

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

Appeal No. 95-0430  
Application 07/697,073<sup>1</sup>

ON BRIEF

MAILED

APR 24 1996

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Before CALVERT, COHEN and STAAB, Administrative Patent Judges.  
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection of claims 13-24. Claims 1-12, the only other remaining claims in the application, stand withdrawn from consideration under 37 CFR 1.142(b) as not readable on the elected invention.<sup>2</sup>

<sup>1</sup> Application for patent filed May 8, 1991.

<sup>2</sup> An amendment filed on November 5, 1993 (Paper No. 12), subsequent to the final rejection, has not been entered.

Appeal No. 95-0430  
Application 07/697,073

Appellants' invention pertains to a weatherstrip molding for attachment to an automotive vehicle, the molding comprising a molded rubber body and a laminated film bonded thereto. The laminated film is of a predetermined color such that the weatherstrip molding may be color coordinated to the vehicle's color scheme. Independent claims 13 and 21 are illustrative of the subject matter at issue and read as follows:

13. A weatherstrip molding comprising:

an EPDM rubber molding body having a first portion durometer hardness greater than that of the remainder of said molding body; and

a laminated film bonded onto said first portion of said molding body, said laminated film including a layer of polyvinylidene fluoride and a layer of polypropylene.

21. A weatherstrip molding comprising:

a metal reinforcing core;

an EPDM rubber molding body coextruded onto said core, said molding body having a first outer portion having a durometer hardness greater than that of the remainder of said molding body, said molding body having a second portion having a flock material bonded thereto; and

a laminated film bonded onto said first portion of said molding body, said laminated film including a layer of polyvinylidene fluoride and a layer of polypropylene, said laminated film further having an outer surface of a predetermined color and a predetermined level of gloss.

Appeal No. 95-0430  
Application 07/697,073

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

|                          |           |               |
|--------------------------|-----------|---------------|
| Kirkwood                 | 4,783,931 | Nov. 15, 1988 |
| Ellison et al. (Ellison) | 4,931,324 | Jun. 5, 1990  |

Claims 13-24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kirkwood in view of Ellison. According to the examiner,

it would have been obvious to one of ordinary skill in the art to utilize Ellison's teaching of using a laminated film bonded to the outermost flange portion in the invention of Kirkwood . . . [and] to modify Kirkwood's invention by using an EPDM rubber in the outermost flange portion having a durometer hardness of at least 20 [sic, 90?] Shore A to provide the desired strength to the molding, based on optimization through routine experimentation. [answer, page 4]

Implicit in the examiner's rejection is the position that the weatherstrip molding of Kirkwood modified in the above manner would correspond to the claimed subject matter in all respects.

Appeal No. 95-0430  
Application 07/697,073

Reference is made to the examiner's answer (Paper No. 17) for the examiner's complete reasoning in support of the above noted rejection. Appellants' arguments thereagainst are found on pages 5-10 of the brief (Paper No. 15).

### *Opinion*

In reaching our conclusions on the issues raised in this appeal, this panel of the board has carefully considered appellants' specification and claims, the applied references<sup>3</sup>, the declaration of co-inventor John W. Belser<sup>4</sup>, and the respective viewpoints of appellants and the examiner. As a consequence of our review, we conclude that the rejection of claims 13-16 and 18 is sound and should be sustained, but that the rejection of claims 17 and 19-24 is not sound and therefore should not be sustained. In addition, we enter a new ground of rejection of claims 19, 20, 23 and 24.

---

<sup>3</sup> In our evaluation of the applied references, we have considered all of the disclosure of each reference for what it would have fairly taught one of ordinary skill in the art. See *In re Boe*, 355 F.2d 961, 148 USPQ 507 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings of each reference, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See *In re Preda*, 401 F.2d 825, 159 USPQ 342 (CCPA 1968).

<sup>4</sup> The Belser declaration (Paper No. 16) was filed contemporaneously with the brief on appeal. Although not expressly stated, we assume the declaration has been entered in that the examiner has addressed its merits in the answer on pages 6-7.

