

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 DONALD R. SMITH

Appeal 2006-2717
Application 09/791,051
Technology Center 3600

Decided: January 31, 2007

Before TERRY J. OWENS, JENNIFER D. BAHR and LINDA E. HORNER,
Administrative Patent Judges.

HORNER, *Administrative Patent Judge.*

STATEMENT OF THE CASE

The Appellants seek our review of the Examiner's final rejection of claims 1-7, 9-12, 14, 15, and 18-20.¹ We have jurisdiction over this appeal under 35 USC § 134(a).

SUMMARY OF DECISION

We AFFIRM-IN-PART.

¹ Claims 8, 13, 16, and 17 have been withdrawn.

THE INVENTION

The Appellant invented a wall adapter for fastening a mullion to a wall (Specification 3). Claims 1 and 9, reproduced below, are representative of the subject matter on appeal.

1. A wall adapter for fastening a mullion to a wall, the mullion mounting a window or door, the mullion being a single piece and having first and second sides, comprising:

a member having a first portion, a first side portion extending from a first edge of the first portion and a second side portion extending from a second edge of the first portion, the first portion, first side portion and second side portion engaging the wall; and

the first portion having a first surface for receiving the single piece mullion, the window or door being mounted to the mullion, the mullion being secured to the wall only through the member.

9. A wall adapter system including:

a wall have a predetermined thickness;

a single piece mullion mounting a door or a window, the single piece mullion having a first side and a second side, each side having an inwardly directed lip;

a cover trim;

a wall adapter having a first portion of predetermined width, at least one side portion extending from a first edge of the first portion,

the first portion having a mullion snap interlock thereon, the mullion snap fit on the mullion snap interlock, the first side portion having a cover trim interlock, the cover trim snap fit on the cover trim interlock, the mullion being secured to the wall only through the wall adapter, the first portion having outer walls forming a portion of the mullion snap interlock, the outer walls covering a portion of the first and second sides of the single piece mullion.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Madl, Jr.	US 3,126,986	Mar. 31, 1964
Mock	US 3,609,928	Oct. 05, 1971
Browne	US 3,858,377	Jan. 07, 1975
Wendt	US 4,606,162	Aug. 19, 1986

The following rejections are before us for review.

1. Claims 1-5, 10, 12, and 18-20 stand rejected under 35 USC § 103(a) as being unpatentable over Madl in view of Wendt.
2. Claims 6, 9, and 11 stand rejected under 35 USC § 103(a) as being unpatentable over Madl in view of Wendt and Mock.
3. Claims 7, 14, and 15 stand rejected under 35 USC § 103(a) as being unpatentable over Madl in view of Wendt and Browne.

OPINION

CLAIMS 1-5, 10, 12, AND 18-20

Claim 1

In the rejection of independent claim 1, the Examiner determined that Madl shows a wall adapter (47) for fastening a mullion (52) to a wall as claimed except that it does not show the mullion being a single piece with first and second sides (Answer 4). The Examiner relied on Wendt to show a single-piece mullion (86) having first and second sides. The Examiner found,

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Madl Jr. to show the mullion being a single piece and having first and second sides as taught by Wendt because having a mullion of a single piece would enable the easy assembly of the mullion and avoid the cumbersome handling/inventorying of multiple parts of the mullion; furthermore, it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art, Howard v. Detroit Stove Works, 150 U.S. 164 (1893) (Answer 4).

The Appellant contends that Madl teaches away from use of a single piece glazing rail of Wendt because Madl teaches using two separate window framing elements (Brief 5). The issue before us is whether the Appellant has shown that the Examiner erred in rejecting claim 1 under 35 USC § 103(a) as obvious over Madl in view of Wendt.

Madl discloses that “[the offset] wall 50 [of the metal extrusion 47] defines the bottom of a dovetail groove 51, the same receiving window-framing members 52 that clamp the window 15 between them, a compressible sealing strip 53 being used to avoid metal-to-glass contact of the glass pane 15 and the members 52” (Madl, col. 3, ll. 32-35). We do not find, and the Appellant fails to point to, any specific teaching in Madl that criticizes, discredits, or otherwise discourages the use of a one-piece mullion in the partition system of Madl.

Wendt shows a glazing rail (86) made of one piece, which demonstrates that one-piece mullions were common knowledge in the art at the time of the invention. A single piece mullion is easier to assemble than a two piece mullion, and one purpose of Madl is to use frame components that are easy to assemble (Madl, col. 1, ll. 9-13).

