

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte LOUIS J. PETROZZIELLO

Appeal No. 2005-0516
Application No. 10/199,803

HEARD: March 9, 2005

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3 to 12 and 14 to 24, which are all of the claims pending in this application.

We REVERSE and REMAND.

BACKGROUND

The appellant's invention is generally related to fencing and is particularly related to protective guards securable to fences (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

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

Allen	3,648,981	Mar. 14, 1972
Demarest	4,071,223	Jan. 31, 1978
Eisele	5,402,988	Apr. 4, 1995
Giannelli	5,762,444	June 9, 1998

The appellant's admission of prior art (specification, pages 1-2; Figures 1-5) relating to a protective guard for a chain link fence (Admitted Prior Art).

Claims 1, 3 to 6, 11 and 14 to 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over the Admitted Prior Art in view of Eisele.

Claims 17 to 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over the Admitted Prior Art in view of Eisele and Giannelli.

Claims 7 to 10 and 20 to 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over the Admitted Prior Art in view of Eisele and Demarest.

Claim 12 stands rejected under 35 U.S.C. § 103 as being unpatentable over the Admitted Prior Art in view of Eisele and Allen.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (mailed May 24, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed March 3, 2004) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1, 3 to 12 and 14 to 24 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Claim 1

We will not sustain the rejection of claim 1 under 35 U.S.C. § 103.

Claim 1 reads as follows:

A protective guard securable over a top support bar of a fence comprising: an elongated tubular member having first and second ends, an outer surface, an inner surface defining an interior space for capturing said top support bar and an elongated opening extending between said inner and outer surfaces and said first and second ends, wherein said elongated tubular member is securable over said top support bar of said fence; and

first and second attachment flanges integrally formed with said elongated tubular member on opposite sides of said elongated opening, wherein said first and second attachment flanges are adapted for engaging opposite sides of said fence when said protective guard is secured atop said top support bar of said fence.

The Admitted Prior Art discloses in Figure 5 a protective guard 52 mounted on a chain link fence 20. As shown in Figures 2-4, the protective guard 52 is an extruded, flexible, plastic tube that defines an interior space 58. The elongated tube 52 is prepared for use as a protective guard atop a fence by making an elongated cut 60 extending between first and second ends 54, 56 of the protective guard 52. As noted above, the elongated tube 52 is flexible so that the tube may be flexed apart at the cut line 60 to provide an opening 62 so that the tube may be placed atop the fence 20. The protective guard 52 is placed atop fence 20 including top support rail 38 by inserting top support rail 38 through opening 62 and into interior space 58 of tube 52. The top support bar 38 is inserted until it abuts against an interior top surface of tube 52.

Eisele's invention relates to embodiments of a new portable fence construction, particularly one useful in sporting events, crowd control and in situations when a fence is needed for a purpose that does not require, or permit permanent fencing. Eisele's portable fence is durable, lightweight and easily transported, erected and dismantled. In use, it will collapse upon impact, due to a break away, in the first embodiment, a joint between the fence post and its supporting leg, and in the second embodiment a joint in the supporting leg, yet in both embodiments the fence may be quickly and easily re-erected.

The first embodiment of Eisele's portable fence is shown in Figures 1-7 and is intended to be assembled, with similar sections, into a fence of any desired length, such as a length sufficient to define the outfield boundary of a baseball or softball field. Each section of fence 1 consists of a frame 2 defined by a series of tubular elements which contain and hold netting 4. The frame 2 consists of a horizontal upper rail 6, a horizontal lower rail 8 and two vertical side rails 12. An off-set section 13 represents a break in the horizontal continuity of the bottom rail 8. Upper and lower rails 6, 8 and vertical side rails 12 are all preferably formed as extruded tubing, and include flange elements 20 (see Figure 6 for a closeup) projecting outward relative to the center of the tubing. The periphery of the netting 4 is received between flanges 20, and preferably is held within flanges 20 by wedge elements 22 (see Figure 7 for detail). Each wedge element 22 includes a flat bottomed base portion 26 that is received between the opposed flanges 20 and which bears upon inner ledges 28 of the flange (shown in closeup in Figure 6), the wedge elements 22 thereby interlocking with the flanges 20 to hold the netting 4 to its associated rail.

In the rejection of claim 1, the examiner (answer, p. 4) ascertained¹ that the Admitted Prior Art lacked "first and second attachment flanges integrally formed with said elongated tubular member on opposite sides of said elongated opening, wherein said first and second attachment flanges are adapted for engaging opposite sides of said fence." The examiner (answer, p. 5) then concluded that

it would have been obvious to one having ordinary skill in the art at the time the invention was made [to] modify the protective guard of Appellant's Prior Art admission (figures 1-5) by providing attachment flanges integrally formed with the elongated tubular member on opposite sides of an elongated opening in order to provide a means to secure the protective guard to the fencing material as taught by Eisele.

