



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,672	06/30/2012	7888445	65461/836827	6906

23643 7590 02/12/2018  
Barnes & Thornburg LLP (IN)  
11 S. Meridian Street  
Indianapolis, IN 46204

EXAMINER

KUGEL, TIMOTHY J

ART UNIT PAPER NUMBER

3991

MAIL DATE DELIVERY MODE

02/12/2018

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

ROCKWOOL INTERNATIONAL A/S  
Requester and Appellant

v.

Patent of  
KNAUF INSULATION LLC and KNAUF INSULATION SPRL  
Patent Owners and Respondents

---

Appeal 2017-004826  
Reexamination Control 95/000,672  
Patent 7,888,445 B2  
Technology Center 3900

---

Before ROMULO H. DELMENDO, RICHARD M. LEBOVITZ, and  
RAE LYNN P. GUEST, *Administrative Patent Judges*.

LEBOVITZ, *Administrative Patent Judge*.

REQUEST FOR REHEARING

Patent Owners request rehearing under 37 C.F.R. § 41.79(a)(1) (“Req. Reh’g) of the Patent Trial and Appeal Board Decision on Appeal under 37 C.F.R. § 41.77(f) entered September 8, 2017 (“41.77f Decision”) affirming the rejection of claims 16, 18, 19, 21, and 22 under 35 U.S.C. § 103(a) as obvious in view of *Worthington*, *Wallace*, and *Helbing*.

Patent Owners (“PO”) contend that the Decision misapprehended or overlooked certain key points in maintaining the rejection. Specifically, Patent Owners state that each of the claims<sup>1</sup> “differently recites a particular quantity of melanoidins in the claimed binder.” Req. Reh’g 1. Patent Owners contends that the Decision “provides no evidence suggesting that these melanoidins would be present in any particular quantity.” *Id.* at 3. Patent Owners also contend that the “Decision provides no explanation as to why even ‘substantial amounts’ of melanoidins would read on the quantities of melanoidins actually recited claims 16, 18, 19, 21, and 22.” *Id.* Patent Owners also contend that the Decision improperly shifted the burden to Patent Owners to submit evidence to the contrary. *Id.* Patent Owner also states that the “Decision’s conclusion that ‘it is *reasonable* to conclude that the Maillard reaction took place,’ . . . falls short of the legal standard for finding inherency.” *Id.* Patent Owners also argue that the “different limitations regarding particular quantities of melanoidins in melanoidin-containing binders” were not addressed in the Examiner’s determination and that the Board provided a new analysis that raises theories for the first time and constitutes a new ground of rejection. Req. Reh’g 7.

To begin, the evidence does not support Patent Owners’ contention that the Examiner did not address the melanoidin “quantity” limitations recited in claims 16, 18, 19, 21, and 22.

In the Examiner’s Determination under 37 C.F.R. § 41.77(d) (entered Oct. 17, 2016) (“Determination”), the Examiner found that “WORTHINGTON,

---

<sup>1</sup> The rejection of claims 16–22 were maintained in the 41.77f Decision, but Patent Owner does not request rehearing with respect to claims 17 and 20 (*see* Req. Reh’g 1), which do not refer to an amount of melanoidins in the binder.

Appeal 2017-004826  
Reexamination Control 95/000,672  
Patent 7,888,445 B2

WALLACE and/or HELBING describe the newly added features of claims 16–22” and referenced pages 12–13 of Requester’s Comments under 41.77(c).

Determination 15.

Requester at the cited pages stated:

Finally, as described above in Section II.C, Owner has further amended claims 16, 18, 19, 21, and 22 to recite additional features that are directed to the role of the melanoidin products in binding the fibers together. Owner acknowledges that these claimed features are satisfied in a binder that contains melanoidin products in quantities that *exceed an impurity level*, i.e. when the reducing-sugar carbohydrate makes up about 73% to about 96% of a total dry weight of binder reactants. First Hampson Decl., ¶ 17. In short, prior art binders with melanoidin products that also disclose, teach, or suggest the claimed range for the dry weight of the reducing-sugar carbohydrate likewise disclose, teach, or suggest these additional features directed to the role of the melanoidin products in binding the mat of fibers and/or fibrous material together.

