

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 GEORGE W. REILLY

Appeal No. 2001-0730
Application No. 09/221,543

ON BRIEF¹

Before COHEN, FRANKFORT, 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 5 to 7 and 12, which are all of the claims pending in this application.

We REVERSE and REMAND.

¹ On October 3, 2001, the appellant waived the oral hearing (see Paper No. 16) scheduled for November 7, 2001.

BACKGROUND

The appellant's invention relates to hardware for mounting toilet bowls, and more particularly, closet bolts (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

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

Flood 1967	3,339,215	Sept. 5,
Kemper 1969	3,424,212	Jan. 28,
Patyna et al. 1969 (Patyna)	3,457,573	July 29,

In addition, the examiner also relied upon the appellant's admission of prior art (specification, pages 1-2; Figure 1) relating to closet bolts and nuts to secure a toilet bowl in place (Admitted Prior Art).

Claims 5 to 7 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over the Admitted Prior Art, Flood, Kemper and Patyna.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (Paper No. 11, mailed July 7, 2000) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 9, filed June 5, 2000) and reply brief (Paper No. 12, filed September 11, 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, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of that evidence, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal.² Accordingly, we will not sustain the

² Thus, there is no need for us to consider the appellant's declaration under 37 CFR § 1.132 dated February 28, 2000 (Paper No. 6).

examiner's rejection of claims 5 to 7 and 12 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in

cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48

USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d
900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Claim 12, the only independent claim on appeal, reads as
follows:

A closet bolt assembly for securing a toilet bowl
flange to a fixed ring below the toilet bowl, said ring
having a slot therein and said toilet bowl flange having
a hole extending therethrough, said closet bolt assembly
comprising:

a nut; and

a closet bolt having a cylindrical shaft with
opposed first and second ends, a planar flange integrally
connected to the second end of said cylindrical shaft and
disposed generally perpendicular to the longitudinal axis
thereof for engaging the fixed ring, with the outer
surface of said cylindrical shaft being threaded from
said first end to a point intermediate the length thereof
a sufficient distance for engaging said nut to said
closet bolt to secure said toilet bowl flange to said
ring, said cylindrical shaft having a hollow passage
extending from said first end toward said second end
thereof, said hollow passage being of non-circular cross-
section whereby when an elongated tool of corresponding
cross-section to said hollow passage is disposed within
said hollow passage of the cylindrical shaft, the closet
bolt may be restrained from rotation to enable said nut
to be threadedly tightened on and threadedly screwed off
of said cylindrical shaft.

In the rejection before us in this appeal (answer, pp. 4-
5), the examiner appears to have ascertained that the Admitted

Prior Art discloses all the claimed limitations except for a hexagonal passage (i.e., a hollow passage of non-circular cross-section extending from the first end of the bolt toward the second end of the bolt). The examiner then set forth the pertinent teachings of Flood, Kemper and Patyna and concluded that in consideration of the teachings of the applied prior art "it would have been obvious to one of ordinary skill in the art to associate an internal wrenching surface (hollow passage) with the prior art bolt shaft in order to prevent bolt rotation during manipulation."

The appellant argues that the applied prior art does not suggest the claimed subject matter. We agree. In our view, the only suggestion for modifying the Admitted Prior Art in the manner proposed by the examiner to arrive at the claimed subject matter 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. That is, we fail to see sufficient suggestion or motivation in the teachings of Flood, Kemper and Patyna for a person of ordinary skill in the art at

the time the invention was made to have associated an internal wrenching surface (hollow passage) with the bolt shaft of the Admitted Prior Art. It follows that we cannot sustain the examiner's rejections of claims 5 to 7 and 12 under 35 U.S.C. § 103.

REMAND

We remand the application to the examiner for further consideration of the following issue under 35 U.S.C. § 103. The examiner has set forth the pertinent teachings of Patyna (answer, p. 4) and has appeared to determine (answer, p. 7) that Patyna discloses all the subject matter of claim 12 except for the nut. We remand the application to the examiner to determine whether or not it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have used Patyna's hollow bolt with a nut and if so, to determine if any of the pending claims should be rejected under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner to reject claims 5 to 7 and 12 under 35 U.S.C. § 103 is reversed. In addition, this application has been remanded to the examiner for further consideration.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (Eighth Edition, Aug. 2001).

REVERSED and REMANDED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
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Appeal No. 2001-0730
Application No. 09/221,543

Page 10

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Appeal No. 2001-0730
Application No. 09/221,543

Page 11

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