

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte KIRAN A. PATEL and STEVEN F. QUADY

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Appeal No. 98-1458  
Application No. 08/499,211<sup>1</sup>

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ON BRIEF

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Before CALVERT, NASE, and CRAWFORD, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 26, which are all of the claims pending in this application.

We AFFIRM-IN-PART and enter new rejections pursuant to

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<sup>1</sup> Application for patent filed July 7, 1995.

Appeal No. 98-1458  
Application No. 08/499,211

37 CFR § 1.196(b).

BACKGROUND

The appellants' invention relates to building siding panels. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Godes 1969	3,473,274	Oct. 21,
Hinds et al. (Hinds) 1971	3,593,479	July 20,
King 15, 1994	5,363,623	Nov.

In addition, this panel of the Board will rely upon the admitted prior art set forth in the specification and drawings (see pages 3-5 of the specification and Figures 1-3 of the drawings).

Claims 1 through 5, 11, 12, 14 and 17 through 19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Godes.

Claims 6, 13, 20 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Godes.

Claims 7, 8 and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Godes in view of King.

Claims 9, 10, 15, 16 and 23 through 26 stand rejected under 35 U.S.C. § 103 as being unpatentable over Godes in view of Hinds.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (Paper No. 7, mailed February 5, 1997) and the examiner's answer (Paper No. 11, mailed August 29, 1997) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 10, filed July 7, 1997) and reply brief (Paper No. 12, filed November 4, 1997) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

**The anticipation issues**

We sustain the rejection of claims 1 through 5 under 35 U.S.C. § 102(b), but not the rejection of claims 11, 12, 14 and 17 through 19.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

*Claims 1 through 5*

Independent claim 1 recites a siding panel comprising, inter alia, a contoured sheet of plastic material, a generally flat nailhem strip, at least one aperture in the nailhem strip, and an elongated rib disposed on the nailhem strip proximate the nail aperture and in predetermined registry therewith. Claim 1 further recites that

said nailhem strip second side substantially free of protrusions proximate said nail aperture for a distance spaced from said elongated rib sufficient to accommodate the nail driving article at said nail aperture.

Claim 1 is anticipated by Godes. Godes discloses a siding panel 12. As shown in Figures 1-4, the siding panel 12 is a contoured sheet of plastic material having a generally flat nailhem strip with nail apertures/slots 32 therein, and an elongated rib/ridge 30 disposed on the nailhem strip proximate the nail apertures/slots and in predetermined registry therewith. As shown in Figure 4, the second side of the nailhem strip is substantially free of protrusions proximate the nail aperture/slot 32 for a distance spaced from the elongated rib/ridge 30 sufficient to accommodate a nail driving article at the nail aperture/slot.

The appellants argue (brief, pp. 5-6) that claims 1 through 5 are patentable since the above-quoted limitation from claim 1 is not met by Godes. Specifically, the appellants point to the relationship between hammer 35 and ridges 30 and 34 as shown in Figure 4 of Godes as establishing that Godes lacks the above-quoted limitation from claim 1. We do not agree. As pointed above, it is only necessary for the claims to "read on" the siding panel disclosed in Godes to be "fully met" by it. In this instance, while there are nail driving articles (such as the hammer 35 shown in Figure 4 of Godes) that are not able to be accommodated within the space between Godes' ridges 30 and 34, we agree with the examiner (answer, p. 4) that the space between Godes' ridges 30 and 34 is sufficient to accommodate other nail driving articles such as a small head hammer or an air-pressure nail gun, which have heads/nozzles smaller than the head of hammer 35.

Since all the limitations of claim 1 are met by Godes, the decision of the examiner to reject claim 1 under 35 U.S.C. § 102(b) is affirmed. Claims 2 through 5 which depend from claim 1 have not been separately argued by the appellants as

required in 37 CFR § 1.192(c)(7) and (8)(iv). Accordingly, we have determined that these claims must be treated as falling with claim 1. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). Thus, it follows that the decision of the examiner to reject claims 2 through 5 under 35 U.S.C. § 102(b) is also affirmed.

*Claims 11, 12 and 14*

Independent claim 11 recites a siding panel comprising, inter alia, a contoured sheet of plastic material, a generally flat nailhem strip, a plurality of elongated apertures in the nailhem strip, and an elongated rib disposed on the nailhem strip in predetermined registry with the apertures. Claim 11 further recites that

said elongated rib comprising a first rib wall extending out of said nailhem plane on said outwardly facing surface side of said nailhem strip, a joining rib wall extending from said first rib wall to a second rib wall, said second rib wall extending back to said nailhem plane and terminating thereat.

The appellants argue (brief, pp. 6-7) that claims 11, 12 and 14 are patentable since the above-quoted limitation from

claim 11 is not met by Godes. Specifically, the appellants point out that the above-quoted limitation from claim 11 is not readable on the solid protrusions/ridge 30 of Godes. We agree. It is our opinion that the examiner's belief (answer, p. 5) that Godes' solid rib 30 has the recited rib walls is without merit. When the terms rib walls (i.e., the first rib wall, the joining rib wall, and the second rib wall) are given their broadest reasonable interpretation consistent with the specification,<sup>2</sup> it is clear to us that the appellants' interpretation is correct.

