

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(2) is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DONALD CASTEEL and JOHN MULLER

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Appeal No. 1997-0074  
Application No. 08/123,092

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ON BRIEF

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Before ABRAMS, STAAB, and MCQUADE, Administrative Patent  
Judges.

ABRAMS, Administrative Patent Judge.

**DECISION ON APPEAL**

This is an appeal from the decision of the examiner  
finally rejecting claims 1-8 and 11-20. Claims 9 and 10 have  
been allowed.

The appellants' invention is directed to a method of

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manufacturing a composite plastic article having an integral handle. The claims on appeal have been reproduced in an appendix to the brief.

**THE REFERENCES**

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

Hunt 20, 1953	2,656,294	Oct.
Wilfert 1962	3,068,044	Dec. 11,
Michel 1977	4,016,230	Apr. 5,
Ashtiani-Zarandi et al. 1990 (Ashtiani-Zarandi)	4,890,877	Jan. 2,
Mills 1993	5,252,164	Oct. 12,

**THE REJECTIONS**

Claims 1-5, 7, 8, 11 and 14-16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ashtiani-Zarandi in view of Wilfert, Mills and Michel.

Claims 6, 12, 13 and 17-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ashtiani-Zarandi in view of Wilfert, Mills, Michel and Hunt.

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Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejection and the conflicting viewpoints advanced by the examiner and the appellants, we make reference to the Examiner's Answers (Papers No. 12 and 16) and to the Appellants' Briefs (Papers No. 11 and 15).

#### OPINION

In reaching our decision on the issues raised in this appeal, we have carefully assessed the claims, the prior art applied against the claims, and the respective views of the examiner and the appellants as set forth in the Answer and the Brief. As a result of our review, and applying the guidance provided by our reviewing court, we have determined that the rejections should not be sustained. Our reasoning in support of this conclusion follows.

All of the claims stand rejected as being unpatentable under 35 U.S.C. § 103. The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, ***In re***

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**Keller**, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See **Ex parte Clapp**, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, **Uniroyal, Inc. V. Rudkin-Wiley Corp.**, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1052 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

All three of the appellants' independent claims are directed to a method of manufacturing an article having an integral handle. Claim 1 is representative, setting forth the invention as comprising the following steps:

providing a structural substrate that has a handle hole of sufficient size to provide a space for gripping a handle that spans the hole,

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attaching a handle frame to the substrate so that it spans the handle hole,

draping a sheet of stretchable material over the substrate and the handle frame so that it covers the handle hole, and

forming the stretchable sheet against the top of the structural substrate and at least partially around the handle frame by differential pressure applied to the draped sheet.

The examiner combines the teachings of four references in order to meet the terms of the claim. The primary reference is Ashtiani-Zarandi, which is cited for its disclosure of an inner door panel having an integral handle and arm rest that are covered with a decorative material. Wilfert is relied upon for showing a handle that is completely encased in a cover. The examiner has not explained how these two references are to be combined, but acknowledges that they fail to describe the techniques used to apply the decorative coverings to the handles. He also states that they "appear to teach covering the handles in a separate step and subsequently attaching them to the inner door panel" (Answer, page 5) which, of course, is contrary to the appellants' claimed method. The examiner then looks to Mills, stating that this reference "teaches that it is desirable to cover the panel

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face and the insert in a single cover forming operation so that . . . [both] will be covered by the same material" (Answer, page 5), after which he concludes that "it therefore would have been obvious to one of ordinary skill in the art to use the vacuum cover application technique of Mills to apply the covering to the handle and panel face in the processes of Ashtiani-Zarandi and Wilfert" (Answer, page 6). Finally, the examiner applies Michel, which is directed to a method of forming articles such as pallets, opining that it would have been obvious, in view of Michel, to draw and secure the vacuum-formed cover of a handle around the handle "because Mills shows this to be possible and Michel teaches the use of vacuum for drawing a covering around a substrate" (Answer, pages 6-7).

The first step in the method recited in claim 1 is providing a structural substrate that has a handle hole, and the second is to attach a handle frame to the substrate so that it spans the hole. These two steps clearly are not explicitly disclosed or taught by either Ashtiani-Zarandi or Wilfert, which are the only two references that even disclose a handle, nor is there reason to believe that such inherently

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would be the case. In this regard, we again note the examiner's opinion that in these references the handle is separately made and covered and then is attached to the supporting substrate. While the door and the panel disclosed by Mills are in juxtaposition once they are installed in the vehicle, the essence of the Mills teaching is merely covering a plurality of separate objects in a single pass, and then cutting them apart for separate use. Therefore, from our perspective, the combined teachings of the first three of the applied references would have provided no suggestion to one of ordinary skill in the art to attach a door handle to a substrate that has a handle hole and then to cover this structure with a single sheet of material by any means, much less by differential pressure. Although Michel discloses attaching two elements together by using differential pressure to form a material about them, it still provides no suggestion to do so to form a composite article comprising a handle and a substrate having a handle hole.

The mere fact that the prior art structure could be modified does not make such a modification obvious unless the

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prior art suggests the desirability of doing so.<sup>1</sup> In the present case, we fail to perceive any teaching, suggestion or incentive which would have motivated one of ordinary skill in the art to utilize the method recited in claim 1 other than the hindsight accorded one who first viewed the appellants' disclosure. This, of course, is not a proper basis for a rejection under 35 U.S.C.

§ 103.<sup>2</sup>

It therefore is our conclusion that the combined teachings of the four references applied against claim 1 fail to establish a *prima facie* case of obviousness with regard to the claimed subject matter. We will not sustain the rejection of claim 1 or, it follows, of claims 2-5, which depend therefrom. The same rationale applies to independent method claims 7 and 11, which describe the invention in slightly different terms, and the claims that depend from them. The rejection of claims 7-11 and 14-16 also is not sustained.

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<sup>1</sup> ***In re Gordon***, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

<sup>2</sup> ***In re Fritch***, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

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Hunt has additionally been cited in the rejection of dependent claims 6, 12, 13 and 17-20, for its teaching of tucking the edges of the covering into a slot in the item being covered. Even if one considers Hunt, which is directed to covering a bowling pin with a fabric and lacquer, to be analogous art, it fails to alleviate the shortcomings discussed above with regard to the four references applied against the independent claims. The rejection of these claims is not sustained.

**SUMMARY**

Neither rejection is sustained.

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The decision of the examiner is reversed.

**REVERSED**

NEAL E. ABRAMS	)
Administrative Patent Judge	)
	)
	) BOARD OF PATENT
LAWRENCE J. STAAB	)
Administrative Patent Judge	) APPEALS AND
	)
	) INTERFERENCES
	)
JOHN P. MCQUADE	)
Administrative Patent Judge	)

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