

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for publication and is not binding precedent of the Board.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 THOMAS J. GRETZ

Appeal No. 2005-2562
Application No. 09/956,610

ON BRIEF

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

DECISION ON APPEAL

Thomas J. Gretz appeals from the final rejection (mailed May 30, 2003) of claims 1-11, all of the claims pending in the application.

THE INVENTION

The invention relates to a flexible plastic sleeve/extender designed for use with an electrical box to position an electrical device, such as an outlet or switch, mounted in the box flush with the surface of a wall and/or to insulate the device from the box.

Representative claim 1 reads as follows:

1. [A] one piece plastic part for an electrical box comprising:

a sleeve having an outer opening at an outer end and an inner opening at an inner end;

two first sides opposite one another and two second flangeless sides opposite one another;

corners connecting said first sides and said second flangeless sides;

each of said first sides having an outer edge and an inner edge;

a flange extending sideways from each of said outer edges of said first sides;

said flanges being sufficiently thin to be recessed under a cover plate;

each of said second flangeless sides having an outer edge and an inner edge;

said outer opening having said outer edge of said first sides and said outer edges of said second flangeless sides substantially coplanar with each other;

said sides forming a generally tubular body sized to receive an electrical device;

said first sides and said second flangeless sides being made of a flexible plastic having a thinness extending from $\frac{1}{4}$ inch just below said outer edges to said inner edges of approximately 0.060 inches thick or less which allows said tubular body to be received in a variety of electrical boxes; and

an opening in each of said flanges capable of passing screws therethrough for fastening an electrical device to an electrical box.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Bachmann	2,297,862	Oct. 06, 1942
Gretz	5,736,674	Apr. 07, 1998

THE REJECTION

Claims 1-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gretz in view of Bachmann.

Attention is directed to the main and reply briefs (filed January 26, 2004 and June 14, 2004) and answer (mailed April 14, 2004) for the respective positions of the appellant and examiner regarding the merits of this rejection.

DISCUSSION

Gretz discloses a plastic part 10 which is conceded by the examiner (see page 3 in the answer) to lack two second sides which are "flangeless" as recited in claim 1. The appellant's specification indicates that this "flangeless" feature "is an

important advantage since two parts can abut one another along their wide [flangeless] sides and thus be 'ganged' together . . . for some electrical boxes" (page 12). In contrast, the two first sides and two second sides of the Gretz plastic part have respective flanges 20, 22, 26 and 28. Gretz teaches that the flanges 26 and 28, which are on the sides corresponding to the second sides recited in claim 1, serve to stiffen the long sides of the part (see column 3, lines 3-7) and position the part relative to a wall by abutting the wall's outer surface (see column 4, lines 50-53). The examiner's reliance on Bachmann to overcome the failure of Gretz to teach second sides which are "flangeless" is not well founded.

According to the examiner, "Bachman[n], as seen in Fig. 4, teaches a similar part for an electrical box with no flanges on the wide side" (answer, page 3). In response to the appellant's argument that the structure shown in Bachmann's Figure 4 is not a plastic extender but part of the electrical box itself, the examiner submits that

Bachmann teaches a metal extension for insertion into a metal electrical box as seen in Figs. 2-4. The part seen in Fig. 4 is the extension. The extension has sides that are identified by number 2 which do not have flanges or

are flangeless. . . . The electrical box of Bachmann is the part seen in Fig. 3 and identified by number 1. The part of Bachmann shown in Fig. 4 is inserted into part number 1 and extends the depth of the box (part 1) and makes it adjustable for walls of different wall thickness. Therefore the part identified by number 2 is an insert for an electrical box [answer, pages 3-4]..

Based on the foregoing findings, the examiner concludes that "[i]t would have been obvious to make the wide sides of Gretz '674 flangeless as taught by Bachman[n] to reduce the amount of plastic necessary to make the product and/or to reduce costs or to eliminate the unnecessary structure" (answer, page 3).

A fair reading of Bachmann, however, shows that the examiner's characterization of the elements illustrated in Figures 3 and 4 as an electrical box and an extender is unreasonable. These elements actually constitute two interlocking halves of "a through wall switch box for two switches S so that a single cable C may be employed to establish a circuit to two rooms" (page 1, column 2, lines 9-11). Hence, together they are comparable to the electrical box 46 with which Gretz's part 10 is intended to be used. Box 46 is similar to Bachmann's box 1, 2, in that it too has "flangeless" sides. Nonetheless, the mere disclosure by Bachmann and Gretz of

electrical boxes having "flangeless" sides would not have provided the artisan with any suggestion or motivation to eliminate the flanges on the second sides of Gretz's plastic extender part 10. To begin with, the extender part 10 serves a distinctly different purpose than the electrical boxes. Moreover, the proposed removal of the part's side flanges would eliminate the stiffening and positioning benefits desired by Gretz, the description of which belies the examiner's contention that the flanges are unnecessary.

The combined teachings of Gretz and Bachmann also fail to support the examiner's bald conjecture that the removal of the flanges would reduce costs to any significant degree.

Thus, Gretz and Bachmann do not justify the examiner's conclusion that the differences between the subject matter recited in claim 1 and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of independent claim 1, and dependent claims 2-11, as being unpatentable over Gretz in view of Bachmann.

As a final matter, we note that the examiner makes mention in the answer (see page 4) of four references which purportedly disclose electrical box extenders having flangeless sides. The

statement of the appealed rejection, however, does not include these references. Where a reference is relied on to support a rejection, whether or not in a minor capacity, there is no excuse for not positively including the reference in the statement of the rejection. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). Consequently, we have not considered the cited references in reviewing the merits of the examiner's rejection. The examiner, of course, has the option of entering new rejections based on these references, if such are deemed to be warranted, in the event of further prosecution.

SUMMARY

The decision of the examiner to reject claims 1-11 is reversed.

REVERSED

JOHN P. MCQUADE)
Administrative Patent Judge)
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) BOARD OF PATENT
JEFFREY V. NASE) APPEALS
Administrative Patent Judge) AND
) INTERFERENCES
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JENNIFER D. BAHR)
Administrative Patent Judge)

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