

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT J. ALLWEIN, LARRY J. WEINSTEIN
and WILLIAM H. OLBERT

Appeal No. 1999-0972
Application 08/724,340

ON BRIEF

Before McQUADE, NASE and GONZALES, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Robert J. Allwein et al. appeal from the final rejection of claims 1 through 16, 18 through 26 and 38 through 66, all of the claims pending in the application. We affirm-in-part.

The invention relates to "a method of and an article for insulating both standard and nonstandard wall, ceiling, floor

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and roof cavities" (specification, page 1). A copy of the
appealed

claims appears in the appendix to the appellants' brief (Paper
No. 14).

The references relied upon by the examiner as evidence of
anticipation and obviousness are:

Sawtell	2,335,968	Dec. 7, 1943
Gay	5,099,629	Mar. 31, 1992
Grant	5,545,453	Aug. 13, 1996

Claims 1 through 6, 9 through 11 and 19 through 24 stand
rejected under 35 U.S.C. § 102(b) as being anticipated by Gay.

Claims 1 through 16 and 18 through 26 stand rejected
under 35 U.S.C. § 103(a) as being unpatentable over Grant.

Claims 38 through 66 stand rejected under 35 U.S.C. §
103(a) as being unpatentable over Sawtell in view of Grant.

The examiner's reasoning in support of these rejections
is set forth in the answer (Paper No. 15).

The appellants' position that the examiner's rejections
are unsound is detailed in the brief (Paper No. 14) and is

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aptly summarized by the following excerpt:

[t]he Gay '629, Grant '453 and Sawtell '968 [references] all disclose insulation with individual packets, batts or blankets sized in width to fit the normal or standard width of the cavities being insulated. . . . However, none of the references relied upon in the final rejection disclose, teach or suggest the concept or structure of the insulation assembly of the present invention for insulating an elongated building cavity wherein the relative widths of the elongated insulation modules of the insulation assembly and the standard nominal cavity width of the elongated cavities to be insulated are such that at least two of the elongated insulation modules are required to insulate a cavity having the nominal standard cavity width as defined in the claims [brief, pages 5 and 6].

This line of argument is persuasive with respect to claims 38 through 66, but not with respect to claims 1 through 16 and 18 through 26.

Turning first to the 35 U.S.C. § 102(b) rejection of claims 1 through 6, 9 through 11 and 19 through 24 , Gay discloses "a thermal insulation packet for fitting into the space above a basement wall between floor joists" (column 2, lines 13 through 15). Figure 2 illustrates "a series of thermal insulation packets connected in manufacturing, and before tearing apart for individual application" (column 2,

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lines 58 through 60). As described by Gay,

[r]eferring now to FIG. 2, a thermal insulation packet generally denoted by the numeral 30 includes a containing material 32 which surrounds a body of insulation material (not shown) and is sealed by a sealing means 34. The sealing means 34 is preferably environmentally safe, and may consist of sewing thread, thermal bonding or any other technique which is known to those of ordinary skill in the art. Although the containing material 32 should allow air to pass therethrough to permit compression for conforming to various spaces, the material should not allow insulation contained therein to escape. Even as the insulation packet may be closely shaped to the space to be insulated, some shaping will undoubtedly be necessary, and the containing material is preferably made of an air-permeable material. Thermal insulation packet 30 may be shaped into an individual pillow-like insulation packet 36 as shown in FIG. 2. The insulation packet may be between about 6 and 16 inches high, between about 6 and 16 inches deep, and between about 12 and 24 inches wide [column 3, lines 24 through 42].

Anticipation is established when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the

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reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

The appellants are correct in their contention that Gay fails to teach their disclosed concept of insulating elongated building cavities wherein the relative widths of the elongated insulation modules of the insulation assembly and the standard nominal cavity width of the elongated cavities to be insulated are such that at least two of the elongated insulation modules are required to insulate a cavity having the nominal standard cavity width. Claim 1, however, is drawn to an insulation assembly per se, and not to the combination of the insulation assembly and the building cavities. The functional language in the claim relating to the building cavities merely defines the claimed insulation assembly in terms of its intended use. As pointed out by the examiner (see page 4 in the answer), the insulation assembly disclosed by Gay (see Figure 2) is inherently capable of the recited intended use, and therefore meets the functional limitations under principles of

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inherency. Since all of the other limitations in claim 1, including the width dimension of "between about one and about eight inches," read on Gay's insulation assembly, the examiner's determination that the subject matter recited in this claim is anticipated by Gay is well founded.

