

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HARRIS M. GITLIN and JAMES W. MALONEY, JR.

Appeal No. 96-3482
Application 08/155,010¹

ON BRIEF

Before MEISTER, ABRAMS and PATE, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1 through 8 and 11. At that point, claims 9 and 10 had been canceled, and the examiner had indicated that dependent claims 5 and 6 would be allowable if rewritten in independent form.

¹ Application for patent filed November 19, 1993.

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The appellants' invention is directed to a variable tension roofing and structural protective harness. The subject matter before us on appeal is illustrated by reference to claim 1, which appears in an appendix to the appellants' Brief on Appeal.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Ballinger	3,715,843	Feb. 13, 1973
McQuirk	4,858,395	Aug. 22, 1989

THE REJECTIONS

Claim 11 stands rejected under 35 U.S.C. § 112, first paragraph, as being drawn to subject matter unsupported in the specification as originally filed.²

Claims 1 through 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ballinger.

² A rejection under 35 U.S.C. § 112, second paragraph, was overcome by amendment after the final rejection, as was one of the two reasons for the rejection under 35 U.S.C. § 112, first paragraph (Paper No. 9). With regard to the latter, we note that the statement regarding the two Section 112 rejections erroneously gives the impression that both reasons had been overcome when, in fact, the rejection of claim 11 for one of them has been maintained in the Examiner's Answer.

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Claims 7, 8 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ballinger in view of McQuirk.

The rejections are explained in the Examiner's Answer.

The opposing viewpoints of the appellants are set forth in the Brief and the Reply Brief.

OPINION

The Rejection Under 35 U.S.C. § 112, First Paragraph

It is the examiner's position that the specification provides no support for the recited "means for allowing vertical movement" and the "means for allowing lateral drift" of the storage shaft. We agree with the appellants that this is not the case, noting the description on page 11 of the specification of shaft slot 49 and lateral drift slot 50, which are shown in Figure 7.

This rejection is not sustained.

The Rejections Under 35 U.S.C. § 103

The examiner bears the initial burden of presenting a *prima facie* case of obviousness (see *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) and *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)), which is established when the teachings of the prior art itself

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would appear to have suggested the claimed subject matter to one of ordinary skill in the art (see *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) and *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)). It is our view that the examiner has failed to do so with regard to either of the Section 103 rejections, and we therefore will not sustain them. Our reasoning follows.

Claim 1 requires, *inter alia*, that the appellants' inventive harness for securing a building against damaging winds comprise "a first sheet of coarsely woven or knitted fabric having a shade or porosity" (emphasis added), in which the ratio of surface area of the opaque threads to the total surface area of the fabric, including the interstice between the threads, "be of 60% to 75%, such that air will pass readily through the fabric." The purpose of this construction, as understood from the specification, is to allow the wind to provide sufficient force upon the fabric on the windward side of the building to press the strap-like elements which extend over the roof in tension against the roof, while causing a minimum of additional reduction of pressure upon the leeward side of the building so as to minimize lift there, which is undesirable (page 13).

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This claim stands rejected as being unpatentable over Ballinger, which is directed to a fire protection cover for a building. The objective of the Ballinger invention is to protect a building from damage by an oncoming fire, and it does so by covering the building with a cover that prevents heat and flame from passing through. We agree with the appellants for the reasons expressed in their Briefs that the examiner's reliance upon Figure 13D of Ballinger as disclosing a coarsely woven fabric is misplaced. Moreover, there is absolutely no explicit or implicit suggestion in Ballinger that there be a particular ratio between the surface area of the opaque threads and the total area of the fabric, much less that it be the 60 to 75 percent described in the appellants' specification as being preferred (pages 7 and 8), and recited in claim 1.

It is our opinion that the teachings of Ballinger fail to establish a *prima facie* case of obviousness with regard to the subject matter of claim 1, and therefore this rejection cannot be sustained. Nor, it follows, can this rejection of dependent claims 2 through 4 be sustained.

Dependent claims 7, 8 and 11 stand rejected under Section 103 on the basis of Ballinger in view of McQuirk. The secondary reference is cited for its teachings regarding the storage of

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fire protection covers upon the roofs of the buildings with which they are to be used. McQuirk does not, however, alleviate the failing in Ballinger which we have pointed out above, and therefore this rejection fails for the same reasons as were applied to the rejection of claim 1.

SUMMARY

None of the rejections are sustained.
The decision of the examiner is reversed.

REVERSED

JAMES M. MEISTER)	
Administrative Patent Judge))	
)	
)	
NEAL E. ABRAMS)	BOARD OF PATENT
Administrative Patent Judge))	APPEALS AND
)	INTERFERENCES
)	
)	
WILLIAM F. PATE III)	
Administrative Patent Judge))	

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