

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HYO S. SHIM
and
STEVE A. WILES

Appeal No. 2000-0085
Application No. 08/802,582

ON BRIEF

Before FRANKFORT, NASE and LAZARUS, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 12, which are all of the claims pending in this application.

Appellants' invention is directed to a frangible

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aircraft floor comprising a perforated thin film for aircraft decompression protection (specification, page 1) and to a method of equalizing pressure in an aircraft which utilizes a floor including a thin frangible film. Independent claims 1, 7 and 9 are representative of the subject matter on appeal and a copy of those claims may be found in the Appendix to appellants' brief.

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

Dernbach et al. (Dernbach) 1974	3,845,879	Nov. 5,
McIntyre et al. (McIntyre) 1976 Brandon	3,938,764	Feb. 17,
21, 1984 FitzGerald	4,432,514	Feb.
Mar. 26, 1991	5,002,085	

Claims 1, 2 and 4 through 8 stand rejected under 35 U.S.C.

§ 103 as being unpatentable over Brandon in view of McIntyre and Dernbach.

Claim 3 stands rejected under 35 U.S.C. § 103 as being

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unpatentable over Brandon in view of McIntyre and Dernbach, as
applied to claim 1 above, and further in view of FitzGerald.

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Claims 9 through 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Brandon in view of McIntyre, Dernbach and FitzGerald.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding the rejections, we make reference to the examiner's answer (Paper No. 12, mailed March 23, 1999) for the reasoning in support of the rejections, and to appellants' brief (Paper No. 11, filed March 1, 1999) and reply brief (Paper No. 13, filed May 17, 1999) for the arguments thereagainst.

OPINION

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

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Looking first at the examiner's rejection of claims 1, 2 and 4 through 8 under 35 U.S.C. § 103 as being unpatentable over Brandon in view of McIntyre and Dernbach, we note that on page 3 of the answer the examiner has urged that Brandon teaches that a relief valve located between the aircraft outer wall and an outboard seat track is well known "except for the relief valve being a thin film having apertures, seams, and frame." In addition, the examiner has urged that McIntyre teaches that frangible means to relieve pressure in the aircraft environment is well known in the art and that Dernbach teaches that "a frangible means with apertures, seam, and frame 6 to relieve pressure is well known in the art" (answer page 3). From these teachings, the examiner concludes that it would have been obvious to one of ordinary skill in the art at the time appellants' invention was made "to have used a frangible film having apertures, seams, and frame 6 in place of Brandon's relief valve as taught by McIntyre et al. and Dernbach et al. to save weight and to relieve pressure so that damages can be prevented" (answer, pages 3-4).

Appellants assert (brief, pages 4-5) that the Dernbach

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reference has no relation whatsoever to decompression protection in an aircraft and that there would be no reason for one skilled in the art to look to the teachings of Dernbach in developing an aircraft decompression protection system. Appellants further argue that the examiner has provided no specific or inherent motivation for the proposed combination of the three applied references and that the three applied references could not be combined in an operative manner consistent with their intended uses, so as to result in appellants' claimed subject matter. In this regard, appellants assert (brief, page 6) that the examiner has utilized appellants' own disclosure in the present application as a road map for piecing together unrelated references without citing any legitimate motivation for the combination and thereby engaged in an improper hindsight reconstruction of the claimed subject matter.

Assuming for argument sake that Dernbach is analogous prior art because it is reasonably related to the general problem of over-pressure relief that appellants have confronted, we nonetheless share appellants' view that there

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is no motivation, teaching or suggestion in the three applied references, whether considered individually or collectively, for the examiner's proposed combination thereof in such a manner as to result in appellants' claimed frangible aircraft floor (claim 1) or method of equalizing pressure in an aircraft (claim 7). In our opinion, the examiner has used impermissible hindsight derived from appellants' own teachings in seeking to combine the spring biased, pivotally mounted decompression relief valve of Brandon, the sealed frangible aircraft floor structure of McIntyre and the safety fitting of Dernbach in a manner so as to result in appellants' claimed subject matter. In this regard, we note that, as our court of review indicated in In re Fritch, 972 F.2d 1260, 1266 n.15, 23 USPQ2d 1780, 1783-84 n.15 (Fed. Cir. 1992), it is impermissible to use the claimed invention as an instruction manual or "template" to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered obvious. That same court has also cautioned against focussing on the obviousness of the differences between the claimed invention and the prior art rather than on the invention as a whole as 35 U.S.C. 103 requires, as we

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believe the examiner has done in the present case. See, e.g.,
Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367,
1383, 231 USPQ 81, 93 (Fed. Cir. 1986), cert. denied, 480 U.S.
947 (1987).

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Since we have determined that the teachings and suggestions found in Brandon considered with those of McIntyre and Dernbach would not have made the subject matter as a whole of claims 1, 2 and 4 through 8 on appeal obvious to one of ordinary skill in the art at the time of appellants' invention, we must refuse to sustain the examiner's rejection of those claims under 35 U.S.C. § 103.¹

As for the examiner's rejections of claim 3 and claims 9 through 12 under 35 U.S.C. § 103 as being unpatentable over Brandon in view of McIntyre, Dernbach and FitzGerald, we have additionally reviewed the FitzGerald patent, but, like appellants (brief, page 8) find nothing therein that provides for that which we have indicated above to be lacking in the examiner's proposed combination of Brandon, McIntyre and Dernbach. As a further point, we note that while the examiner has relied upon FitzGerald as teaching that Mylar is well

¹The examiner's mention of "the Murphy reference" (answer, page 7, lines 3-4) and of replacing the valve of "Murphy" (page 7, lines 13-15) is not understood, since no Murphy reference has been applied in the present application and forms no part of the rejections before us on appeal.

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known in the art to constitute a "frangible" means (answer, pages 4 and 5), we find no mention of Mylar in the disclosure of the FitzGerald patent. In column 3, lines 1-6, FitzGerald indicates that the rupture member (12) may be made of a variety of non-metallic materials, including "a variety of plastics, resins[,] and other materials such as graphite which is presently preferred," but nowhere mentions Mylar specifically. Accordingly, the examiner's rejection of claim 3 and of claims 9 through 12 under 35 U.S.C. § 103 will likewise not be sustained.

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In light of the foregoing, the decision of the examiner to reject claims 1 through 12 of the present application under 35 U.S.C. § 103 is reversed.

REVERSED

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CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
JEFFREY V. NASE)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
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RICHARD B. LAZARUS)	
Administrative Patent Judge)	

CEF:hh

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