

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte ALDEN T. GIBBS

Appeal No. 95-1337  
Application 08/004,962<sup>1</sup>

ON BRIEF

MAILED

JUN 27 1996

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

Before COHEN, STAAB and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection (Paper No. 11) of claims 5, 7, 10, 12 and 39 through 48. Claims 6, 8, 9, 11 and 13 through 23, the only other claims pending in the application, stand withdrawn from consideration pursuant to 37 CFR § 1.142(b).

The subject matter on appeal pertains to the mounting of slate panels on a supporting structure to form a wall or roof.

<sup>1</sup> Application for patent filed January 15, 1993.

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Claims 39, 46 and 47, the three independent claims on appeal, are illustrative. Copies of these claims as submitted with the appellant's brief (Paper No. 18) are appended hereto.

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

Austin	1,004,338	Sep. 26, 1911
Alvarez, Jr. (Alvarez)	2,292,984	Aug. 11, 1942
Marrel, French Patent Document <sup>2</sup>	531,256	Jan. 10, 1922

The following additional references are relied upon below pursuant to 37 CFR § 1.196(b):<sup>3</sup>

Slate Roofs, National Slate Association, pp. 6, 14, 47, 72 (1953)

Levine, "Slate: An Historic and Repair Profile," Inspired, A Quarterly Publication Devoted to the Preservation of Historic Churches and Synagogues (1987)

The NRCA Steep Roofing Manual, National Roofing Contractors Association, pp. 76, 91, 92 (1990)

The appealed claims stand rejected as follows:

a) claims 5, 7, 10, 12 and 39 through 48 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention;

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<sup>2</sup> An English language translation of this reference, prepared by the Patent and Trademark Office, is appended hereto.

<sup>3</sup> Copies of these references were originally submitted by the appellant on September 16, 1993 (Paper No. 5). Additional copies are attached to the brief as Exhibits 2 through 4.

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b) claims 5, 10 and 39 through 48 under 35 U.S.C.

§ 102(b) as being anticipated by Austin;

c) claim 7 under 35 U.S.C. § 103 as being unpatentable over Austin in view of Marrel; and

d) claim 12 under 35 U.S.C. § 103 as being unpatentable over Austin in view of Alvarez.

With regard to the standing 35 U.S.C. § 112, second paragraph, rejection, the examiner contends that:

Claim 46 is indefinite as to whether "its free end" line 7 is of the free ends set forth on line 6 and as to whether "its first portion" line 14 is of the first portions set forth on line 13. Claim 39 is indefinite as to how the assembly may be both for mounting slate panels (line 1) and comprise slate panels (lines 4, 8 and 9). Are the panels of lines 8 and 9 the same as or are they in addition to the panels of line 1?

As with claim 39, the same indefiniteness exists with claim 47 [final rejection, pages 2 and 3].

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977). Although the claim language questioned by the examiner is somewhat unwieldy, it does define the appellant's invention with a reasonable degree of precision and particularity.

More specifically, notwithstanding some redundant references to free ends and first portions, claim 46 is

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reasonably precise in setting out and circumscribing a mounting clip having two free ends and two first portions. In the same vein, claims 39 and 47 are reasonably precise in reciting the combination of a slate panel mounting assembly, a plurality of slate panels and a structure upon which the slate panels are mounted. There is no inconsistency between the functional references to the slate panels to describe the purpose of the mounting assembly and the positive recitations of the panels as part of the claimed combination. In this regard, claims 39 and 47 do not define the slate mounting assembly as comprising the panels.

In light of the foregoing, we shall not sustain the standing 35 U.S.C. § 112, second paragraph, rejection of claims 39, 46 and 47, or of claims 5, 7, 10, 12, 40 through 45 and 48 which depend therefrom.

With regard to the standing 35 U.S.C. § 102(b) rejection, anticipation is established only 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 Systems, Inc., 730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984)).

Austin discloses a roof construction wherein imperforate shingles or panels 4 are fastened to the rafters 1 of a building structure via spaced, parallel cross bars 2 mounted on

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the rafters and fasteners 3 affixing the shingles to the cross bars. Each fastener is composed of a single elongated piece of metal configured to have a loop 10 which hooks into a groove on the bottom of a cross bar and free end portion lugs 11 which engage indentations 12 in the side edges of adjacent shingles. As shown in the drawing figures, the shingles are arranged in overlapping rows, with each row being associated with a respective cross bar. The only disclosure in the Austin reference relating to the composition of the shingles or panels is that they are "molded of any suitable plastic or other material, preferably cement, paraffin or glass or any other suitable substance, similar to the above" (page 1, lines 12 through 15).

Independent claims 39 and 47 recite combinations which include a plurality of slate panels. Austin does not disclose such panels. The examiner's contention that the slate panels are not positively recited in claims 39 and 47 (see page 4 in the answer, Paper No. 20) is belied by the straightforward language in these claims setting forth a "slate mounting assembly ... in combination with ... said slate panels." The alternative argument that "Austin does teach a variety of panel materials from plastic to concrete, and thus would inherently accommodate well known slate material" (answer, page 4) is also unpersuasive due to a complete lack of any evidentiary support therefor.

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Independent claim 46 recites a mounting clip of generally T-shape having rather specifically defined outwardly opening clamp arms. Austin does not disclose such a mounting clip. In this regard, it is not apparent, nor has the examiner specifically explained, how Austin's fasteners 3 possess "each feature in appellant's claim 46" (answer, page 5).

For these reasons, Austin does not disclose, expressly or under principles of inherency, each and every element of the inventions set forth in independent claims 39, 46 and 47. Accordingly, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of these claims, or of claims 5, 10, 40 through 45 and 48 which depend therefrom, as being anticipated by Austin.

