

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte THOMAS J. ANDRES

Appeal No. 2002-2208
Application No. 09/543,989

ON BRIEF

Before FRANKFORT, STAAB 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 25-34, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to extrusions which are connected to a rigid underlying support, such as wood joists, by a snap connector (specification, page 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

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

van den Broek	3,959,830	Jun. 1, 1976
Yoder	5,048,448	Sep. 17, 1991
Groh et al. (Groh)	5,070,664	Dec. 10, 1991
Pollock	5,613,339	Mar. 25, 1997

The following rejections are before us for review.¹

Claims 25-27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Pollock.

Claims 25-27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by van den Broek.

Claims 25-27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Yoder.

Claims 25-34 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Groh.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer

¹ The double patenting rejection set forth in the final rejection has been overcome by the filing of a terminal disclaimer (see answer, page 2).

(Paper No. 9) for the examiner's complete reasoning in support of the rejections and to the brief and reply brief (Paper Nos. 7 and 10) 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.

Appellant has elected to group all claims together (brief, page 3). Thus, in accordance with 37 CFR § 1.192(c)(7), we shall decide the appeal of each of the rejections on the basis of independent claim 25, with the remainder of the claims so rejected standing or falling with representative claim 25. See In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978).

Turning first to the rejection of claims 25-27 as being anticipated by Pollock, we direct our attention to the embodiments of Figures 14 and 15, the embodiments relied upon by the examiner in rejecting the claims. Pollock discloses a deck plank 1 made of extruded synthetic resin, such as polyvinyl chloride (PVC). A cover 7 made of "rigid" PVC (column 5, lines 34-35) is snapped over a plank member 5A or 5B. Pollock's plank member responds to the structure recited in claim 25 as follows: the plank member comprises a pair of outer leg members (side flanges 13a', 13b' or 13Ba,

13Bb), a pair of inner leg members (section side webs 19Aa, 19Ab), an upper load bearing portion (upper web 17A or 17B) and a lower support member (base web sections 11A or 11B) connecting each outer leg member to an adjacent inner leg member.

As disclosed by Pollock in the sentence bridging columns 5 and 6, the cover 7 “is sufficiently flexible that following extruding and subsequent forming operations, long continuous lengths of the cover may be rolled in a roll” and is characterized as being sufficiently flexible that lifting and twisting the cover relative to the plank will not cause damage to the cover or the plank and that the hooks 35a, 35b and cooperating ridges 37a, 37b deform sufficiently so as to release cross flanges 25 held therebetween (column 8, lines 3-7). Pollock is silent with respect to the flexibility of the plank member 5A or 5B.

The prior art reference need not expressly disclose each claimed element in order to anticipate the claimed invention. See Tyler Refrigeration v. Kysor Indus. Corp., 777 F.2d 687, 689, 227 USPQ 845, 846-847 (Fed. Cir. 1985). Rather, if a claimed element (or elements) is inherent in a prior art reference, then that element (or elements) is disclosed for purposes of finding anticipation. See Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631-33, 2 USPQ2d 1051, 1052-54 (Fed. Cir. 1987).

It is well settled that the burden of establishing a prima facie case of anticipation resides with the Patent and Trademark Office (PTO). See In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). When relying upon the theory of

inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. See Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Patent App. & Int. 1990).

The plank member of Figure 14 or Figure 15 of Pollock is made of PVC, the same material as appellant's extrusion, and comprises a series of interconnected long and narrow horizontal and vertical members, akin to that of appellant, as illustrated in Figure 4. In light of these structural similarities to appellant's extrusion, Pollock's disclosure is sufficient to reasonably support the examiner's determination that Pollock's plank member possesses the requisite resiliency to meet the limitations recited in the last paragraph of claim 25² so as to establish a prima facie case of anticipation and thereby shift the burden to appellant to prove that Pollock's plank member does not possess such resiliency.³ Appellant has not come forward with any evidence to satisfy that burden. Compare In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977); In re Ludtke, 441 F.2d 660, 664, 169 USPQ 563, 566-67 (CCPA 1971). Appellant's mere argument on page 4 of the brief that, because Pollock

² We understand the last paragraph of claim 25 to call for the extrusion, by virtue of both the material from which it is made and its structure, to be sufficiently resilient to be capable of bending outwardly and upwardly as recited therein and snapping inwardly and downwardly to interlock with a snap connector in the manner recited therein.

³ After the PTO establishes a prima facie case of anticipation based on inherency, the burden shifts to the appellant to prove that the subject matter shown to be in the prior art does not possess the characteristics of the claimed invention. See In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985); In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986).

teaches a channel 9 and cover 7, Pollock's plank member "could not possibly bend outwardly and upwardly about an axis extending through the center of the extrusion" is not evidence. See In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974)(attorney's arguments in a brief cannot take the place of evidence).

Inasmuch as appellant's arguments are insufficient to rebut the examiner's prima facie case of anticipation, we shall sustain the rejection of claim 25, as well as claims 26 and 27 which fall with representative claim 25, as being anticipated by Pollock.

The examiner has also rejected claims 25-27 as being anticipated by van den Broek. In rejecting these claims, the examiner refers to Figures 1 and 4-7 and panel 10. The panels 10 which the examiner has determined correspond to the extrusion recited in claim 25 are made of "any suitable plastic material such as PVC or the like" (column 4, lines 47-48) and are assembled to form the wall of an in-ground swimming pool. The van den Broek patent is silent with regard to the rigidity or flexibility of the panels 10. The examiner contends that the extrusion 10 inherently possesses the resiliency called for in claim 25 because it is made of PVC (answer, page 5). For the following reasons, we do not find the examiner's position to be well taken.

