

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte J. BRUCE EMMONS

Appeal No. 1999-1523
Application No. 08/839,065¹

ON BRIEF

Before ABRAMS, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 8.² Claims 9 to 19 have been indicated as being allowable. Claim 20 has been canceled.

We AFFIRM-IN-PART.

¹ Application for patent filed April 23, 1997.

² Claim 1 was amended subsequent to the final rejection.

BACKGROUND

The appellant's invention relates to a connector. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the supplemental appendix of claims (Paper No. 11, filed December 22, 1998).

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

Rensch 1972	3,688,461	Sept. 5,
Hollis, Sr. 1976	3,969,563	July 13,

Claims 1 to 3 and 6 to 8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Rensch.

Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Rensch.

Claim 5 stands rejected under 35 U.S.C. § 103 as being unpatentable over Rensch in view of Hollis, Sr.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 12, mailed January 4, 1999) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 10, filed November 30, 1998) and reply brief (Paper No. 13, filed March 8, 1999) for the appellant's arguments thereagainst.

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.

Claim 1

We sustain the rejection of claim 1 under 35 U.S.C. § 102(b).

Anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. See Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)); however, the law of anticipation does not require that the reference teach what the appellant is claiming, but only that the claims on appeal "read on" something disclosed in the reference (see Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984)).

We agree with the examiner than claim 1 is anticipated by Rensch since the subject matter recited in claim 1 "reads on" Rensch. We read claim 1 on Rensch's Figure 1³ as follows:

A connector, comprising:

a first connecting interface adapted to be connected to and across a cross-section of a first beam (the radial arms of Rensch's junction elements 2A and 2C extending at the three o'clock position, the web of Rensch's junction element 2A extending from the three o'clock positioned arm to the five o'clock positioned arm, the web of Rensch's junction element

³ For convenience, we will make the following designations: (1) the upper left junction element 2 is designated junction element 2A; (2) the bottom left junction element 2 is designated junction element 2B; (3) the bottom center junction element 2 is designated junction element 2C; (4) the rightmost girder running between junction element 2A and junction element 2C is designated girder 3D; (5) the leftmost girder running between junction element 2A and junction element 2C is designated girder 3E; (6) the rightmost girder running between junction element 2A and junction element 2B is designated girder 3F; (7) the leftmost girder running between junction element 2A and junction element 2B is designated girder 3G; (8) the bottommost girder running between junction element 2B and junction element 2C is designated girder 3H; and (9) the topmost girder running between junction element 2B and junction element 2C is designated girder 3I.

2C extending from the 11 o'clock positioned arm to the three o'clock positioned arm, and if needed girder 3D);

a second connecting interface adapted to be connected to and across a cross-section of a second beam (the radial arms of Rensch's junction elements 2A and 2B extending at the 11 o'clock position, the web of Rensch's junction element 2A extending from the seven o'clock positioned arm to the 11 o'clock positioned arm, the web of Rensch's junction element 2B extending from the 11 o'clock positioned arm to the one o'clock positioned arm, and if needed girder 3G);

a first load bearing member having two ends and a length extending generally across said first connecting interface (Rensch's girder 3E);

a second load bearing member having two ends and a length extending generally across said second connecting interface, one of said second load bearing member ends being adjacent one of said first load bearing member ends (Rensch's girder 3F);

a third load bearing member having two ends and extending generally between the other said end of said first load bearing member and the other said end of said second load bearing member (Rensch's girder 3I); and

wherein said first, second and third load bearing members are arranged in a generally triangular arrangement (see Figure 1 of Rensch wherein girders 3E, 3F and 3I are shown in a triangular arrangement) such that a load along one of the beams is transferred along at least one of said load bearing members (a load along one of the beams (e.g., a load applied from the right in Figure 1 of Rensch) is inherently transferred along at least one of the load bearing members (i.e., girders 3E, 3F and 3I)).

The appellant's arguments concerning claim 1 (brief, pp. 6-7, and reply brief, pp. 1-2) are unpersuasive for the following reasons. First, claim 1 is anticipated by Rensch since claim 1 "reads on" Rensch as set forth above. Second, claim 1 is directed to the connector per se and not the combination of the connector, a first beam and a second beam. Third, we do not agree with the appellant's position (brief, p. 6) that it is not proper to read Rensch's girders and junction elements as both a "connector" and a "beam." Lastly, while Rensch's framework shown in Figure 1 might not actually be subjected to lateral loads (e.g., from the right in Figure

1), we nevertheless find that as set forth above that Rensch's framework is inherently capable of transferring a lateral load from a beam to at least one of the load bearing members (i.e., girders 3E, 3F and 3I).

