

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SVEIN NORDTVEDT

Appeal No. 96-1058
Application 08/211,143¹

HEARD: September 18, 1997

Before STONER, *Chief Administrative Patent Judge*, and LYDDANE and CRAWFORD, *Administrative Patent Judges*.

STONER, *Chief Administrative Patent Judge*.

DECISION ON APPEAL

Svein Nordtvedt, appellant, appeals from the final rejection of claims 8 through 10 and 12 through 17 under 35 U.S.C. § 103. Claims 11 and 18 have been indicated as allowable subject to being rewritten in independent form. We reverse.

¹ Application for patent filed March 22, 1994

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The claimed invention relates to an escape device for use in exiting a building. Claim 8 is illustrative and defines the claimed invention as follows with bracketed numerals added for purposes of our discussion:

8. An escape device comprising

[1] a collapsible tubular stocking having a plurality of longitudinally disposed sections, each said section having a vertically extending back portion and an obliquely extending front portion defining a funnel-shaped passage therebetween;

[2] a plurality of bracing rings secured to said stocking at spaced apart intervals, each bracing ring being disposed between a respective pair of said stocking sections and defining an access opening into a funnel-shaped passage of a respective stocking section therebelow; and

[3] a plurality of rigid connecting means, each said connecting means being secured to a respective bracing ring to project from said ring for mounting in an opening of a building to provide an access path for an occupant of the building to a respective access opening for entry into said stocking.

Claims 8 through 10 and 12 through 17 stand rejected under 35 U.S.C. § 103 as unpatentable over Nordtvedt (U.S. Pat. No. 4,595,074, granted June 17, 1986) in view of Schuett (U.S. Pat. No. 275,083, granted April 3, 1883). The examiner states (answer, pp. 2-3), and the appellant concedes, so far as claim 8 is concerned (brief, p. 5), that Nordtvedt discloses an escape device like that claimed in the clauses [1] and [2] of claim 8. The examiner recognizes that Nordtvedt fails to disclose the

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structure recited in the clause [3] of claim 8, namely "a plurality of rigid connecting means, each said connecting means being secured to a respective bracing ring to project from said ring for mounting in an opening of a building to provide an access path for an occupant of the building to a respective access opening for entry into said stocking." Finding in Schuett "a connecting means (A-E) for bridging an opening of a building with an access opening adjacent the ring portion of his [Schuett's] escape stocking," the examiner determines that, "It would have been obvious to one of ordinary skill in the art to modify Nordtvedt to comprise connecting means as claimed to his ring portion (11) to bridge openings of a building to the access openings adjacent his ring portions" (answer, p. 3).

We shall not sustain the examiner's rejection of claims 8 through 10 and 12 through 17.

Our court of review has repeatedly cautioned against employing hindsight by using the applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. *See, e.g., Grain Processing Corp. v. American Maize-Products Co.*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988). That court has also cautioned against

focussing on the obviousness of the differences between the claimed invention and the prior art rather than on the obviousness of the claimed invention as a whole as § 103 requires. *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).

Like the appellant, we think that the most which is suggested by these references is "a structure in which the upper end of the Nordtvedt stocking would be provided with a frame from which the stocking could be suspended from a building" (brief, pp. 6-7).² The claims, of course, require more. Independent claim 8 and independent claim 15, from which all of the other claims on appeal depend, require a plurality of rigid connecting means, each of which is secured to a respective bracing ring. Nothing in either Nordtvedt or Schuett would have suggested providing more than a single connecting means between the

² The appellant states, "Simply suspending the stocking of Nordtvedt from a building using a rigid frame at the top end does not result in the claimed structure nor does such provide the new and unobvious results obtained by applicant's claimed structure" (brief, p. 7). Thus, the appellant does not appear to contend that the means or, in appellant's words, "rigid frame" by which Schuett suspends the iron ring F and sack F' does not constitute "rigid connecting means."

building and the escape "stocking" of Nordtvedt (col. 3, l. 35) or the "long canvas bottomless sack" of Schuett (p. 1, right col., l. 61).

The examiner contends that an extension of the teachings of these references to have provided a plurality of "rigid connecting means" would have been obvious, given the multiple entry locations of Nordtvedt (answer, p. 4).³ We do not see why that would have been so. At most, the references to Nordtvedt and Schuett teach suspending the escape device at the top and connecting the bottom to those aiding in the escape, namely to the ship below in Nordtvedt or to the rescuers holding the lines H of Schuett. No other form of connection to the structure or building being escaped is taught or suggested by these references, so far as we have been apprised by the examiner, and we think that in this regard the examiner is relying upon impermissible hindsight to reconstruct the claimed invention from

³ The examiner, in passing, refers to "cited patent 4,162,717 to Orii" (answer, p. 4). Where a reference is relied upon to support a rejection, whether or not in a "minor capacity," there would appear to be no excuse for not positively including the reference in the statement of the rejection. See *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). Because the examiner has not seen fit to include the "Orii" reference in the rejection of these claims, we have not considered that reference en route to reaching our decision in this appeal.

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the teachings of these references.

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Because we do not consider the teachings of the Nordtvedt and Schuett references to have established *prima facie* obviousness of the claimed subject matter, we see no need to, and therefore decline to, comment upon the Lien affidavit filed April 17, 1995.

The decision of the examiner is reversed.

REVERSED

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BRUCE H. STONER, JR., Chief)	
Administrative Patent Judge)	
)	
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)	BOARD OF PATENT
WILLIAM E. LYDDANE)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
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MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	

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