Accordingly, we shall sustain the standing 35 U.S.C. § 102(b) rejection of claim 1 as being anticipated by Gay. We also shall sustain the standing 35 U.S.C. § 102(b) rejection of dependent claims 2 through 6, 9 through 11 and 19 through 24 as being anticipated by Gay since the appellants have not challenged

such with any reasonable specificity, thereby allowing these claims to stand or fall with parent claim 1 (see In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987)).

As for the 35 U.S.C. § 103(a) rejection of claims 1 through 16 and 18 through 26, Grant discloses a multiple conformable insulation assembly 60 comprising at least two

mineral fiber batts 62, exterior layers 42 encasing the batts and a support layer 64 interconnecting the batts so as to space them apart a distance 66 approximately equivalent to the width of standard construction members such as joists and studs. The support layer 64 may include perforations 65 to allow easy separation of the batts.

Here again, the appellants are correct in their contention that Grant fails to teach the their disclosed insulation concept. As explained above, however, claim 1 is drawn to an insulation assembly per se. Although Grant does not disclose any specific width for insulation modules or batts 62, the appellants have not disputed the examiner's conclusion (see page 5 in the answer) that it would have been obvious to one of ordinary skill in the art to provide these modules with a width as recited in claim 1. As so modified, the Grant insulation assembly 60 would meet all of the limitations in claim 1 including the functional limitations relating to the intended use of the claimed assembly. Hence, the examiner's conclusion that the differences between the subject matter recited in claim 1 and the prior art embodied

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by Grant are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art is well taken.

Accordingly, we shall sustain the standing 35 U.S.C. § 103(a) rejection of claim 1 as being unpatentable over Grant. We also shall sustain the standing 35 U.S.C. § 103 rejection of dependent claims 2 through 16 and 18 through 26 as being unpatentable over Grant since the appellants have not challenged such with any reasonable specificity, thereby allowing these claims to stand or fall with parent claim 1 (see In re Nielson, supra).

We shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 38 through 66 as being unpatentable over Sawtell in view of Grant.

Sawtell discloses a multi-ply insulation blanket formed of superposed insulating sheets tied together by adhesive-reinforced stitching 11, scoring 18 or dimples 20. The blanket is adapted to be disposed between structural members such as the rafters 20¹ of a roof. According to Sawtell,

¹Sawtell has employed reference numeral 20 to denote both the dimples (see Figure 5) and the rafters (see Figure 7).

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[although the rafters 20 will ordinarily be a fairly standard distance apart, there may be some variation in spacing in different houses and buildings. Accordingly, the blankets of insulation 22 are supplied in such width as to adequately fit the widest spacing which will normally be encountered. In cases where the full width of the blankets 22 is not needed, the edges of each blanket may be conveniently turned down against the sides of the rafters as indicated at 24 [page 3, column 1, lines 10 through 19].

As conceded by the examiner (see page 6 in the answer), Sawtell does not meet the limitations in claims 38 through 66 relating to the modular aspects of the appellants' invention. In this regard, independent claim 38, from which claims 39 through 53 depend, recites a building structure comprising, inter alia, adjacent framing members spaced apart distances both equal to and less than a standard spacing of at least 15 inches, and an insulation panel comprising at least two separably joined insulation modules, each having a width of between about one and eight inches, held in place between adjacent framing members spaced apart a distance equal to or less than the standard spacing. Independent claim 54, from which claims 55 through 66 depend, recites a method for insulating cavities defined by framing members spaced apart

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distances equal to or less than a standard spacing of at least 15 inches comprising, inter alia, the steps of providing a series of separably joined insulation modules, each having a width of between about one and eight inches, detaching at least one module from the series to form an insulation panel having a width approximating the distance between adjacent framing members and inserting the panel into the cavity. In short, there is nothing in Grant's disclosure of multiple conformable insulation assembly 60 which cures the Sawtell's failure to meet these claim limitations.

In summary, the decision of the examiner to reject 1 through 16, 18 through 26 and 38 through 66 is affirmed with respect to claims 1 through 16 and 18 through 26 and reversed with respect to claims 38 through 66.

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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

JOHN P. McQUADE)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JOHN F. GONZALES)	
Administrative Patent Judge)	

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