

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TERESA M. OKONSKY

Appeal No. 1999-0636
Application No. 08/828,375¹

ON BRIEF

Before COHEN, FRANKFORT and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 7 through 10, 16, 18, 20, 21 and 24 through 28. Claims 26 and 27 were amended (see Paper No. 20 and Paper No. 21) after the final rejection. Claims 1 through

¹ Application for patent filed March 28, 1997. According to the appellant, the application is a continuation of Application No. 08/391,546, filed February 21, 1995, now abandoned.

Appeal No. 1999-0636
Application No. 08/828,375

5, 22 and 23, the only other claims remaining in the
application, have been indicated as allowable by the examiner.

BACKGROUND

The appellant's invention relates to an expandable partition kit or gate assembly which is adapted to be mounted, in one embodiment, into a wall or, in another embodiment, onto a finished wall. The assembly includes a housing for storing the expandable gate in collapsed form. The expandable gate may be in the form of an accordion gate (2), as illustrated in Figures 1, 2 and 5 or a rollable netting/fabric/material stored on a spool within the housing, as illustrated in Figures 6 through 8. A copy of the claims on appeal is contained in the appendix to the appellant's brief.²

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Martinek	1,882,331	Oct. 11, 1932
La Mell et al. (La Mell) 1979	4,160,972	Jul. 10,
Johnston	4,821,786	Apr. 18, 1989

A reference made of record by this panel of the Board is:

Christison	2,455,112	Nov. 30, 1948
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The following rejections are before us for review.

² The copy of claim 20 in the appendix is an inaccurate reproduction of the claim of record in that, in line 4, "than" should be "that."

1. Claims 16, 18, 20, 21, 24 and 26 through 28 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Martinek.
2. Claims 7, 8, 10 and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Martinek in view of La Mell.
3. Claims 9 and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Johnston in view of La Mell.

Reference is made to the brief (Paper No. 19) and the answer (Paper No. 22) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The anticipation rejection

Turning first to the examiner's rejection of independent claim 20 as being anticipated by Martinek, the examiner finds that

Martinek discloses an expandable partition comprising a housing means 11, an expandable stiff partition 16,17,18,19, and a panel means 44. Inasmuch as the links 18 are secured by pivots 19 to the vertical bars 17 which are in turn secured to the housing, the claim recitation "said partition being pivotably secured to said housing means" is fully met [answer, page 3].

Appellant argues, *inter alia*, that (1) "pocket 11" is not a "housing means" as recited in claim 20 (brief, page 10) and (2) the Martinek gate (16) is not "pivotably secured to said housing means" as required by the claim (brief, pages 10 through 12).

As to the appellant's first argument, we find that Martinek's Figures 1 through 3 and 6 clearly illustrate a shell-like structure³ attached to the wall (10) to line at least the upper and side faces of the recess in the wall. That this structure is distinct from the wall itself is

³ While the reference numeral 11 as shown in Figures 2 and 6 appears to be directed at this structure, the reference numeral 11 in Figures 1 and 3 appears to be directed more to the recess or cavity disposed within the shell-like structure.

evident from the different cross-hatching used by Martinek. Notwithstanding that Martinek does not refer to this structure as a "housing" or "housing means," we agree with the examiner that this shell-like structure responds to the "housing means" limitation of claim 20.

We do, however, agree with the appellant's second argument that the gate (16) of Martinek is not "pivotably secured to said housing means." While we appreciate that flat bars (18) of Martinek's gate are pivotably mounted to vertical bars (17) of the gate so as to permit folding and expansion of the gate, we note that the pivotable securement of portions of the gate to other portions of the gate does not meet the claim limitation that the gate be pivotably secured to "said housing means." Based on our review of Martinek, it appears that the gate (16) is fixedly (not pivotably) secured at one end (end bar 24) relative to the shell-like structure via a frame (12) and fixed member

(26). Therefore, we have determined that Martinek does not anticipate the subject matter of claim 20 or claims 16, 18, 24 and 26 through 28 which depend from claim 20.⁴

Accordingly, we reverse the examiner's decision to reject claims 20, 16, 18, 24 and 26 through 28 under 35 U.S.C. § 102(b) as being anticipated by Martinek.