Given the closed double wall structure of the panels 10 and the purpose (i.e., formation of a swimming pool wall) which they serve, one of ordinary skill in the art would expect these panels to be relatively rigid, especially when considered in light of

van den Broek's disclosure of a modified wall panel 92⁴ as shown in Figure 2.

According to van den Broek (column 6, lines 40-47),

[s]ince only a single wall is provided for each panel 92 the panels are flexible to a certain degree and can be assembled together as shown in FIG. 2 to provide a curved wall structure. By using the 9-inch wide panels 92 it is possible to construct a curved wall having a radius of approximately 17 feet without placing any undue stress on the panel during cold bending of the panel.

From our perspective, one of ordinary skill in the art would have inferred from van den Broek's characterization of the modified panel 92, which differs from the panel 10 in that the wall on one surface is eliminated between the center groove 94 and the transverse reinforcing walls 96 and 98, as being "flexible to a certain degree" by virtue of its single wall structure that the panel 10 is not flexible.

Having determined that van den Broek lacks disclosure, either expressly or under principles of inherency, that the panels 10 relied upon by the examiner possess the resiliency called for in claim 25, we shall not sustain the examiner's rejection of

⁴ In that the examiner has referred only to the panel 10 and has not relied on the modified panel 92 in rejecting claims 25-27, our review of this rejection is limited only to determining whether the panel 10 anticipates appellant's claimed subject matter. In the event of further prosecution, however, the examiner may wish to consider whether the subject matter of claim 25 and some of the claims depending therefrom is anticipated by the modified panel 92.

claim 25, or claims 26 and 27 which depend therefrom, as being anticipated⁵ by van den Broek.

The examiner's rejection of claims 25-27 as being anticipated by Yoder is articulated on page 4 of the answer as follows:

Yoder '448 shows, Figs. 2, 6, and 7, elongated extrusions 24 having outer legs 40 connected to inner legs 44 as by a horizontal support member 46 with an upper load bearing horizontal portion 38. Retaining tab of an inner leg is as along 48.

With respect to the resiliency limitation of claim 25, the examiner states on page 6 of the answer that

[t]he extrusion of Yoder '448 can be flexed about a central axis, (as about an axis running within support 42), with the legs 48, (extending inwardly on either side), capable of grasping under any locking tab of an element, or connector, if one were to desire to hold the inwardly directed legs in the same manner as the outwardly directed legs are held by locking tabs 58.

The only argument offered by appellant as to why the subject matter of claim 25 is not anticipated by Yoder is that Yoder shows a much different connection method than does appellant; specifically, Yoder teaches a connection method in which the extrusion (plank member 24) is flexed inwardly and downwardly in order for lateral member 48 to be angularly inserted underneath locking tab 58 and lacks a teaching or

⁵ Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

suggestion of bending the extrusion upwardly and outwardly and then having it snap back to connect it to the connector, as recited in claim 25 (see brief, page 5).

Appellant's characterization of the connection method disclosed by Yoder is correct. In particular, Yoder discloses that

[a]ttachment of the second side 66 [of the plank member 24] is facilitated by the flexible characteristics of the material used in forming the plank member 24 permitting the plank 24 to be slightly flexed to permit the lateral member 48 of the second side 66 to be angularly inserted underneath the locking tab 58 of the corresponding flange engaging portion 54 [column 4, lines 61-67].

We observe, however, that appellant's claim 25 is not directed to a method of assembling an extrusion to a snap connector; rather, claim 25 is directed to an extrusion having sufficient resiliency that it is capable of bending outwardly and upwardly about an axis extending through the center of the extrusion when pressed onto a snap connector and snapping inwardly and downwardly to interlock with the snap connector. The very same "flexible characteristics of the material used in forming the plank member 24" which enable the plank member to be flexed as shown in Figure 6 would reasonably appear to likewise enable the plank member to be flexed upwardly and outwardly in the manner set forth by the examiner on page 6 of the answer.

Accordingly, we conclude that the examiner has provided sufficient factual basis and technical reasoning to support the position that Yoder's plank member 24 possesses the resiliency called for in the last paragraph of claim 25 so as to establish a prima facie case of anticipation under the principles of inherency, thereby shifting the

burden to appellant to prove that Yoder's plank member 24 does not possess the resiliency required by claim 25. Appellant has not come forth with evidence or reasoning to meet this burden. Thus, we shall sustain the examiner's rejection of claim 25, as well as claims 26 and 27 which fall with representative claim 25, as being anticipated by Yoder.

We turn finally to the examiner's rejection of claims 25-34 as being anticipated by Groh. As articulated on page 4 of the answer, the examiner's rejection is based on a determination that the structure illustrated in Figure 6, which includes the rolled steel bleacher beam 130 and the "generally rigid" thermoplastic cover 131 installed over the steel beam, is an extrusion as called for in appellant's claim 25. While the cover 131 is a coextrusion of a capstock 119 and substrate 120, it does not comprise a pair of inner and outer leg members as recited in claim 25. The steel beam 130, on the other hand, comprises a pair of outer leg members (outer vertical walls 136), a pair of inner leg members (intermediate vertical walls 133), an upper load bearing horizontal portion (upper ledges 134 and upper central table 132) and a lower horizontal support member (horizontal bases 135) connecting each outer leg member to an adjacent inner leg member, but cannot reasonably be considered to be a resilient extrusion as called for in claim 25 (see brief, page 5). We thus cannot sustain the examiner's rejection of claim 25, or claims 26-34 which depend from claim 25, as being anticipated by Groh.

CONCLUSION

To summarize, the examiner's rejections of claims 25-27 as being anticipated by Pollock and by Yoder are sustained and the rejections of claims 25-27 as being anticipated by van den Broek and claims 25-34 as being anticipated by Groh are reversed. The decision of the examiner is affirmed-in-part.

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

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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