

The opinion in support of the decision being entered today was **not** written for publication in a law journal and is **not** binding precedent of the Board.

Paper No. 45

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ROBERT L. JENKINS, GEORGE F. WILKINS, MICHAEL J.  
NOONE,  
OGLESBY  
NORMAN M. ROBINSON and ROBERT E.

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Appeal No. 1997-0449  
Application 08/380,244

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HEARD: February 7, 2000

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Before FRANKFORT, STAAB, and McQUADE, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1-14, all the claims currently pending in the present application.

By way of background, this is the second appeal of claims

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directed to the composition roofing shingle disclosed in this application. In Appeal No. 94-1620 in Application 07/859,240, the parent of the present application, we affirmed rejections of all the claims then pending under 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 103. Appellants elected to continue prosecution by way of this continuation application, wherein the claims of the parent '240 application have been amended, new claims have been added, and evidence of nonobviousness in the form of declarations by co-inventor Robert L. Jenkins have been submitted.

Appellants' invention pertains to a composition roofing shingle which includes a shingle body having a layer of elongated release material affixed to an exposed face thereof. The release material further bears planographic indicia thereon for identifying the shingle as to at least one parameter of its manufacture. Claim 1, the sole independent claim on appeal, is illustrative of the appealed subject matter and reads as follows:

1. A composition roofing shingle comprising an elongated shingle body having an exposed face, and a separate layer of elongated release material affixed to said exposed face throughout the extent of the shingle body, said release

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material bearing planographic indicia thereon at predetermined intervals, with said release material comprising

- (a) means by which the planographic indicia is applied to the shingle, to which the release material is affixed; and

with said planographic indicia

- (b) comprising means for identifying the shingle as to at least one parameter of its manufacture.

The references relied upon by the examiner in the final rejection are:

McCorkle	3,138,897	June 30, 1964
Morgan et al. (Morgan)	3,624,975	Dec. 7, 1971
Hoffman	3,835,604	Sept. 17, 1974
Tajima et al. (Tajima)	4,055,453	Oct. 25, 1977
Small	4,644,592	Feb. 24, 1987
May	4,751,122	June 14, 1988
Simon	4,907,636	Mar. 13, 1990

The following rejections are before us for review:

(a) claim 13, under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regards as the invention,

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(b) claims 1-14, under 35 U.S.C. § 103, as being unpatentable over May or Morgan or Tajima or McCorkle in view of Hoffman, and

(c) claims 1-14, under 35 U.S.C. § 103, as being unpatentable over May or Morgan or Tajima or McCorkle in view of Small or Simon.

Reference is made to appellants' brief, reply brief, and supplemental reply brief (Paper Nos. 37, 40 and 42, respectively) and to the examiner's answer and supplemental answer (Paper Nos. 38 and 41) for the respective positions of appellants and the examiner regarding the merits of these rejections.

*The rejection under 35 U.S.C. § 112*

Claim 13 depends from claim 2 and calls for the indicia and release material together to comprise "a preprinted portion of a roll of release material."

In rejecting claim 13 under § 112, the examiner states that "Claim 13 appears to present the release material as part of a roll of release material. But, how would the release material be formed in a roll if, indeed, it is applied to the

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shingle?" (answer, page 3). It thus appears that the examiner considers it to be improper to refer to the release material affixed to an exposed face of the shingle body as being "a portion . . . of a roll of release material," as called for in claim 13.

Appellants' argument against this rejection is found on page 20 of the brief and reads as follows:

Before the application of the release material and the indicia to the shingle, they existed in a roll of release material, with the indicia preprinted on the release material. As that roll was unrolled and cut into segments, or "portions", as recited in claim 13, the indicia and release material are together applied to the shingle. Once unrolled and applied to the shingle they form a unit with the shingle, but such indicia and release material still, taken together comprise a preprinted portion of a roll of release material. . . . [W]hat is being claimed here is not anything that is still in a roll; merely that the indicia and release material were once in a roll, and now comprise a "portion" of the roll of which they were once a part.

While we appreciate appellants' point that the indicia and release material may have existed as a roll of preprinted release material prior to being applied to the shingle body, this circumstance is not brought out by the language of claim

13.<sup>1</sup> From our perspective, claim 13 injects an element of uncertainty into the claims in calling for the release material, previously recited as being "affixed to said exposed face . . . of the shingle body" (claim 1), as also being "a preprinted portion of a roll of release material" (claim 13). Accordingly, we will sustain this rejection.

*The rejection under 35 U.S.C. § 103*

An analysis of independent claim 1 reveals that the claimed subject matter is a roofing shingle comprising (1) a shingle body having an exposed face, (2) a separate layer of elongated release material affixed to the exposed face of the shingle body, and (3) planographic indicia for identifying the shingle as to at least one parameter of its manufacture located on the release material at predetermined intervals. In the present case,

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<sup>1</sup> In the event of further prosecution, appellants may wish to amend claim 13 to read as follows:

13. The shingle according to claim 2, wherein *prior to its application to the shingle body*, the indicia and release material together comprise a preprinted portion of a roll of release material.

