

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte H. E. STANGE

Appeal No. 2003-0040
Application No. 09/314,079

ON BRIEF

Before COHEN, STAAB, and BAHR, Administrative Patent Judges.
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1, 2, 4-11, 13-22 and 29-37, all the claims currently pending in the application.

Appellant's invention pertains to a method (claims 1, 2, 4-10 and 30-37), an apparatus (claims 11 and 13-20), and a kit (claims 21, 22 and 29) for compensating for a vertical offset between a top surface of a paved roadway and a top surface of a cover that occupies an opening extending downward through the roadway. A further

understanding of the invention can be derived from a reading of independent claims 1, 11, 21, 30 and 37, which appear in the appendix to appellant's main brief.

The following references are relied upon by the examiner in the final rejection and answer as evidence of obviousness:

Poupitch	2,735,470	Feb. 21, 1956
Gruenwald	4,597,692	Jul. 01, 1986
Papp	4,614,065	Sep. 30, 1986
Wollar et. al. (Wollar)	4,740,123	Apr. 26, 1988
Johnson	4,934,715	Jun. 19, 1990
Dannhauser	4,973,191	Nov. 27, 1990

The following rejections under 35 U.S.C. § 103(a) are before us for review:

(1) claims 1, 2, 6 and 10, rejected as being unpatentable over Papp in view of Dannhauser;¹

(2) claims 4 and 5, rejected as being unpatentable over Papp in view of Dannhauser and Gruenwald;

(3) claims 7, 30-32 and 37, rejected as being unpatentable over Papp in view of Dannhauser and Wollar;

(4) claims 8 and 9, rejected as being unpatentable over Papp in view of Dannhauser and Poupitch;

(5) claims 11 and 18, rejected as being unpatentable over Papp in view of Johnson;

¹Claim 2 was inadvertently not included in the list of claims rejected on this reference combination on page 4 of the answer.

(6) claims 13 and 21, rejected as being unpatentable over Papp in view of Johnson and Wollar;

(7) claims 14-16 and 22, rejected as being unpatentable over Papp in view of Johnson, Wollar and Poupitch;

(8) claim 17, rejected as being unpatentable over Papp in view of Johnson and Dannhauser;

(9) claims 19 and 20, rejected as being unpatentable over Papp in view of Johnson and Gruenwald;

(10) claim 29, rejected as being unpatentable over Papp in view of Johnson, Wollar and Gruenwald;

(11) claims 33 and 34, rejected as being unpatentable over Papp in view of Dannhauser, Wollar and Poupitch; and

(12) claims 35 and 36, rejected as being unpatentable over Papp in view of Dannhauser, Wollar and Gruenwald.

Reference is made to appellant's main and reply briefs (Paper Nos. 15 and 17) and to the examiner's answer (Paper No. 16) for the respective positions of appellant and the examiner regarding the merits of these rejections.

DISCUSSION

At the outset, appellant "questions whether the Papp patent is analogous art" (main brief, page 5). In an obviousness determination under 35 U.S.C. § 103(a), the

question of whether an applied reference constitutes analogous art is normally considered to be a threshold issue. However, in the view we take in this appeal, even if we assume that Papp is analogous art, the obviousness rejections made by the examiner in the final rejection and maintained in the answer are not well founded.

With reference to appellant's drawing Figure 1, each of the independent claims on appeal calls for, in one form or another, a mat (121) having at least three circumferentially spaced holes (124), and a plurality of cooperating fasteners (141) for securing the mat to a roadway cover (111).

Papp, the primary reference in each of the examiner's rejections, is directed to plumbing cleanout apparatus which is adjustable vertically to conform to the level of a concrete floor poured therearound. Papp's apparatus comprises an inner cylindrical body 13 having external threads 14 thereon. Holes 16 in the bottom of the inner body permit the inner body to be attached to an upstanding cleanout pipe 12. A seal 18 is formed between the top portion of the cleanout pipe and the inner portion of the inner body. A member 19 having an outer diameter larger than the diameter of the outer portion of the inner body is disposed over the inner body so that a concrete floor 11 poured around the cylindrical member does not come into contact with the threads of the inner body. After the concrete cures, member 19 is removed and an outer cylindrical body 24 having threads on the interior thereof is threadably engaged with the threads of the inner body. Outer body 24 is rotated in one direction or the other to bring

it to a desired adjusted vertical position just below the top of the concrete floor, and a set screw 26 is used to secure the position of the outer body relative to the inner body. Next, a plug 20 is installed in the top of the inner body. Finally, a cap 27 having a coverplate 31 is installed over the outer body to close off the top of the outer body (see Figures 10 and 11). As explained in the paragraph spanning columns 3 and 4, the cap and coverplate are held in position by a bolt 33 that passes through a central opening 32 in the cap and coverplate and is threaded into an opening 22 in the plug 20. As can be seen by comparing Figures 10 and 11, the cap and coverplate may be tipped to one side to adjust to the pitch of the floor if the floor is not level. In order to facilitate such tipping, the central opening 32 is elongated (column 3, lines 64-66).

