

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT L. DONNELLY and CARL R. GERDTS

Appeal No. 1999-1370
Application No. 08/513,350

ON BRIEF

Before GARRIS, WARREN, and JEFFREY SMITH, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 9 and 11-13 which are all of the claims remaining in the application.

The subject matter on appeal relates to an architectural product which comprises polyurethane laminating adhesive

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overlaying an interior face surface to thereby prevent moisture penetration into the interior face surface of more than about five grams per square meter of the interior face surface per hour. Further details of this appealed subject matter are set forth in representative independent claim 9 which reads as follows:

9. In an architectural product installed in a building and having a core portion with an interior face surface and an exterior face surface directed respectively toward an interior and an exterior of said building and being inherently unstable in dimension if subjected to varying moisture conditions at said interior and exterior face surfaces, and having a moisture barrier on said exterior face surface exposed to the exterior of said building, the improvement which comprises polyurethane laminating adhesive overlying said interior face surface preventing a moisture penetration into said interior face surface of more than about five grams per square meter of said interior face surface per hour, thereby substantially shielding said core portion from moisture relative to said interior face surface, and at least one lamina layer overlying said interior face surface and adhered to said interior face surface by said laminating adhesive, said lamina layer including an aesthetic architectural interior design surface visibly exposed to the interior of said building.

In support of his obviousness conclusion, the examiner relies upon the declaration of Robert L. Donnelly filed December 29, 1997 (see Paper No. 10). More specifically, the examiner relies upon a statement in this declaration which the examiner regards as an admission that evinces obviousness with respect to the here claimed subject matter.

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Claims 9 and 11-13 stand rejected under 35 U.S.C. § 103 as being unpatentable over "appellants['] own admission in the Declaration of Robert L. Donnelly filed December 29, 1997 (Paper No. 10)" (answer, page 3). On page 3 of the answer, the examiner expresses his position in the following manner:

Appellants admit that use of polyurethane adhesive in wood products laminating industry is well known. Appellants also admit that the polyurethane adhesive is old and known. Appellants also admit that the moisture penetration characteristics of such polyurethane adhesives is that, if applied at any thickness within well known range of thickness are sufficient to prevent moisture penetration in excess of five grams per square meter per hour.

Appellants do not admit use of plywood panels in architectural construction having external surface and interior surface.

However use of plywood panels as an architectural product is well known and old. Therefore it would have been obvious to use known polyurethane adhesive in producing plywood panels having aesthetic appearance.

This rejection cannot be sustained.

As argued by the appellants on this appeal and as supported by the express language of the declaration, the declaration statements concerning the moisture characteristics of polyurethane adhesives are derived from the declarant's own knowledge rather than knowledge in the prior art. Under these

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circumstances, we are constrained to regard the examiner's obviousness conclusion as based on impermissible hindsight rather than prior art teachings. To the extent that the examiner's conclusion of obviousness might implicitly involve an inherency theory, it is appropriate to emphasize that a retrospective view of inherency cannot serve as a substitute for actual teaching or suggestion in the prior art. In re Newell, 891 F.2d 899, 901, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989). It follows that we cannot sustain the section 103 rejection advanced by the examiner on this appeal.

As a final matter of concern, we note that the examiner refers to a nonapplied reference of record (i.e., the Klasell patent 5,439,749) on page 4 of the answer in an apparent attempt to support his obviousness conclusion. However, in assessing the section 103 rejection before us, we have not considered this reference because the examiner has not positively included it in his statement of the rejection. See In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970); also see The Manual of Patent Examining Procedure, § 706.02(j)(7th ed., Rev. 1, Feb. 2000).

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The decision of the examiner is reversed.

REVERSED

	Bradley R. Garris)	
	Administrative Patent Judge)	
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)	
	Charles F. Warren)	BOARD OF
PATENT)	
	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
	Jeffrey T. Smith)	
	Administrative Patent Judge)	

BRG:tdl

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