S.C. § 103 is
not sustained

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

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Appeal No. 99-0210
Application 08/732,285

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