“The prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed in the '198 application.” *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

We conclude that Madl does not teach away from using a one-piece mullion, because it does not discourage one from using such a mullion. Quite the opposite, Madl encourages the use of frame components that are easy to assemble. Madl's teaching would have provided sufficient motivation for one having ordinary skill in the art at the time of the invention to use the one piece mullion, as taught by Wendt, in place of Madl's two piece window framing system. We conclude that it

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would have been obvious to one having ordinary skill in the art at the time of the invention to use the single piece mullion of Wendt in place of the two piece mullion of Madl.

The Appellant further argues that Wendt does not disclose a wall adapter for fastening a mullion to a wall. The Examiner did not rely on Wendt for the teaching of a wall adapter. “Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references.” *In re Merck & Co.*, 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986) (citing *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)). Thus, Wendt must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole. The Examiner relied on Wendt for the teaching of the use of a one-piece mullion for supporting a glass window. As such, we find the Appellant’s argument unpersuasive.

The Appellant also argues that Madl does not show the window secured to the wall only through the mullion because the window in Madl is also supported in part by the metal extrusion (47) (Brief 5). We do not see where claim 1 requires that the window is secured only through the mullion. Rather, claim 1 recites that the window or door is mounted to the mullion and the mullion is secured to the wall only through the member. Madl clearly shows this in Figures 5 and 6, in which the window (15) is clamped between the window-framing members (52), and the window-framing members (52) are secured to the wall (13) only through the metal extrusion (47) (Madl, col. 3, ll. 21-37). As such, we are not persuaded by the Appellant’s argument.

We conclude that the Examiner did not err in his rejection, and we thus sustain the Examiner's rejection of claim 1 under 35 USC §103(a) as being unpatentable over Madl in view of Wendt.

Claim 2

The Appellant contends that neither Madl nor Wendt discloses the inner surfaces of the first portion, first side portion and second side portion engaging the wall (Brief 6). Figure 6 of Madl shows the inner surfaces of the first portion (50), the first side portion (48), and the second side portion (41) engaging the wall (13) (Answer 3). As such, we sustain the Examiner's rejection of claim 2.

Claim 3

The Appellant contends that neither Madl nor Wendt discloses a mullion snap interlock on a member engaging a wall (Brief 6). The Examiner contends that Figure 6 of Madl shows the first portion (50) of the wall adapter (47) engages the wall (13) and has a snap interlock (51) (Answer 3).

Madl discloses that “[the offset] wall 50 [of the metal extrusion 47] defines the bottom of a dovetail groove 51, the same receiving window-framing members 52 that clamp the window 15 between them, a compressible sealing strip 53 being used to avoid metal-to-glass contact of the glass pane 15 and the members 52” (Madl, col. 3, ll. 32-35). Madl's window-framing members (52) do not appear to snap into engagement with the dovetail grooves (51). The purpose of Madl, however, is to use frame components that are easy to assemble (Madl, col. 1, ll. 9-13). Wendt teaches a snap interlock between its glazing rail (86) and the lips (82 and 84) of clip (68). (Wendt, Figure 4 and col. 3, ll. 34-35).

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To establish a prima facie case of obviousness, the references being combined do not need to explicitly suggest combining their teachings. See e.g., *In re Kahn*, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1337-38 (Fed. Cir. 2006) (“the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references”); and *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) (“for the purpose of combining references, those references need not explicitly suggest combining teachings.”).

An explicit teaching that identifies and selects elements from different sources and states that they should be combined in the same way as in the invention at issue, is rarely found in the prior art. As precedent illustrates, many factors are relevant to the motivation-to-combine aspect of the obviousness inquiry, such as the field of the specific invention, the subject matter of the references, the extent to which they are in the same or related fields of technology, the nature of the advance made by the applicant, and the maturity and congestion of the field.

. . .

Precedent has also recognized that “[t]he suggestion or motivation to combine references does not have to be stated expressly; rather it may be shown by reference to the prior art itself, to the nature of the problem solved by the claimed invention, or to the knowledge of one of ordinary skill in the art.”

In re Johnston, 435 F.3d 1381, 1385, 77 USPQ2d 1788, 1790-91 (Fed. Cir. 2006) (citing *Medical Instrumentation and Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1221-22 (Fed. Cir. 2003)). “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of

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the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” *Kahn*, 441 F.3d at 987-88, 78 USPQ2d at 1336 (quoting *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)).

Madl is concerned with using frame components that are easy to install. Wendt teaches a mullion having a snap fit interlock engagement to a glazing rail. Snap fit interlocks are installed by merely exerting sufficient pressure on the components to force the hook portions of the components to snap together and lock in place. We conclude that it would have been obvious to one having ordinary skill in the art at the time of the invention, in view of the purpose of Madl, to use Wendt’s snap interlock connection for attaching the mullion to the metal extrusion (47) of Madl, because such a snap interlock is easy to assemble. As such, we sustain the Examiner’s rejection of claim 3.

