

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CLINTON R. STRONG

Appeal No. 2000-2147
Application No. 08/835,709

ON BRIEF

Before THOMAS, HAIRSTON, and DIXON, Administrative Patent Judges.
HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims
1 through 22.

The disclosed invention relates to a raceway for association with a floor of a structure to provide at least one of power and communications connectivity between a location on the floor and a support of the structure.

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Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. For association with a floor of a structure to provide at least one of power and communications connectivity between a location on said floor and a support of said structure, a raceway comprising:

a housing, substantially equal in length to a distance between said location on said floor and said support of said structure, having a conduit that is adapted to receive a line from said support of said structure, said line capable of communicating a signal to said location on said floor; and

a fastener that can be associated with said housing to at least substantially ensconce said line, said fastener and said housing cooperating to integrate a floor cover with said raceway.

The references relied on by the examiner are:

Storck	4,270,833	Jun. 2, 1981
Batty et al. (Batty)	4,780,094	Oct. 25, 1988
Wegmann, Jr. (Wegmann)	5,267,367	Dec. 7, 1993

Claims 1, 2, 5 and 7 through 12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Batty.

Claims 3, 4, 13 through 15 and 17 through 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Batty in view of Wegmann.

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Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Batty in view of Storck.

Claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Batty in view of Wegmann and Storck.

Reference is made to the briefs (paper numbers 18 and 20) and the answer (paper number 19) for the respective positions of the appellant and the examiner.

OPINION

We have carefully considered the entire record before us, and we will reverse the 35 U.S.C. § 102(b) rejection of claims 1, 2, 5 and 7 through 12, and the 35 U.S.C. § 103(a) rejection of claims 3, 4 and 6. On the other hand, we will sustain the 35 U.S.C. § 103(a) rejection of claims 13 through 22.

Except for "a raceway comprising: a housing, substantially equal in length to a distance between said location on said floor and said support of said structure, having a conduit . . . ; and a fastener . . . , said fastener and said housing cooperating to integrate a floor cover with said raceway," the remainder of claim 1 is couched in intended use language that will or may occur at a future date. As a result of the same intended use and future tense language, claim 13 is only directed to "a raceway

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comprising: a housing, substantially equal in length to a distance between said location on said floor and said support of said structure, comprising a conduit and a sloping side, said conduit . . . , and said sloping side, having a length substantially equal to a length of said raceway, provides a gradual transition between said floor and said raceway . . . ; and a fastener " Inasmuch as the future tense language in the claims may never occur, it is not used to differentiate the claimed invention over the teachings of the applied reference(s). The same holds true for the language in the claims directed to the manner in which the claimed raceway is to be used. In re Sinex, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962) (statement of intended use in an apparatus claim failed to distinguish over the prior art apparatus); Ex parte Masham, 2 USPQ2d 1647, 1648 (Bd. Pat. App. & Int. 1987) ("a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus").

According to the examiner (answer, page 5), Batty discloses a raceway that comprises housing 11 and fastener 19, and that the fastener and the housing cooperate "to integrate a floor cover

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(carpeting) with said raceway." Appellant argues inter alia (brief, pages 7 and 8; reply brief, pages 2 and 3) that Batty fails to disclose a fastener and a housing cooperating "to integrate a floor cover with said raceway."

Although we agree with the examiner that the plastic strip 19 broadly functions as a fastener for the underlying strips, we do not agree with the examiner that the fastener 19 and the housing 11 cooperate to "integrate" a floor cover with the raceway. At most, the fastener 19 and the housing 11 in Batty only cooperate to allow the carpet to be placed over them (Abstract; column 2, lines 31 and 55). Thus, the 35 U.S.C. § 102(b) rejection of claims 1, 2, 5 and 7 through 12 is reversed because Batty does not disclose every limitation of the claimed invention. Glaxo Inc. v. Novopharm Ltd., 52 F.3d 1043, 1047, 34 USPQ2d 1565, 1567 (Fed. Cir.), cert. denied, 516 U.S. 3378 (1995).

The 35 U.S.C. § 103(a) rejection of claims 3, 4 and 6 is reversed because the teachings of Wegmann and Storck do not cure the noted shortcoming in the teachings of Batty.

Turning to the obviousness rejection of claims 13 through 15 and 17 through 22, we agree with the examiner's findings

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(answer, page 6) that Wegmann discloses a raceway with sloped sides 15 "so that vehicles or pedestrians can cross over the raceway without incident." Appellant's arguments (brief, pages 12 through 14) to the contrary notwithstanding, the examiner has provided motivation (i.e., to allow vehicles or pedestrians to cross over a raceway "without incident") for combining the teachings of the references. Since "traffic" crossings discussed in Wegmann may be cart traffic in an office environment, we agree with the examiner (answer, pages 6 and 7) that it would have been obvious to one of ordinary skill in the art "to provide the raceway of Batty et al. with a sloping side . . . in order to facilitate walking or driving a vehicle over the raceway in view of the teaching of Wegmann, Jr." As indicated supra, any limitation of claim 13 that is couched in language that calls for a future action or an intended use can not be used to differentiate the claimed invention over the applied prior art. For this reason, the limitation "to integrate said raceway and said floor cover" does not differentiate the claimed invention over the applied prior art because the fastener and the housing are claimed as merely "capable of cooperating" to perform the noted function. Accordingly, the 35 U.S.C. § 103(a) rejection of

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claim 13 is sustained. The 35 U.S.C. § 103(a) rejection of claims 14 through 22 is likewise sustained because the appellant has chosen to let these claims stand or fall with claim 13 (brief, page 14).

DECISION

The decision of the examiner rejecting claims 1, 2, 5 and 7 through 12 under 35 U.S.C. § 102(b) is reversed, and the decision of the examiner rejecting claims 3, 4 and 6 under 35 U.S.C. § 103(a) is reversed. With respect to claims 13 through 22, the 35 U.S.C. § 103(a) rejection is affirmed. Accordingly, the decision of the examiner is affirmed-in-part.

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

AFFIRMED-IN-PART

JAMES D. THOMAS)	
Administrative Patent Judge)	
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KENNETH W. HAIRSTON)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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)	
JOSEPH L. DIXON)	
Administrative Patent Judge)	

KWH:hh

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