

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD J. BUTLER, MURRAY C. JEFFERIES,
and HENRIQUE M. C. DOS REIS

Appeal No. 96-1633
Application 08/119,245¹

ON BRIEF

Before MEISTER, McQUADE and STAAB, *Administrative Patent Judges*.

STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1, 3-11

¹ Application for patent filed December 15, 1993. This application is a national stage application under 35 U.S.C. § 371 of PCT/CA91/00107, filed April 2, 1991.

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and 13-18, all the claims remaining in the application.²

Appellants' invention pertains to a composite joint sealing gasket (claims 1 and 3-11), and to a method of making a composite joint sealing gasket (claims 13-18). Appellants' composite gasket is said to be capable of establishing both a "wet" seal and a "dry" seal between a panel and a supporting frame by providing the gasket with both a flowable joint sealing mastic composition and a flexible resilient sealing member. Independent claims 1 and 13 are representative, respectively, of the gasket and method claims on appeal, and copies thereof can be found in the appendix to appellants' brief.

The following references of record are relied upon by the examiner in support of rejections under 35 U.S.C. § 103:

Wohl et al. (Wohl)	3,388,517	Jun. 18, 1968
Zahn	3,456,408	Jul. 22, 1969
Bouchey	3,881,290	May 6, 1975

Claims 13 and 15-18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wohl in view of Zahn.

² An amendment filed on June 9, 1995 subsequent to the final rejection (Paper No. 13, duplicate unsigned copy designated Paper No. 12) has been entered. See the advisory letter mailed June 20, 1995 (Paper No. 14).

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Claims 1, 3-11 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wohl in view of Zahn as applied in the rejection of claim 13 et al., and further in view of Bouchey.

Considering first the rejection of independent method claim 13, the examiner finds that Wohl "discloses the seal essentially as claimed," and that Zahn "discloses a similar seal having a sealing composition 30 which is pre-applied to the resilient member" (answer, page 3). In rejecting claim 13, the examiner concedes that Wohl does not disclose that the sealing composition 70 is pre-applied to Wohl's resilient member A. Nevertheless, the examiner concludes that it would have been obvious to one of ordinary skill in the art to modify Wohl by pre-applying the sealing composition 70 to the resilient member A, "thereby providing an alternative method of making of the seal and providing a seal that is easy to install" (answer, pages 3-4). Although not specifically stated, it appears to be the examiner's position that the gasket arrangement of Wohl modified in the above manner would result in the practice of the claimed method because the steps of method claim 13 would necessarily result from providing

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Wohl with a pre-applied resilient member.

As to independent article claim 1, the examiner further relies on Bouchey for its teaching of using a release substrate on a window seal. According to the examiner, the basic combination of Wohl and Zahn teaches essentially all that is claimed in claim 1, with the exception of a release substrate removably adhered to the tacky sealing composition 70. With respect to this deficiency of the basic combination, the examiner further posits:

Although Zahn does not specifically disclose the use of a release substrate, some covering would be necessary for shipping and handling since the tacky sealing composition is pre-applied to the resilient member. Also, Bouchey discloses that it is known to use a release substrate on a window seal. It would have been obvious to include a release substrate, since it is necessary with the Zahn seal, and since Bouchey discloses that it is desirable to keep the seal clean. [answer, page 4]

We will not sustain these rejections.

Our court of review has repeatedly cautioned against employing hindsight by using appellants' disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. *See, e.g., Grain Processing Corp. v. American-Maize Products Co.*, 840 F.2d 902, 907, 5 USPQ2d

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1788, 1792 (Fed. Cir. 1988). That court has also cautioned against focusing on the obviousness of the differences between the claimed invention and the prior art rather than on the obviousness of the claimed invention as a whole as § 103 requires. *See, e.g., Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1383, 231 USPQ 81, 93 (CCPA 1986), *cert. denied*, 480 U.S. 947 (1987). In the present instance, we think that the examiner has lost sight of the claimed invention as a whole and has improperly focused upon the supposed obviousness of the differences between the claimed invention and the prior art cited against the claims.

Appellants' invention as a whole in this case is a *composite* gasket capable of establishing both "wet" and "dry" seals, wherein the gasket has a tacky, viscous, flowable joint sealing composition *pre-applied* to the resilient member, i.e., applied at a time *prior to* assembly of the gasket with the panel and supporting frame. This is reflected in method claim 13 by calling for the steps of "advancing a continuous length of a flexible resilient member," and "feeding a tacky, viscous, flowable joint sealing composition onto [an] inner

edge portion [of the resilient member] . . . to form a continuous composite joint sealing gasket." In article claim 1, the composite nature of the gasket is reflected in the preamble, where the claim is characterized as being drawn to a "composite gasket," and in the body of the claim, which states that the composite gasket comprises "an elongated flexible, resilient member[,] . . . a tacky viscous, flowable joint sealing composition supported [thereon,] . . . and further including a release substrate on

said first side [of the resilient member], removably adhered to said sealing composition."³

Admittedly, when the Wohl sealing arrangement is in its finished installed form (see Figure 10), the mastic 70 provides a "wet" seal between the panel B and the support frame C, and the resilient sealing member A provides a "dry" seal between the panel and the support frame. Thus, it would

³ As aptly pointed out by appellants on page 6 of the brief, presumably with respect to article claim 1, "[t]he recitation of the release paper serves to emphasize the 'composite' nature of the gasket having both the dry sealing element and the wet sealing composition in an integral structure prior to application."