The appellant argues (brief, p. 5) that the applied prior art does not suggest a protective guard securable over a top support bar of a fence having both an elongated tubular member and first and second attachment flanges integrally formed with the elongated tubular member such that the first and second attachment flanges are adapted for engaging opposite sides of a fence when the protective guard is secured atop the top support bar of the fence. The appellant asserts that:

Clearly, Eisele neither discloses nor suggests providing a "protective guard" over the "top support bar" of a fence. Eisele's "horizontal rail 6" (FIG. 3) is not akin to Appellant's "protective guard." In fact, Eisele's horizontal rail 6 is similar to

¹After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Appellant's "top support bar." Eisele's horizontal rail 6 cannot be both a "top support bar" and a "protective guard" secured over the top support bar.

After reviewing the teachings of the Admitted Prior Art and Eisele, it is our opinion that there is no teaching, suggestion or motivation therein that would have made it obvious at the time the invention was made to a person having ordinary skill in the art to have modified the Admitted Prior Art so as to arrive at the invention recited in claim 1. The appellant is correct that Eisele does not disclose providing a "protective guard" over the "top support bar" of a fence. In our view, Eisele's tubular horizontal upper rail 6 is not sufficiently similar to the Admitted Prior Art's protective guard 52 so to have suggested to a person having ordinary skill in the art to provide first and second attachment flanges to the Admitted Prior Art's protective guard 52.

In our view, the only suggestion for modifying the Admitted Prior Art in the manner proposed by the examiner to arrive at the subject matter of claim 1 stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claim 1 under 35 U.S.C. § 103 is reversed.

Claims 3 to 6, 11 and 14 to 16

The decision of the examiner to reject dependent claims 3 to 6, 11 and 14 to 16 under 35 U.S.C. § 103 is reversed for the reasons set forth above with respect to claim 1.

Claims 7 to 10, 12 and 17 to 19

We have also reviewed the references to Giannelli, Demarest and Allen additionally applied in the rejection of dependent claims 7 to 10, 12 and 17 to 19 but find nothing therein which makes up for the deficiencies of the Admitted Prior Art and Eisele discussed above with respect to claim 1. Accordingly, the decision of the examiner to reject dependent claims 7 to 10, 12 and 17 to 19 under 35 U.S.C. § 103 is also reversed.

Claim 20

We will not sustain the rejection of claim 20 under 35 U.S.C. § 103.

Claim 20 reads as follows:

A combination including a protective guard securable over an upper edge of a fence comprising:
said fence including a top support bar;
said protective guard including an elongated, flexible tubular member having first and second ends, an outer surface, an inner surface defining an

interior space and an elongated opening extending between said inner and outer surfaces and said first and second ends, wherein said elongated, flexible tubular member is securable over said top support bar of said fence;

first and second attachment flanges integrally formed with said elongated member on opposite sides of said elongated opening, wherein said first and second attachment flanges are adapted for engaging opposite sides of said fence when said protective guard is secured atop said top support bar of said fence; and

at least one securing element engaging said first and second attachment flanges and passing through said fence for securing said protective guard to said fence.

The applied prior art does not suggest the claimed subject matter of claim 20 for the reasons set forth above with respect to claim 1. Accordingly, the decision of the examiner to reject claim 20 under 35 U.S.C. § 103 is reversed.

Claims 21 to 24

The decision of the examiner to reject dependent claims 21 to 24 under 35 U.S.C. § 103 is reversed for the reasons set forth above with respect to claim 20.

REMAND

This application is remanded to the examiner for consideration of the following issue. Is claim 1 anticipated² by the horizontal upper rail 6 of Eisele? In that regard, we note that claim 1 is directed to a protective guard per se³ and not to the combination of a protective guard secured over the top support bar of a fence as set forth in claim 20. In making this determination, the examiner must ascertain whether or not the horizontal upper rail 6 of Eisele is capable of being secured over a top support bar of a fence so that Eisele's flanges 20 would engage opposite sides of the fence when the horizontal upper rail 6 is secured atop the top support bar of a fence.

CONCLUSION

²A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

³In this regard we note the use of "intended use" language in claim 1 (e.g., securable over, adapted for).

To summarize, the decision of the examiner to reject claims 1, 3 to 12 and 14 to 24 under 35 U.S.C. § 103 is reversed. In addition, this application has been remanded to the examiner for further consideration.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01.

REVERSED; REMANDED

JOHN P. McQUADE)	
Administrative Patent Judge)	
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