For the reasons stated above, the decision of the examiner to reject claim 1 under 35 U.S.C. § 102(b) is affirmed.

Claims 2, 3 and 6 to 8

The appellant has grouped claims 1 to 3 and 6 to 8 as standing or falling together.⁴ Thereby, in accordance with 37 CFR § 1.192(c)(7), claims 2, 3 and 6 to 8 fall with claim 1. Thus, it follows that the decision of the examiner to reject claims 2, 3 and 6 to 8 under 35 U.S.C. § 102(b) is also affirmed.

Claims 4 and 5

We will not sustain the rejection of claims 4 and 5 under

⁴ See page 4 of the appellant's brief.

35 U.S.C. § 103.

Claim 4 reads as follows: "The connector of claim 1, wherein said connector is formed as a single-piece from a casted piece of metal."

The examiner found (answer, p. 5) that "Rensch sets forth the invention except for the connector, including the load bearing members, being formed integrally as a single-piece."

Thereafter, the examiner took the position that

case law dictates that forming several pieces integrally as a single-piece is not considered to be patentable subject matter, and that it would have been obvious to one of ordinary skill in the art to modify the configuration of Rensch to be formed as an integral single-piece, in order to increase the rigidity of the assembly, and to reduce the number of steps required to produce the structure.

The appellants argue (brief, pp. 7-8, and reply brief, pp. 2-3) that Rensch requires "that the junction elements 2 are separate pieces from the girders 3" and that there is no suggestion or incentive to make Rensch's lattice structure into a single piece. Lastly, the appellant concludes that the

examiner has "failed to establish a *prima facie* case of obviousness for Claims 4 and 5."

In rejecting claims 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). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

We agree with the appellant that the examiner has failed to establish a prima facie case of obviousness for claims 4 and 5. In that regard, it is our determination that the claimed limitation of claim 4 (i.e., said connector is formed as a single-piece from a casted piece of metal) would not have been obvious to one of ordinary skill in the art at the time the invention was made from the teachings of the applied prior art (i.e., Rensch alone or combined with Hollis). In addition, we note that the examiner incorrectly drew from case law turning on specific facts, a general obviousness rule: namely, that forming several pieces integrally as a single-piece is not considered to be patentable subject matter. No such per se rule exists. The examiner's citation (answer, p. 8) of In re Larson, 340 F.2d 965, 144 USPQ 347 (CCPA 1965) or any other case as a basis for rejecting claims that differ from the prior art by reciting a single-piece is improper, if it sidesteps the fact-intensive inquiry mandated by 35 U.S.C. § 103. Thus, in this case, one must determine if it would have been obvious to one of ordinary skill in the art at the time the invention was made to make Rensch's connector as a single-piece. We think not for the reasons expressed by the

appellant. Furthermore, even if it would have been obvious to make Rensch's connector as a single-piece of metal, there is no suggestion of forming such a single-piece from "a casted piece of metal" as recited in claim 4.⁵

For the reasons stated above, the decision of the examiner to reject claims 4 and 5 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 3 and 6 to 8 under 35 U.S.C. § 102(b) is affirmed and the decision of the examiner to reject claims 4 and 5 under 35 U.S.C. § 103 is reversed.

⁵ We view the casting limitation of claim 4 (i.e., said connector is formed as a single-piece from a **casted** piece of metal) as presenting a structural limitation not accounted for in the examiner's rejection of claim 4.

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

NEAL E. ABRAMS)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

Appeal No. 1999-1523
Application No. 08/839,065

Page 14

HOWARD & HOWARD
1400 NORTH WOODWARD AVENUE
SUITE 101
BLOOMFIELD HILLS, MI 48304-2856

APPEAL NO. 1999-1523 - JUDGE NASE
APPLICATION NO. 08/839,065

APJ NASE

APJ STAAB

APJ ABRAMS

DECISION: **AFFIRMED-IN-PART**

Prepared By: Gloria Henderson

DRAFT TYPED: 01 Jul 99

FINAL TYPED: