

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES P. LYNCH

Appeal No. 97-4241
Application No. 08/183,066¹

ON BRIEF

Before COHEN, ABRAMS and STAAB, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1-6, 8-29 and 36-39. Claim 7 has been cancelled, and claims 30-35 withdrawn as directed to a nonelected invention.

The appellant's invention is directed to a canopy structure adapted to be erected in custom configurations, and

¹ Application for patent filed January 18, 1994.

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to a method of providing a sheltered space. The subject matter before us on appeal is illustrated by reference to claims 1 and 36, which have been reproduced in an appendix to the Appeal Brief.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

McCarthy 1959	2,873,750	Feb. 17,
Lundblade 25, 1981	4,285,355	Aug.
Pandell 1987	4,642,868	Feb. 17,
Cannon <i>et al.</i> (Cannon) 1987	4,677,999	Jul. 7,
Balicki <i>et al.</i> (Balicki) 10, 1990	4,914,767	Apr.
Jamieson 1992	5,161,561	Nov, 10,
Samson <i>et al.</i> (Samson) 1993	5,198,287	Mar. 30,
British application 13, 1963	918,136	Feb.

THE REJECTIONS

The following rejections stand under 35 U.S.C. § 103:

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(1) Claims 1-6, 8-10, 17, 18, 22-27 and 36-39 on the basis of the British reference in view of Cannon and Balicki.

(2) Claims 14 and 29 on the basis of the British reference in view of Cannon, Balicki and Lundblade.

(3) Claims 11-13, 20, 21 and 28 on the basis of the British reference in view of Cannon, Balicki, Jamieson and McCarthy.

(4) Claims 15 and 16 on the basis of the British reference in view of Cannon, Balicki and Samson.

(5) Claim 19 on the basis of the British reference in view of Cannon, Balicki and Pandell.

The rejections are explained in Paper No. 7 (the final rejection).

The opposing viewpoints of the appellant are set forth in the Brief and the Reply Brief.

OPINION

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness under 35 USC § 103, it is incumbent upon the

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examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1052 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

Independent claims 1 and 23 are directed to a structure comprising a flexible sheet of material that is elastic in at least one direction and that will, when deformed into a stretched state by support poles placed beneath it, exert a restoring force that applies a compression force to the poles. They also require a plurality of anchors that grip the edge margin of the sheet. Independent claim 36 contains like requirements, expressed in terms of a method. All three of these claims stand rejected as being unpatentable over the

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British reference in view of Cannon and Balicki. It is the examiner's position that the British reference teaches all of the structure required by claims 1 and 23 except for elastic sheet and the releasable edge clamps, but that the addition of these features to the primary reference would have been obvious in view of the teachings of the two secondary references. We do not agree. Our rationale for arriving at this conclusion follows.

The British reference is directed to providing an improvement in awnings and tent roofs in which drainage is provided for rainwater that ordinarily would collect thereon. It discloses a sheet (1) that is provided with a plurality of openings (5). The sheet is made of canvas so that it shows "a considerable rigidity and, therefore, resistance to collapsing, fluttering and oscillating under the action of wind" (page 2, lines 6-11). Attached to the sheet at each opening is a downwardly oriented pipe made of material that is "highly elastic" (page 1, line 60). The sheet is supported at its edge by a plurality of poles (2, 4). Once the awning is erected, the elastic pipes are tensioned to the extent that a funnel-like depression (b) is formed in the sheet at each

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opening (page 2, line 28 *et seq.*). Rainwater runs into these depressions, and then is carried off through the elastic pipes.

It is the objective of the Cannon reference to provide a canopy in which the support poles need not be closely spaced in order to prevent excessive sagging. This is accomplished by using as a canopy sheets of stretch material having inelastic or low stretch tendons such as that used in automobile seat belts fastened to its edges (column 3, lines 14 and 15). Each panel is described as being "very resilient" (column 4, lines 28 and 29). The canopy formed according to this invention comprises a "basic rectangular array of four panels (column 4, lines 20 and 21). The canopy is supported by edge posts and center posts having guy wires which are anchored in the ground.

It is axiomatic that the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). It is our primary conclusion that one

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of ordinary skill would not have been motivated to replace the inelastic canvas used in the British reference by the elastic sheet disclosed by Cannon, because to do so would eliminate the rigidity expressly required in order for the British invention to function in the desired manner.

An additional basis also exists for arriving at this conclusion. All three of the appellant's independent claims require that there be supporting poles so positioned as to stretch the sheet, and that the restoring force of the stretched sheet apply a compression force on each of these poles. In the British reference, the absence of elasticity means that there is no such restoring force to be applied by the sheet. In the Cannon system, it does not appear that any of the poles deform the sheet so as to create a restoring force which applies a compression load to them, since all are located at the edges of the sheets and appear to engage the inelastic edge bindings. Thus, the combined teachings of these two references would not, in our view, have rendered this feature of the claims obvious to one of ordinary skill in the art.

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Balicki has been applied by the examiner for its disclosure of clamps (5) that grip the edges of a beach blanket to keep it from blowing away. Only claim 1 requires such structure, but we fail to perceive any teaching or suggestion which would have led one of ordinary skill in the art to utilize such a clamp on the edges of the canopies of the British reference and Cannon, in view of the fact that neither requires such a releasable attachment means.

From our perspective, the only suggestion to combine the teachings of the references in the manner proposed by the examiner is found in the hindsight accorded one who first viewed the appellant's disclosure. This, of course, is an improper basis for a rejection. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

For the reasons set forth above, it is our conclusion that the teachings of the three references cited against the appellant's independent claims fail to establish a *prima facie* case of obviousness with regard to the subject matter recited therein. Moreover, the deficiencies present in these references are not overcome by taking into consideration the

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other applied references. We therefore will not sustain any
of the rejections.

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The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge))	
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NEAL E. ABRAMS)	BOARD OF PATENT
Administrative Patent Judge))	APPEALS AND
))	INTERFERENCES
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LAWRENCE J. STAAB)	
Administrative Patent Judge))	

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