Nor shall we sustain the standing 35 U.S.C. § 103 rejection of claim 7 as being unpatentable over Austin in view of Marrel or of claim 12 as being unpatentable over Austin in view of Alvarez. In short, the examiner's application of Marrel and Alvarez in support of these rejections (see page 4 in the final rejection) does not cure the above noted deficiency of Austin with respect to the subject matter recited in parent claim 39.

The following rejections are entered pursuant to 37 C.F.R. § 1.196(b).

Claims 5, 10, 39 through 45, 47 and 48 are rejected under 35 U.S.C. § 103 as being unpatentable over Austin in view

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of Marrel, the Slate Roofs publication, the Levine article, and the NRCA publication.

Austin, discussed above, teaches or would have suggested a roof construction meeting all of the limitations in claims 5, 10, 39 through 45, 47 and 48 except for those requiring the panels to be slate. Marrel, the Slate Roofs publication, the Levine article, and the NRCA publication establish that slate roofing panels are well known in the prior art for their highly durable nature and aesthetically pleasing appearance. It would have been obvious to one of ordinary skill in the art to make the roof shingles or panels disclosed by Austin of slate in order to attain the self-evident benefits of these attributes.

The arguments presented in the brief which are relevant to this rejection are not persuasive. Austin's cross bars 2 and rafters 1 respectively meet the mounting track and framework limitations in the rejected claims. Although Austin's fasteners 3 are not expressly described as being made of a "springy material" (claims 5 and 10), the metal from which the fasteners are made would inherently possess a minimum degree of resilience which is all that is necessary to meet this broad limitation. Finally, the indentations 12 in Austin's shingles constitute "notches" (claims 10, 42 and 43) under the ordinary and accustomed meaning of this term.

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Claim 7 is rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

The recitation in this claim that each clip has two sets of U-shaped clamp arms with each arm disposed in a surface indentation in a different panel whereby the clip is mounted into two adjacent panels does not make sense on its face or when read in light of the underlying disclosure.

In summary:

a) the decision of the examiner to reject claims 5, 7, 10, 12 and 39 through 48 under 35 U.S.C. § 112, second paragraph, claims 5, 10 and 39 through 48 under 35 U.S.C. § 102(b), and claims 7 and 12 under 35 U.S.C. § 103 is reversed; and

b) new rejections under 35 U.S.C. § 103 and 35 U.S.C. § 112, second paragraph, are entered pursuant to 37 C.F.R. § 1.196(b).

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 of the decision (37 C.F.R. § 1.197). Should the appellant elect to have further prosecution before the examiner in response to the new rejections under 37 C.F.R. § 1.196(b) by way of amendment or showing of facts, or both, not previously of record, a

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shortened statutory period for making such response is hereby set to expire two months from the date of this decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REVERSED; 37 CFR 1.196(b).



IRWIN CHARLES COHEN )  
Administrative Patent Judge )



LAWRENCE J. STAAB )  
Administrative Patent Judge )



JOHN P. McQUADE )  
Administrative Patent Judge )

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APPENDIX

39. A slate mounting assembly for mounting slate panels to a structure for forming a roof or wall for the structure wherein the structure has framework, said assembly being in combination with said structure and said slate panels, said assembly comprising a plurality of spaced parallel generally flat mounting tracks, each of said tracks having a base portion mounted against and to said framework, each of said tracks having fastener accommodating structure, a plurality of rows of slate mounting panels, each of said rows of slate panels being associated with a respective one of said tracks, each of said panels having two spaced side edges, surface indentations in each of said panel side edges, a fastener in the form of an intermediary device engaged in each of said surface indentations, each of said fasteners being secured to its said track by being detachably hooked to said fastener accommodating structure, each of said panels being imperforate except for any perforations at said surface indentations, and said rows of panels being mounted in an overlapping manner with respect to each other to cover and conceal said fasteners.

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46. A mounting clip for detachably mounting a panel to a track or deck, said clip being of generally T-shape and made of a one piece integral spring wire member, said T-shape having two aligned arms and a generally coplanar perpendicular leg located where said arms are juxtaposed each other, said wire member terminating in two free ends, each of said free ends having a first portion of said wire member integral with its said free end, said first portion being bent toward its said free end but spaced therefrom to form a U-shaped outwardly opening clamp arm which comprises a respective one of said aligned arms for being clamped around an edge of a panel to mount said clip to the panel whereby said clip may be simultaneously mounted to two side by side panels, each of said first portions having a second portion of said wire member integral with its said first portion, said second portion being bent back toward said first portion to form a double thickness at a part of said clamp arm opposite its said free end, each of said clamp arms thereby being of U shape with two spaced sides joined by a bight, said free end being on one of said sides of said U shape and both of said first portion and said second portion being on the other of said sides of said U shape to form a double thickness from said first portion and said second portion on said other side of said U-shape, and each of said second portions being bent perpendicularly away from each of said arms and said

second portions being integral with each other to form a double thickness perpendicular extension which comprises said leg for engagement with a track to mount the side by side panels to the track.

47. A slate mounting assembly for mounting slate panels to a structure for forming a roof or wall for the structure wherein the structure has framework, said assembly being in combination with said structure and said slate panels, said assembly comprising a plurality of spaced parallel generally flat mounting tracks, each of said tracks having a base portion mounted against and to said framework, each of said tracks having fastener accommodating structure, a plurality of rows of slate mounting panels, each of said rows of slate panels being associated with a respective one of said tracks, each of said panels having two spaced side edges, a fastener in the form of an intermediary device engaged in each of said side edges, each of said fasteners being secured to its said track by being detachably hooked to said fastener accommodating structure, each of said panels being imperforate except for any perforations at said fasteners, and said rows of panels being mounted in an overlapping manner with respect to each other to cover and conceal said fasteners.