In rejecting the appealed claims, the examiner finds correspondence between the coverplate 31 of Papp and appellant's mat and between the cap 27 of Papp and appellant's roadway cover. It also appears that the examiner equates the bolt 33 of Papp to one of appellant's fasteners 141 for securing the mat to the cover. The examiner acknowledges that Papp does not meet the limitations of the appealed claims calling for a mat having at least three circumferentially spaced holes, and a plurality of cooperating fasteners for securing the mat to the cover. To make up for these deficiencies, the examiner turns to either Dannhauser (rejections (1) to (4), (11) and (12)) or Johnson (rejections (5) to (10)).

Dannhauser pertains to a manhole cover comprising a lid 2 having a replaceable insert plate 5 secured thereto by screw connections 14. The screw connections are made by inserting screws from below through holes in the lid and into corresponding blind threaded bores in the underside of the insert plate. Johnson relates to an improved gasket for use with manhole covers. In Johnson, manhole cover 10 is secured to frame by a plurality of bolts 21, typically four in number.

In the present case, the examiner's rejection is deficient for at least the following reasons. First, it is not clear precisely how the examiner proposes to modify Papp in order to meet the limitations of the appealed claims calling for a mat having at least three circumferentially spaced holes, and a plurality of cooperating fasteners for securing the mat to the cover. In this regard, it is not clear whether the examiner proposes to (a) provide a plurality of bolts similar to bolts 33 in Papp, or (b) retain the single bolt 33 of Papp and provide additional threaded fasteners directly securing coverplate 31 to cap 27.

Second, regardless of the intended modification of Papp in view of Dannhauser or Johnson, the teachings of the applied references do not provide a reasonable basis for concluding that it would have been obvious to one of ordinary skill in the art to modify Papp in a manner that results in a mat having at least three circumferentially spaced holes and a plurality of cooperating fasteners for securing the mat to a roadway cover. Concerning modification (a), modifying Papp by providing a plurality of bolts

similar to bolts 33 would compromise the ability of Papp's coverplate and cap to tip to the side to match the pitch of the floor. This would have been a disincentive to one of ordinary skill in the art to modify Papp in this manner. Hence, modification (a) would not have been obvious. *See, for example, Tec Air Inc. v. Denso Mfg. Michigan Inc.*, 192 F.3d 1353, 1360, 52 USPQ2d, 1294, 1298 (Fed. Cir. 1999) (where the proposed modification would render the prior art being modified unsatisfactory for its intended purpose, the proposed modification would not have been obvious). As to modification (b), the disclosures in Dannhauser and Johnson of bolts for securing either an insert plate to a manhole cover (Dannhauser) or a manhole cover to a frame (Johnson) differ substantially from the disclosure of Papp of a cleanout apparatus that is adjustable to conform the cleanout to the level of a poured concrete floor. From our perspective, there is no reasonable suggestion in either reference combination, or need in view of the divergent objectives of the references involved, for their combination. In this regard, Papp voices no concern whatsoever for the construction details of the coverplate/cap subassembly, and Papp's bolt 33 would appear to be fully capable of maintaining the position of the coverplate relative to the cap without modification.²

²This assumes that Papp's coverplate 31 and cap 27 are not an integrated subassembly. For all Papp discloses, the coverplate may be welded or otherwise joined to the cap, which would obviate the need for providing separate mechanical fasteners for securing the coverplate to the cap.

Third, the examiner has articulated no convincing reason for modifying Papp in a way that would result in the claimed subject matter of the independent claims on appeal. For example, in rejecting claim 1 as being unpatentable over Papp in view of Dannhauser, the examiner determined that it would have been obvious in view of Dannhauser to provide Papp with a plurality of fasteners “in order to secure a protective mat [i.e., Papp’s coverplate 31] to a cover” (answer, page 5). However, Papp indicates that bolt 33 is already quite capable of securing the coverplate 31 to the cap 27. See column 4, lines 15-18 (“After such [tipping] adjustment has been made, then the bolt (33) is tightened down to secure the cap (27) and cover (31) to the position shown in FIG. 12.”). Accordingly, we find that there would be no need, and thus no motivation except that derived from impermissible hindsight, for modifying the apparatus of Papp in the manner proposed by the examiner. In this regard, the mere fact that a prior art reference may be modified in the manner suggested by the examiner does not make such a modification obvious unless the prior art suggested the desirability of the modification. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Here, the prior art relied upon by the examiner contains no such suggestion.

For these reasons, we conclude that the teachings of Papp when combined with Dannhauser and/or Johnson would not have suggested to one of ordinary skill in the art providing the apparatus of Papp with a coverplate 31 having at least three

circumferentially spaced holes, and a plurality of cooperating fasteners for securing the coverplate to the cap 27. It follows that rejections (1), (5) and (8) will not be sustained.

As to the remaining rejections, we have carefully considered the Gruenwald, Wollar, and Poupitch references additionally applied in these rejections, but find nothing therein that makes up for the deficiencies of Papp, Dannhauser and Johnson discussed above. Accordingly, rejections (2) to (4), (6), (7) and (9) to (12) also will not be sustained.

The decision of the examiner finally rejecting the appealed claims is reversed.

REVERSED

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

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