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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* JAMES L. HUBBARD, BRAD GUILANI,  
DARYL J. MARVIN, and ZBIGNIEW PIECH

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Appeal 2018-008384  
Application 14/413,484  
Technology Center 3600

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Before STEFAN STAICOVICI, ANNETTE R. REIMERS, and  
FREDERICK C. LANEY, *Administrative Patent Judges*.

LANEY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant<sup>1</sup> appeals under 35 U.S.C. § 134(a) from the Examiner's decision (dated January 10, 2018, hereinafter "Non-Final Act.") rejecting claims 1–11 and 20 under 35 U.S.C. § 103(a) as unpatentable over Fargo (WO 2011/146071 A1, pub. Nov. 24, 2011), Resch (US 2006/0199017 A1, pub. Sept. 7, 2006), and Miller (US 2007/0107993 A1, pub. May 17, 2007).<sup>2</sup> We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> We use the word "Appellant" to refer to "applicant" as defined in 37 C.F.R. § 1.42. Appellant identifies Otis Elevator Company as the real party in interest. Appeal Br. 1.

<sup>2</sup> In the Answer (dated June 14, 2018, hereinafter "Ans."), the Examiner withdrew the rejection of claims 12–19. Ans. 3.

### CLAIMED SUBJECT MATTER

The claims relate to a two-part sheet metal elevator guide rail that has a first part 40 formed from a metal sheet, which has an exterior treated to resist corrosion, bent into a configuration that mounts within an elevator hoistway and guides an elevator car or counterweight, and a second cover part 48 formed from a different metal to cover an exterior surface of the first sheet metal part with a configuration that establishes a coefficient of friction to facilitate brake engagement with the cover to resist movement along the guiderail. Spec. ¶¶ 4, 47, Fig. 2.

Claims 1 and 20 are independent. Claims 2–11 each of which depends, either directly or indirectly, from claim 1. Claim 1 is illustrative of the claimed subject matter and is reproduced below with emphasis added to highlight the limitation that is central to Appellant’s patentability arguments.

1. An elevator guide rail, comprising:
  - a metal sheet comprising a first metal bent into a configuration that establishes at least one mounting portion configured to facilitate mounting the guiderail within an elevator hoistway and at least one guiding portion configured to guide movement of an elevator car or counterweight along the guiderail, *the metal sheet including an exterior surface treated to resist corrosion*; and
  - a cover over at least some of the exterior surface, the cover comprising a second, different metal having an exterior that is different than the exterior surface of the metal sheet, the cover exterior being configured to establish a coefficient of friction to facilitate brake engagement with the cover for resisting movement of the elevator car or counterweight along the guiderail.

Appeal Br. 8 (Claims App.).

OPINION

In the Non-Final Action, the Examiner rejected claims 1–11 and 20 after determining the claimed subject matter to be obvious over the combined teachings of Fargo, Resch, and Miller. Non-Final Act. 3–7. Appellant contends that the Examiner erred by misapprehending the teachings of Resch, which Appellant asserts “explicitly *teaches away* from the Examiner’s suggested modification” that is necessary to reach the claimed combinations. Appeal Br. 3. Specifically, Appellant contends Resch teaches against modifying the metal sheet disclosed in Fargo to have “an exterior surface treated to resist corrosion,” which independent claim 1 recites. *Id.* at 4. This alleged error is Appellant’s only basis for contending the Examiner’s rejection of claims 1–11 should be reversed. *See id.* at 3–5.

Notably, although Appellant argues dependent claim 8 separately, the substance of that argument is essentially the same as the argument made for the rejection of claims 1–7 and 9–11. *See id.* at 5. In addition, as the Examiner notes at page 4 of the Answer, Appellant does not present any separate patentability arguments for independent claim 20, that does not include a similar limitation requiring “an exterior surface [of the metal sheet to be] treated to resist corrosion,” which underlines the only patentability argument Appellant makes in this appeal. *Id.* As a result, we summarily sustain the Examiner’s rejection of claim 20 and we select claim 1 to decide this appeal, with claims 2–11 standing or falling with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv) (permitting the Board to select a single claim to decide the appeal as to a single ground of rejection of a group of claims argued together). For the following reasons, we do not find Appellant’s argument persuasive.

The Examiner finds Fargo to disclose the “metal sheet” 20, 26 that claim 1 recites, except it is “silent with respect to the metal sheet including an exterior surface treated to resist corrosion and a cover over at least some of the exterior surface.” Non-Final Act. 3. The Examiner, however, finds further that Resch teaches it was known to treat the exterior surface of the metal sheet of an elevator guide rail to resist corrosion and finds that Miller teaches the recited “cover” 40 over an exterior surface of the metal sheet 32 of guide rail 24. *Id.* at 3–4 (citing Resch, ¶ 2, Fig. 1; Miller, ¶¶ 24, 27). The Examiner reasons that a skilled artisan at the time of the invention would have known to modify the exterior surface of the metal sheet that Fargo discloses with a corrosion resist treatment because Resch teaches that this was a known process used for “service life and operability” of the part. *Id.* at 3. The Examiner reasons also that:

[i]t would have been obvious to one having ordinary skill in the art at the time that the instant invention was made to place a cover, as taught by Miller et al, over the treated exterior surface of the metal sheet of Fargo et al as modified by Resch et al, to provide a second, different metal having an exterior that is different than the exterior surface of the metal sheet of Fargo et al to establish a coefficient of friction to facilitate brake engagement with the cover for resisting movement of an elevator car or counterweight along the guiderail, for operability and safety of an elevator.

