

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL T. COLE

Appeal 2007-1972
Application 11/141,758
Technology Center 2800

Decided: August 24, 2007

Before JAMES D. THOMAS, LEE E. BARRETT,
and HOWARD B. BLANKENSHIP, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1-7, 9-18, and 20-25, the only claims pending in this application. We have jurisdiction under 35 U.S.C. §§ 6(b), 134(a).

INTRODUCTION

The claims are directed to an in-floor fitting that is adapted to be inserted within an opening in a floor. The fitting includes at least five signal connection devices, and a cover including doors over access paths to the signal connection devices. The doors are configured to be moved between open and closed positions. (Abstract.) Claim 1 is illustrative:

1. A fire-rated in-floor poke-thru fitting configured to be mounted within an opening in a concrete floor or steel deck, comprising:

at least five signal connection devices;

an intumescent insert; and

a cover comprising doors over access paths to said at least five signal connection devices, wherein said doors are configured to be moved between open and closed positions, wherein said at least five signal connection devices are accessible when said doors are in the open position, and wherein said at least five signal connection devices are protected from an external environment when said doors are in the closed position,

wherein the fire-rated in-floor poke-thru fitting is to be secured into the concrete floor or steel deck.

The Examiner relies on the following prior art references to show unpatentability:

Castellani	US 4,770,643	Sept. 13, 1988
Hadfield	US 4,883,924	Nov. 28, 1989
Bambardekar	US 6,175,078 B1	Jan. 16, 2001
Bonilla	US 6,551,130 B2	Apr. 22, 2003

The rejections as presented by the Examiner are as follows:

1. Claims 1-6, 12-17, and 23-25 are rejected under 35 U.S.C § 103(a) as unpatentable over Bambadekar and Bonilla.
2. Claims 7, 9, 11, 18, 20, and 22 are rejected under 35 U.S.C § 103(a) as unpatentable over Bambadekar, Bonilla, and Castellani.
3. Claims 10 and 21 are rejected under 35 U.S.C § 103(a) as unpatentable over Bambadekar, Bonilla, and Hadfield.

OPINION

The Examiner applies the teachings of Bambadekar and Bonilla against claims 1-6, 12-17, and 23-25 in a § 103 rejection. We note, initially, that Appellant's Specification (¶ 5) cites the Bonilla patent, which discloses eight telecommunication jacks in a poke-thru fitting, and alleges that the telecommunication jacks in the described fitting are open to the external environment. The Specification at paragraph 2, however, reports that proposed certification standards require that such fittings keep scrub water out of the portion of the fitting that houses the electrical outlet and communication/data receptacles or jacks. Moreover, as noted in the Specification (¶ 2), it is desirable that poke-thru fittings be designed to prevent moisture infiltration from above the floor. The Specification does not allege that Appellant was the one who discovered that water or excessive moisture is detrimental to the proper functioning of electronic receptacles or jacks.

The foregoing considerations should be sufficient to demonstrate the unpatentability of claims of the scope of instant claim 1 (requiring “a cover comprising doors over access paths” to “at least five” signal connection devices), or even broader claim 12 (requiring “a door” positioned over “at least one” of the five signal connection devices).

Perhaps in an abundance of caution, the Examiner provides a reference showing doors over access paths to telecommunication jacks in a poke-thru fitting (Bambardekar). The Examiner finds that all elements of instant claim 1 (and claim 12) are found in Bambardekar and Bonilla, and concludes that the teachings of the references considered together show that the artisan would have found the claimed subject matter as a whole to be obvious.

A person having ordinary skill in the art uses known elements for their intended purpose. *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969) (radiant-heat burner used for its intended purpose in combination with a spreader and a tamper and screed). “[W]hen a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740, 82 USPQ2d 1385, 1395-96 (2007) (quoting *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282 (1976)).

Appellant argues, in defense of claim 1, that “[a]ttempting to add additional jacks from Bonilla to Bambardekar would render Bambardekar inoperable for its intended purpose.” (Appeal Br. 7.) Appellant’s position reflects a misapprehension (or mischaracterization) of the rejection applied

against claim 1, which the Examiner makes clear is not based on the incorporation of specific doors depicted in Bambardekar with specific poke-thru fittings depicted in Bonilla, or incorporation of the “additional jacks” of Bonilla into the poke-thru fittings of Bambardekar. As the Examiner indicates, the test for obviousness is not whether the features of one reference may be bodily incorporated into the structure of another reference. Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). It is not necessary that the inventions of the references be physically combinable to render obvious the invention under review. *In re Sneed*, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983).

