

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

Appeal No. 2006-1145
Application No. 10/143,977
Technology Center 3637

ON BRIEF

Before OWENS, LEVY, and FETTING, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-6, 9-11, 15-17, 21 and 22. Claims 7, 8, 12-14 and 18-20 have been withdrawn from consideration based upon an election of species requirement (brief, page 4). Claims 23 and 24 have been cancelled (brief, page 5).

We AFFIRM.

BACKGROUND

The appellant's invention relates to an adjustable security apparatus for protection of door and window openings (specification, page 1).

Claim 1 is representative of the invention, and is reproduced as follows:

An adjustable apparatus for protection of a door or window opening having an upper frame and a lower frame, said adjustable apparatus comprising:

a plurality of posts;

a first end plate for fastening a first end of said adjustable apparatus to the upper frame of said opening; and

a second end plate for fastening a second end of said apparatus to the lower frame of said opening;

wherein said plurality of posts further comprise:

a first portion having a predetermined length; and

a second portion having a predetermined length;

wherein said first portion telescopically engages said second portion, and

wherein a length of said plurality of posts telescopically adjusts to correspond to a longitudinal dimension between said upper frame and said lower frame of said opening.

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

Hughes	4,229,919	Oct. 28, 1980
McClure	5,253,839	Oct. 19, 1993
Moses	5,314,156	May 24, 1994

Claims 1-3, 5, 6, 9-11, 16, 17, 21 and 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Moses.

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Moses in view of Hughes.

Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Moses in view of McClure.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (supplemental answer mailed November 23, 2005) for the examiner's complete reasoning in support of the rejections, and to the brief (filed March 10, 2005) for the appellant's arguments thereagainst.

Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered. See 37 CFR § 41.37(c)(1)(vii) (eff. Sept. 13, 2004).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we make the determinations which follow. We begin with the rejection of claims 1-3, 5, 6, 9-11, 16, 17, 21 and 22 under 35 U.S.C. § 102(b) as being anticipated by Moses. We note at the outset that appellant has argued the claims as a group. Accordingly, we select claim 1 as representative of the group. By way of background, it is well settled that if a prior art device inherently possesses the capability of functioning in the manner claimed, anticipation exists whether there was a recognition that it could be used to perform the claimed function. See, e.g., In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). See also

LaBounty Mfg. v. Int'l Trade Comm'n, 958 F.2d 1066, 1075, 22 USPQ2d 1025, 1032

(Fed. Cir. 1992) (in quoting with approval from Dwight & Lloyd Sintering Co. v.

Greenawalt, 27 F.2d 823, 828 (2d Cir. 1928)):

The use for which the [anticipatory] apparatus was intended is irrelevant, if it could be employed without change for the purposes of the patent; the statute authorizes the patenting of machines, not of their uses.

Appellant asserts (brief, page 10) that the focus of the disclosed structure of Moses is entirely on a suspended support system, and not on a security apparatus for a door or window as claimed. It is argued (id.) that there is no teaching that the suspension structure may be used to close an opening and that “the telescopic support column 20 attaches to a support beam 40, which may be used as a carrier rail for suspended equipment or the like. It may not be mounted within a frame of a window or a door, nor would there be any reason to do so.”

With respect to the examiner’s assertion that Moses is capable of performing the claimed intended use, appellant asserts (brief, page 12) that Moses does not teach a structure that can fasten to a frame at its second end and that “plate 64 is not adapted for attachment to a frame of a window or door, but merely to a channel structure 40 or a rail. Even if the plate 60 were mounted at the top of a door or window frame, it would not be mounted at the bottom, as the entire purpose of the structure in Moses is to allow a device to hang free in a suspended position.”

We begin our analysis with claim construction. Before addressing the examiner's rejections based upon prior art, it is an essential prerequisite that the claimed subject matter be fully understood.

Analysis of whether a claim is patentable over the prior art begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. See Smithkline Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988). Accordingly, we will direct our attention to appellant's claim 1 to derive an understanding of the scope and content thereof.

We find that the claim language "for protection of a door or window opening having an upper frame and a lower frame" does not recite the window or door opening in combination with the adjustable apparatus. Rather, the claim is directed to an adjustable apparatus for protection of a door or window opening. Because the window or door is not claimed in combination with the apparatus, we agree with the examiner (answer, page 5) that the window or door with upper and lower frame is an intended use for the claimed apparatus. Thus, to meet the language of claim 1, it

is necessary that the apparatus of the reference inherently be capable of protecting a door or window.

With this claim construction in mind, we turn to Moses. As shown in figure 2, post 20 includes a portion 50 that is telescopically engaged with portion 52. In addition, head and foot plates 60 and 64 include holes 62, 66 respectively (col. 3, lines 54-58). As shown in figure 1, head plate 60 is attached to ceiling 22 (col. 3, line 6) and head plate and the foot plate are identical and interchangeable (col. 3, lines 59 and 60). Foot plate 62 may be attached to support beam 40 through screw rods 70, washers 78 and bolts 72 (col. 4, lines 8-14). In addition, as shown in figures 1 and 3, head plate 60 is secured to ceiling 22 by bolts (unlabeled).

