

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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JAMES J. ROSASCO, DOUGLAS L. WITTE  
and PETER STURRUS

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Appeal No. 2004-0182  
Application No. 09/933,354

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ON BRIEF

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Before ABRAMS, McQUADE, and BAHR, Administrative Patent Judges.  
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 7, 9 and 18-20. Claims 11-15 have been allowed, claims 2-6, 8 and 10 have been indicated as containing allowable subject matter, and claims 16 and 17 have been canceled.

We REVERSE.

### BACKGROUND

The appellants' invention relates to a method of manufacturing a structural tube. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Lawson	2,862,292	Dec. 2, 1958
Licklitter <u>et al.</u> (Licklitter)	3,638,465	Feb. 1, 1972
Sturrus	5,454,504	Oct. 3, 1995

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

- (1) Claims 1, 7 and 9 on the basis of Licklitter in view of Sturrus.
- (2) Claim 18 on the basis of Licklitter in view of Lawson.
- (3) Claims 19 and 20 on the basis of Licklitter in view of Lawson and Sturrus.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the Answer (Paper No. 11) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 10) and Reply Brief (Paper No. 12) for the appellants' arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the

respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The appellants' invention is directed to methods of manufacturing structural tubes adapted to telescopingly engage one another, for use in items such as vehicle jacks. Each of the four independent claims before us on appeal requires, inter alia, the steps of rollforming a roll of sheet material into a "tubular shape," and forming a longitudinal "channel" in the tubular shape. In all of the rejections, the examiner has found this structure to be present in the rollformed structural element disclosed by Licklitter, and has combined Licklitter with Sturrus (claims 1, 7 and 9), Lawson (claim 18), and Sturrus and Lawson (claims 19 and 20), in order to meet other limitations of the claims. The appellants argue that the structural element disclosed by Licklitter is not a "tubular shape" and does not include a "channel," as is required by all of the claims (Brief, page 12). We agree, and on this basis will not sustain any of the rejections.

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, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the 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, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

The common applicable definition of “tubular” is “having the form of or consisting of a tube,” and a “tube” is “a hollow elongated cylinder.”<sup>1</sup> It is quite clear from Figure 20 that the Lickliter structural element does not fall within these definitions, for it comprises an elongated hollow body configured in cross-section as an inverted “T” formed of three essentially rectangularly-shaped sections which are connected together at their bases. From our perspective, neither the entire structural element nor any of the three sections constitutes a “tubular shape,” that is, a hollow elongated cylinder. Thus, we cannot agree with the examiner that “the T-shaped section 22 is clearly a tube” (Answer, page 6; emphasis added). This deficiency is not cured by further consideration of Sturrus, which discloses a pair of joined hollow elements of rectangular cross-section, or Lawson, which is directed to a flat strip.

It therefore is our view that the combined teachings of the references fail to establish a prima facie case of obviousness with regard to any of independent claims 1, 18, 19 and 20, and we will not sustain the three rejections.

#### CONCLUSION

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<sup>1</sup>Merriam Webster's Collegiate Dictionary, Tenth Edition, 1996, page 1270.

None of the rejections is sustained.

The decision of the examiner is reversed.

NEAL E. ABRAMS  
Administrative Patent Judge

JOHN P. McQUADE  
Administrative Patent Judge

JENNIFER D. BAHR  
Administrative Patent Judge

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PRICE, HENEVELD, COOPER,  
DeWITT & LITTON  
695 KENMOOR, S.E.  
POST OFFICE BOX 2567  
GRAND RAPIDS, MI 49501