Appeal No. 95-0430  
Application 07/697,073

Kirkwood, the examiner's primary reference, pertains to a weatherstrip molding for an automotive vehicle. The weatherstrip molding comprises an elastomeric EPDM rubber material extruded around a metal core. In a first embodiment, Figures 1-3, the rubber material is of a single hardness throughout and the metal core extends into an outermost flange portion 34 of the strip. With respect to this embodiment, Kirkwood states that "[s]ometimes . . . it is desirable that the outermost flange of the large channel portion 34 (which is readily visible) should have a minimum of shrink marks, and this can be achieved by grinding and if necessary, applying a light coating of polymeric paint" (column 3, lines 57-63). The polymeric paint, also referred to as a "veneer" of rubber, provides better weathering characteristics (column 4, lines 10-12). In a second embodiment, Figure 4 and column 4, lines 29-49, the rubber material is of dual hardness, with the outermost flange being of relatively hard rubber ("about 45 Shore D") and the remainder being of relatively soft rubber ("in the order of 70-75 Shore a hardness"). The harder rubber "is so strong that it avoids the need for the support of the metal core, and . . . effectively is a continuation of the door frame surface without any grinding, and consequently without the need for subsequent painting" (column 4, lines 40-46).

Appeal No. 95-0430  
Application 07/697,073

Although not expressly stated, we consider that Kirkwood's use of firm dense rubber for the outermost flange in the Figure 4 embodiment obviates the need for the grinding and painting steps because the harder denser rubber already has a sufficiently uniform and weather resistant surface. When considered in this manner, the statements "In some instances it is deemed desirable to avoid the grinding and painting steps" (column 4, lines 29-30) and "the rubber surface will function as a glass run . . . without any grinding, and consequently without the need for subsequent painting" (column 4, lines 42-46), which appear in Kirkwood's discussion of the Figure 4 embodiment, do not mean that further surface treatment of the outermost flange of the Figure 4 embodiment is precluded, but rather that subsequent "painting" or coating with an additional veneer of rubber is not required to achieve a reasonably uniform and weather resistant surface. Accordingly, we do not read Kirkwood as ruling out the possibility of subsequently treating the exposed surface of the outermost flange of the Figure 4 embodiment in order to improve its general appearance. Appellants would appear to agree with this interpretation of Kirkwood's Figure 4 embodiment in that co-inventor Belser states in his declaration on page 2:

Appeal No. 95-0430  
Application 07/697,073

It is my understanding that the Kirkwood '931 patent describes a glass run channel including a first portion of soft rubber (70 durometer) and a second portion of harder rubber (90+ durometer). The outer surface normally requires either buffing or grinding to give a uniform non-wavy surface. *Additionally, the harder surface can be painted with a polymeric paint to improve the appearance.* [emphasis added]

Ellison relates to a laminated sheet material for use in surfacing automobile body panels or the like. The sheet material has the appearance of a base coat/clear coat paint finish. The laminate comprises a substantially clear outer layer 11 of a weatherable polymer such as Fluorex®, a pigmenting layer 12 comprising, e.g., metallic or mica flakes uniformly distributed in a polymer, and a bonding layer 13 for bonding the sheet material to a supporting substrate. The supporting substrate may be made of metal, wood, or molded polymer.

Based on this reading of the applied references, we conclude that it would have been obvious to one of ordinary skill in the art to provide the exposed surface of the outermost flange of Kirkwood's Figure 4 embodiment with a laminated film of the type disclosed by Ellison in order to color coordinate this visible surface portion of the weatherstrip to the vehicle's color scheme. In this regard, we observe that those skilled in

Appeal No. 95-0430  
Application 07/697,073

the art recognize that it is known to coordinate the color of weatherstrip molding or portions thereof with the vehicle color scheme for purposes of styling. See the background discussion on page 1 of appellants' specification. We will therefore sustain the standing § 103 rejection of claim 13, as well as claim 16 which depends therefrom. We will also sustain the rejection of claims 14 and 18, since Kirkwood discloses the EPDM molding body being coextruded with a metal core 17, as called for in claim 14, and a flock material F bonded to a second portion of the molding body, as required by claim 18.

As to claim 15, which further calls for the first portion of the molding body to have a durometer hardness of at least 90 Shore A and for the remainder of the molding body to have a durometer hardness no greater than approximately 70 Shore A, it would appear from the above quoted portion of the Belser declaration<sup>5</sup> that appellants regard Kirkwood as, at the very least, suggesting durometer hardnesses within the claimed ranges. In any event, in that the examiner's conclusion that the claimed ranges would have been obvious in view of the teachings of

---

<sup>5</sup> "It is my understanding that the Kirkwood '931 patent describes a glass run channel including a first portion of soft rubber (70 durometer) and a second portion of harder rubber (90+ durometer)." Belser declaration, page 2.