. . . As described above, Worthington provides explicit disclosure of a substantially overlapping range for the dry weight of a reducing-sugar carbohydrate. Thus, the binder provided by the combination of Worthington, Wallace, and Helbing would produce melanoidin products in quantities entirely consistent with those produced in the claimed binder and would therefore likewise perform the role of binding the mat of fibers and/or fibrous material together, as recited in claims 16, 18, 19, 21, and 22.

Requester’s 41.77(c) Comments (filed July 1, 2015).

In Patent Owners’ Comments under 37 C.F.R. § 41.77(e) (filed Nov. 17, 2016) that were subsequent to the Examiner’s Determination and the Requester’s 41.77c Comments, Patent Owners argued that the Examiner did not consider the additional limitations in claims 16, 18, 19, 21, and 22 (PO 41.77e Comments 9), but ignored the Examiner’s express reference to Requester’s explanation of why

the claimed amounts of melanoidin binder would be reasonably expected to have been produced by the modified process of Worthington, Wallace, and Helbing.

The Board's 44.77f Decision followed the Requester's reasoning, which had been adopted by the Examiner, namely:

[T]he Examiner found that the amounts of reducing sugar carbohydrate present in Worthington meet the claimed requirement of "about 73% to about 96% of a total dry weight of binder reactants." Examiner's 41.77d Determination 13. Patent Owner did not dispute that such amounts of reducing sugar carbohydrate are described by Worthington.

41.77f Dec. 11.

It is not disputed that Worthington describes the recited amounts of carbohydrate, as well as ammonium (and other amine) and polycarboxylic acid. DOA 21. The amounts of amine and ammonia in Worthington (col. 3, 11. 17–22, 45–50; col. 5, 11. 20–25; Example 1 at col. 8; Table spanning cols. 7-8, e.g., Nos. 2 and 22) do not appear to be insubstantial, but rather are substantial reactants. While Worthington may not have recognized that a melanoidin was produced, because [of] the presence of all reactants recited in the claims and in substantial amounts, it is reasonable to conclude that the Maillard reaction took place, resulting in substantial amounts of melanoidin.

*Id.* at 18.

Thus, the 41.77f Decision did not set forth a new ground of rejection because the reasoning in the 41.77f Decision was the same as that adopted by the Examiner's Determination, i.e., the cited publications describe the same quantities of reactants as claimed, making it reasonable to find that the Maillard reaction occurred and produced the same product in the same amounts recited in the claims. Because Requester originally set forth this rationale in the Requester's 41.77c

Appeal 2017-004826  
Reexamination Control 95/000,672  
Patent 7,888,445 B2

Comments, which was later adopted by the Examiner's Determination under 41.77d, Patent Owners had a full and fair opportunity to respond to it.

Patent Owners contend that the Board improperly shifted the burden to Patent Owner to show the melanoidin was not formed in the same quantities recited in the rejected claims. We do not agree that the burden was improperly shifted. The burden is properly shifted to patent owner when there is a factual basis to believe a skilled artisan would have made substantially identical products from the teachings of the prior art:

Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product.

...

Whether the rejection is based on "inherency" under 35 U.S.C. § 102, on "prima facie obviousness" under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art products.

*In re Best*, 562 F.2d 1252, 1255 (CCPA 1977) (footnote omitted).

As explained above, the Requester originally set forth a factual basis for finding that the modified process of Worthington, Wallace, and Helbing produced melanoidin in the quantities encompassed by the claims. Patent Owners were aware of this position in Requester's 41.77c Comments, and adopted by the Examiner's Determination. Patent Owner's main response to the rejection is that melanoidin is not formed. PO 41.77e Comments 3. This argument was addressed in the 41.77f Decision, beginning on page 11. Patent Owners, however, did not respond to the so-called "quantities of melanoidin" evidence put forth by

Appeal 2017-004826  
Reexamination Control 95/000,672  
Patent 7,888,445 B2

Requester, which provided the factual basis to have shifted the burden to Patent Owners to prove that such quantities were not present. This burden has not been met by Patent Owners.

In sum, Patent Owners did not persuasively identify a point overlooked or misapprehended in the 41.77f Decision.

REHEARING DENIED

For Patent Owner:

BARNES & THORNBURG LLP (IN)  
11 S. Meridian Street  
Indianapolis, IN 46204

For Third Party Requester:

Tiffany L. Williams  
KILPATRICK, TOWNSEND & STOCKTON LLP  
1100 Peachtree Street, Suite 2800  
Atlanta, GA 30309