Since all the limitations of claim 11 are not met by Godes, the decision of the examiner to reject claim 11, and claims 12 and 14 dependent thereon, under 35 U.S.C. § 102(b) is reversed.

*Claims 17 through 19*

Independent claim 17 recites a prefabricated building module which can be combined with at least one other building

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<sup>2</sup> See In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

module to form a substantially complete building. The prefabricated building module comprises, inter alia, at least one exterior wall and a plurality of panels, each of which comprises a contoured plastic sheet having a generally flat nailhem strip, at least one nail aperture in the nailhem strip, and an elongate rib disposed on the nailhem strip proximate the nail aperture and in predetermined registry therewith. Claim 17 further recites that

said nailhem strip second side substantially free of protrusions proximate said nail aperture for a distance spaced from said elongated rib sufficient to accommodate the nail driving article at said nail aperture.

The appellants argue (brief, p. 7) that claims 17 through 19 are patentable since Godes does not disclose a prefabricated building module as recited in claim 17. We agree.<sup>3</sup>

Since all the limitations of claim 17 are not met by Godes, the decision of the examiner to reject claim 17, and

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<sup>3</sup> The examiner did not respond to this argument in the answer.

claims 18 and 19 dependent thereon, under 35 U.S.C. § 102(b) is reversed.

**The obviousness issues**

We sustain the rejection of claims 6 through 9 and 25 under 35 U.S.C. § 103, but not the rejection of claims 10, 13, 15, 16, 20 through 24 and 26.

The test for obviousness is what the teachings of the applied prior art would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

*Claims 13, 15, 16, 20 through 24 and 26*

The decision of the examiner to reject claims 13, 15, 16, 20 through 24 and 26 is reversed since the limitations of their respective independent claims (i.e., claim 11 or claim 17) are not suggested by the teachings of the applied prior art. In that regard, none of the applied prior art (i.e., Godes, King and Hinds) would have suggested the three rib walls as recited in claim 11 or the prefabricated building module as recited in claim 17.

*Claim 10*

The decision of the examiner to reject claim 10 is reversed since the "overlapping serpentine shape" of the hook-like projection is not suggested by the teachings of the applied prior art. In that regard, none of the applied prior art (i.e., Godes, King and Hinds) would have suggested the "overlapping serpentine shape" of the hook-like projection as recited in claim 10.

In response to the appellants' argument (brief, p. 13) that the "overlapping serpentine shape" of the hook-like projection is not suggested by the teachings of the applied prior art, the examiner noted (answer, p. 6) that the "overlapping serpentine shape" of the hook-like projection is old and well known as shown in prior art that was not applied by the examiner. Since the applied prior art does not teach the "overlapping serpentine shape" of the hook-like projection, we are constrained to reverse the decision of the examiner to reject claim 10.

*Claims 7 through 9 and 25*

The appellants have grouped claims 7 through 9 and 25 as standing or falling together with claim 1.<sup>4</sup> In addition, dependent claims 7 through 9 and 25 have not been separately argued by the appellants. Accordingly, these claims will be treated as falling with their parent claim (i.e., claim 1). See In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525,

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<sup>4</sup> See page 4 of the appellants' brief.

1528 (Fed. Cir. 1987); and In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978). Thus, it follows that the decision of the examiner to reject claims 7 through 9 and 25 under 35 U.S.C.

§ 103 is also affirmed.

*Claim 6*

Claim 6 recites:

The siding panel of claim 1, wherein said rib is about 0.05 to about 0.20 inch thick and about 0.05 to about 0.40 inch high.

The examiner contended (final rejection, p. 2) that the rib's (i.e., the ridge 30 of Godes) dimensions are merely design choices. The appellants (brief, p. 12) disagreed.

It is our opinion that the claimed thickness and height of the rib would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the teachings of Godes. In that regard, Godes teaches that the ridges 30 and 34 have a thickness sufficient to limit the penetration of fastener 16 and thereby create a clearance space 36 between the head of the fastener 16 and the panel 12. Accordingly, the thickness of the ridges must exceed the thickness of the head of the fastener. The extent to which the thickness of the ridges exceeds the thickness of the head of the fastener would have been an obvious matter of designer's choice based upon the amount of clearance space desired. As to the height of Godes' ridge 30, Godes' Figure 4 is sufficient in our view to suggest that the height of the ridge exceed the thickness of the ridge.

Our determination of the obviousness of the subject matter of claim 6 accords with the general rule that discovery of an optimum value of a result effective variable (in this case, the optimum thickness and height of the ridges) is ordinarily within the skill of the art. See In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980) and In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). As stated in In re Huang, 100 F.3d 135, 139, 40 USPQ2d 1685, 1688 (Fed. Cir. 1996):

This court and its predecessors have long held, however, that even though applicant's modification results in great improvement and utility over the prior art, it may still not be patentable if the modification was within the capabilities of one skilled in the art, unless the claimed ranges "produce a new and unexpected result which is different in kind and not merely in degree from the results of the prior art."

