

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RON CATES

Appeal No. 1999-1038
Application 08/602,125

ON BRIEF

Before COHEN, McQUADE and GONZALES, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Ron Cates appeals from the final rejection of claims 1 through 15 and 18 through 22, all of the claims pending in the application.¹ We reverse.

¹ Claim 15 has been amended subsequent to final rejection.

The invention relates to "a hanging or mounting strap to assist in holding a lighting fixture during its installation to a mount, such as a post, a wall or the like" (specification, page 1). Claims 1 and 15 are illustrative and read as follows:

1. A mounting strap to assist in holding a lighting fixture near an attachment point therefor during its installation, the strap comprising:

a member having a length defined between a first end and a second end wherein a portion at the first end is bent at an angular point along the length to form an acute angle with respect to the length of the member;

a first aperture along the length of the member remote from the angular point at which the portion at the first end is bent wherein the angular point is attachable to the attachment point and the first aperture is connectable to the lighting fixture wherein the member is bent at a point between the angular point and the aperture forming an obtuse angle with respect to the length of the member wherein the member is linear except for the bent angular point and the bent point forming an obtuse angle.

15. A method for assisting installation of a lighting fixture to a mount, the method comprising the steps of:

providing a strap having a length defined between a first end and a second end;

securing the first end of the strap for attachment to the mount;

attaching the second end of the strap to the light

Appeal No. 1999-1038
Application 08/602,125

fixture;

bending a portion of the first end of the strap to form an acute angle between the portion and the length of the strap; and

bending a portion of the second end of the strap to form an obtuse angle wherein the strap is linear except for the bent end portions.

The references relied upon by the examiner as evidence of obviousness are:

Parker	2,971,737	Feb. 14, 1961
Robinson	3,082,987	Mar. 26, 1963

Claims 1, 3, 4, 6 through 10, 13 through 15 and 18 through 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Parker.

Claims 2, 5, 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Parker in view of Robinson.

Reference is made to the appellant's main and reply briefs (Paper Nos. 8 and 11) and to the examiner's answer (Paper No. 10) for the respective positions of the appellant and the examiner with regard to the merits of these inventions.

Parker, the examiner's primary reference, discloses a

Appeal No. 1999-1038
Application 08/602,125

strap-like brace 10 for mounting an electrical outlet box to a wall joist or stud. The embodiment illustrated in Figures 1 through 5 includes a first end composed of a bend 11, a fastening area 12 and a nail/screw aperture 13 for connection to the joist or stud and a second end composed of a tongue 14 having bends 15 and 16, an offset extension 17, a bend 18 and a terminal end 19 for connection to the outlet box. The embodiment illustrated in Figure 6 is similar but includes an inclined flat portion 28 and a screw/rivet aperture 29, instead of tongue structure 14, for connection to the outlet box.

The claims on appeal include three which are independent, claims 1, 8 and 15. Claim 1 recites a lighting fixture mounting strap comprising a member having a portion bent at an angular point to form an acute angle and a bent point forming an obtuse angle wherein the member is linear except for the bent angular point and the bent point forming the obtuse angle. Claim 8 recites a lighting fixture installing system comprising a strap which is linear except for a first bend and a second bend wherein the first bend forms an acute angle and

Appeal No. 1999-1038
Application 08/602,125

the second bend forms an obtuse angle. Claim 15 recites a method for assisting installation of a lighting fixture comprising the steps of bending a strap to form both an acute angle and an obtuse angle wherein the strap is linear except for the bent portions.

Conceding that Parker does not fully meet these claim limitations, particularly to the extent that they encompass the acute angle bend, the examiner nonetheless concludes that it would have been an obvious matter of design choice to provide Parker's brace with an acute angle bent portion "since such a modification is merely a change in degree and is generally recognized as being within the level of one skilled in the art" (answer, page 5). The examiner goes on to explain (see pages 6, 7 and 9 in the answer) that motivation for this proposed modification lies in Parker's teaching at column 3, line 32 et seq. that the brace is capable of being bent. The mere fact that the prior art could be so modified, however, would not have made the modification obvious unless the prior art suggested the desirability of the modification (see In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed.

Appeal No. 1999-1038
Application 08/602,125

Cir. 1992); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). Parker fails to suggest any desirability of providing the brace disclosed therein with an acute angle of the sort recited in claims 1, 8 and 15. Indeed, given the relationships between the brace, joist/stud and outlet box shown in Figures 3 through 6, Parker would appear to teach away from such a modification. We are therefore constrained to conclude that Parker falls short of establishing a prima facie case of obviousness with respect to the subject matter recited in claims 1, 8 and 15.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 1, 8 and 15, or of claims 3, 4, 6, 7, 9, 10, 13, 14 and 18 through 22 which depend therefrom, as being unpatentable over Parker.

Since Robinson does not cure the above noted deficiencies of Parker with respect to the subject matter recited in independent claims 1 and 8, we also shall not sustain the standing 35 U.S.C. § 103(a) rejection of dependent claims 2, 5, 11 and 12.

Appeal No. 1999-1038
Application 08/602,125

The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	
JOHN P. McQUADE)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
JOHN F. GONZALES)	
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Appeal No. 1999-1038
Application 08/602,125

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