

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte WALLACE LONDON

Appeal No. 2001-1635
Application No. 09/294,873

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, NASE and BAHR,
Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 1, 7 and 10, as amended subsequent to the final rejection.¹ These claims constitute all of the claims pending in this application.

¹ While the examiner has approved entry of the amendment after final rejection (Paper No. 7, filed May 10, 2000), we note that the amendment to claims 1, 7 and 10 has not been clerically entered.

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We REVERSE.

BACKGROUND

The appellant's invention relates to a jointed clamp that can be mounted inside a garment bag (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:

Fine	3,000,145	Sep. 19, 1961
London et al. (London)	4,363,388	Dec. 14, 1982

Claims 1, 7 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over London in view of Fine.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the final rejection (Paper No. 5, mailed February 10, 2000) and the answer (Paper No. 13, mailed September 28, 2000) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 12, filed July 24, 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. Upon evaluation of all the evidence before us, 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. Accordingly, we will not sustain the examiner's rejection of claims 1, 7 and 10 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).

The appellant argues that the applied prior art does not suggest the claimed subject matter. We agree.

Claims 1 and 7 require the jointed clamp to include

a single upper transverse member that extends through a lower half of an upper section of said front end portion of said upper channel walls and extends through a forward upper half portion of said upper resilient material; and a single lower transverse member that extends through an upper half of a lower section of said front end portion of said bottom channel walls behind where said clasp is pivotally mounted thereto and extends through a forward lower half portion of said lower resilient material, with the result that said upper and lower resilient materials are positively, respectively retained in said upper and lower channels.

Claim 10 recites that each clamp jaw of the jointed clamp includes

a single transverse rivet that extends through a section of said front end portion of said channel walls that is closer to said open inner side, and extends through a forward end section of said inner portion of said block with the result that said block is positively retained in said channel.

Thus, all the claims under appeal require a single transverse member to extend through both channel walls and the block of resilient material. However, these limitations are not suggested by the applied prior art. In that regard, while Fine does teach fastening a truss 18 to a channel 12 by screws 24 extending through apertures 24 in the side walls 16 of the channel 12, Fine does not teach or suggest using a single transverse member extending through both side walls 16 of the channel 12 and the truss 18 for fastening the truss to the channel. To supply this omission in the teachings of the applied prior art, the examiner made determinations (final rejection, pp. 3-4; answer, pages 4-5) that these differences would have been obvious to an artisan. However, these determinations have

not been supported by any **evidence**² that would have led an artisan to arrive at the claimed invention.³

In our view, the only possible suggestion for modifying London in the manner proposed by the examiner to meet the above-noted limitations 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 rejections of claims 1, 7 and 10.

² Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg., Inc. v. SGS Importers Int'l., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), cert. denied, 117 S. Ct. 80 (1996), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998), cert. denied, 119 S. Ct. 1804 (1999). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." Thus, when an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, xxx F.3d xxx, xxx-xx, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002). See also In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

³ In our view, the combined teachings of the applied prior art at best would have made it obvious at the time the invention was made to a person of ordinary skill in the art to have secured London's resilient blocks 45 and 55 within their respective channels 40 and 50 with screws extending through apertures in the side walls 42 and 52 of the channels.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 7 and 10 under 35 U.S.C. § 103 is reversed.

REVERSED

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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