Appeal No. 95-0430  
Application 07/697,073

Kirkwood is reasonable and has not been disputed by appellants, we will also sustain the standing § 103 rejection of claim 15.

We reach an opposite conclusion with respect to claims 17, 21 and 22, each of which requires the laminated film to have an outer surface of a predetermined color. As correctly pointed out by appellants, Ellison discloses a transparent outer layer 11 with a pigmented layer 12 underneath. The examiner has not explained, nor is it apparent to us, how the combined teachings of Kirkwood and Ellison teach, suggest or infer that the outer surface of the laminated film may be colored, as now claimed, in particular since Ellison expressly discloses that the outer surface of the laminated film should be substantially clear or transparent in order to achieve the desired "wet look" finish.

We have considered all of appellants' arguments as they apply to the claims the rejection of which we have sustained. However, we have not been persuaded that the examiner's rejection of these claims was in error. Our position with regard to these arguments should be apparent from the discussion above. For the most part, appellants point out the individual deficiencies of the applied references. However, nonobviousness cannot be established by attacking the references individually when, as here, the rejection is predicated upon a combination of prior art

Appeal No. 95-0430  
Application 07/697,073

disclosures. See *In re Merck & Co. Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). On page 10 of the brief, appellants argue that "[t]he Kirkwood '931 reference fails to disclose the desirability and advantages of extending the metallic core into the outer flange portion to support a decorative film" and that "[t]he Ellison reference further fails to disclose the possibility of directly bonding a laminate film to an EPDM rubber surface, wherein the EPDM rubber surface is supported by a metallic core." This argument is not persuasive because it is not commensurate in scope with the *claimed* invention. Specifically, the appealed claims, and in particular claim 14, do not require the metal core to underlie the laminated film, as implied by appellants.

Having arrived at the conclusion that the evidence of obviousness as applied to the rejection of appealed claims 13-16 and 18 is sufficient to establish a *prima facie* case of obviousness, we now consider anew the issue of obviousness under 35 U.S.C. § 103 in light of appellants' rebuttal evidence in the form of the Belser declaration, being mindful of the necessity of reweighing the entire merits of the matter of obviousness and hence of considering all of the evidence of record anew. *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). In this regard, we are mindful that evidence of nonobviousness in any

Appeal No. 95-0430  
Application 07/697,073

given case may be entitled to more or less weight, depending upon its nature and its relationship with the merits of the invention. *Stratoflex Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983).

We have carefully read the Belser declaration relied upon by appellants. The declaration sets out that Mr. Belser has a degree in chemical engineering, that since 1953 he has been employed as a product engineer by Standard Products Company of Cleveland, and that, for the last approximately 35 years, he has been "involved in" designing well over 300 "weatherstrip systems" and has received "numerous patents." However, the relationship of (1) Mr. Belser's work experience, (2) the "systems" with which he has been "involved," and (3) the "numerous patents" he has received, to the field of decorative weatherstrip molding is not revealed. Thus, we do not consider that the credentials presented by the declaration establish Mr. Belser as an expert in the field of applying decorative laminate film to weatherstrip molding.

For the most part, the declaration expresses Mr. Belser's opinion that appellants should prevail on the issues arising under 35 U.S.C. § 103. In a nutshell, the declaration is long on opinion but short on facts, data, or other objective

Appeal No. 95-0430  
Application 07/697,073

evidence which would support that opinion. Where, as here, declarant's opinions are primarily an expression of the ultimate legal conclusion of obviousness, they are entitled to little weight. See *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985). Thus, we consider that Mr. Belser's opinion that the present invention would not have been obvious in view of the teachings of Kirkwood and Ellison is little more than argument and cannot be treated as objective evidence.

We note in particular that there is no objective evidence (e.g., test data) in the record to support declarant's assertion that the tests mentioned in the declaration actually took place, much less to support appellants' conclusions based on those alleged tests (i.e., that a film laminate of polyethylene terephthalate, polypropylene, and polyvinylidene fluoride is "particularly useful," and that the "preferred" support of the laminated film of decorative material by a solid metal core has a favorable effect on subsequent stretch forming). Moreover, Mr. Belser's opinion based on these alleged tests that "the present invention" would not have been obvious appears to be based on an incorrect understanding of what constitutes the present (i.e., claimed) invention. For example, declarant states on pages 1-2 that "I conducted a series of tests . . . [and] discovered that a

