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14/126,721	12/16/2013	Michael J. Sievers	72394US02/ BAF-17-1456US	8274
151608	7590	09/02/2020	EXAMINER	
IP Group of DLA Piper LLP (US)/BASF 1650 Market St, Suite 5000 Philadelphia, PA 19103			HIJAZ, OMAR F	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHAEL J. SIEVERS, MICHAEL J. MCNULTY, MICHAEL DREWERY, RICK DAVENPORT, MARY POMA, PAUL J. FOX, and COLBY A. SWANSON

Appeal 2019-004425
Application 14/126,721
Technology Center 3600

Before BRETT C. MARTIN, ANNETTE R. REIMERS, and MICHAEL L. WOODS, *Administrative Patent Judges*.

MARTIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–9, 12–15, 23, and 24. Claims 16–22 were withdrawn from consideration and claims 10 and 11 were canceled during prosecution. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as BASF, SE. Appeal Br. 1.

CLAIMED SUBJECT MATTER

The claims are directed “to a high performance wall assembly having a structural foam layer.” Spec. ¶ 2. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A high performance wall assembly comprising:
 - an exterior covering being at least one of a siding panel, brick, and insulating foam panel;
 - a frame assembly having a top member, a bottom member opposite said top member, and a plurality of vertical members coupled to and extending between said top and bottom members with said frame assembly having an interior side and an exterior side opposite said interior side;
 - a rigid foam insulating panel comprising a closed-cell foam having a plurality of particles of pre-expanded polymers and a binder, said rigid foam insulating panel being disposed adjacent to said exterior side of said frame assembly and extending from said exterior side of said frame assembly and terminating at an exterior surface of said rigid foam insulating panel, with said exterior surface of said rigid foam insulating panel receiving said exterior covering and spacing said exterior covering from said exterior side of said frame assembly;
 - a structural foam layer disposed between and adhered to said plurality of vertical members and adhered to an interior surface of said rigid foam insulating panel between said plurality of vertical members such that said plurality of vertical members are not encapsulated in said structural foam layer, said structural foam layer being selected from the group of polyurethane foams, polyurea foams, and combinations thereof, said structural foam layer having a cohesive strength of from about 5.0 to about 50.0 pounds per square inch; and
 - wherein said structural foam layer adheres said rigid foam insulating panel to said frame assembly such that said rigid foam insulating panel is free of fasteners.

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Buttress	US 1,549,292	Aug. 11, 1925
Charlson	US 6,125,608	Oct. 3, 2000
Vandehey	US 6,662,516 B2	Dec. 16, 2003
Edstrom	US 8,178,643 B2	May 15, 2012
Hagen	US 2005/0055973 A1	Mar. 17, 2005
Brusman	US 2011/0047908 A1	Mar. 3, 2011
Thomas	US 2011/0296794 A1	Dec. 8, 2011

REJECTIONS

Claims 1, 23, and 24² stand rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. Final Act. 2.

Claims 1, 2, 5, 6, 12, 13, and 15 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Hagen, Vandehey, and Charlson. Final Act. 3.

Claims 3 and 4 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Hagen, Vandehey, Charlson, and Buttress. Final Act. 7.

Claims 7–9 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Hagen, Vandehey, Charlson, and Thomas. Final Act. 9.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Hagen, Vandehey, Charlson, and Brusman. Final Act. 11.

Claims 23 and 24 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Hagen, Vandehey, Charlson, and Edstrom. *Id.*

² The Examiner only specifically identifies claims 1, 23, and 24, but all of the remaining claims subject to this appeal depend from claim 1, so this rejection encompasses all pending claims.

OPINION

New Matter

Appellant presents no argument as to the Examiner's rejection noting that the Specification does not have support for "a cohesive strength of from about 5.0 to 50.0 pounds per square inch." As the Examiner points out, the Specification discloses a range of "5.0 to 50.0 pounds per square foot."

Final Act. 2. Accordingly, we agree with the Examiner's rejection and because of the lack of argument, summarily affirm the rejection.

Obviousness

All of the Examiner's rejections rely on the interpretation of Hagen that it teaches the claimed binder found in each of independent claims 1, 23, and 24. Although the Examiner does not expressly say so in the rejection, the Examiner relies on inherency in finding that Hagen teaches the claimed binder. As the Examiner states in the Answer, "polystyrene foam, like other polymers inherently comprises polymer particles that are bonded together, otherwise the structure would fall apart." Ans. 4.

We first note that the Examiner appears to confuse something that is bound together as compared to something that includes a binder. The claims recite a binder and, therefore, the Examiner must show that a binder is actually present in the cited prior art and not simply that something is bound together or it "would fall apart." Ignoring the presence of an actual binder improperly reads a claim element out of the claim.

As to inherency, Appellant is correct that, "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be recognized by persons of ordinary skill.' 'Inherency, however, may not be established by probabilities or possibilities.'" Reply Br. 6 (citing *In re*

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Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999)). In support of this argument, Appellant presents evidence that one method of manufacturing expanded polystyrene “includes subjecting pre-expanded beads to steam so that the beads bind together...without a binder.” Appeal Br. 7 (citing *Expanded Polystyrene (EPS) and the Environment*). Given this evidence it is clear that a binder is not necessary in order for EPS beads to bind together. Accordingly, a binder is not necessary, and, therefore cannot be considered inherent as found by the Examiner. As such, we do not sustain the Examiner’s obviousness rejections.

CONCLUSION

The Examiner’s rejections are AFFIRMED.

More specifically,

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1-9, 12-15, 23, 24	112	Written Description	1-9, 12-15, 23, 24	
1, 2, 5, 6, 12, 13, 15	103	Hagen, Vandehey, Charlson		1, 2, 5, 6, 12, 13, 15
3, 4	103	Hagen, Vandehey, Charlson, Buttress		3, 4
7-9	103	Hagen, Vandehey, Charlson, Thomas		7-9
14	103	Hagen, Vandehey, Charlson, Brusman		14
23, 24	103	Hagen, Vandehey, Charlson, Edstrom		23, 24
Overall Outcome			1-9, 12-15, 23, 24	

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED