

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MICHAEL J. HUBBARD, WALTER J. KELLY,
ANTHONY VERROCCHI and RAYMOND J. WEINERT

Appeal No. 2002-2123
Application No. 09/197,140`

ON BRIEF

Before FRANKFORT, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 9 to 11, 13, 14 and 16 to 30, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a method and apparatus for continuously seaming cured stock wide panels of EPDM membrane to form a composite EPDM roofing membrane of predetermined width and indefinite length (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art of record relied upon by the examiner in rejecting the appealed claims is:

Cardinal, Jr.	4,050,972	Sept. 27, 1977
Hollis	4,343,667	Aug. 10, 1982
McCarville et al. (McCarville)	4,931,126	June 5, 1990
Davis et al.	5,545,685	Aug. 13, 1996

The examiner also relied upon the appellants' admission of prior art (specification, page 1, lines 14 to 30) relating to applying sheets of cured EPDM membrane on a flat roof (Admitted Prior Art).

Claims 9 to 11, 13, 14 and 16 to 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hollis in view of McCarville, Davis, Cardinal and the Admitted Prior Art.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 17, mailed May 23, 2002) for the examiner's complete reasoning in support

of the rejection, and to the brief (Paper No. 16, filed April 16, 2002) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 9 to 11, 13, 14 and 16 to 30 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Lastly, in determining obviousness/nonobviousness, an invention must be considered "as a whole," 35 U.S.C. § 103, and claims must be considered in their entirety. Medtronic, Inc. v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

In the rejection before us in the appeal, the examiner determined (answer, pp. 5-9) that it would have been obvious at the time the invention was made to a person of ordinary skill in the art to (1) modify the apparatus of Hollis by using a plurality of supply rolls as suggested by McCarville; (2) modify the apparatus of Hollis as modified by McCarville in (1) above by using cured EPDM membranes rather than uncured EPDM membranes as suggested by Davis and the Admitted Prior Art; (3) modify the apparatus of Hollis as modified by McCarville in (1) above to overlap the supply rolls as suggested by McCarville and/or Cardinal; and (4) modify the apparatus of Hollis as modified by McCarville in (1) above to utilize pinch rolls as suggested by Cardinal as Hollis' lap press.

In our view, it would not have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified Hollis to arrive at the claimed subject matter. In that regard, while each of the above-noted modifications to Hollis may have been obvious to an artisan from the teachings of the applied prior art, the invention when considered "as a whole" as required by 35 U.S.C. § 103 is not suggested by the applied prior art. As should be apparent from a reading of the examiner's rejection, the examiner has completely reworked Hollis' apparatus. The only possible suggestion for modifying Hollis in the manner proposed by the examiner to arrive at the claimed subject matter is hindsight knowledge derived from the appellants' own disclosure.¹ It follows that we cannot sustain the examiner's rejections of claims 9 to 11, 13, 14 and 16 to 30 under 35 U.S.C. § 103.

¹ The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

CONCLUSION

To summarize, the decision of the examiner to reject claims 9 to 11, 13, 14 and 16 to 30 under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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Appeal No. 2002-2123
Application No. 09/197,140`

Page 7

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