Turning next to the examiner's 35 U.S.C. § 102(b) rejection of claim 21, Martinek discloses a "housing means" (the shell-like structure as discussed above and incorporated herein), the outermost edge surface of the "housing means" forming a plane, and an expandable partition (gate 16) stored within the "housing means." The gate (16) is expandable well beyond, or to the right of in Figure 1, the outermost edge surface of the shell-like "housing means." Therefore, from our viewpoint, the gate is expandable "about" an arbitrary axis (e.g., the axis running through the sixth vertical bar 17 from the left) located to the right of (beyond) the outermost

⁴ Anticipation under 35 U.S.C. § 102 is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. See RCA Corp. V. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

surface of the "housing means" and to the left of the right end of the gate (16) in Figure 1.

Therefore, while we have carefully considered the appellant's argument on pages 14 and 15 of the brief, we do not find it persuasive. To the extent that the appellant's argument is that the Martinek gate does not pivot in addition to expanding linearly, we emphasize that claim 21 does not recite any pivoting or pivotable securement of the gate. Accordingly, such a feature cannot be relied upon for patentability of claim 21.⁵

Accordingly, we shall sustain the examiner's rejection of claim 21.

The obviousness rejections

Martinek discloses an expandable gate assembly comprising a "housing means" (the shell-like structure as discussed above and incorporated herein) and an expandable gate (16) stored in the "housing means." With regard to claim 25, Martinek lacks

⁵ It is well settled that the particular feature or fact upon which an applicant predicates patentability must not only be disclosed in the specification but also brought out in the claims. See In re Richards, 187 F.2d 643, 645, 89 USPQ 64, 66 (CCPA 1951).

a teaching that the gate has a height "less than approximately 50 inches" and "an alarm activated by movement of said gate."

Regarding the height of the gate, the examiner's position is that the specific height of the gate is not seen as constituting a patentable distinction because one having ordinary skill in the art would have readily recognized such a dimensional decision as a matter of design engineering choice (answer, pages 3 and 4). The appellant, on the other hand, asserts that "[t]here is no reason to believe that anyone would be motivated to reduce the size of MARTINEK to less than approx. 50 inches" (brief, page 16). We agree with the examiner.

One of ordinary skill in the art reading the Martinek disclosure would have understood that the disclosed gate assembly is intended to form a retractable barrier across an opening and would have appreciated that the dimensions of the gate must be determined by the particular opening sought to be closed. Further, we find absolutely no teaching or suggestion by Martinek that the disclosed gate is suitable only for openings of 50 inches or more in height. Moreover, the appellant has not alleged or shown that the claimed height

solves any stated problem. Accordingly, we agree with the examiner that the particular height of the gate would have been an obvious matter of design choice within the skill of the art.⁶

The examiner contends that it would have been obvious to incorporate an audible alarm on the Martinek gate to detect unauthorized movement of the gate, in view of the teaching by La Mell to provide an alarm on a barrier (answer, page 3). The appellant argues on pages 15 through 17 of the brief that the combined teachings of Martinek and La Mell would not have suggested provision of an alarm on the Martinek gate because (1) Martinek is designed to prevent movement and block passage and thus does not need an alarm and (2) the alarm of La Mell is adapted (by the incorporation of a delay circuit) for use with freely movable barrier members and thus would not have suggested provision of an alarm on the rigid gate assembly of Martinek.

The appellant's first argument is not well taken. While we appreciate that the Martinek gate is provided with a wide

⁶ See In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

steel tape (33) as a reinforcing member at the top of the gate to assure rigidity and ease of operation of the gate and eliminate side-sway (page 1, lines 1-9), one of ordinary skill in the art reading the disclosure of Martinek would have understood that no gate is completely impenetrable or tamper-proof and would have recognized the merits of an alarm system to indicate unauthorized tampering or movement of the gate.

The appellant's second argument is directed to the fact that the La Mell alarm system is specifically adapted for use on Venetian blinds or similar window barriers which are subject to harmless movement as the result of wind disturbances. The La Mell system comprises a magnet (42) on the window sill (18) and a reed switch (40) mounted on a lower rail (26) of the Venetian blind (10) which senses the proximity of the magnet (42) thereto. When the blind is moved relative to the window frame, the reed switch (40) is moved out of proximity to the magnet (42), thereby causing the reed switch to change states. The disclosed improvement in the La Mell system is an alarm circuit (44), discussed in detail in column 6, line 39, to column 7, line 9, which permits actuation of the alarm generating device (54) only after the

reed switch has been out of proximity with the magnet for a predetermined period of time. The alarm circuit is designed to prevent false alarms caused by wind disturbances of the blind while warning of a more sustained movement of the blind caused by an intruder. The appellant's argument is, in effect, that such a delay to prevent false alarms would have been unnecessary or undesirable on the relatively rigid gate of Martinek.

