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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TOBIAS WEILER

Appeal 2018-005950
Application 14/269,263
Technology Center 3700

Before DANIEL S. SONG, BRANDON J. WARNER, and
PAUL J. KORNICZKY, *Administrative Patent Judges*.

WARNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Illinois Tool Works Inc. (“Appellant”)¹ appeals under 35 U.S.C. § 134(a) from the Examiner’s decision rejecting claims 2, 7, 10–12, and 15–26, which are all the pending claims. Appeal Br. 1, 5. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We REVERSE.

¹ Illinois Tool Works Inc. is the applicant, as provided in 37 C.F.R. § 1.46, and is identified as the real party in interest. Appeal Br. 5.

CLAIMED SUBJECT MATTER

Appellant's disclosed invention "relates to a sealing plug for sealing an opening in a component, in particular a vehicle body part." Spec., p. 1, ll. 3-4. Claims 16, 18, and 26 are independent. Claim 16, reproduced below, is illustrative of the subject matter on appeal.

16. A sealing plug configured to seal an opening in a component, the sealing plug comprising:

an annular shank centered on an axis and closed on one end by a sealing surface, the shank extending into the opening when the sealing plug seals the opening;

a cone-shaped sealing lip having a free end extending from the shank and axially towards the one end, the free end being locked in place on a rear side of the component to close the opening when the shank extends into the opening, the sealing lip having a plurality of discrete portions spaced circumferentially apart from one another by recesses extending towards the axis and entirely through the sealing lip; and

a plurality of separate and distinct first flexible folding zones connecting adjacent discrete portions of the sealing lip, each of the plurality of separate and distinct first flexible folding zones being folded while the shank is inserted into the opening to a condition positioned entirely within the recess between the adjacent discrete portions to allow a circumference of the sealing lip to be reduced, each of the plurality of separate and distinct first flexible folding zones automatically unfolding back when the sealing plug seals the opening.

EVIDENCE

The Examiner relied on the following evidence in rejecting the claims on appeal:

Parker	US 3,156,372	Nov. 10, 1964
Takahashi	US 4,715,095	Dec. 29, 1987
van den Beld	US 4,760,935	Aug. 2, 1988

REJECTIONS

The following rejections are before us for review:

- I. Claims 2, 7, 11, 12, 15–23, and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over van den Beld and Takahashi. Final Act. 2–6.
- II. Claims 10, 24, and 26 stand rejected under 35 U.S.C. § 103 as being unpatentable over van den Beld, Takahashi, and Parker. *Id.* at 7–10.

ANALYSIS

In each of Rejections I and II, the Examiner relies on a combination of teachings from van den Beld and Takahashi to reject the claims as obvious. *See* Final Act. 2–10. Appellant argues that the Examiner has not set forth an adequate reason why one of ordinary skill in the art would have combined the features from these references, suggesting instead that the combination is the result of improper hindsight reconstruction. *See* Appeal Br. 11–19 (focusing on independent claim 16), 19–21 (focusing on independent claim 18), 27–34 (focusing on independent claim 26). We agree.

As the requisite articulated reasoning for combining van den Beld and Takahashi, the Examiner states that it would have been obvious “to have provided the sealing lip 4 of [v]an [d]en Beld, [with] flexible folding zones, for the predictable result of providing effective locking as taught by Takahashi.” Final Act. 4 (citing Takahashi, col. 5, ll. 1–3); *see also id.* at 5 (same reasoning for claim 18), *id.* at 9 (same reasoning for claim 26). But this reason disregards the fact that van den Beld *already provides* effective locking, in the context of a seal no less. *See, e.g.,* van den Beld, Figs. 5, 6

(depicting bottom sealing lip or retaining ring 4" and top sealing lip 3' being cooperatively locked to vehicle bodywork 12 to seal an opening therein); *id.*, col. 3, l. 56 – col. 4, l. 12 (describing same and noting that these sealing elements “ensure very satisfactory sealing by the closure member”).

Although Takahashi teaches discrete projections 4 that flex inwardly to insert and attach leg portion 2 of a plate fastener, the notion of using a plurality of flexible folding zones as part of a continuous sealing lip is disclosed—not by the cited art—but by Appellant. Thus, we agree with Appellant that the rejection does not sufficiently explain *why* a person of ordinary skill in the art would have combined these disparate teachings. *See* Appeal Br. 11–19.

In other words, the Examiner has not sufficiently articulated reasoning based on rational underpinnings as to why one skilled in the art would have been prompted to combine the teachings of van den Beld and Takahashi (along with Parker in Rejection II) in the manner proposed. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (stating that “[r]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006))); *see also* Appeal Br. 12–13 (citing same).

Here, in response to Appellant’s arguments, the Examiner simply reiterates the individual teachings relied upon and alleges that the arguments are directed to each reference individually. *See* Ans. 2–6. But the Examiner does not provide any additional explanation as to why such individual teachings—particularly those of van den Beld and Takahashi—would be

combined to arrive at the specific use of a plurality of flexible folding zones as part of a continuous sealing lip as claimed. *See id.*

Rejections based on obviousness must rest on a factual basis; in making such a rejection, the Examiner has the initial burden 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. *See In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967). Here, absent improper hindsight reconstruction, we do not see a sufficient reasoned explanation based on a rational underpinning as to why one of ordinary skill in the art would have been led to modify van den Beld and Takahashi, and a reason for such modification is not otherwise evident from the record.

Even if we presume that the Examiner's findings regarding individual elements from each of van den Beld and Takahashi are supported by a preponderance of the evidence,² we note that a claim "composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art." *KSR Int'l Co.*, 550 U.S. at 418. Rather, a sustainable obviousness rejection further needs to explain the reasoning by which those findings support the Examiner's conclusion of obviousness. *Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1328–30 (Fed. Cir. 2009). In this case, the rejection fails to meet this required standard.

² We do not find any indication that Takahashi's purported "sealing lip" (discrete projections 4) would function as a seal, or that these projections have any recesses extending therethrough to receive flexible folding zones therein. *See* Appeal Br. 13–18.

Accordingly, based on the record before us, the Examiner has not met the burden of establishing a proper prima facie case of obviousness. On this basis, we do not sustain Rejections I and II.

DECISION

We REVERSE the Examiner's decision rejecting claims 2, 7, 11, 12, 15–23, and 25 under 35 U.S.C. § 103 as being unpatentable over van den Beld and Takahashi.

We REVERSE the Examiner's decision rejecting claims 10, 24, and 26 under 35 U.S.C. § 103 as being unpatentable over van den Beld, Takahashi, and Parker.

CONCLUSION

In summary:

Claims Rejected	Basis	Affirmed	Reversed
2, 7, 11, 12, 15–23, and 25	35 U.S.C. § 103 van den Beld and Takahashi		2, 7, 11, 12, 15–23, and 25
10, 24, and 26	35 U.S.C. § 103 van den Beld, Takahashi, and Parker		10, 24, and 26
Overall Outcome			2, 7, 10–12, and 15–26

REVERSED