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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO. Includes application details for 11/813,764 and 23370 7590 10/06/2020, listing inventor Henry Vincent Dunn and attorney KILPATRICK TOWNSEND & STOCKTON LLP.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte HENRY VINCENT DUNN, STEPHEN WOOLFENDEN,
DAVID ANTHONY THOMAS, and JOHN ROBERT HOYES

Appeal 2019-006818
Application 11/813,764
Technology Center 1700

Before LINDA M. GAUDETTE, N. WHITNEY WILSON, and
BRIAN D. RANGE, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON APPEAL¹

The Appellant² appeals under 35 U.S.C. § 134(a) from the Examiner's decision finally rejecting claims 1–3, 6–11, 14, and 16–19.³

We REVERSE.

¹ This Decision includes citations to the following documents: Specification filed July 11, 2007, as amended (“Spec.”); Final Office Action dated October 23, 2018 (“Final”); Appeal Brief filed May 1, 2019 (“Appeal Br.”); Examiner’s Answer dated July 18, 2019 (“Ans.”); and Reply Brief filed September 18, 2019 (“Reply Br.”).

² We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. The Appellant identifies the real party in interest as Flexitallic Investments Inc. Appeal Br. 1.

³ We have jurisdiction under 35 U.S.C. § 6(b). An oral hearing was held on September 24, 2020.

CLAIMED SUBJECT MATTER

The invention relates to a gasket material comprising a fiber component (fibrillating fiber and mineral fiber), a rubber component, and a further resilient material. Spec. 3:1–4. More specifically, the inventive gasket material includes chemically exfoliated vermiculate (“CEV”) as the further resilient material. *Id.* at 3:4–5. According to the Specification, by using CEV in combination with a fibrillating fiber component, much lower levels of rubber are required in the gasket material. *Id.* at 3:7–9. Low levels of rubber are described as “advantageous because they result in lower levels of organic material in the final product, high stress retention, high load bearing capability and a reduced reduction in sealing performance at higher temperatures as CEV out-performs rubber at high temperatures.” *Id.* at 3:14–19.

Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A gasket material comprising:
 - (a) a start layer comprising rubber;
 - (b) a body layer on top of the start layer and comprising
 - (i) a fiber component comprising a fibrillating fiber component and a mineral fiber component, wherein the total amount of fibrillating fiber component and mineral fiber component is 25–70% w/w of the gasket material,
 - (ii) a rubber component derived from a rubber solution,
 - (iii) a further resilient material in an amount of 1–95% w/w of the gasket material, wherein the further resilient material comprises a water-based chemically exfoliated vermiculite (CEV) component, and
 - (iv) a filler material; and
 - (c) a finish layer on top of the body layer and comprising rubber.

Appeal Br. 12 (Appendix A).

REJECTIONS

1. Claims 1–3, 6–11, and 16–19 are rejected under 35 U.S.C. § 103(a) as unpatentable over Shekleton (US 6,399,204, issued June 4, 2002) as evidenced by Bauer (US 5,437,920, issued August 1, 1995), in view of Tracy (US 4,786,670, issued November 22, 1988) and Hoyes (US 2003/0132579 A1, published July 17, 2003) as evidenced by the Applicant’s admission. Final Act. 3.

2. Claim 14 is rejected under 35 U.S.C. § 103(a) as unpatentable over Shekleton as evidenced by Bauer, in view of Tracy and Hoyes as evidenced by the Applicant’s admission, in further view of Denman (US 2,136,734, issued November 15, 1938). Final Act. 14.

OPINION

“To render a later invention unpatentable for obviousness, the prior art must enable a person of ordinary skill in the field to make and use the later invention.” *In re Kumar*, 418 F.3d 1361, 1369 (Fed. Cir. 2005) (citations omitted). “[W]hen the prior art includes a method that appears, on its face, to be capable of producing the claimed composition,” “[t]he applicant has the burden of coming forward with evidence in rebuttal.” *Id.* at 1368. “This burden may be met by presenting sufficient reason or authority or evidence, on the facts of the case, to show that the prior art method would not produce or would not be expected to produce the claimed subject matter.” *Id.*

The Appellant argues that the applied prior art “fails to teach or suggest any method capable of combining the recited elements to form the claimed gasket material.” Appeal Br. 2. In support of this argument, the Appellant

relies on the Declaration of Stephen Bond, PhD, filed September 4, 2018 (“Bond Decl. IV”). *Id.* at 3. “Facts, such as test data demonstrating inoperativeness . . . , or facts set forth in an affidavit (37 CFR 1.132) of an expert in the field suggesting that inoperativeness, [are] highly probative.” *In re Payne*, 606 F.2d 303, 315 (CCPA 1979) (citations omitted). Based on Dr. Bond’s testimony regarding his education and work experience, we find that Dr. Bond is an expert in the field of mineral chemistry and high temperature sealing materials, and is qualified to testify as to the level of ordinary skill in the art at the time of the present invention. *See* Bond Decl. IV ¶ 2.