Appellant’s response to the legal principle that a conclusion of obviousness does not require a showing of “bodily” incorporating elements in the prior art: “the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose.” (Reply Br. 5.) That argument is based, in turn, on the maxim that the references must be considered in their entirety. Appellant does not explain how considering references in their entirety -- which we acknowledge as a requirement in an obviousness inquiry -- somehow means that the inventions of the references have to be shown physically combinable. Appellant does, however, frequently cite to *Manual of Patent Examining Procedure* (MPEP) § 2141.02 as support for Appellant’s position.

MPEP § 2141.02, under heading VI, relates to prior art references. The section instructs the reader that a prior art reference must be considered in its entirety, including portions that would lead away from the claimed invention. Support for the reminder is identified in *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551, 220 USPQ 303, 312 (Fed. Cir. 1983) (prior art plastics processing taught that unsintered polytetrafluoroethylene (PTFE) should be stretched slowly, thus teaching away from claimed rapid stretching).

“A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.*, 73 F.3d 1085, 1090, 37 USPQ2d 1237, 1241 (Fed. Cir. 1995) (quoting *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994)).

The “teaching away” that Appellant alleges with respect to the references, however, is that Bambardekar teaches away from poke-thru fittings that cannot be positioned in a floor opening more than four inches in diameter. We can assume, for purposes of this appeal, that Bambardekar “teaches away” in the manner alleged by Appellant. As the Examiner indicates (Answer 6), instant claim 1 does not place a limitation on the dimensions of the poke-thru fitting. Appellant has not identified anything in the references that would warn the artisan against covering access paths to signal connection devices in a poke-thru fitting, or more specifically placing a cover comprising doors over access paths to at least five signal connection

devices. Moreover, the artisan is presumed to have at least common sense. *See In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985) (argument presuming that element, if not wanted, would not be removed by a skilled worker presumes stupidity rather than skill). Even with some degree of “bodily” incorporation of the structures described by the references, simply removing one or two electrical power receptacles from the combined fitting would provide sufficient space for at least five signal connection devices *and* sliding doors. (Answer 6.) Claim 1 does not address how many, if any, electrical receptacles are required.

In response to the rejection of claims 10 and 21 under 35 U.S.C § 103(a) as unpatentable over Bambadekar, Bonilla, and Hadfield, Appellant submits that the acknowledged teaching of a tab and a notch by Hadfield is not part of an intumescent insert and the tab is not received within a notch in the first plate to align an intumescent insert with a plate. (Appeal Br. 16.) Neither we nor the Examiner disagree with the assessment. However, nonobviousness 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 at 425, 208 USPQ at 881 (CCPA 1981)). As the Examiner indicates (Answer 7), Hadfield was cited to show that the use of a tab and a notch for aligning two objects was well (and widely) known. Yet, Appellant has provided no evidence tending to show that the inclusion of a tab on an intumescent insert and a notch on a plate to align the insert in relation to the plate was “uniquely challenging or difficult for one of ordinary skill in the art.” *See Leapfrog Enters., Inc. v.*

Fisher-Price, Inc., 485 F.3d 1157, 1162, 82 USPQ2d 1687, 1692 (Fed. Cir. 2007) (citing *KSR*, 127 S. Ct. at 1740-41, 82 USPQ2d at 1396).

We have considered claims 1 and 10 as representative in our review of the rejections, based on Appellants' remarks in the Brief, but are not persuaded of error. We sustain the rejection of claims 1-6, 10, 12-17, 21, and 23-25. Because Appellant relies on the arguments presented for claim 1 in response to the § 103 rejection of claims 7, 9, 11, 18, 20, and 22, we also sustain the rejection of those claims. *See* 37 C.F.R. § 41.37(c)(1)(vii).

CONCLUSION

In summary, the rejection of claims 1-7, 9-18, and 20-25 under 35 U.S.C. § 103 is affirmed.

Appeal 2007-1972
Application 11/141,758

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

AFFIRMED

pgc

MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO IL 60661