

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER A. MONTANA and PETER B. WALSH

Appeal No. 1997-2781
Application No. 08/422,348

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, ABRAMS,
and GONZALES, 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 1 through 18. No other claims are pending in the application.

Appellants' invention relates to a screen door having a flexible screen (25) and a rigid, transparent protective cover

(30) overlapping the screen to protect the screen from wear or damage particularly from children and pets. The portion of the protective cover overlapping the screen is provided with air holes to permit air to circulate through the screen. Claim 1, the only independent claim on appeal, recites that the rigid, transparent cover has at least a portion lying in overlapping relation to the screen and further that the overlapping cover portion (i.e., the portion overlapping the screen) has air holes.

The appendix to appellants' brief contains a copy of the claims argued in this appeal.

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

Beers 1928	1,690,094	Nov. 6,
Crescentini 1942	2,286,899	Jun. 16,
McDonald 1961	2,975,830	Mar. 21,
Stevens 1963	3,084,737	Apr. 9,

The appealed claims stand rejected under 35 U.S.C. § 103 as follows:

1. Claims 1 through 4, 7 and 9 through 18 as unpatentable over McDonald in view of Stevens;

2. Claims 5 and 6 as unpatentable over McDonald in view of Stevens and Beers; and

3. Claim 8 as unpatentable over McDonald in view of Stevens and Crescentini.

Claims 13 and 17 additionally stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regard as their invention.

In their briefs, appellants did not argue the § 112, second paragraph, rejection of claims 13 and 17 and, instead, on page 2 of the main brief requested cancellation of these claims to remove the § 112, second paragraph issue from this appeal. In his answer, the examiner refused to cancel claims 13 and 17 presumably because the request for cancellation was not submitted as an amendment in a separate paper pursuant to § 1207 of the Manual of Patent Examining Procedure (7th ed., July 1998). Accordingly, the appeal of claims 13 and 17 is still before us. However, since the § 103 and § 112, second paragraph, rejections of these claims have not been argued and

since appellants have declared their intention to cancel these claim, we herewith dismiss the appeal as to claims 13 and 17. Thus, the only issues remaining for our review involve the § 103 rejections of claims 1 through 12, 14 through 16 and 18.

With regard to the § 103 rejection of claims 1 through 4, 7, 9 through 12, 14 through 16 and 18, the examiner's position is as follows:

McDonald discloses a flexible screen 18,19 supported by a frame, and a protective cover 10 disposed proximate to and in overlapping relation with the flexible screen 18,19. While McDonald does not disclose the cover as comprising a plurality of air holes, Stevens discloses a cover comprising air holes 53,57, wherein, to incorporate this teaching into the cover of McDonald for the purpose of providing ventilation would have been obvious to one of ordinary skill in the art. [Answer, page 4.]

We are unable to sustain the § 103 rejection of claims 1 through 4, 7, 9 through 12, 14 through 16 and 18. It is well established patent law that the prior art must provide one of ordinary skill in the art with the motivation for making the modification needed to arrive at the claimed invention. In re Lulu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984).

In the present case, appellants' rigid panel merely serves as a protective cover for the screen. In contrast, McDonald's solid outer panel member 10 serves as an exterior closure door for a building (see column 1, lines 15-18, and column 2, lines 57-60, of the McDonald specification) to provide protection against cold and/or inclement weather (see column 2, lines 57-60, of the McDonald specification).

Stevens discloses a ventilating window structure having a fixed outer glass pane 56 and an inner glass pane 56a which is movable between opened and closed positions. Both of the glass panes are provided with air ventilation holes 53, 57. When the inner glass pane is moved to its closed position in the proximity of the outer glass pane, it seats against grommets 54 around the screened holes 53 in the outer glass pane to seal off the screened holes 53, thereby preventing the circulation of air through holes 53. We fail to understand how such an arrangement can be incorporated into McDonald's screen and exterior closure door assembly.

Furthermore, we do not agree that Stevens broadly suggests the concept of providing air ventilating holes in a closure structure such as McDonald's exterior closure door 10 because

McDonald's closure door 10 is intended to block entry of outside air to provide protection against cold and inclement weather. In our viewpoint, one of ordinary skill in the art would not have been motivated to modify McDonald's exterior closure door 10 in such a way to defeat the basic purpose of the door. See Ex parte Hartmann, 186 USPQ 366, 367 (Bd. App. 1974) and Ex parte Thompson, 184 USPQ 558, 559 (Bd. App. 1974).

The prior art relied upon by the examiner thus fails to establish a prima facie case of obviousness with respect to the subject matter of claims 1 through 4, 7, 9 through 12, 14 through 16 and 18. We therefore must reverse the § 103 rejection of these claims. We also must reverse the § 103 rejections of claims 5, 6 and 8 since the Beers and Crescentini references do not rectify the shortcomings of McDonald and Stevens.

In summary, the examiner's decision rejecting claims 1 through 12, 14 through 16 and 18 is reversed, and the appeal as to claims 13 and 17 is dismissed.

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

REVERSED/DISMISSED-IN-PART

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JOHN F. GONZALES)	
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HEM/jlb

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