Appeal No. 95-0430  
Application 07/697,073

laminated film including a base layer of polyethylene terephthalate, an intermediate layer of polypropylene, and an outer layer of polyvinylidene fluoride, such as FLUOREX™ is particularly useful." The *claimed* invention, however, does not require a base layer of polyethylene terephthalate, or an intermediate layer of polypropylene, or an outer layer of polyvinylidene fluoride. Declarant also states on page 2 that "[t]hrough experimentation, I additionally determined that the laminated film of decorative material should preferably be supported by a solid metal core if subsequent stretch forming of the part is an objective" (declaration, page 2). The *claimed* invention, however, does not require that the metal core be "solid," or that the metal core directly underlie the laminate film, or subsequent stretch forming of the molding. Likewise, the appealed claims neither preclude the use of an adhesive for bonding the film to the rubber, nor require that the film be "directly" bonded to the EPDM rubber, as the arguments appearing in the last three lines on page 2 and the first line on page 3 appear to assume.

When the evidence submitted by appellants is considered, we are of the view that, on balance, it does not outweigh the evidence of obviousness provided by the combined

Appeal No. 95-0430  
Application 07/697,073

teachings of Kirkwood and Ellison. Therefore, we will affirm the standing § 103 rejection of claims 13-16 and 18.

Turning to claims 19, 20, 23 and 24, the preamble of claim 19, for example, announces that the claim is directed to "A method for producing the product of Claim 18. . . ." However, an inspection of the body of claim 19 reveals that the claim does not positively recite any method steps. Rather, the body of the claim appears to merely set forth additional structural limitations of the product to be produced. Under these circumstances, it is quite impossible for us to discern whether the claim is directed to a method of making a product or to the product itself, and if directed to the method of making a product, exactly what "method" (i.e., steps) the claim is intended to cover. The same criticism applies to claims 20, 23 and 24.

While we might speculate as to what is meant by the claim language, our uncertainty provides us with no proper basis for making the comparison between that which is claimed and the prior art, as we are obligated to do. Rejections based on 35 U.S.C. § 103 should not be based upon "considerable speculation as to the meaning of the terms employed and assumptions as to the scope of the claims." *In re Steele*, 305 F.2d 859, 134 USPQ 292

Appeal No. 95-0430  
Application 07/697,073

(CCPA 1962). When no reasonably definite meaning can be ascribed to certain terms in a claim, the subject matter does not become obvious, but rather the claim becomes indefinite. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). Accordingly, we are constrained to reverse the examiner's rejection of claims 19, 20, 23 and 24 under 35 U.S.C. § 103. We hasten to add that this reversal is a procedural reversal rather than one based upon the merits of the rejection. We take no position as to the pertinence of the prior art as applied by the examiner in his rejection.

Pursuant to our authority under 37 CFR 1.196(b), we enter the following new ground of rejection.

Claims 19, 20, 23 and 24 are rejected under 35 U.S.C. § 112, second paragraph, for failing to particular point out and distinctly claim the subject matter sought to be patented. These claims, although purporting to be method claims, do not positively recite any method steps. Hence, their metes and bounds cannot be determined.

In summary, the examiner's decision to reject claims 13-24 under 35 U.S.C. § 103 is affirmed as to claims 13-16 and 18, but is reversed as to claims 17 and 19-24. In addition,

Appeal No. 95-0430  
Application 07/697,073

pursuant to 37 CFR 1.196(b), we have entered a new rejection of claims 19, 20, 23 and 24.

The decision of the examiner is affirmed-in-part.

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date hereof (37 § CFR 1.197).

With respect to the new rejection under 37 CFR § 1.196(b), should appellants elect the alternate option under that rule to prosecute further before the Primary Examiner by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision. In the event appellants elect this alternate option, in order to preserve the right to seek review under 35 U.S.C. 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

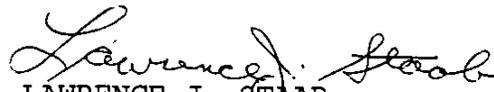
Appeal No. 95-0430  
Application 07/697,073

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

  
IAN A. CALVERT )  
Administrative Patent Judge)

  
IRWIN CHARLES COHEN )  
Administrative Patent Judge)

  
LAWRENCE J. STAAB )  
Administrative Patent Judge)

BOARD OF PATENT  
APPEALS  
AND  
INTERFERENCES

Appeal No. 95-0430  
Application 07/697,073

HARNESS, DICKEY & PIERCE  
P.O. Box 828  
Bloomfield Hills, Michigan 48303