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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DARIUS J. PREISLER and
CHRISTOPHER A. HEIKKILA

Appeal 2018-000871
Application 14/632,238
Technology Center 3900

Before ANNETTE R. REIMERS, JILL D. HILL, and
JEFFREY A. STEPHENS, *Administrative Patent Judges*.

HILL, *Administrative Patent Judge*.

DECISION ON APPEAL

Darius J. Preisler and Christopher A. Heikkila (Appellants) appeal under 35 U.S.C. § 134 from the Examiner’s final decision rejecting reissue claims 1–21 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Appellants’ current application seeks to reissue U.S. Patent 8,690,233 B2 (“the ’233 patent”), issued April 8, 2014, which issued from U.S. Patent Application Serial No. 13/453,201, filed April 23, 2012. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

CLAIMED SUBJECT MATTER

Appellants' reissue claims relate to a carpeted automotive vehicle load floor having sandwich-type composite panels with cellular cores, and a top covering layer bonded to the panels, except where the top covering layer forms a living hinge. '233 Patent, Abstract, 1:6–10. The Specification describes prior art cold-pressed sandwich-type panels with cellular cores and how they are formed, stating that cold-pressed panels disadvantageously required a subsequent operation to form hinges therebetween. *Id.* at 1:14–58. The Specification then describes prior art sandwich-type composite panels made from thermoplastic materials and having certain integrally formed living hinges that are disadvantageously less robust for extended use. *Id.* at 1:59–2:16.

Independent claim 1, reproduced below with annotations indicating the proposed amended claim scope, illustrates the appealed subject matter.

1. A carpeted automotive vehicle load floor comprising:
 - a composite panel having first and second reinforced **[thermo]**plastic skins and a **[thermo]**plastic cellular core disposed between and bonded to the skins, the first skin having a top surface;
 - a cover having top and bottom surfaces and spaced apart from the composite panel; and
 - a substantially continuous top covering layer bonded to the top surface of the panel and the top surface of the cover to at least partially form a carpeted load floor having a carpeted cover, wherein an intermediate portion of the top covering layer between the cover and the panel is not bonded to either the panel or the cover to form a living hinge which allows the carpeted cover to pivot between different use positions relative to the rest of the load floor.

Appeal Br. 19 (Claims App.) (emphasis added).

REJECTION

Claims 1–21 stand rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. Final Act. 3.

ISSUES

The Examiner determines that the broad concept of the composite panel comprising plastic skins and a plastic cellular core was not described in the '233 Patent sufficiently to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Final Act. 3. According to the Examiner, “a review of the Specification indicates that the first and second skins and core are only described as being formed from thermoplastic materials and are not described as being formed generally from plastic materials.” *Id.* at 4 (citing '233 Patent 1:25–28, 2:30–32, 2:59–60, 3:3–6, 3:28–29, 4:35–40, 4:42–45, 5:9–14, 5:19–21, 5:37–39). The Examiner also finds that the Specification only supports the claiming of thermoplastics, because it “describes a method of forming the vehicle load floor by applying heat and forming the composite stack, which is a thermoplastic method,” such that Applicant cannot claim the full range of plastics, “which would include thermosetting as well as thermoplastics.” *Id.* (citing '233 Patent 5:30–47). The Examiner contends that Appellants’ consistent reference to the material as “thermosplastic” indicates that the material being specifically thermoplastic is critical to the invention, despite thermoplastic and thermosetting materials being “known for use in forming automotive load floors, which is supported by Exhibits A-G to the Preisler declaration.” *Id.* at 6 (citing *In re Curtis*, 354 F.3d 1347, 1358 (Fed. Cir. 2004) (“A patentee

will not be deemed to have invented species sufficient to constitute the genus by virtue of having disclosed a single species when . . . the evidence indicates ordinary artisans could not predict the operability in the invention of any species other than the one disclosed.”)).

According to Appellants, the disclosure of a species (e.g., thermoplastics) can support claiming of a genus (e.g., plastics) where “(1) the disclosed species is not critical to the invention” (Appeal Br. 8 (citing *Utter v. Hiraga*, 845 F.2d 993, 998 (Fed. Cir. 1988)), and “(2) it was well-known in the art that alternative species could be used with the invention” (*id.* (citing *Streck, Inc. v. Research & Diagnostic Sys., Inc.*, 665 F.3d 1269, 1285 (Fed. Cir. 2012))). During reissue prosecution, Appellants submitted a declaration of inventor Darius J. Preisler setting forth, *inter alia*, that multiple types of plastics, including thermoplastics and thermosets, were known for use in automotive load floors prior to the filing date of the ’233 patent, and affirmatively stating that the specific type of plastic from which the skins and core of the sandwich-type panels are fabricated is not critical to the invention of ’233 Patent. Appeal Br. 9–11 (citing Preisler Decl. ¶¶ 15, 21, 24–26, 28).

Appellants argue that “[t]he facts of *In re Curtis* are materially different than those before the Board on this appeal,” because the Curtis patent very clearly indicated that the subject matter that the patentee sought to remove from the claims (i.e., microcrystalline wax) was “important to patentability” and had no known alternatives. Appeal Br. 12. In the present case, Appellants argue, “thermoplastic and thermoset materials were known, predictable options for forming an automotive load floor,” and “the specific

type of plastic from which the skins and core of the sandwich-type panels are fabricated is not critical to the invention.” *Id.* at 16.

The Examiner responds that, in the '233 Patent, “every time the first and second skins 16 and 18 and core 20 are referenced, they are **only** described as being formed from thermoplastic materials and are never described as being formed generally from plastic materials or being formed from any materials other than thermoplastic materials.” Ans. 5 (citing '233 Patent 3:25–30, 4:35–40, 5:18–25).

Appellants reply that, *inter alia*, “[t]he inventor’s sworn statement in the reissue declaration supersedes and refutes any contention there was a clear and deliberate choice to limit the claim scope to thermoplastic materials in the as-filed application.” Reply Br. 3.

The Examiner has the better argument. The issue before us is whether the broad concept of the composite panel comprising plastic skins and a plastic cellular core was described in Appellants’ Specification sufficiently to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. We agree with the Examiner that the first and second skins 16 and 18, and the core 20, are only described as being formed specifically from thermoplastic materials, rather than from another material or generally from plastic. Ans. 5. Thus, regardless of the predictability of results of substituting alternatives, or the actual criticality of thermoplastics in the overall invention, Appellants’ Specification, as a whole, indicates to one skilled in the art that the inventors had possession only of the skins and core comprising specifically thermoplastic. This determination is not refuted by

any sworn statement by the inventor(s) regarding possession of a broader claim scope.

Regarding the claim language of US Patent No. 8,764,101 to Saur (Appeal Br. 16–17), we are aware of no precedent that the patenting of broad claim scope evidences patentability of similarly broad claim scope in other patent documents.

Thus, for the reasons explained above, we discern no error in the Examiner’s determination that the reissue claims fail to comply with the written description requirement, because plastic skins and a plastic cellular core were not described in Appellants’ Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

DECISION

We AFFIRM the rejection of claims 1–21 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement.

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. § 41.50(f).

AFFIRMED