We have carefully considered this argument, but we do not find it persuasive. La Mell clearly teaches the desirability of providing an alarm on a movable barrier positioned in an opening to detect movement of the barrier by intruders seeking access to the opening. While it may be true that a delay circuit in the alarm system would not have been considered by one of ordinary skill in the art to be desirable for all gates in all situations, we find the teaching of La Mell sufficient to have suggested broadly the provision on the Martinek gate of an alarm, even if not the particular alarm system disclosed by La Mell, activated

by movement of the gate to warn of actual or attempted unauthorized access to the opening sought to be closed by the gate.

Accordingly, we shall sustain the examiner's 35 U.S.C. § 103 rejection of claim 25 as being unpatentable over Martinek in view of La Mell. As the appellant has conceded that the additional limitations recited in claims 7 and 8 which depend from claim 25 are disclosed by Martinek (see brief, page 17), it follows that we shall also sustain the examiner's rejection of these claims under 35 U.S.C. § 103 as unpatentable over Martinek in view of La Mell.

As to claim 10, we find that the "housing means" of Martinek, as perhaps best illustrated in Figures 1, 3 and 6, is mounted on the structure (10), which is disclosed by Martinek as being "a wall, jamb, partition or other surface" (page 1, lines 46 and 47). We consider the wall or other surface (10) to be a "finished surface" as claimed. Accordingly, we shall also sustain the examiner's rejection of claim 10 under 35 U.S.C. § 103 as being unpatentable over Martinek in view of La Mell.

Turning finally to the examiner's rejection of claims 25 and 9 under 35 U.S.C. § 103 as being unpatentable over Johnston in view of La Mell, Johnston discloses a closure structure for closing a doorway comprising a housing means (box-like enclosure 17) and a reel or spool of closure material (18) bordered at one end by a stabilizing member (19) provided with supporting wheels (24) at the upper end thereof adapted to travel in a guide means (23) of a track hanger (22) mounted to the top of the doorway. The closure material (18) is disclosed as being screen cloth, vinyl "or other plastic suitable for storm door usage" (column 1, lines 58-62). The box-like enclosure (17) is mounted to the door jamb (12) and a strip (37) of magnetic material is mounted to the other door jamb (13). As explained in column 2, lines 41-50, the magnetic material enables the jamb (13) to releasably maintain the closure in the closed position, such that application of a sufficiently hard force will cause the closure to disengage from the magnetic material and automatically retract to protect the closure whereas mere high winds will not cause the closure to retract.

In rejecting claims 25 and 9, the examiner recognizes that Johnston does not disclose a closure height of "less than approximately 50 inches" or an alarm as required by the claims. However, the examiner asserts that the specific height of the gate is merely an obvious matter of design choice and that it would have been obvious to provide an alarm on the Johnston closure in view of the teachings of La Mell.

As to the height of the closure, we agree with the examiner that the particular dimensions of the closure would have been an obvious matter of design choice within the skill of the art. As noted above, the appellant has not alleged or shown that the claimed height solves any stated problem. One of ordinary skill in the art having read the Johnston disclosure would have selected dimensions appropriate for the particular doorway or other opening sought to be closed.

We have considered the appellant's arguments bridging pages 18 and 19 of the brief that La Mell would not have suggested providing an alarm, activated by movement of the closure material, on the Johnston closure structure, but we do not find them persuasive. La Mell clearly teaches the desirability of providing an alarm on a movable barrier

positioned in an opening to detect movement of the barrier by intruders seeking access to the opening. While it may be true that a delay circuit in the alarm system would not have been considered by one of ordinary skill in the art to be desirable for all closures in all situations, we find the teaching of La Mell sufficient to have at least suggested broadly the provision on the Johnston closure of an alarm, even if not the particular alarm system disclosed by La Mell, activated by movement of the closure to warn of actual or attempted unauthorized access to the opening sought to be closed by the closure structure.

