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Andrus Intellectual Property Law, LLP
100 EAST WISCONSIN AVENUE, SUITE 1100
MILWAUKEE, WI 53202

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MILLNER, MONICA E

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ARNE GYA and TOR WILLIAM HOYVIK

Appeal 2015-006323
Application 13/393,292
Technology Center 3600

Before MICHAEL L. HOELTER, MICHELLE R. OSINSKI, and
GORDON D. KINDER, *Administrative Patent Judges*.

HOELTER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is a decision on appeal, under 35 U.S.C. § 134(a), from the Examiner's final rejection of claims 22–24 and 26–30.¹ App. Br. 7. Appellants' counsel presented oral arguments on July 6, 2017. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ The Examiner withdrew the rejection of claim 25 as being obvious over Arnstein and McCracken. Ans. 2; *see also* Reply Br. 1. No other rejection of this claim is before us for review.

THE CLAIMED SUBJECT MATTER

The disclosed subject matter “relates to a long, hollow, multiple-sided profile device. More particularly it concerns a long, hollow, multiple-sided profile device where at least one of the sides of the profile is provided with boltholes.” Spec. 1:2–5. Claims 22, 26, 28, and 30 are independent. Claim 22 is illustrative of the claims on appeal and is reproduced below:

22. A device for building support structures for tubing and cableways, the device comprising a hollow, closed, three-sided profile that is elongated in a length direction and is triangular in a cross direction that is perpendicular to the length direction, the profile having elongated first and second sides that are set at a right angle with respect to each other in the cross direction, each of the first and second sides having a bolt hole that is longer in the length direction than in the cross direction, and an elongated third side that is connected to the first and second elongated sides and has a bolt opening that is sized larger than the bolt holes of the first and second sides, wherein the bolt opening is sized, located and aligned along the third side with respect to the bolt holes which are located in and along the first and second sides to define a straight-line fixation path extending completely through the bolt opening and the bolt hole of at least one of the first and second sides, and extending perpendicularly to the at least one of the first and second sides and at an acute angle relative to the third side, whereby the profile is adapted to be fixed to a building support structure along the straight-line fixation path.

REFERENCES RELIED ON BY THE EXAMINER

Arnstein	US 1,656,810	Jan. 17, 1928
McCracken	US 5,307,601	May 3, 1994

THE REJECTION ON APPEAL

Claims 22–24 and 26–30 are rejected under 35 U.S.C. § 103(a) as unpatentable over Arnstein and McCracken.

ANALYSIS

Independent claims 22, 26, 28, and 30 each include the recitation of “a bolt hole that is longer in the length direction than in the cross direction” and “a bolt opening that is sized larger than the bolt holes.” The Examiner relies on Arnstein for disclosing these limitations.² Final Act. 3. On the one hand, the Examiner states that Arnstein discloses “having a bolt hole that is longer in the length direction than in the cross direction (see oval openings in Fig. 2).” Final Act. 3. However, contrary to this finding that Arnstein’s oval is the recited “bolt hole,” the Examiner also states that Arnstein “teaches larger oval bolt openings and smaller bolt holes.” Ans. 5; *see also* Ans. 9 (discussing “an oval bolt opening” and “the bolt openings which are shown as oval in Arnstein”). *See also* the Examiner’s annotation of Figure 2 of Arnstein that has been modified to include labels identifying the oval as the “bolt opening,” and a smaller aperture as the “bolt hole.” Ans. 5.

Addressing the Examiner’s former finding, by correlating the oval to the recited “bolt hole,” it is not clear to us where Arnstein also teaches the limitation of “a bolt opening that is sized larger than the bolt holes.” Addressing the Examiner’s latter finding of the “bolt hole” being a smaller aperture, Appellants contend that under this correlation, the Examiner

² The Examiner relies on McCracken for “using large holes for weight reduction of a profile as well as user access for bolt passing into a smaller [] hole.” Final Act. 4.

ignores the recitation that the bolt hole “is longer in the length direction than in the cross direction.” *See* App. Br. 12; *see also* Reply Br. 4–6. Appellants state, “the references fail to disclose the structure and configuration of the claimed *bolt holes* and *bolt openings*.” Reply Br. 4.

The Examiner’s position is that “there is no invention in merely changing the shape or form of an article” and that Arnstein discloses, “an oval bolt opening that is longer in a length direction.” Ans. 9. However, the limitation is “*a bolt hole* that is longer in the length direction” (emphasis added), not the recited “bolt opening” (the claims recite the bolt opening “is sized larger than the bolt holes”).³

Accordingly, it is unclear what aperture in Arnstein the Examiner is correlating to the recited “bolt hole” and what aperture is being correlated to the recited “bolt opening” such that the correlated apertures also teach the subsequent limitations of the “hole” being longer in a certain direction and the “opening” being larger than the “hole.” We are instructed by our reviewing court, “all that is required of the office to meet its prima facie burden of production is to set forth the statutory basis of the rejection and the reference or references relied upon in a sufficiently articulate and informative manner as to meet the notice requirement of [35 U.S.C.] § 132.” *In re Jung*, 637 F.3d 1356, 1363 (Fed. Cir. 2011). However, we are also instructed that the Examiner fails to carry the procedural burden of establishing a prima facie rejection when the rejection is so “uninformative that it prevents the applicant from recognizing and seeking to counter the

³ Further confusion reigns when the Examiner addresses dependent claim 24 stating, the “bolt holes that are smaller and triangular.” Final Act. 4–5. However, claim 24 recites, “the bolt hole is rectangular,” not “triangular.”

grounds for rejection.” *Jung*, 637 F.3d at 1362 (citing *Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990)).

In view of the above, the Examiner has not been consistent as to which aperture is correlated to the “opening” and which is correlated to the “hole.” Additionally, the Examiner has stated a rejection based on the “opening” being longer in a length direction when, in fact, the claims recite that it is the “hole” that is longer in the length direction. Accordingly, there is no indication the Examiner has carried the procedural burden of establishing a prima facie rejection. We reverse the Examiner’s rejection of independent claims 22, 26, 28, and 30, along with dependent claims 23, 24, 27, and 29.

DECISION

The Examiner’s rejection of claims 22–24 and 26–30 as being obvious over Arnstein and McCracken is reversed.

REVERSED