

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte STEVE W. MELTON

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Appeal No. 1999-0614  
Application No. 08/804,410<sup>1</sup>

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ON BRIEF

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 2 through 5 and 7, which are all of the claims pending in this application.

We REVERSE.

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<sup>1</sup> Application for patent filed February 21, 1997.

BACKGROUND

The appellant's invention relates to an apparatus for converting the appearance of an existing chain link fence into the appearance of a wood planked fence. An understanding of the invention can be derived from a reading of exemplary claim 7, which appears in the opinion section of this decision.

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

Nugent et al. (Nugent)	3,913,889	Oct. 21, 1975
Veenstra	4,582,284	Apr. 15, 1986
Vise 1996	5,556,080	Sep. 17,

The following rejections are before us for review.

1. Claims 7 and 2 through 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Vise in view of Nugent.
2. Claims 7, 4 and 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Nugent in view of Veenstra.

Reference is made to the brief (Paper No. 7) and supplemental brief (Paper No. 9) and the final rejection (Paper No. 5) and answer (Paper No. 10) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Claim 7, the only independent claim on appeal, reads as follows:

An apparatus for converting the appearance of an existing chain link fence into a wood appearing planked fence comprising in combination:

an existing chain link fence having opened spaces between adjacent links of the fence, said chain link fence forming a plank support system;

a plurality of vertically disposed spaced plastic fence planks adapted to be mounted on said plank support system, each of said fence planks have upper slanted surface edges and vertical outer surfaces that simulate the appearance of a wooden fence in both surface grain and color;

at least two mounting members for each of said planks, each of said mounting members having larger

cross sectional outer sections and smaller cross sectional inner sections, said inner sections being capable of being inserted into the opened spaces between adjacent links of the existing chain link plank support system; and

fastener means for mounting said mounting members to said planks and the support system when said mounting members inner sections are inserted into the opened spaces formed between chain links whereby said planks are held to existing support system by the mounting members and fasteners means. Turning first to the examiner's rejection of claims 7 and

2 through 4 as being unpatentable over Vise in view of Nugent, the examiner's findings regarding the disclosure of Vise are set forth on page 2 of the final rejection. The examiner's position is that Vise discloses the invention as recited in claim 7 except for the fence planks being formed of plastic and having "upper slanted surface edges and vertical outer surfaces that simulate the appearance of a wooden fence in both surface grain and color" (see final rejection, page 2). The examiner asserts, however, that it would have been obvious "to modify the fence planks of Vise by forming them from plastic, as taught by Nugent et al., in order to reduce the overall weight of the fence assembly" (final rejection, page 3). The appellant's brief does not challenge this assertion by the examiner.

With regard to the slanted surface edges and vertical outer surfaces that simulate the appearance of a wooden fence in both surface grain and color, the examiner takes the position that "since no engineering advantages have been disclosed for forming the fence planks as having slanted surface edges and vertical outer surfaces that simulate the appearance of a wooden fence in both surface grain and color, it would have been a mere design choice" (final rejection, page 3). The examiner further asserts that:

since no engineering advantages have been set forth in the specification for forming the components as claimed, and since various other configurations would appear to work equally as well, the subject matter in question cannot be given patentable weight and is considered a matter of design choice. It should be noted that the limitations stated in independent claim 7, "vertical outer surfaces that simulate the appearance of a wooden fence in both grain and color" do not specifically state any dimensions or shapes, in fact, the examiner takes the position that the definition of the appearance of a wooden fence is undefined and could incorporate an infinite number of shapes, colors, and designs (i.e., a sanded, smooth, grainless cut, with black paint versus a wooden cut with bark still attached). Therefore, the reference of Vise can be considered as having a [sic] vertical outer surfaces that simulate the appearance of a wooden fence in both grain and color [answer, page 4].

Initially, with regard to the claimed "vertical outer surfaces that simulate the appearance of a wooden fence in both surface grain and color," while such language may encompass a variety of surfaces and colors, we do not find tenable the examiner's position that the foraminous expanded metal panels (24) of Vise can be considered as having vertical outer surfaces that simulate the appearance of a wooden fence in both grain and color.

The appellant argues that the purpose of the appellant's invention is to convert the appearance of an existing chain link fence into the appearance of a wooden plank fence and that neither Vise nor Nugent teaches such a conversion. The appellant contends that, contrary to the assertions of the examiner, the appellant's claimed structure does have a defined purpose (to simulate the appearance of a wooden fence plank) and, thus, "cannot merely be ignored if not found in the art or disregarded under the disguise of design choice" (brief, page 9). We agree with the appellant.

