

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID A. COWAN

Appeal No. 96-4044
Application 08/396,253¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, and COHEN and MEISTER, Administrative Patent Judges.

McCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 34 through 40 under 35 U.S.C. § 103.² No other claims are pending in the application.

¹ Application for patent filed February 28, 1995. According to appellant, the application is a continuation of Application 07/674,097, filed March 25, 1991, now abandoned.

² An appeal in appellant's parent application identified in footnote 1 supra, resulted in an affirmance of the examiner's rejection of claims 28 through 33 under 35 U.S.C. § 103 (see Appeal No. 95-0172). These claims have been canceled in favor of prosecuting the claims now pending in the application.

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Appellant's invention relates to a plastic fencing structure of the type having a plurality of openings 6. In appellant's invention as defined in claim 34 (the only independent claim on appeal), a plastic reflective tape strip means 2 having a water resistant pressure sensitive adhesive backing 8 is disposed on one side of the fence and is adhered through the openings in the fence to a plastic backing strip means 9 on the other side of the fence. Claim 34 further recites that the reflective tape has a width between edges which is less than the height of the openings in the fence, that the edges of the reflective tape lie within the height of the openings³, and that substantially the entire surface area of the reflective tape overlying the openings is adhered to the backing strip.

A copy of the appealed claims is appended to appellant's brief.

The following references are relied upon by the examiner as evidence of obviousness in support of his rejections under 35 U.S.C. § 103:

³ This feature is shown in Figure 2 of the original drawings to satisfy the description requirement in the first paragraph of 35 U.S.C. § 112, but is not described in the specification as required in 37 CFR §§ 1.71, 1.75(d)(1).

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Lappala et al. (Lappala)	3,214,320	Oct. 26, 1965
Andrews	3,347,527	Oct. 17, 1967
Schmanski et al. (Schmanski)	4,605,204	Aug. 12, 1986

Claims 34 through 40 stand rejected under 35 U.S.C. § 103 as being unpatentable over Andrews in view of Schmanski and Lappala. The examiner concedes that claim 34 differs from Andrews by reciting that the fencing is plastic and that the reflective tape has a water resistant pressure sensitive adhesive. He concludes, however, that the teaching of Schmanski would have made it obvious to make Andrews' fencing from plastic and that the teachings of Lappala would have made it obvious to utilize a water resistant pressure sensitive adhesive for adhering Andrews' reflective tape to the backing strip.⁴

In addition, the examiner concedes that the applied references do not teach the claimed relationship of the width of the reflective tape to the height of the openings in the fence as defined in claim 34 and as described supra. He nevertheless contends that it would have been an obvious matter of engineering design choice? (answer, page 5) to provide Andrews'

⁴ In our decision (Appeal No. 95-0172) in appellant's parent application, we agreed with these conclusions of obviousness.

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structure with the claimed relationship of the width of the reflective tape to the height of the openings in the fence such that substantially the entire surface area of the reflective tape overlying the openings adheres to the backing strip.

In support of patentability, appellant contends on pages 3, 4 and 6-8 of the brief that the claimed relationship of the width of the reflective tape to the height of the openings and to the backing strip solves two problems not solved or even recognized by the applied references. First, he states that the claimed relationship eliminates any creases in the reflective tape strip means across its entire width in the region of the openings, . . .? (brief, page 7). Second, he states that the claimed relationship eliminates any possibility of the reflective tape strip means being pulled away from the backing strip means across its width in the region of the openings . . .? (brief, page 7).

We have carefully considered the issues raised in this appeal together with the examiner's remarks and appellant's arguments. As a result, we conclude that the rejection of the appealed claims cannot be sustained.

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In the present case, the examiner acknowledges on page 8 of the answer that appellant's claimed relationship of the width of the reflective tape to the backing tape and to the height of the openings in the fence as defined in claim 34 solves the first problem stated supra, namely the elimination of creases in the reflective tape across its entire width in the region of the openings. As a result, this claimed relationship may not be dismissed as an obvious matter of design choice as the examiner has done here. Compare In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975) (?Use of such a means . . . solves no stated problem and would be an obvious matter of design choice within the skill of the art.?). The solution to the first problem stated supra is sufficient to preclude the application of the Kuhle rule pertaining matters of design choice. It therefore is no moment that the asserted solution to the second problem mentioned above may be ?unfounded? as contended by the examiner on page 8 of the answer.

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The examiner's decision rejecting appealed claims 34 through
40 is reversed.

REVERSED

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HARRISON E. McCANDLISH, Senior)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
IRWIN CHARLES COHEN)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JAMES M. MEISTER)	
Administrative Patent Judge)	

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