*Id.* at 4.

Appellant does not dispute the findings and reasoning of the Examiner that are supported by Fargo and Miller. *See* Appeal Br. 3–5; *see also* Reply Br. 1–4. Instead, Appellant argues that the Examiner misapprehends the teachings of Resch and, when Resch is read for what it teaches as a whole, there is no rational underpinning to the Examiner’s reasoning for why it

would have been obvious to a person of ordinary skill in the art to modify the exterior surface of the recited metal sheet with a treatment to resist corrosion. *Id.* Specifically, Appellant argues that Resch “does not teach how to protect a guide rail.” Reply Br. 1. Appellant does not dispute that paragraph 2 of Resch, which the Examiner cites as support, teaches using a treatment to resist corrosion, but contends that paragraph 2 does not show it was known to use the treatment with guide rails. Reply Br. 2.

In particular, Appellant contends that Resch, when considered as a whole, supports an opposite conclusion that the corrosion resistant treatment cannot be used with guide rails. Appeal Br. 3–4 (citing Resch, ¶ 8); Reply Br. 2 (citing Resch, ¶¶ 4, 8). In particular, Appellant highlights paragraph 8 of Resch, which states:

*[t]he sacrificial layers mentioned in the introduction are also not suitable for a temporary protection, since they have the disadvantage that they enter into an intimate connection with the surface to be protected and cannot be removed again or can be removed only with a substantial outlay on processing. Moreover, they change the properties of the blank surface and thus cannot be used with guide rails, drive shafts and the like.*

(emphasis added). Appellant reads “in the introduction” from the above paragraph to include those treatments mentioned in paragraph 2, and we agree. *See* Appeal Br. 4; *see also* Reply Br. 2. In view of Resch’s teaching in paragraph 8, Appellant argues that “[t]he Examiner’s interpretation of paragraph [0002] is directly contrary to the explicit statement in paragraph [0008], is therefore unreasonable, and cannot serve as a basis for attempting to establish a *prima facie* case of obviousness.” Reply Br. 2.

We are not persuaded, however, that paragraph 8 of Resch supports Appellant’s “teaching away” argument. Although we do agree with

Appellant to an extent, it is limited to agreeing that paragraph 8 of Resch teaches against using the corrosion resistant treatments mentioned in paragraph 2 on the part of a guide rail that is in direct contact with an elevator car or counterweight. We disagree, however, that it teaches against using the treatments on *all parts* of a guide rail. Our understanding is informed by paragraph 6 of Resch, which clarifies that the “blank surface” of a guide rail that is identified in paragraph 8 refers specifically to the “running surfaces” of such rails because those are the parts that directly interact with the elevator car or counterweight and, as such, are the only parts that must be “absolutely smooth and clean.” With this context, we find that a skilled artisan would understand Resch’s reference to “guide rail” in paragraph 8 as intending to identify specifically the “running surfaces” portion of an elevator guide rail.

As a result, we do agree Resch teaches against treating the recited “metal sheet” portion of Appellant’s claimed elevator guide rail because that portion does not form the “running surfaces” or come into direct contact with an elevator car or counterweight. A skilled artisan would understand instead that the “cover” portion that claim 1 recites is the “running surface” of Appellant’s claimed guide rail. The Examiner does not suggest a skilled artisan would have understood Resch to show it was known to treat the recited cover to resist corrosion. Rather, the Examiner determines that it would have been obvious “*to place a cover . . . over the treated exterior surface of the metal sheet . . . to provide a second, different metal having an exterior that is different than the exterior surface of the metal sheet . . . to establish a coefficient of friction to facilitate brake engagement with the cover for resisting movement of an elevator car or counterweight along the*

guiderail.” Non-Final Act. 4 (emphasis added). Notably, Appellant does not dispute the rational underpinning of this determination by the Examiner, except in so far as to dispute the obviousness of treating the exterior surface of the metal sheet.

Appellant has not persuasively shown Resch teaches away from modifying the metal sheet disclosed in Fargo because the claimed “metal sheet” is simply the supporting structure for the “cover,” which a skilled artisan would understand to be the structure that forms the “running surface” of the claimed guide rail. Accordingly, a skilled artisan would understand that because the “metal sheet” of the claimed guide rail does not come into direct contact with an elevator car or counterweight, it is not required to be “absolutely smooth and clean,” and, thus, Resch’s reference to “guide rails” in paragraph 8 does not apply to the “metal sheet” disclosed in Fargo. Thus, because of each of the above factors, we find no error or deficiency with the Examiner’s reliance on paragraph 2 of Resch to support the determination that a skilled artisan would have known to modify the exterior surface of the metal sheet disclosed in Fargo with a corrosion resist treatment because it was a known process used to improve the “service life and operability” of that metal part.

For the foregoing reasons, Appellant has not shown persuasively that the Examiner’s rejection of claim 1 was improper. Therefore, because claims 2–11 fall with independent claim 1, we sustain the Examiner’s rejection of claims 1–11.

#### CONCLUSION

The Examiner’s rejection of claims 1–11 and 20 is affirmed.



DECISION SUMMARY

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>References</b>	<b>Affirmed</b>	<b>Reversed</b>
1-11, 20	103(a)	Fargo, Resch, Miller	1-11, 20	

TIME PERIOD FOR RESPONSE

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