From our review of Moses, we find that although Moses discloses securing posts 20 to a ceiling by bolts extending through holes 62, post 20 is inherently capable of being secured to the top of a door or window frame. In addition, although foot plate 64 is disclosed as being secured to support beam 40, we find that by virtue of the holes 66 in the foot plate 64, that the footplate is inherently capable of being secured to the bottom of a door or window frame, as the foot plate and head plate can be oriented to have the narrow dimension point in any of four directions. Thus, although Moses is not directed to protecting a door or window frame, we find that the post 20 is inherently capable of being mounted in a door or window frame.

We are not persuaded by appellant's assertion that there is no teaching or suggestion that the suspension structure may be used to close an opening. Firstly, claim 1 does not recite closing an opening. Secondly, from the structure of post 20, as described, supra, we find that post 20 is inherently capable of being mounted in a door or window frame because of the telescoping nature of the parts of the post.

Nor are we persuaded by appellant's assertion (brief, page 11) that the telescopic support column 20 of Moses "may not be mounted within a frame of a window or door, nor would there be any reason to do so." Appellant has not provided any convincing reasons as to why the post 20 of Moses could not be mounted within a door or window frame.

Nor are we persuaded by appellants' assertion (brief, page 12) that Moses does not teach a structure that can fasten to a frame at its second end, and that even if the plate 60 were mounted at the top of a door or window frame, it would not be mounted at the bottom, as the entire purpose of the structure of Moses is to allow the device to hang free in a suspended position. From the disclosure of Moses that foot plate 64 has holes 66 therein (figure 2) for allowing the telescoping column 20 to mount to support beam 40, we find that by virtue of the holes 66 in foot plate 64, redundant the telescoping column 20 is inherently capable of being mounted to the bottom frame of a door or window.

From all of the above, we find that Moses anticipates claim 1, and are not convinced of any error on the part of the examiner in rejecting claim 1 under 35 U.S.C. § 102(b). In sum, because claim 1 is not drawn to the combination of a door or window frame and a telescoping support, but rather to the telescoping support for use in the frame of a door or window, we find that the claimed invention is met by Moses. If appellant desires to obtain patent coverage for a new use of an existing structure, appellant's claims should be in the form of a new use for an old device, and written as process claims. In addition, we are cognizant of the differences between the device of Moses and appellant's invention, such as the single end plate 3 and single traversing plate 5 for multiple telescoping columns, along with the vertical transversing plates or bars 12, 13. However, these differences are not distinctly brought out in claim 1. As broadly drafted, claim 1 is broad enough to be met by the disclosure of Moses in a manner unintended by appellant. The rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Moses is sustained, along with claims 2, 3, 5, 6, 9-11, 16, 17, 21 and 22, which fall with claim 1.

We turn next to the rejection of claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Moses in view of Hughes. The examiner's position (answer, page 4) is that Moses does not disclose the first portion to be solid. To overcome this deficiency of Moses, the examiner turns to Hughes for a teaching of having a solid member telescopically engaged within a tubular member. Appellant

asserts (brief, page 13) that Hughes does not make up for the deficiencies of Moses, and (brief, page 14) that Hughes merely teaches a solid member telescopically engaged with a tubular member. It is argued (id.) that “the structures, their application and related technologies are totally different and would not render the claimed invention obvious. Moreover, they would mitigate against their combination.”

From our findings, supra, with respect to claim construction and the teachings of Moses, and Hughes’ disclosure of a support post or pipe inserted into a tubular member as part of a support bracket, we agree with the examiner that an artisan would have been motivated to make the first portion 50 of the telescopic support column of Moses solid as taught by Hughes and agree with the examiner that making one of the telescoping members solid would provide strong structural support. The rejection of claim 4 under 35 U.S.C. § 103(a) is sustained.

We turn next to the rejection of claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Moses in view of McClure. The examiner’s position (answer, page 5) is that Moses does not disclose “fasteners engaging the coupling and adjustable to compress the coupling, thereby applying frictional force to the first portion and fixing the first portion to the second portion.” To overcome this deficiency of Moses, the examiner turns to McClure for a teaching of a coupling having fasteners to compress the coupling. The examiner’s reasoning is that an artisan would have been motivated to make the modification because it would enable easy length

adjustment as taught by McClure. Appellant asserts (brief, page 14) that “claim 15 depends from claim 1 (via claim 9) and the features of the basic invention are not taught or suggested by Moses. The Examiner does not look to McClure to remedy these deficiencies. Nor can McClure provide the motivation and teaching needed to modify Moses. The Examiner relies upon McClure solely for its teaching of a coupling 29 (col. 3, lines 40-45 for fasteners.” From our findings, supra, with respect to the teachings of Moses, and McClure’s disclosure (figure 1 and col. 3, lines 40-45) of coupling 29 having fasteners for bracing a door frame, we agree with the examiner, for the reasons set forth in the answer, that an artisan would have been motivated to provide Moses with fasteners connected to couplings to fix the first portion to the second portion of the telescoping columns of Moses. In addition, we note that the nut 58 and bolt 56 of Moses is seen to constitute a coupling and fastener as recited in claim 15. Accordingly, for this additional reason, we find that the applied prior art teaches or suggests the invention of claim 15. The rejection of claim 15 under 35 U.S.C. § 103(a) is sustained.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-3, 5, 6, 9-11, 16, 17, 21 and 22 under 35 U.S.C. § 102(b) is affirmed. The rejection of claims 4 and 15 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

TERRY J. OWENS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
STUART S. LEVY)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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ANTON W. FETTING)	
Administrative Patent Judge)	

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Παγε 13

SSL/lg

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Application No. 10/143,977

Παγε 14

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