

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS C. BEHLING

Appeal No. 97-0381
Application 08/324,108¹

ON BRIEF

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

DECISION ON APPEAL

This appeal is from the final rejection of claims 12 through 17. Claims 1 through 11, the only other claims pending in the application, stand withdrawn from consideration pursuant to 37 CFR § 1.142(b) as being directed to a non-elected invention.

¹ Application for patent filed October 14, 1994.

Appeal No. 97-0381
Application 08/324,108

The subject matter on appeal relates to a method of manufacturing a pre-fabricated building wall. Claim 12 is illustrative and reads as follows:

12. A method of manufacturing a wall for a manufactured building, said method comprising:

providing a rectangular frame having opposite plate members and studs extending between said plate members;

applying glue to said studs and said plate members;

placing wallboard in contact with said glue applied to said studs and plate members;

attaching a rigid rail to said studs to overly and in contact with the wallboard to urge said wallboard against said studs as said glue cures;² and

removing the rail when said glue has set.

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

Dawdy	4,069,640	Jan. 24, 1978
Kuhr	4,757,663	Jul. 19, 1988

² The language employed by the appellant to define the "attaching" step in claim 12 is obviously garbled and is deserving of correction in the event of further prosecution before the examiner.

Appeal No. 97-0381
Application 08/324,108

Claims 12 through 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kuhr in view of Dawdy.³

Reference is made to the appellant's main and reply briefs (Paper Nos. 7 and 9) and to the examiner's answer (Paper No. 8) for the respective positions of the appellant and the examiner with regard to the merits of this rejection.

Kuhr discloses a method of manufacturing a building wall or partition 60. With reference to Figure 6, Kuhr states that

the partition 60 is built by connecting the floor runner 61 and the ceiling runner 62 with the end studs 63 and the intermediate studs 64, and attaching the wallboard 66 to the resulting framework. . . . The wallboard 66 may be attached to the studs 63 and 64 and to the runners 61 and 62 by the screws 68 or an adhesive [column 3, lines 11 through 25].

As implicitly conceded by the examiner (see pages 3 and 4 in the answer), Kuhr does not teach and would not have suggested a wall manufacturing method having the rigid rail attaching and removing steps specified in appealed claim 12. Indeed, Kuhr does not disclose any such "bracing" steps.

³ This ground of rejection was applied to claims 13 and 14 for the first time in the examiner's answer (Paper No. 8). The rejection of claims 13 and 14 which had been set forth in the final rejection (Paper No. 5) has been withdrawn by the examiner (see page 5 in the answer).

Appeal No. 97-0381
Application 08/324,108

Dawdy discloses a wall manufacturing method wherein wallboard 14 is adhered to a stud 12 by adhesive beads 30. As described by Dawdy,

the wallboards 14 are placed against the adhesive beads 30 in the manner known in the art. The wallboard is temporarily braced to hold it firmly against the adhesive bead[s], while adhesive develops a strong bond, all in accordance with the methods known in the art. After the adhesive has set, any temporary bracing is removed, and the wallboard 14 remains adhered to the stud 12 [column 2, lines 3 through 10].

According to the examiner,

it would be [sic, would have been] obvious to one of ordinary skill in the art at the time the invention was made to provide the method of Khur [sic, Kuhr] with the [bracing] steps of Dawdy to ensure a rigid attachment of the wallboard to the studs and plate members. It is [sic, would have been] also obvious to one of ordinary skill in the art that the bracing means could be of any form to ensure said glue is set properly on several wallboards to a frame. The specific device used is a matter [of] choice [answer, pages 3 and 4].

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id.

Appeal No. 97-0381
Application 08/324,108

In the present case, the combined teachings of Kuhr and Dawdy do not provide the factual basis necessary to support a conclusion that the subject matter recited in claim 12 would have been obvious within the meaning of 35 U.S.C. § 103. As noted above, Kuhr does not teach and would not have suggested a wall manufacturing method having the rigid rail attaching and removing steps recited in appealed claim 12. Arguably, Dawdy's rather broad teaching of temporarily bracing a wallboard to a stud until the adhesive therebetween sets and then removing the bracing would have suggested the addition of similar steps to Kuhr's method. There is nothing in the combined teachings of these references, however, which would have suggested the addition to Kuhr's method of the specific "bracing" steps required by claim 12, to wit: "attaching a rigid rail to said studs to overly and in contact with the wallboard to urge said wallboard against said studs as said glue cures; and removing the rail when said glue has set." The examiner's conclusion that these particular limitations would have been obvious matters of choice is based, not on fact, but on speculation, unfounded assumptions and a hindsight reconstruction of the appellant's invention.

Appeal No. 97-0381
Application 08/324,108

In this light, we shall not sustain the standing 35 U.S.C. § 103 rejection of independent claim 12 or of claims 13 through 17 which depend therefrom.

The decision of the examiner is reversed.

REVERSED

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
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)	
JOHN P. McQUADE)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

Appeal No. 97-0381
Application 08/324,108

Baker and Daniels
205 West Jefferson Boulevard
Suite 250
South Bend, IN 46601