Vise discloses a fence system including a frame or support structure (22), which, as shown in Figure 6, includes existing chain link material (70), and foraminous panels (24)

made of expanded metal, or other foraminous panel material, to be mounted to the existing chain link material by means of a bracket (72) having an aperture (75) therein for passage of a fastener (46) therethrough and a nut (57) for securing the bracket against the chain link material (see Figures 7 and 8). The panels (24), when mounted on the chain link fence structure as disclosed, provide a deterrent to intrusion which overcomes many of the disadvantages of conventional chain link material as a deterrent to climbing and unraveling or cutting of the material discussed in column 1, line 39, to column 2, line 52. The foraminous structure of the panels, comprising integral strands (38) and spaced bonds (40) forming cell apertures (42), helps prevent penetration because it is almost impossible, within a practical period of time, to cut or torch a sufficiently large hole through a panel (24), as explained in column 9, lines 40 to 54.

The Vise fence system is directed solely to providing an impenetrable barrier to provide improved security for existing chain link fencing; Vise is not at all concerned with converting the appearance of an existing chain link fence into the appearance of a wood planked fence, as recited in the

preamble of claim 7. Moreover, from our viewpoint, the Vise fence system is not capable, without modification, of effecting such a conversion, as the panels (24) of Vise do not give the fence an appearance which could reasonably be considered "a wood appearing planked fence" as claimed.

Claim 7 further recites two features of the planks which distinguish the planks of the appellant's invention from the panels (24) of Vise to achieve the function set forth in the preamble and help further define what the appellant means by "a wood appearing planked fence." Specifically, the claim requires that the planks be provided with "upper slanted surface edges and vertical outer surfaces that simulate the appearance of a wooden fence in both surface grain and color."

In determining that modification of the Vise panels to have upper slanted surface edges and vertical outer surfaces as claimed would have been obvious, the examiner, in effect, dismisses these features as mere design considerations solving no stated problem. It is readily apparent from the claims on appeal, from the appellant's specification (page 1) and from the appellant's brief (page 9) that the claimed shape and surface of the planks serve to fulfill the stated objective of

simulating a wooden plank fence by providing an appearance of what is very well known for wooden fence planks in order to improve the appearance of an existing chain link fence.

Accordingly, we agree with the appellant that it is inappropriate in this case to dismiss these features as mere matters of design choice.

We have reviewed the teachings of both Vise and Nugent and we find therein no suggestion to modify the panels of Vise so as to comprise the claimed features. While the shape and surface grain of the Vise panels perhaps *could* have been modified as proposed by the examiner, it is not apparent to us why one of ordinary skill in the art would have been motivated to make such a modification to these foraminous panels. The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. See In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

While we acknowledge the examiner's reference (answer, page 4) to the appellant's statement, on page 9 of the brief,

that slanting of the upper surfaces of wooden planks is known, we do not find such knowledge suggestive of the modification of the Vise panels, which are not wooden planks.

For the foregoing reasons, we are constrained to reverse the examiner's rejection of claims 7 and 2 through 4 under 35 U.S.C. § 103 as being unpatentable over Vise in view of Nugent.

Turning now to the examiner's rejection of claims 7, 4 and 5 under 35 U.S.C. § 103 as being unpatentable over Nugent in view of Veenstra, we note that Nugent discloses a snow fence comprising a plurality of vertically extending light-weight plastic slats (4, 5 or 30) secured to a support structure comprising upper and lower cables and wire mesh (1) extended between support posts by fastening devices such as staples and adhesives. Veenstra discloses a hanger bracket adapted for securement to a chain link fence for hanging a garment or other article (column 1, lines 6 to 8). The bracket comprises a cruciform base (3), a hook (5) and a proximal portion (4) which extends rearwardly from the hook to the base for supporting the hook thereon. The base comprises four extended arms (6,7,8,9) of varying widths and lengths as

shown in Figures 1 and 3, such that, in use, the arms (6,8) extend behind an upper and lower protruding link of one of the diamond-shaped holes of a chain link fence (1) and the remaining two arms (7,9) extend in front of the remaining upper and lower inwardly recessed links within the same diamond-shaped hole. The bracket disclosed by Veenstra is reusable and pocket-sized (column 3, lines 9 to 19).

It is the examiner's position that it would have been obvious to one of ordinary skill in the art at the time of the appellant's invention to replace the Nugent mounting members (i.e., the staple or adhesive) with the bracket disclosed by Veenstra "in order to *releasably* secure the planks to the fence". Further, according to the examiner, modification of the slats of Nugent to provide upper slanted surface edges and vertical outer surfaces simulating the appearance of a wooden fence in both surface grain and color would have been a mere design choice, as "no engineering advantages have been disclosed" for forming the fence planks as claimed (final rejection, page 4).

We agree with the appellant, for the reasons stated on pages 11 and 12 of the brief, that the combined teachings of

Nugent and Veenstra would not have suggested to one of ordinary skill in the art the use of the brackets disclosed therein for mounting the Nugent slats to a chain link fence.

Accordingly, we shall not sustain the examiner's 35 U.S.C. § 103 rejection of claims 7, 4 and 5.

CONCLUSION

To summarize, the decision of the examiner to reject claims 2 through 5 and 7 under 35 U.S.C. § 103 is reversed.

REVERSED

LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JOHN P. McQUADE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

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