With regard to claim 9, which depends from claim 25, the appellant further argues that Johnston "teaches away from the material as being functional as a gate in that the mechanism immediately retracts the material to protect it when the closure has applied force acting on it" (brief, page 19). We see nothing in this protective retractability feature which precludes its function as a "gate"⁷ as claimed.

⁷ A "gate" is "a movable framework or solid structure, esp. one that swings on hinges, controlling entrance or exit through an opening in a fence or wall" (Webster's New World Dictionary, Third College Edition (Simon & Schuster, Inc. 1988)).

For the foregoing reasons, we shall sustain the examiner's rejection of claims 25 and 9 under 35 U.S.C. § 103 as being unpatentable over Johnston in view of La Mell.

REMAND TO THE EXAMINER

We remand the application to the examiner for consideration of the following issues:

(1) Do claims 2, 3, 5, 7, 8, 10, 16, 18, 20-24 and 26-28 particularly point out and distinctly claim the subject matter which the appellant regards as the invention, as required by the first paragraph of 35 U.S.C. § 112? In particular:

(a) Would one of ordinary skill in the art reading the appellant's disclosure understand what is meant by "said partition being pivotably secured to said housing means such that it is expandable at an acute angle to said axis" as recited in claim 20 (and incorporated by all claims depending therefrom)?

(b) Is the recitation in claims 2, 3, 5, 7, 8, 10, 18, 22, 23, 27 and 28 (and incorporated by all claims depending from these claims) that the housing means is "installed," "mounted" or "in engagement with" a wall or a finished surface

commensurate in scope with the preambles of these claims, which recite an "expandable partition kit" or "expandable gate assembly"? The kit or assembly as disclosed would not appear to us to include the wall or wall surface.

(c) Would one of ordinary skill in the art understand what is meant by the language "expandable about an axis" as recited in claim 21?

(2) Is the subject matter of claims 7-10, 16, 18, 20 and 24-28 supported by the appellant's original disclosure, as filed on February 21, 1995 as Application No. 08/391,546, in compliance with the written description requirement of the first paragraph of 35 U.S.C. § 112? In particular:

(a) Is the limitation "expandable at an acute angle" in claim 20 (and incorporated by all claims depending therefrom) adequately supported in the appellant's original disclosure?

(b) Does the appellant's original disclosure provide adequate support for the gate height of "less than approximately 50 inches" recited in claim 25 (and incorporated by all claims depending therefrom)?

(3) Does Christison (U.S. Patent No. 2,455,112, issued November 30, 1948) anticipate the subject matter of any of the

claims on appeal? Christison discloses an extensible guard (comprising vertical members 16-18 and links 19) slidably supported by means of U bolts (29) fitting about a plurality of disposed rods (28) secured within a cabinet (31) mounted to a wall (30). With particular reference to claim 20, as noted in column 2, lines 16-19, the U bolts are bent to permit pivotal movement of the entire guard about the rods (28).

This application, by virtue of its "special" status, requires immediate action. Manual of Patent Examining Procedure (MPEP) § 708.01 (7th ed., July 1998). Further, it is important that the Board of Appeals and Interferences be informed promptly of any action affecting the status of the appeal.

CONCLUSION

To summarize, the decision of the examiner to reject claims 20, 16, 18, 21, 24 and 26 through 28 under 35 U.S.C. § 102(b) is affirmed as to claim 21 but reversed as to claims 20, 16, 18, 24 and 26 through 28. The decision of the examiner to reject claims 25, 7, 8 and 10 under 35 U.S.C. § 103 as being unpatentable over Martinek in view of La Mell and

claims 25 and 9 under 35 U.S.C. § 103 as being unpatentable over Johnston in view of La Mell is affirmed. Additionally, the application is remanded to the examiner for consideration of the issues noted above.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a remand. 37 CFR § 1.196(e) provides that

Whenever a decision of the Board of Patent Appeals and Interferences includes or allows a remand, that decision shall not be considered a final decision. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board of Patent Appeals and Interferences may enter an order otherwise making its decision final.

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

The effective date of the affirmance is deferred until conclusion of the proceedings before the examiner unless, as a mere incident to the limited proceedings, the affirmed rejections are overcome. If the proceedings before the examiner does not result in allowance of the application,

abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejections, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART and REMANDED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	
)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
JENNIFER D. BAHR)	
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Appeal No. 1999-0636
Application No. 08/828,375

Page 22

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