Additionally, as stated in In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990):

The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims. . . . These cases have consistently held that in such a situation, the applicant must show that the particular range is *critical*, generally by showing that the claimed range achieves unexpected

results relative to the prior art range [citations omitted].

In the present case, however, the appellants have not even alleged, much less established, that the claimed thickness and height produce unexpected results. Therefore, we are of the opinion that it would have been obvious to one of ordinary skill in the art at the time of appellants' invention to have modified Godes' ridge 30 to be about 0.05 to about 0.20 inch thick and about 0.05 to about 0.40 inch high. Accordingly, the decision of the examiner to reject claim 6 under 35 U.S.C. § 103 is affirmed.

**New grounds of rejection**

Under the provisions of 37 CFR § 1.196(b), we enter the following new grounds of rejection.

1. Claims 11 through 16 and 26 are rejected under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed. Specifically, the phrase "said second rib wall

extending back to said nailhem plane and terminating thereat" recited in claim 11 lacks written description support in the original disclosure.

The written description requirement serves "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him; how the specification accomplishes this is not material." In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). In order to meet the written description requirement, the appellants do not have to utilize any particular form of disclosure to describe the subject matter claimed, but "the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Put another way, "the applicant must . . . convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Further, the content of the drawings must

also be considered in determining compliance with the written description requirement. See Vas-Cath, 935 F.2d at 1561, 19 USPQ2d at 1116.

We have reviewed the originally filed specification and find no support therein for the limitation "said second rib wall extending back to said nailhem plane **and terminating thereat.**" Specifically, the originally filed specification fails to set forth the plane at which the second rib wall is the nailhem plane. While the originally filed specification does set forth (p. 6) that the underside of the rib 132 can be filled and abut the exterior wall of a building, the claims at issue cannot be read on this species for the reasons the Godes does not anticipate claim 11 as discussed above.

We have also reviewed the originally filed drawings and find no support therein for the limitation "said second rib wall extending back to said nailhem plane **and terminating thereat.**" Specifically, while originally filed Figures 4 and 6 disclose the elongated rib as comprising a first rib wall

extending out of the nailhem plane, a joining rib wall extending from the first rib wall to a second rib wall, and the second rib wall extending back toward the nailhem plane, the originally filed drawings fail to disclose that the second rib wall terminates **at the nailhem plane.**

2. Claims 1 through 10 and 17 through 25 are rejected under 35 U.S.C. § 103 as being unpatentable over the admitted prior art set forth in the specification and drawings (see pages 3-5 of the specification and Figures 1-3 of the drawings) in view of Godes.

As set forth in the specification and drawings, the admitted prior art teaches the claimed subject matter except for the claimed elongate rib.

In applying the above-noted test for obviousness, we reach the conclusion that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the siding panels of the admitted prior art with ridges as suggested and taught by Godes' ridges 30 and 34

to automatically limit the depth to which fasteners are driven to permit expansion and contraction of the panels. We recognize that Godes provides his ridges for reasons different than the appellants, however, as long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor. See In re Dillon, 919 F.2d 688, 693, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990)(en banc), cert. denied, 500 U.S. 904 (1991) and In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992).

As to claims 6 and 20, it is our opinion that the claimed subject matter would have been obvious for the reasons set forth above in our affirmance of the examiner's rejection of claim 6.

#### CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 9 and 25 is affirmed; the decision of the examiner to reject claims 10 through 24 and 26 is reversed; a

new rejection of claims 11 through 16 and 26 under 35 U.S.C. § 112, first paragraph, has been added pursuant to provisions of 37 CFR

§ 1.196(b); and a new rejection of claims 1 through 10 and 17 through 25 under 35 U.S.C. § 103 has been added pursuant to provisions of 37 CFR § 1.196(b).

In addition to affirming the examiner's rejection of one or more claims, this decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR

§ 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision . . . .

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere

incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

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; 37 CFR § 1.196(b)

IAN A. CALVERT )  
Administrative Patent Judge )  
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)  
) BOARD OF PATENT  
JEFFREY V. NASE ) APPEALS

Administrative Patent Judge )           AND  
  )   INTERFERENCES  
  )  
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  )  
MURRIEL E. CRAWFORD            )  
Administrative Patent Judge    )

JVN/gjh

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APPEAL NO. 98-1458 - JUDGE NASE  
APPLICATION NO. 08/499,211

APJ NASE

APJ CALVERT

APJ CRAWFORD

DECISION: **AFFIRMED-IN-PART;**  
**37 CFR § 1.196(b)**

Prepared By: Gloria Henderson

**DRAFT TYPED:** 02 Feb 99

**FINAL TYPED:**