Dr. Bond testified that “gasket sealing materials may be made by a variety of processes and may include a variety of materials. But certain materials are unsuited for use in certain processes.” *Id.* ¶ 5. According to Dr. Bond, “even when a component is known for use in a first gasket sealing material made by a first method, often it is challenging, and sometimes impossible, to incorporate that component into a second gasket material made by a second method.” *Id.* ¶ 5. In paragraphs 6–12 of his declaration, Dr. Bond explains why he would not have expected that Shekleton’s polymer, fibers, graphite, and filler, and Hoyes’s rubber solution and CEV, could be combined successfully using the Shekleton, Hoyes, or Tracy processes.

“The Board has broad discretion as to the weight to give to declarations offered in the course of prosecution.” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1368 (Fed. Cir. 2004). Here, we observe that, at the time of his declaration, Dr. Bond was “employed as Vice President of Technology at Flexitallic” (Bond Decl. IV ¶ 2), which appears to be the real party in interest (*see supra* note 2). Therefore, Dr. Bond was not a completely disinterested person. Further, the appeal record lacks factual corroboration to support Dr.

Bond's opinion that the prior art methods could not have been used to produce the claimed gasket material. *See generally* Bond Decl. IV ¶¶ 5–12. These are factors that warrant discounting Dr. Bond's opinion. *See Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d at 1368 (“Although there is ‘no reason why opinion evidence relating to a fact issue should not be considered by an examiner,’ *In re Alton*, 76 F.3d 1168, 1175 n.10 (Fed. Cir. 1996), the Board is entitled to weigh the declarations and conclude that the lack of factual corroboration warrants discounting the opinions expressed in the declaration”); *cf. In re Bulina*, 362 F.2d 555, 559 (CCPA 1966) (“Such ex parte affidavits must, of course, be closely scrutinized and weighed with care, it being kept in mind that they may unconsciously and unintentionally be colored as a result of enthusiasm for the subject matter of the application. We think also that an affidavit by an applicant or co-applicant as to the advantages of his invention is less persuasive than one made by a disinterested person. However, it is not to be disregarded for that reason alone and may be relied on when sufficiently convincing.” (internal citations omitted)).

In this case, however, we need not determine the weight to be accorded to Dr. Bond's declaration because the declaration is evidence, and the Examiner reversibly erred in failing to meaningfully address this evidence (*see, e.g.,* Ans. 16 (“[T]he evidence presented by Appellant is not persuasive. The evidence merely describes different methods of making gasket materials. However, data has not been presented which shows that the prior art would not result in the claimed gasket material.”); Final Act. 17 (“[T]he instant claims are for a product, not a process. The rejection is based on the claimed product. Additionally, the process by which a product is made is not germane to the issue of patentability of the product.”)). *See* Appeal Br. 6 (“In response

to Appellant's arguments and evidence, the Office failed to set forth any relevant facts or reasoning to explain why it found the arguments and evidence unpersuasive.”); Reply Br. 4 (“The Answer demonstrates that the Office improperly analyzed Appellant’s rebuttal evidence under a product-by-process framework, and ignored case law that applies generally to all product claims.”); *cf. In re Sullivan*, 498 F.3d 1345, 1353 (Fed. Cir. 2007) (“The claimed composition cannot be held to have been obvious if competent evidence rebuts the prima facie case of obviousness. By failing to consider the submitted evidence, the Board thus committed error. That is not to suggest the Board’s finding of obviousness must be overturned in light of the evidence; rather, the Board must give the declarations meaningful consideration before arriving at its conclusion.”).

For the above reasons, we do not sustain the rejections of claims 1–3, 6–11, 14, and 16–19.

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–3, 6–11, 16–19	103(a)	Shekleton, Bauer, Tracy, Hoyes, Applicant’s admission		1–3, 6–11, 16–19
14	103(a)	Shekleton, Bauer, Tracy, Hoyes, Applicant’s admission, Denman		14
Overall Outcome:				1–3, 6–11, 14, 16–19

REVERSED