

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte OSKAR BSCHORR and MARTIN ABENDSCHEIN

---

Appeal No. 1998-1452  
Application 08/408,006<sup>1</sup>

---

HEARD: NOVEMBER 3, 1999

---

Before McCANDLISH, Senior Administrative Patent Judge,  
FRANKFORT and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Oskar Bschorr et al. appeal from the final rejection of claims 1, 2, 4 through 7 and 11 through 13. Claims 3, 8 through 10 and 14, the only other claims pending in the

---

<sup>1</sup> Application for patent filed March 22, 1995.

Appeal No. 1998-1452  
Application 08/408,006

application, stand withdrawn from consideration pursuant to 37 CFR § 1.142(b). We reverse.

The subject matter on appeal relates to "a device for avoiding squeaking noises on a window pane, particularly a passenger car side window which can be displaced transversely to a seal resting against the pane" (specification, page 1). Claim 1 is illustrative and reads as follows:<sup>2</sup>

1. Arrangement for avoiding generation of squeaking noises by a window pane which is displaced relative to a sealing element resting thereon, wherein:

said sealing element comprises a hollow strip; and

a vibration damping element is coupled to receive vibrations from said sealing element;

wherein said vibration damping element provides an additional modal damping R which satisfies the inequality

$$K - F_1 + R > 0$$

K being a constant, and F [sic,  $F_1$ ], being the first derivative of force exerted by said sealing element with respect to speed of said sealing element.

---

<sup>2</sup> Our review of the appealed claims indicates that the references to the "absorbing" element in claims 2, 4, 5 and 11 lack a proper antecedent basis, an informality which is deserving of correction in the event of further prosecution before the examiner.

Appeal No. 1998-1452  
Application 08/408,006

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

Lynch                      3,159,886                      Dec. 8, 1964

Nozaki                      4-163,226                      June 8, 1992  
Japanese Patent Document<sup>3</sup>

The appealed claims stand rejected as follows:

a) claims 1, 2, 4 through 7 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Nozaki;<sup>4</sup> and

b) claims 1, 2, 12 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Nozaki in view of Lynch.<sup>5</sup>

---

<sup>3</sup> An English language translation of this reference, prepared on behalf of the Patent and Trademark Office, is appended hereto.

<sup>4</sup> The examiner has withdrawn the 35 U.S.C. § 102(b) alternative to this rejection which was set forth in the final rejection (see page 3 in the examiner's answer, Paper No. 17).

<sup>5</sup> This particular rejection was entered for the first time in the examiner's answer (Paper No. 17) in contravention of the pertinent PTO practice in effect at the time. Given the nature of the arguments advanced in the appellants' main and reply briefs (Paper Nos. 16 and 18), the examiner's failure to follow proper procedure in making the rejection has not put the appellants at any disadvantage. Since the 35 U.S.C. § 102(b) rejection of claims 12 and 13 as being anticipated by

Appeal No. 1998-1452  
Application 08/408,006

Nozaki, the examiner's primary reference, pertains to a weather strip for sealing, among other things, a slidable window in an automobile. According to Nozaki, "conventional" weather strips having hollow sealing areas made of solid rubber are so

rigid it is difficult to move the window up and down (see translation pages 2 and 3). Attempts to solve this problem by making the hollow sealing areas of a more flexible sponge rubber have been unsuccessful because the sponge rubber is unduly deformable and stretchable (see translation pages 3 and 4). Nozaki's solution is a weather strip having a hollow portion made of both solid and sponge rubber. The particular embodiments relied upon by the examiner (see pages 4 and 5 in the answer) are shown in Figures 4 and 5 and include hollow sealing areas 12 formed, at least in part, of a relatively thin layer of solid rubber 16 backed by a layer of sponge rubber 15.

---

Lynch which was set forth in the final rejection has not been restated in the answer, we presume that it has been withdrawn by the examiner (see Ex parte Emm, 118 USPQ 180, 181 (Bd. App. 1957)).

Appeal No. 1998-1452  
Application 08/408,006

Lynch discloses a "resilient sealing trim or weather strip having a longitudinally extending flexible tube [hollow rubber sealing portion 12] with portions of its length containing a resilient filler [elastomeric foamed-in-place resin 27] serving to prevent crimping or transverse collapsing of the tube when it is curved on a relatively short radius" (column 1, lines 14 through 18).

As indicated above, appealed claim 1 recites an arrangement for avoiding squeaking noises generated by a window pane being

displaced relative to a sealing element wherein a vibration damping element provides an additional modal damping satisfying a specific mathematically-defined inequality. Nozaki and Lynch are completely devoid of any teaching or suggestion of this vibration damping element inequality. Indeed, neither of these references exhibits any concern whatsoever with the problem of sealing element/window pane vibration. Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154

Appeal No. 1998-1452  
Application 08/408,006

USPQ 173, 177-78 (CCPA 1967). In making such a rejection, an 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. In the present case, the examiner's attempt (see pages 4 through 7 in the answer) to supply the aforementioned deficiencies in Nozaki and Lynch relative to the subject matter recited in claim 1 is fraught with speculation, unfounded assumptions and hindsight reconstruction.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejections of claim 1 or of claims 2, 4 through 7 and 11 through 13 which depend therefrom.

The decision of the examiner is reversed.

REVERSED

Appeal No. 1998-1452  
Application 08/408,006

HARRISON E. McCANDLISH	)	
Senior Administrative Patent Judge	)	)
	)	
	)	
	)	
CHARLES E. FRANKFORT	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
JOHN P. McQUADE	)	
Administrative Patent Judge	)	

Appeal No. 1998-1452  
Application 08/408,006

Evenson, McKeown, Edwards  
and Lenahan  
Suite 700  
1200 G Street, NW  
Washington, DC 20005

JPM/ki