

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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HALL VIRGIL JR.

Appeal No. 1996-1049
Application No. 08/238,681

ON BRIEF

Before JOHN D. SMITH, GARRIS and OWENS, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 1-9, which are all of the claims in the application. The rejection of claim 3 is withdrawn in the examiner's answer (page 5).

THE INVENTION

Appellant claims a molded element and a mold for making the molded element.

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In a reply brief filed on October 30, 1995 (paper no. 11), appellant requested that claim 1, which is the sole independent claim directed toward the molded element, be amended to read as follows:

1. In a molded element containing therein a horizontally disposed bore for receiving a fastener therein, the improvement comprising:

a plurality of downwardly disposed first elements having distal ends, said plurality of first elements being spaced apart from one another; and

a plurality of upwardly disposed second elements having distal ends, said plurality of second elements being spaced apart from one another;

wherein said plurality of first elements are offset from said plurality of second elements;

wherein said distal ends of said plurality of first elements and said distal ends of said plurality of second elements are outwardly arcuate and combine to form a horizontally disposed bore cylindrical having at least one end open for receiving a threaded fastener therein.

This amendment, which added "are outwardly arcuate and", "cylindrical" and "threaded" in the last element of claim 1, and canceled claim 3, was not submitted in a separate paper and entered into the record. In a subsequent amendment filed on May 27, 1997 (paper no. 15), an amendment was submitted which included adding "cylindrical" but did not include adding

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"are outwardly arcuate and" or "threaded". This amendment was entered and is the most recent amendment of record.

Appellant (brief, page 3; reply brief, page 1) and the examiner (answer, pages 3-5) argue the case as though the amendment in the October 30, 1995 reply brief has been entered. For purposes of expediting prosecution and making efficient use of the board's resources, we decide the appeal of the rejection of claim 1 based upon the claim as argued by appellant and the examiner, i.e., as it appears in the October 30, 1995 reply brief, even though the amendment therein has not yet been clerically entered.¹

Claim 9, which is the sole claim directed toward the mold, is argued by appellant and the examiner as it appears of record. That claim is as follows:

9. In a mold for producing a molded element containing therein a horizontally disposed bore for receiving a threaded fastener therein, the improvement comprising:

an upper portion containing a plurality of downwardly disposed elements, said downwardly disposed elements being spaced apart in parallel planes and having arcuate distal ends; and

¹ See the remand at the end of this opinion.

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cylindrical bore capable of receiving a threaded fastener. Harrison's upwardly and downwardly disposed elements have teeth which face, respectively, downwardly and upwardly, for locking with upper and lower saw-tooth surfaces of male connectors which are inserted between the upwardly and downwardly disposed elements (col. 2, lines 20-29; col. 4, lines 47-66; col. 5, lines 44-47). The male connectors can be square or rectangular (col. 5, lines 3-15), and can have vertical and canted surfaces which extend over their sides as well as the top and bottom (col. 4, line 67 - col. 5, line 3).

The examiner argues that "[i]t would have been an obvious matter of design choice to modify Harrison's distal ends to have outwardly arcuate shape, since such a change would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art. In re Dailey, [357 F.2d 669,] 149 USPQ 47 (CCPA 1976 [sic, 1966])." In *Dailey*, the majority was not convinced that the "less than hemisphere" shape of each section of a nursing bottle which has a rigid section near the nipple and a flexible section which is drawn into the rigid section as the bottle is emptied, "is significant or is

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anything more than one of numerous configurations a person of ordinary skill in the art would find obvious for the purpose of providing mating surfaces in the collapsed container" of the applied reference. See *Dailey*, 357 F.2d at 672-73, 149 USPQ at 50.

Appellant argues that appellant's arcuate elements are significant because they result in a cylindrical bore which allows for a threaded fastener to be used rather than Harrison's square or rectangular fastener which is pushed into the female connector (brief, page 3). The examiner provides no reasoning as to why one of ordinary skill in the art would have considered the difference between Harrison's configuration and appellant's arcuate configuration to be insignificant such that Harrison's configuration would have fairly suggested appellant's configuration to one of ordinary skill in the art. The examiner, instead, merely relies upon a *per se* rule that mere changes of shape are obvious. As stated by the Federal Circuit in *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995), "reliance on *per se* rules of obviousness is legally incorrect and must cease."

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The examiner argues that Harrison's column 6, lines 11-15 suggest that this reference is not limited to rectangular or square lugs (answer, page 5). That portion of Harrison states: "While numerous modification [sic, modifications] of the disclosed embodiments will undoubtedly occur to those of skill in the art, it should be understood that the spirit and scope of the invention is to be limited solely by the appended claims." The examiner's argument is not convincing because the examiner has not explained why this disclosure would have fairly suggested, to one of ordinary skill in the art, use of arcuate elements which form a cylindrical bore which is capable of receiving a threaded fastener.

The examiner argues that appellant's claims 1, 2, 4-6 and 8 are directed to a molded product and that the particular arcuate shape of the elements of the mold are not part of the product as claimed and, therefore, are not a positive limitation (answer, page 5). As indicated by page 5 of the examiner's answer, claim 1 as interpreted by the examiner expressly recites that the distal ends of the elements of the molded product are outwardly arcuate.

The examiner argues that Harrison clearly shows a cylindrical fastener in figures 2 and 4 and, therefore, discloses a cylindrical bore (answer, page 5). Harrison, however, states that "[t]he bottom lugs **34** are positioned out of vertical alignment with respect to the upper lock lugs **32** and are bisected by a vertical plane bisecting the space between adjacent ones of the upper lock lugs **32** as will be apparent from inspection of FIG. 4. The upper lock lugs **32** extend transversely with respect to the seat in a horizontal manner at an elevation above the elevation of the lower portion of the bed plate ..." (col. 3, lines 58-65). This disclosure indicates that the upper and lower lock lugs are flat rather than arcuate and, therefore, provides no indication that the bore is cylindrical. Figure 2 shows these same upper and lower lock lugs (32 and 34).

For the above reasons, we conclude that the examiner has not carried the burden of establishing a *prima facie* case of obviousness of appellant's claimed invention. We therefore reverse the examiner's rejection.

REMAND

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We remand the application to the examiner for the examiner to obtain from appellant a separate paper wherein claim 1 is amended to read as argued by appellant and the examiner in this appeal, i.e., as it appears on page 2 of the reply brief filed on October 30, 1995², and claim 3 is canceled, and to enter this amendment into the record.

² As indicated by the amendment filed on May 27, 1997 (paper no. 15), in claim 1 in the October 30, 1995 reply brief, "cylindrical" should appear before rather than after "bore".

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DECISION

The rejection of claims 1, 2 and 4-9 under 35 U.S.C.
§ 103 over Harrison is reversed.

REVERSED and REMANDED

JOHN D. SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
BRADLEY R. GARRIS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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TERRY J. OWENS)	
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