

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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

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Ex parte MICHAEL S. COULTON

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Appeal No. 2004-1298  
Application No. 09/875,074

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ON BRIEF

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Before STAAB, McQUADE and NASE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Michael S. Coulton appeals from the final rejection of claims 1 through 22, all of the claims pending in the application.

THE INVENTION

The invention relates to “a spacer product which is utilized in a wall and/or roof construction and which provides a drainage path and air space adjacent both an inner sheathing member and an outer building material to retard deterioration of the structure” (specification, page 1). Representative claim 1 reads as follows:

1. A spacer product for providing a drainage path and air space within a building structure so as to retard deterioration of the building structure, consisting essentially of:

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a continuous, indeterminate-length, roll-form web of thermoplastic material having a front face and rear face, said web capable of being rolled lengthwise into a spiral roll during manufacture and unrolled lengthwise in a substantially straight direction during installation;

a first set of hollow spacer elements integrally formed on said web and projecting outwardly from said front face of said web, each spacer element of said first set of spacer elements having an apex portion such that a drainage path and air space is created extending adjacent and along said front face; and

a second set of hollow spacer elements formed integrally on said web and projecting outwardly from said rear face of said web in an opposite direction relative to said first set of spacer elements, each spacer element of said second set of spacer elements having an apex portion such that a drainage path and air space is created extending adjacent and along said rear face;

said first set of hollow spacer elements being offset from said second set of hollow spacer elements.

#### THE PRIOR ART

The items relied on by the examiner to support the final rejection are:

Rothberg	5,383,314	Jan. 24, 1995
Coulton et al. (Coulton '521)	5,673,521	Oct. 7, 1997
Brodeur et al. (Brodeur)	5,688,073	Nov. 18, 1997

The subject matter discussed in the appellant's specification at page 9, lines 8 through 14, page 10, lines 19 through 22, and page 11 lines 1 through 3 and 17 through 21, exemplified in part by reference to U.S. Patent No. 5,099,627 to Coulton et al. (Coulton '627), which the examiner considers to be prior art (the admitted prior art).<sup>1</sup>

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<sup>1</sup> The appellant does not dispute the examiner's assessment that all of this subject matter constitutes prior art.

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### THE REJECTIONS

Claims 1, 2, 7, 8, 14, 15, 17 and 20 through 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Coulton '521 in view of Brodeur.

Claims 3 through 6 and 9 through 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Coulton '521 in view of Brodeur and Rothberg.

Claims 13 through 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Coulton '521 in view of Brodeur and the admitted prior art.

Attention is directed to the brief (Paper No. 11) and to the final rejection and answer (Paper Nos. 5 and 12) for the respective positions of the appellant and the examiner regarding the merits of these rejections.

### DISCUSSION

Coulton '521, the examiner's primary reference, discloses a roof vent designed to enhance the circulation of air in the space between a roof and the underlying ceiling structure (see column 1, lines 12 through 18). In Coulton's words,

the present invention provides a roof vent [V], comprising: a continuous, indeterminate-length rolled web [1] composed of a series of sequentially-thermoformed integral longitudinal sections of thermoformable material. Each section has a plurality of incompressible spacer elements [3-6] projecting in spaced relation from the web for spacing the web from the roof when installed thereon. The elements are separated from one another lengthwise along the web to permit the web to be rolled lengthwise into a spiral roll during manufacture and unrolled lengthwise during installation. The elements are hollow and integral with the web, and they have a wall thickness which is thinner than said web as a result of having been drawn therefrom during thermoforming. Preferably, screening [9] is interposed among the spacer elements lengthwise of the web on opposite sides of its longitudinal median to prevent ingress of foreign objects [e.g., insects, rain, snow and blown objects].

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When installed, the vent spaces a cap [22] (such as a ridge cap) from the roof surface to provide a venting flow path for air between the interior of the building and the ambient atmosphere [column 2, lines 32 through 52].

As conceded by the examiner (see pages 2 and 6 in the final rejection), the roof vent disclosed by Coulton '521 does not respond to the limitations in independent claim 1, or the corresponding limitations in independent claims 7 and 20, requiring first and second offset sets of hollow spacer elements projecting outwardly from the front and rear faces, respectively, of the web. The Coulton vent has but a single set of hollow spacer elements projecting outwardly from one face of its web. To overcome this deficiency, the examiner turns to Brodeur.

Brodeur discloses an earth drain adapted to be vertically driven into the ground to a substantial depth to foster drainage of soils, such as clay, having low water permeability. The drain 10 comprises a core 11 composed of a flat flexible web 12 having an array of solid projections 13 extending from both of its sides and a sheet-like filter 15 encasing the core and spaced from the web by the projections. In use, "when the drain is inserted in the soil, water may pass through the filter (which prevents the ingress of soil particles) into the space between the filter and the web so that water may flow through the drain in the space between the filter and the web" (column 2, lines 38 through 42).

In proposing to combine Coulton '521 and Brodeur to reject claims 1, 7 and 20, the examiner submits that it would have been obvious "to employ a second set of hollow spacer elements . . . as taught by Brodeur et al. on the rear face of the web disclosed by . . . Coulton et al. providing the ability for moisture and water to flow on both sides of the web" (final rejection, page 3 and page 6).

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Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion in the prior art supporting the combination. In re Fritch, 972 F.2d 1260,1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner proposed by an examiner would not make the modification obvious unless the prior art suggested the desirability of the modification. Id.

In the present case, the collective teachings of Coulton '521 and Brodeur contain no indication that it would be desirable or in any way advantageous to provide the Coulton vent with the capability of allowing moisture and water to flow on both sides of its web as urged by the examiner. To the contrary, Coulton expressly describes the vent as promoting the circulation of air within a roof structure while preventing, via screening material 9, the passage of water therethrough. This stated objective completely belies the examiner's rationale for combining the two references. Simply put, the only suggestion for selectively combining the disparate teachings of a reference (Coulton '521) drawn to a roof vent designed to prevent the passage of water therethrough and a reference (Brodeur) directed to an earth drain for facilitating the drainage of water from relatively impermeable types of soil stems from hindsight knowledge impermissibly derived from the appellant's disclosure.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of independent claims 1, 7 and 20, and dependent claims 2, 8, 14, 15, 17, 21 and 22, as being unpatentable over Coulton '521 in view of Brodeur.

As neither Rothberg nor the admitted prior art cures the above noted shortcomings of the Coulton '521 and Brodeur combination relative to the subject

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matter recited in parent claims 1 and 7, we also shall not sustain the standing 35 U.S.C. § 103(a) rejection of dependent claims 3 through 6 and 9 through 12 as being unpatentable over Coulton '521 in view of Brodeur and Rothberg or the standing 35 U.S.C. § 103(a) rejection of dependent claims 13 through 19 as being unpatentable over Coulton '521 in view of Brodeur and the admitted prior art.

SUMMARY

The decision of the examiner to reject claims 1 through 22 is reversed.

REVERSED

LAWRENCE J. STAAB  
Administrative Patent Judge

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) BOARD OF PATENT

JOHN P. McQUADE  
Administrative Patent Judge

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JEFFREY V. NASE  
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