Claim 4

The Appellant contends that Madl does not disclose cover trim interlocks on the first and second side portions because the concealing members (46) of Madl are part of the vertical frame components (12), not the window framing component (15) (Brief 6). The Examiner determined that Madl, in Figure 6, shows cover trim interlocks (46) (Answer 9).

Madl shows in Figures 1 and 3 the concealing members (46) as part of the vertical frame components (12). As shown in Figure 6, Madl’s outer flange walls (48) are flush with the sides of the wall, and Madl does not teach using an attachment mechanism, such as a screw, to attach the side flanges to the wall. As such, the first and second side portions (outer flange walls (48)) of Madl’s metal

extrusion (47) have no need for side cover trim. We find no teaching, suggestion, or motivation in Madl or Wendt for adding cover trim interlocks on the side portions of the wall adapter member. As such, we do not sustain the Examiner's rejection of claim 4.

Claim 5

The Appellant contends that neither Madl nor Wendt has outer walls that are exterior the side walls of the mullion (Brief 6). The Examiner contends that Madl shows, in Figure 5, the first portion having first and second inner snap hooks and adjacent first and second outer walls and the mullion snap fit between the inner snap hooks and the outer walls (Answer 9).

As shown in Figures 5 and 6, the window framing members (52) of Madl are held in place by dovetail grooves (51) and are not snap fit between adjacent inner snap hooks and outer walls as claimed. The Examiner has not provided any further explanation of where in Figure 5 the elements of claim 5 are shown in Madl. As such, we do not sustain the Examiner's rejection of claim 5.

Claim 10

The Appellant argues that neither Madl nor Wendt shows the step of securing a wall adapter to a wall (Brief 7). The Examiner determined that the claimed method steps would have been the obvious method steps for constructing Madl's structure, as modified by Wendt (Answer 10).

Madl shows in Figure 6 that the metal extrusion (47) extends around a panel wall (13) (Madl, col. 2, l. 71 – col. 3, l. 1). Madl describes, "Each component comprises a metal extrusion 47 of channel form with inner and outer flange walls

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48 that receive a panel 13 between them as do flanges 41 of the frame components 14 [*sic*, 12]” (Madl, col. 3, ll. 27-30). Although Madl does not explain the exact steps taken to secure the metal extrusion (47) to the wall (13), we find that it is an inherent and necessary step of the process for attaching the metal extrusion (47) to the wall (13) that the person assembling somehow secures the metal extrusion (47) to the wall (13) to prevent it from falling off. As such, we find that the step of securing a wall adapter to a wall would have been obvious to one having ordinary skill in the art in view of the combined teachings of Madl and Wendt.

The Appellant further makes the same arguments as to the deficiencies of Madl and Wendt as was made for claim 1. We find these arguments unpersuasive for the same reasons set forth *supra*. As such, we sustain the Examiner’s rejection of claim 10.

Claim 12

The Appellant argues that Madl and Wendt teach away from the claimed step of screwing the wall adapter to the wall because they do not suggest any such structure (Brief 8). The Examiner determined that the claimed method steps would have been the obvious method steps for constructing Madl’s structure, as modified by Wendt (Answer 10).

As discussed *supra*, Madl does not provide any express teaching of how its metal extrusion (47) is secured to the panel (13). Madl, however, also does not discourage one having ordinary skill in the art from screwing the metal extrusion (47) adapter to the wall (13). Further, Wendt teaches to attach its pivot clips (68),

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to which the one piece mullion (86) is attached, to the sill (14) and header using screws (89) (Wendt, Figure 4, and col. 3, ll. 32-33).

We conclude that one having ordinary skill in the art at the time of the invention would have been led to attach Madl's metal extrusion (47) to the panel (13) using screws, as taught in Wendt, to achieve a secure attachment.

As such, we sustain the Examiner's rejection of claim 12.

Claim 18

Claim 18 depends from and further limits claim 9. The rejection of claim 9 as being unpatentable over Madl in view of Wendt and Mock cannot be sustained, for the reasons discussed *infra*. It follows that the rejection of claim 18 based on Madl and Wendt likewise cannot be sustained.

Claim 19

The Appellant contends that neither Madl nor Wendt discloses a storefront mullion. The Examiner determined that the mullion of Madl inherently can be a store front as claimed as there is no structural difference between the claimed mullion and the mullion taught by Madl (Answer 9).