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reasonably appear that Wohl's sealing arrangement in its final, installed form is quite similar to appellants' sealing arrangement in its final, installed form. However, as is made clear by Wohl (see Figure 8), the mastic 70 is not pre-applied to the resilient sealing member A prior to commencement of the assembly process, but rather is applied with a mastic gun 90 having a nozzle 92 which forces the mastic body 70 against the lower edge of the windowpane B (column 5, lines 33-35). This is followed by installing the molding 40 to complete the frame (see Figure 9), and finally by forcing the resilient sealing member A into the space 48 between the molding 40 and the windowpane B (see Figure 10) to form a completed joint. When viewed in this sense, Wohl is relevant to appellants' claimed subject matter only in that the final product produced thereby is similar to the final product produced by using appellants' composite gasket. The examiner then looked to another reference, Zahn, for its teaching a "[flowable] sealing composition 30 which is pre-applied to the resilient member" (answer, page 3), and in the case of the article claims, to yet another reference, Bouchey, for its teaching "that it is known to use a release substrate on a window seal" (answer,

page 4).

While at first blush there is some logic to the examiner's rationale for combining the teachings of Wohl and Zahn when viewed in the abstract, the error in the examiner's line of reasoning, as we see it, is its focus on the obviousness of the modifications rather than on the obviousness of the claimed invention as a whole. Our first difficulty with the examiner's rejection is that the proposed modification of Wohl runs directly counter to the Wohl's clear teaching that the mastic 70 is applied by flowing it into the partially formed joint at the time the joint is assembled. It is not clear that Wohl's mastic compound is even capable of being maintained in place on the resilient sealing member A as a pre-applied element, or that Wohl's sealing arrangement is in any way deficient because the mastic is not pre-applied. In this regard, Wohl appears to have given no thought whatsoever to pre-applying the mastic to any of the members that make up the finished joint, much less the resilient member A, as called for in the appealed claims.

Another difficulty we have with the rejection relates to Zahn. Unlike Wohl, Zahn is not concerned with providing a

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composite seal capable of providing two types of sealing, i.e., "wet" sealing and "dry" sealing. This is because Zahn's strip 24 is not intended to provide any meaningful sealing function, but is rather for the purpose acting as a dam to prevent the mastic 30 from being extruded out of the space between the panel and the supporting frame when the frame members are brought into their final assembled position (column 1, lines 16-21; column 1, lines 63-68; column 3, lines 47-56).

Finally, there is the matter of the motivation for the proposed combination of Wohl and Zahn. It appears to be the examiner's position that the rationale for the proposed combination is (1) to provide an alternative method of making the seal of Wohl, and (2) to provide a seal that is easy to install. As to (1), the fundamental differences in structure, function, and manner of application of the seals of Wohl and Zahn suggest that an ordinarily skilled artisan would not consider one to be an alternative to the other. Concerning (2), there is no basis for concluding that the pre-applying Wohl's mastic to resilient sealing member A would necessarily make the resulting gasket easier to install, and an argument

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could be made that the resulting gasket would be more difficult to install.

In light of the foregoing, we will not sustain the standing rejection of claims 13 and 15-18 under 35 U.S.C. § 103 as being unpatentable over Wohl in view of Zahn.

Considering the rejection of claims 1, 3-11, and 14 under 35 U.S.C. § 103 as being unpatentable over Wohl in view of Zahn and further in view of Bouchey, as aptly pointed out by appellants, Bouchey adds little to the evidentiary basis of the rejection. This is so because the teaching of Bouchey relied upon by examiner, i.e., "that it is known to use a release substrate on a window seal" (answer, page 4), is also taught by Wohl at release substrate 80 used to cover the adhesive surface 64 of tape 60. In brief, the additional teachings of Bouchey do not make up for the shortcomings of Wohl and Zahn discussed above. Accordingly, we also will not sustain the standing rejection of claims 1, 3-11, and 14.

As stated by the court in *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.),

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cert. denied, 488 U.S. 825 (1988), "it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention." In our opinion, this is precisely what the examiner has done in arriving at the subject matter of the appealed claims. We are therefore unable to agree with the examiner that one of ordinary skill in the art would have arrived at the subject matter of the appealed claims based on the teachings of Wohl and Zahn, with or without the additional teachings of Bouchey.

The decision of the examiner is reversed.

REVERSED

JAMES M. MEISTER)	
Administrative Patent Judge)	
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LAWRENCE J. STAAB)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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