

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 WARREN F. YOUNG

Appeal 2007-0009
Application 10/345,461¹
Technology Center 3600

Decided: April 10, 2007

Before: MURRIEL E. CRAWFORD, STUART S. LEVY, and LINDA E. HORNER, *Administrative Patent Judges.*

LEVY, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF CASE

31 Appellant appeals under 35 U.S.C. § 134 (2002) from a final rejection
32 of claims 1, 2, 4, and 5. Claim 3 has been allowed (Br. 1). We have
33 jurisdiction under 35 U.S.C. § 6(b) (2002).

¹ Application filed January 17, 2003. The real party in interest is the inventor (Br. 1).

1 Appellant invented a fence where the fence posts and fence rails are
2 made of steel. (Specification 1). The fence is designed so that all the rails
3 may be pushed snugly against each other in the in-line post. (Specification
4 3). To prevent someone from stealing the rails by removing spacer 16
5 (figure 9), a post cap 18 is provided with a lock thereon. (Specification 6).

6 Claim 1 is representative of the invention and reads as follows:

7 1. An interlocking and anti-theft steel fencing system
8 comprising a plurality of tubular steel posts vertically supported
9 from a ground and horizontally spaced and a plurality of
10 horizontal tubular steel rails connected between the posts, at
11 least one of the posts being an in-line post, the in-line post
12 being provided with opposite vertical side portions, the in-line
13 post having openings on one side portion and openings on an
14 opposite side portion for receiving therein the ends of rails
15 which connect to the in-line post, the openings being of
16 essentially the same shape as the outside shape of the horizontal
17 rails but being slightly larger to permit canting of the ends of
18 the rails in the openings, the rails being fitted into the in-line
19 post so that the rails coming in from opposite sides of the in-
20 line post through the openings are in abutting relation within
21 the in-line post, at least one of said posts constituting an end
22 post, the end post having openings along one side surface
23 portion only of the end post for receiving therein the ends of
24 rails connected to the end post, the openings on the end post
25 being of the same shape and slightly larger than the outer
26 periphery of the rails connecting into the end post, the end post
27 having its rails extending inwardly less than the full width of
28 the end post, a vertical spacer extending essentially the full
29 height of the end post between the ends of the rails and the
30 inside portion of the end post opposite from the openings
31 therein, a post cap received over the top of the end post when
32 the spacer is in position; and means for locking the post cap
33 securely in place on the top of the end post.

34

1 The Examiner rejected claims 1, 2, 4, and 5 under 35 U.S.C. § 103(a)
2 (2004). The Examiner asserts (Answer 2-3) that the grounds of rejection of
3 claims 2, 4, and 5 have not been withdrawn by the Examiner, but are not
4 under review on appeal because these claims have not been presented for
5 review in Appellant's Brief. In the Brief (p. 1) Appellant asserts that claims
6 1, 2, 4, and 5 are appealed. As Appellant only argues the rejection of claim
7 1, we find that dependent claims 2, 4, and 5 are before us for decision on
8 appeal and rise or fall with the rejection of claim 1.

9

10 The prior art relied upon by the Examiner in rejecting the claims on
11 appeal is:

12	Gerstner	US 2,800,305	Jul. 23, 1957
13			
14	Bright	US 3,921,960	Nov. 25, 1975
15			
16	Pettit	US 4,722,514	Feb. 02, 1988

19 Claim 1 stands rejected under 35 U.S.C. § 103(a) as unpatentable over
20 Pettit, Gerstner, and Bright.

21 Appellant contends that the claimed subject matter would not have
22 been obvious. More specifically, Appellant contends (Br. 5) that the prior
23 art does not suggest abutting rails (Br. 5-6) and that the ribs 43 on the post
24 cap 37 of Pettit do not constitute a means for locking the post cap. The
25 Examiner contends (Answer 4-5) that Pettit fails to disclose that the posts
26 and rails are made of steel, and Pettit fails to disclose that the rails are in
27 abutting relationship. To make up for these deficiencies of Pettit, the

- 1 Examiner turns to Bright for a suggestion of steel posts and rails, and turns
- 2 to Gerstner for a suggestion of abutting rails.

3 We reverse.

ISSUE

Has Appellant shown that the Examiner erred in holding that the combined teachings and suggestions of Pettit, Bright, and Gerstner would have suggested to an artisan the subject matter of claim 1?

FINDINGS OF FACT

Based upon a preponderance of the evidence, we make the following findings of fact:

- 12 1. Appellant invented a fence having fence posts and fence rails made
13 of steel. (Specification 1).

14 2. The fence is designed so that all the rails may be pushed snugly
15 against each other in the in-line post. (Specification 3).

16 3. To prevent someone from stealing the rails by removing spacer 16
17 (Fig. 9), a post cap 18 is provided with a lock thereon.
18 (Specification 6).

19 4. Purely by way of example, the lock consists of a shaft 26 which
20 extends from the side of post 22 horizontally below the upper end
21 of the post. On the end of the shaft, a finger 28 having a hook 30 is
22 mounted. (*Id.*).

23 5. Pettit discloses that even though the parts have beveled end
24 portions for insertion into holes or other portions in an extremely

1 simple matter, notwithstanding the beveled ends, the parts have a
2 friction fit with each other. (Pettit, col. 1, ll. 24-29).

