

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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte IAN B. ALEXANDRE

Appeal No. 2001-0528
Application No. 08/892,348

ON BRIEF

Before COHEN, ABRAMS, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 21 to 32, which are all of the claims pending in this application.¹

We AFFIRM-IN-PART.

¹ Claims 23, 25, 26 and 28 to 32 were amended subsequent to the final rejection.

BACKGROUND

The appellant's invention relates to a modularized structure framing system and module erection tools (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

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

Wilson 1923	1,448,244	Mar. 13,
Kofahl et al. 1957 (Kofahl)	2,803,856	Aug. 27,
Pennecot 1975	3,921,355	Nov. 25,
Coulthard 10, 1978	4,118,903	Oct.
Schonert 1981	4,281,491	Aug. 4,

The rejections set forth in the examiner's answer (Paper No. 15, mailed October 24, 2000) are as follows:

- (1) Claims 21 to 24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Pennecot.
- (2) Claims 21 to 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Schonert in view of Kofahl.

(3) Claims 26 to 32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Schonert in view of Kofahl and Wilson.

(4) Claims 24 and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Schonert in view of Kofahl and Coulthard.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 14, filed August 9, 2000) and reply brief (Paper No. 16, filed December 26, 2000) for the appellant's arguments thereagainst.

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.

Rejection (1)

We sustain the rejection of claims 21 to 24 under 35 U.S.C. § 102(b) as being anticipated by Pennecot.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

We agree with the examiner's rationale (answer, pp. 5 and 10-11), which we incorporate as our own, that claims 21 to 24

are anticipated by Pennecot. The appellant's argument (brief, p. 5) that Pennecot uses a ladder frame construction and permanently installs the square collars 36 in the assembled building, while true, is not persuasive since claims 21 to 24 do not distinguish over those teachings. Additionally, while the appellant further argues (brief, p. 5) that Pennecot's square collars 36 are not "alignment tools," we point out that no evidence on this point has been submitted by the appellant.² In any event, it is our view that Pennecot's square collars 36, as shown in Figures 16 to 19, clearly function to align various modules and therefore are "alignment tools."

For the reasons set forth above, the decision of the examiner to reject claims 21 to 24 under 35 U.S.C. § 102(b) is affirmed.

Rejection (2)

² It is well settled that attorney's argument in a brief cannot take the place of evidence. In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974).

We sustain the rejection of claims 21 and 22 under 35 U.S.C. § 103 as being unpatentable over Schonert in view of Kofahl, but not the rejection of claim 23.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). In considering the question of the obviousness of the claimed invention in view of the prior art relied upon, we are guided by the basic principle that the question under 35 U.S.C. § 103 is not merely what the references expressly teach but what they would have suggested to one of ordinary skill in the art at the time the invention was made. See Merck & Co., Inc. v. Biocraft Laboratories, Inc., 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989) and In re Keller, 642 F.2d 413, 425, 208 USPQ

871, 881 (CCPA 1981). That is, the question of obviousness cannot be approached on the basis that an artisan having ordinary skill would have known only what they read in the references, because such artisan is presumed to know something about the art apart from what the references disclose. See In re Jacoby, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962). It is not necessary that suggestion or motivation be found within the four corners of the references themselves; a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Further, in an obviousness assessment, skill is presumed on the part of the artisan, rather than the lack thereof. In re Sovish, 769 F.2d 738, 226 USPQ 771 (Fed. Cir. 1985). We are bound to consider the disclosure of each reference for what it fairly teaches one of ordinary skill in the art, including not only the specific teachings, but also the inferences which one of ordinary skill in the art would reasonably have been expected to draw therefrom. See In re

Boe, 355 F.2d 961, 148 USPQ 507 (CCPA 1966); and In re Preda, 401 F.2d 825, 159 USPQ 342 (CCPA 1968).

With this as background, we find ourselves in agreement with the examiner's rationale (answer, pp. 5-6 and 11-17), which we incorporate as our own, that claims 21 and 22 are unpatentable over the teachings of Schonert and Kofahl. In our view, the combined teachings of Schonert and Kofahl would have made it obvious at the time the invention was made to a person of ordinary skill in the art to have included in Schonert's modular wall framing system a quad wall module, a door module and a window module.

With respect to claim 23, we agree with the appellant's argument that a person of ordinary skill in the art would not consider Schonert's plate straps 44 (see Figures 4 and 6) to be "alignment tools" since they do not clearly function to align various modules. In our view, as shown in Figures 4 and 6 of Schonert, the aligning of the modules is done by abutting the modules together and then securing the abutted modules together with the plate straps 44. Accordingly, the subject

matter of claim 23 is not suggested by the combined teachings of Schonert and Kofahl.

For the reasons set forth above, the decision of the examiner to reject claims 21 and 22 under 35 U.S.C. § 103 is affirmed and the decision of the examiner to reject claim 23 under 35 U.S.C. § 103 is reversed.

Rejection (3)

Claims 26 to 32 which depend from claims 21 and 22 have not been separately argued by the appellant and in fact have been grouped by the appellant in the brief (p. 3) with claims 21 and 22 as a first group. Accordingly, we have determined that these claims will be treated as falling with claims 21 and 22. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987) and 37 CFR §§ 1.192(c)(7) and 1.192(c)(8)(iv). Thus, it follows that the examiner's rejection of claims 26 to 32 under 35 U.S.C. § 103 as being unpatentable over Schonert in view of Kofahl and Wilson is sustained.

Rejection (4)

We will not sustain the rejection of claims 24 and 25 under 35 U.S.C. § 103 as being unpatentable over Schonert in view of Kofahl and Coulthard.

In our view, the only suggestion for combining the teachings of Coulthard with the teachings of Schonert and Kofahl in the manner proposed by the examiner (answer, pp. 8-9) to meet the limitations of claims 24 and 25 stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejection of claims 24 and 25.

CONCLUSION

To summarize, the decision of the examiner to reject claims 21 to 24 under 35 U.S.C. § 102(b) is affirmed; the

decision of the examiner to reject claims 21, 22 and 26 to 32
under

35 U.S.C. § 103 is affirmed; and the decision of the examiner
to reject claims 23 to 25 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

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LAW OFFICES OF JOHN D. GUGLIOTTA
137 S MAIN STREET
SUITE 202
AKRON, OH 44308

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