

The opinion in support of the decision being entered today was **not** written for publication and 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 ERIC R. RINDERER

Appeal No. 2000-1651
Application No. 08/871,923

ON BRIEF

Before CALVERT, MCQUADE, and LAZARUS, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 32, all the claims in the application.

The claims on appeal are drawn to a support for electrical cable (claims 1 to 14), a rack for supporting electrical cable (claims 15 to 26), a method of constructing a

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support for electrical cable (claims 27 to 30), and a method of supporting electrical cable (claims 31 and 32). They are reproduced in the appendix of appellant's brief.¹

The references applied in the final rejection are:

Bergquist 23, 1959	2,891,750	Jun.
Burke 1968	3,406,932	Oct. 22,
Mason 1976	3,948,473	Apr. 6,
Dooley 1995	5,465,929	Nov. 14,

The appealed claims stand finally rejected under 35
U.S.C.

§ 103(a) as follows:

(1) Claims 1 to 26, 31 and 32, unpatentable over Burke in view of Dooley and Mason.

(2) Claims 27 to 30, unpatentable over Bergquist in view of Burke.

Rejection (1)

We will first consider this rejection as it applies to claim 15. The structure recited in claim 15 differs from that

¹In reviewing the specification, it appears that on page 13, line 12, "have" should be --has--, and "greater" should be --smaller--.

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disclosed by Burke in that, inter alia, the claimed lower and upper longitudinal members each comprise a metal tube "of circular cross-section," whereas the lower and upper longitudinal hollow members 10, 12, 22, 24 of Burke each are disclosed as having a rectangular cross-section. The examiner takes the position that (answer, page 6):

It would have been an obvious matter of design choice to have modified Burke in view of Dooley to have made the upper and lower member comprising a metal tube having a circular cross section since such a modification is merely a change in shape and is generally recognized as being within the level of one skilled in the art. *In re Dailey et al.*, [357 F.2d 669, 672-73,] 149 USPQ 47[,50 (CCPA 1966)].

After fully considering the record in light of the arguments presented in appellant's brief and reply brief, and in the examiner's answer, we conclude that the rejection is not well taken.

In the Dailey case cited by the examiner, the Court held the claimed device to be obvious over a patent to Matzen, stating (357 F.2d at 672-73, 149 USPQ at 50):

Appellants have presented no argument which convinces us that the particular configuration of their container is significant or is anything more than one of numerous configurations a person of ordinary skill in the art would find

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obvious for the purpose of providing mating surfaces in the collapsed container of Matzen.

In the present case, appellant argues that the circular cross-section of the longitudinal members is significant in that (brief, page 9):

The circular shape allows the use of standard electrical conduit (which is circular) and standard conduit fittings. The use of standard electrical conduit has a number of important advantages. For example, standard conduit is relatively inexpensive to fabricate and/or purchase. Further, electrical conduit is easy to handle, assemble and bend on the job site using existing tools. Also, circular-section conduit can be threadably connected, thereby eliminating the need for screw fasteners as used in the prior art. Thus, appellant's system is economically fabricated and is readily modified and installed on the job site without the need for special equipment.

In response to this argument, the examiner contends (answer, pages 9 and 10):

the reasoning behind the applicant's use of a tubular member having a circular cross-section is for the purpose of allowing the members to be threadably connected or made of standard electrical conduit however; [sic] the applicant does not claim these limitations within the scope of the claim language. These limitations may be improved advantages over the prior art however, without the applicant specifically claiming these limitations within the claims the examiner is obligated to examine the claims as presented without reading the specification into the claim.

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This argument by the examiner is not persuasive. In order to distinguish the claims over the prior art, an applicant is not required to recite the advantages flowing from the claimed invention; rather, the claims must include the structure which provides those advantages. Cf. In re Peterson, 390 F.2d 735, 741-42, 156 USPQ 504, 509 (CCPA 1968) (claims not patentable because not limited to the structure which will provide asserted unexpected results). Here, claim 15 is limited to the structure which provides the asserted advantages over the prior art, in that it recites that the lower and upper longitudinal members each comprise a metal tube of circular cross-section. In the absence of any evidence that the circular cross-sectional shape of the longitudinal members would have been obvious, which evidence the examiner has not cited,² the asserted advantages resulting from use of a circular cross-sectional shape preclude the examiner's implicit conclusion that that shape would have been merely an

² "A rejection based on section 103 must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art." In re GPAC, Inc., 57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995).

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obvious matter of design choice. Cf. In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

The Dooley and Mason references are cited by the examiner as evidence of the obviousness of providing, respectively, end-to-end couplings for cable racks and wings on the ends of a cross or side member. Neither of these references discloses or suggests longitudinal members having a circular cross-section, and thus they are not relevant to the above-discussed question of the obviousness of claim 15 over Burke.

Accordingly, the rejection of claim 15, and of claims 16 to 26 dependent thereon, will not be sustained. We also will not sustain the rejection of independent claims 1 and 31, and of their dependent claims 2 to 14 and 32, since claims 1 and 31 also require tubular longitudinal members of circular cross-section, and thus are considered patentable over the applied prior art for the same reasons as claim 15.

Rejection (2)

Bergquist discloses a cable support system having racks 11 with upper and lower longitudinal members 13, cross members 14, and side members 17, all of the members being welded together. The upper and lower longitudinal members of

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Bergquist are, however, made of wire rather than tubing. The ends of the racks are coupled together by bolts 21 passing through eyes 20 at the ends of the longitudinal members. Where the cable support changes direction (diverges), as at 33, 37 or 38 in Fig. 1, a rack may be bent and its ends coupled to the ends of the two diverging racks. The examiner states the basis of the rejection as (answer, page 8):

Burke teaches that it is known to have upper and lower support members (24 and 25) being metal tubes. It would have been obvious to one having ordinary skill in the art at the time of the invention to have modified Bergquist to have made the upper and lower support members of metal tubes for purpose of reducing the amount of material being used therefore cost effective.

We will not sustain this rejection. In the first place, Bergquist so emphasizes the advantages of making the rack out of wire (see, e.g., col. 1, lines 54 to 72, and col. 3, lines 5 to 7) that we do not believe that one of ordinary skill would have been motivated to substitute tubing for wire. Moreover, Burke does not disclose bending the tubular longitudinal members, in fact, it is not clear how Burke's support system would be routed around a corner, other than by using a connection as shown in Fig. 4. Also, it is not

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evident how Burke's supports are connected end-to-end, and it does not appear that they could use the bolt-and-eye system disclosed by Bergquist. For these reasons, we do not consider that one of ordinary skill would have found it obvious to modify Bergquist in view of Burke.

Rejection Pursuant to 37 CFR § 1.196(b)

Pursuant to 37 CFR § 1.196(b), claims 20, 31 and 32 are rejected for failing to comply with the second paragraph of 35 U.S.C. § 112, for the following reasons:

(A) Claim 20 is indefinite in that the term "support" in line 1 has no antecedent basis.

(B) In claim 31, appellant recites in lines 1 and 2 "The method of supporting electrical cable comprising: preparing a support [etc.]," and then recites in line 21 "the method comprising:" These two recitations of "method comprising" render the claim indefinite in that it is not clear whether the claimed method includes the step of preparing a support, or only the steps of laying cable and inserting cable (lines 22 to 27).

Conclusion

The examiner's decision to reject claims 1 to 32 is

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reversed. Claims 20, 31 and 32 are rejected pursuant to 37
CFR

§ 1.196(b).

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. and Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

REVERSED; 37 CFR § 1.196(b)

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Administrative Patent Judge)	
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JOHN P. MCQUADE)	
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