- 3 6. It is further disclosed that when assembled, the fence will be
4 extremely sturdy to prevent the parts from rattling when subjected
5 to wind forces, but the parts will be able to move relative to each
6 other to allow for expansion and contraction. (Pettit, col. 1, ll. 17-
7 23).
- 8 7. Bars 30 and 31 prevent removal of subassemblies 26 from the
9 posts. (Pettit, col. 4, ll. 41-43).
- 10 8. Ribs 43 are formed on inside surfaces of cap 37, and result in caps
11 being held in position "with a good tight friction fit." (Pettit, col. 5,
12 ll. 5-19).
- 13 9. Gerstner discloses a fence having what appears to be abutting rails
14 as shown in Fig. 3.
- 15 10. Bright discloses a fence having rails and posts made of steel.
16 (Bright, col. 3, ll. 30 and 31).

17
18 PRINCIPLES OF LAW

19 On appeal, Appellant bears the burden of showing that the Examiner
20 has not established a legally sufficient basis for combining the teachings of
21 the applied prior art. Appellant may sustain this burden by showing that,
22 where the Examiner relies on a combination of disclosures, the Examiner
23 failed to provide sufficient evidence to show that one having ordinary skill
24 in the art would have been motivated to combine the references as suggested

1 to make Appellant's invention. *See United States v. Adams*, 383 U.S. 39
2 (1966); *In re Kahn*, 441 F.3d 977, 987-988, 78 USPQ2d 1329, 1336 (Fed.
3 Cir. 2006); *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H.
4 Patrick, Co.*, 464 F.3d 1356, 1360-1361, 80 USPQ2d 1641, 1645 (Fed. Cir.
5 2006). The mere fact that all the claimed elements or steps appear in the
6 prior art is not per se sufficient to establish that it would have been obvious
7 to combine those elements. *United States v. Adams*, *id*; *Smith Industries
8 Medical Systems, Inc. v. Vital Signs, Inc.*, 183 F.3d 1347, 1356, 51 USPQ2d
9 1415, 1420 (Fed. Cir. 1999).

10
11 ANALYSIS

12 We note at the outset Appellant's statement (Br. 8) that "[t]he use of
13 the term 'steel' in applicant's claims is merely didactic and is not intended to
14 impart any patentable weight to the claims." From the description in Bright
15 of having fence posts and rails of steel, and the above statement by
16 Appellant, we find that an artisan would have been motivated to make the
17 fence rails and posts of Pettit out of steel, to prevent rusting.
18 In addition, although we find from the description in Pettit that the rails have
19 a friction fit with each other and that they are able to move relative to each
20 other to allow for expansion and contraction, we find no clear teaching that
21 the rails would abut one another during expansion. We would have to resort
22 to unfounded speculation to find that the rails between the line posts of Pettit
23 abut one another during expansion periods, as advanced by the Examiner
24 (Answer 6). However, from the disclosure of Pettit (fact 6) that the fence

parts will not rattle when subjected to wind forces, and the illustration in Gerstner that appears to show abutting rails (fact 9), we find that an artisan would have been motivated to use abutting rails in Pettit.

4 Turning to the contention of whether the ribs 43 of Pettit constitute a
5 lock, we are cognizant of the Examiner's assertion that Appellant's
6 Specification refers to the described lock as being "[p]urely by way of
7 example" (fact 4). However, considering that disclosure with the previous
8 recitation in the Specification that the lock is provided to prevent someone
9 from stealing the rails, we interpret the reference to the lock being "[p]urely
10 by way of example" to mean that other locks may be used. The friction fit
11 cap of Pettit is not a lock, as the cap can be removed by pulling it off or
12 pushing or prying it off, such as with a screwdriver and hammer. Because
13 the lock is provided to prevent stealing the fence, we find that a friction fit is
14 insufficient to meet the limitations of claim 1. It follows that we agree with
15 Appellant (Br. 5) that the combined teachings and suggestions of the prior
16 art would not have suggested all of the language of claim 1.

CONCLUSION OF LAW

19 On the record before us, Appellant has shown that the Examiner has
20 erred in rejecting claim 1 under 35 U.S.C. § 103(a) as being unpatentable
21 over Pettit in view of Bright and Gerstner. In addition, we cannot sustain the
22 rejection of dependent claims 2, 4, and 5 because the Examiner has not
23 shown how the additional references make up for the basic deficiency of
24 Pettit, Bright, and Gerstner. We observe that Cain, U.S. Patent 5,593,141,
25 relied upon by the Examiner to reject claim 2, does show a padlock locking a

1 post cap. However, from our review of the reference, we find that Cain
2 describes a lock on a gate post, to prevent the gate from being opened, and
3 does not describe a cap on the fence post, or that the lock is to prevent the
4 fence rails from being stolen. Accordingly, we find that the teachings and
5 suggestions of Cain fail to make up for the basic deficiencies of the prior art
6 applied against claim 1.

DECISION

8 The Examiner's rejection of claims 1, 2, 4, and 5 under 35 U.S.C.
9 § 103(a) is Reversed.

10

11 REVERSED

12

13

14

15

16

17 vsh

18

19

20

21

22

23

24

William S. Dorman
830 Beacon Building
406 South Boulder
Tulsa OK 74103