The specification does not describe a "storefront mullion." Based on the broad meaning of the words used, we find that a "storefront mullion" is merely a mullion that is capable of being used on the front of a store. We find no structural difference between this storefront mullion and the mullion of Madl, as modified by the one piece mullion of Wendt.

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The claimed invention would have been obvious to one having ordinary skill in the art at the time of the invention based on the wall adapter of Madl, as modified by the one-piece mullion of Wendt, for the same reasons provided *supra* with regard to claim 1. As such, we sustain the Examiner's rejection of claim 19.

Claim 20

Claim 20 depends from and further limits claim 5. As such, we do not sustain the Examiner's rejection of claim 20 for the same reasons set forth *supra* with regard to claim 5.

CLAIMS 6, 9, AND 11

Claims 6 and 11

The Examiner found that Mock shows a trim panel (46) that has a snap fit to enable quick and easy mounting of the trim panel (Answer 4). The Appellant argues that Madl teaches against side trim panels because Madl has no suggestion to use them, being apparently satisfied with the appearance of edge flanges (41) (Brief 7).

Mock teaches using trim channels (46) to cover the fasteners (44) used to attach the parts (30, 34) to the plaster board (18) (Mock, col. 3, ll. 18-21). As we set forth *supra* for claim 4, Madl's outer flange walls (48) are flush with the sides of the wall, and Madl does not teach using a fastener, such as a screw, to attach the side flanges to the wall. As such, the first and second side portions (outer flange walls (48)) of Madl's metal extrusion (47) have no need of side cover trim. Thus, we find no motivation to modify the side flanges of Madl to add the side cover trim of Mock. As such, we do not sustain the Examiner's rejection of claims 6 and 11.

Claim 9

Claim 9, similar to claim 5, recites that the first portion has outer walls forming a portion of the mullion snap interlock, the outer walls covering a portion of the first and second sides of the single piece mullion. For the same reasons set forth *supra* for claim 5, we find that neither Madl nor Wendt teaches or suggests these outer walls as claimed. We further find that Mock fails to cure this deficiency in the prior art. As such, we do not sustain the Examiner's rejection of claim 9.

CLAIMS 7, 14, AND 15

Claims 7 and 14

The Examiner determined that Browne shows a main portion (22) and an adjustment portion (66) as recited in claim 7 (Answer 5). The Examiner also found that the method steps of claim 14 would have been the obvious method steps of constructing Madl's structures, as modified by Wendt and Browne (Answer 7). The Appellant contends that Browne does not disclose an adjustable device for use with a range of wall thicknesses (Reply Brief 3).

Browne discloses a joint structure (10) used to connect wall panels of buildings. Browne discloses that the joint structure (10) has a first member (18) with parallel legs (22, 24) and a second member (20) with parallel legs (26, 28) (Browne, col. 2, ll. 35-37). The legs (26, 28) each terminate in a ratchet tooth (30, 34) which is snapped into engagement with a ratchet tooth (32, 36) on leg (22, 24) (Browne, col. 2, ll. 37-41). As such, there is but one fixed position of members (18, 20) with respect to each other. These members (18, 20) are fixed at a set

distance apart determined by the engagement of the ratchet teeth pairs (30, 32 and 34, 36).

Browne further discloses that leg (22) has an extension with teeth (70), and leg (24) has an extension with teeth (78) (Browne, col. 3, ll. 3-4 and 13-14). The joint structure (10) of Browne further includes retainer members (60, 62) which have legs (66, 72) (Browne, col. 2, ll. 64-65). Leg (66) terminates in a ratchet tooth (68), which “cooperates with one of the teeth 70 supported by leg 22” (Browne, col. 3, ll. 1-3). Similarly, leg (72) terminates in a ratchet tooth (76) “engaged with one of the teeth 78” of leg (24) (Browne, col. 3, ll. 12-13). It is not clear from this description of Browne how the teeth (70, 78) of legs (22, 24) would operate to allow adjustability of the joint structure (10) given the fixed position of members (18, 20).

We find no suggestion, teaching, or motivation to modify the metal extrusion (47) to make it adjustable. We conclude that one having ordinary skill in the art would not have been led to make this modification to Madl based on the teachings of Browne. As such, we do not sustain the Examiner’s rejection of claims 7 and 14.

Claim 15

Claim 15 depends from and further limits claim 14. As such, we do not sustain the Examiner’s rejection of claim 15 for the same reasons set forth *supra* with regard to claim 14.

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CONCLUSION

To summarize, the decision of the Examiner to reject claims 1-3, 10, 12, and 19 is sustained and the decision of the Examiner to reject claims 4-7, 9, 11, 14, 15, 18, and 20 is no sustained.

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

AFFIRMED-IN-PART

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