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there appears to be no dispute that each of the primary references (May, Morgan, McCorkle and Tajima) constitutes a roofing shingle comprising (1) and (2). As to (3), we hold that the requirement that the planographic indicia identifying the shingle as to at least one parameter of its manufacture sufficiently functionally relates the printed matter implicitly comprising the claimed planographic indicia to the shingle to which it is affixed, such that this indicia represents a difference or distinction over the primary references which must be given weight in considering the obviousness of the appealed claims. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). As to the secondary references relied upon by the examiner in rejecting the appealed claims, Hoffman pertains to building insulation that includes printed information (e.g., the manufacturer's name) on portions of the insulation's backing, while each of Small and Simon teaches release material affixed to a product, wherein the release material has printed thereon instructions relating to installation of the product. For the purposes of this appeal, we will assume that these reference

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teachings establish a *prima facie* case of obviousness of the claimed subject matter.

Appellants devote a considerable portion of their argument in favor of patentability to the evidence of nonobviousness they have submitted. This evidence consists of two declarations by co-inventor Robert L. Jenkins provided for the purpose of showing copying by others of the presently claimed invention.<sup>2</sup> It is well settled that a nexus must be established between the merits of the claimed invention and the evidence proffered to show nonobviousness if such evidence is to be accorded substantial weight in deciding the obviousness/nonobviousness issue. See *Simmons Fastener Corp. v. Illinois Tool Works, Inc.*, 739 F.2d 1573, 1575, 222 USPQ 744, 746 (Fed. Cir. 1984), *cert. denied*, 471 U.S. 1065 (1985). Moreover, in any given case, evidence of nonobviousness may be entitled to more or less weight, depending upon its nature and its relationship with the merits of the invention. *Stratoflex*

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<sup>2</sup>The declarations in question were submitted by appellants on May 15, 1995 (Paper No. 29, executed by Jenkins on May 11, 1995, hereinafter "Jenkins I") and July 31, 1995 (Paper No. 32, executed by Jenkins on July 24, 1995, hereinafter "Jenkins II").

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*Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538, 218 USPQ 871, 879  
(Fed. Cir. 1983).

The declarations in aggregate reveal, among other things,  
the following chronology of events attested to by declarant  
Jenkins:

- ! On November 30, 1989, CertainTeed Corporation, the assignee of the present invention, began marketing shingles that included release material having planographic material thereon for identifying the shingle as to at least one parameter of its manufacture (Jenkins I, ¶3; Jenkins II, ¶5; Exhibit F of Jenkins II).
- ! Throughout the course of 1990, there were a number of well attended trade shows for the roofing industry and professional meetings for representatives of major shingle manufacturers (Jenkins II, ¶3).
- ! Subsequent to CertainTeed's introduction of the above described shingles several manufacturers of roofing shingles began marketing shingles that included release material having planographic material thereon for identifying the shingles as to at least one parameter of their manufacture (Jenkins I, ¶3; Exhibits A-E of Jenkins I).
- ! The shingles of Exhibits A-E of Jenkins I were not available prior to CertainTeed's introduction in November of 1989 of shingles that included release material having planographic material thereon for identifying the shingle as to at least one parameter of its manufacture (Jenkins II, ¶2).

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In addition, declarant Jenkins attests that the level of available information as to new products of competitive shingle manufacturers is relatively high, that the totality of significant shingle manufacturers is relatively small (about a dozen), and that, as a consequence, introduction of new products

of any one shingle manufacturer is quickly known to the other significant shingle manufacturers (Jenkins I, ¶3).

In the present case, the appearance in the marketplace in late 1989 of shingles embodying the features of Exhibit F of Jenkins II, the standard practices of the shingle roofing industry (e.g., trade shows, professional meetings, etc.), the subsequent appearance of shingles embodying the features of Exhibits A-E of Jenkins I, and the relative simplicity of the subject matter involved here, all support a conclusion that the makers of Exhibits A-E had access to the presently claimed invention shortly after CertainTeed's introduction of shingles like those of Exhibit F into the marketplace in late 1989. In addition, a comparison of Exhibits A-E of Jenkins I and

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Exhibit F of Jenkins II supports a conclusion that shingle products bearing release material like those of Exhibits A-E of Jenkins I correspond to the subject matter of the appealed claims. It has been stated that access in combination with similarity can create a strong inference of copying. See *Cable Elec. Prods. v. Genmark, Inc.*, 770 F.2d 1015, 1027, 226 USPQ 881, 888 (Fed. Cir. 1985). In addition, the circumstance that the alleged copying activity subsequent to late 1989 involves a number of manufacturers suggests that the claimed invention was well received in the roofing shingle making industry. The above considerations lead us to conclude that the Jenkins declarations support a conclusion of copying by others of the subject matter of the appealed claims.

We have carefully weighed the examiner's evidence of obviousness (i.e., the applied prior art references) against appellants' evidence of nonobviousness (the Jenkins I and Jenkins II declarations). In so doing, we are aware that, depending on the facts of each case, copying by others may or may not be indicative of nonobviousness (*see, for example, Cable Elec. Prods. v. Genmark, Inc.*, 770 F.2d at 1028, 226

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USPQ at 889; *Vandenberg v. Dairy Equip. Co.*, 740 F.2d 1560, 1567, 224 USPQ 195, 199 (Fed. Cir. 1984)). Given the facts of this case, we conclude that, on balance, appellants' evidence of copying by other is sufficient in this instance to overcome the *prima facie* case of obviousness made out by the examiner.

It follows that we will not sustain the standing rejections of the appealed claims under 35 U.S.C. § 103.

*Summary*

The rejection of claim 13 under 35 U.S.C. § 112, second paragraph, is affirmed.

The rejections of claims 1-14 under 35 U.S.C. § 103 are reversed.

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

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

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Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	
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	)	
	)	INTERFERENCES
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