

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANCOIS ZWEIG

Appeal No. 1999-0604
Application 08/575,477

ON BRIEF

Before CALVERT, CRAWFORD, and GONZALES, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 11 to 20, all the claims remaining in the application.

The claims on appeal are drawn to a cable tray, and are reproduced in the appendix of appellant's brief.

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The reference applied in the final rejection is:

Simon	533,039	July 28, 1993
(European Application)		

Claims 11 to 20 stand finally rejected as unpatentable over Simon, under 35 U.S.C. § 103(a).

In the answer, the examiner indicates that Simon U.S. Patent No. 5,531,410 is the English-language equivalent of the Simon European Application, and appellant has not disagreed. Accordingly, we will for convenience consider the rejection in relation to the disclosure of the Simon '410 patent, and any further references to "Simon" are to that patent. The five excerpts from the Simon European Application translated by appellant on pages 4 and 5 of the brief appear to correspond to col. 1, lines 25 to 30, 36 to 51, and 61 to 65, and col. 2, lines 33 to 44 and 49 to 53, of the Simon patent.

Claim 11 reads (emphasis added):

11. Cable tray comprising a treillis [sic: trellis] including a plurality of longitudinal wires and a plurality [of] U-shaped transverse wires fixed to one another, the plurality of longitudinal wires running longitudinally along substantially the entire length of the tray, said plurality of transverse U-shaped wires being disposed transversely to the plurality of longitudinal wires and spaced longitudinally from one another, said

treillis [sic: trellis] defining a trough having a bottom and opposed sides, said plurality of longitudinal wires including edge longitudinal wires defining free edges of the opposed sides and bottom longitudinal wires forming the bottom of the trough, said bottom longitudinal wires including sidemost bottom longitudinal wires located adjacent the respective sides of the trough and intermediate bottom longitudinal wires disposed between the sidemost bottom longitudinal wires, at least one of said intermediate bottom longitudinal wires having a cross sectional area less than that of the said sidemost bottom longitudinal wires.

There is no dispute that Simon discloses a cable tray meeting all of the recited limitations, except for the underlined portion of the claim. According to appellant, he has discovered that if, as recited in the underlined portion, the cross-sectional area (i.e., the diameter) of the longitudinal wires not at the sides is reduced relative to the diameter of the sidemost longitudinal wires, the weight and cost of the tray are reduced without reducing its mechanical strength (specification, page 1, line 33, to page 2, line 3).

In the Simon patent, there is no disclosure of what the diameters of the bottom longitudinal wires 8 are, but from the drawings they all appear to be of the same diameter. At the upper ends of transverse U-shaped wires 7 Simon discloses a

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hook 72, with two longitudinal wires 9 and 10 of different diameters running through the bends 73 of the hooks, the purpose of these

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wires being to "rigidify the structure" of the cable way (col. 2, lines 40 to 44). From Fig. 5, the diameter of wire 10 appears to be less than the diameter of wires 8 and 9.

Notwithstanding Simon's lack of disclosure that bottom longitudinal wires 8 should or may be of different diameters, the examiner concludes that such a modification of Simon would have been obvious in view of Simon's teaching "that it is known to have longitudinal wires and/or transverse wires having different cross sections and different diameter sizes . . . than that [sic: those] of the other longitudinal wires" (answer, page 4). The examiner also states at pages 6 to 8 of the answer:

In response to the applicant's arguments the examiner admits that Simon does not disclose at least one intermediate bottom longitudinal wires [sic] having a cross sectional area less than that of the said sidemost bottom longitudinal wires. But . . . it would have been an obvious matter of design choice to [provide?] at least one intermediate bottom longitudinal wires [sic] having a cross sectional area less than that of the said sidemost bottom longitudinal wires, since such a modification would have involved a mere change in the size of the diameter of a component. A change in size is generally recognized as being

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within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). The change in diameter of the bottom longitudinal wires would not destroy the function of the Simon wire tray nor would it produce any unexpected results.

* * * * *

Simon discloses that it is known to have a longitudinal wire [10] having a cross section area of less than that of the said sidemost bottom longitudinal wires. It would have been obvious to one having ordinary skill in the art to have made at least one intermediate bottom longitudinal wire having the lessen [sic: lesser] cross sectional area because the applicant contends that to provide such a wire provides the unexpected result of reduction in cost and weight. The examiner would like to point out that to materially reduce the size of a component is well known in the art to reduce the cost and weight of the invention and is therefore not an unexpected or patentable feature as the applicant suggests.

We do not consider this rejection to be well taken. In the first place, it is not evident why Simon's disclosure of an additional, smaller diameter wire 10 in the bend 73 of hook 72 for the purpose of "rigidifying the structure" would have suggested reducing the diameter of one or more of Simon's bottom wires 8. Contrary to the examiner's conclusion, supra, we do not regard Simon's disclosure of wire 10 as a teaching that any of the longitudinal wires may have different

diameters, but rather that a smaller-diameter wire may be added to the margin of the tray to rigidify the structure.

Secondly, it may well be that it would have been an obvious matter of design to reduce the diameter of all the wires of the Simon tray, or at least all of the longitudinal wires, if one wished, for example, to reduce the weight and cost at the expense of load-carrying capacity. However, we do not consider that it would have been an obvious matter to change the diameter of only some of the longitudinal wires relative to the others, and there is no teaching in Simon to that effect.

"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). In the present case, the claimed subject matter may, in hindsight, appear to be an obvious modification of the Simon apparatus, but in the absence of any suggestion of such modification in the prior art, such a hindsight view would seem to be based on

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appellant's own disclosure. This is not a proper basis for a rejection under § 103.

The rejection of claim 11, and thus of dependent claims 12 to 20, will therefore not be sustained.

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Conclusion

The examiner's decision to reject claims 11 to 20 is reversed.

REVERSED

	IAN A. CALVERT)	
	Administrative Patent Judge))	
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PATENT))	BOARD OF
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AND))	APPEALS
	MURRIEL E. CRAWFORD)	
INTERFERENCES	Administrative Patent Judge))	
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