

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(2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL R. BACINA and JOHN J. FUSCO

Appeal No. 96-1201
Application 08/122,970¹

ON BRIEF

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

DECISION ON APPEAL

This is an appeal from the examiner's refusal to allow claims 1-13 as amended after final rejection. Claim 14 has been canceled. These are all the claims in the application.

Application for patent filed September 17, 1993.

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The claimed invention relates to a reinforcement for automotive body panels. More specifically, the tooling holes are configured so that paint draining from the tooling hole reinforcement points does not engender a drip or run.

Claim 1 reproduced below is further illustrative of the claimed subject matter.

1. A reinforcement for an automotive body panel positioned in vertically extending orientation for receiving a liquid surface coating thereon, the body panel including a generally vertically extending exterior surface, the reinforcement comprising;

means defining a depression on the surface, said depression having a portion parallel to said body panel and imperforate canted portions extending between said parallel portion and said exterior surface; and

means defining a nonfunneling surface proximate the lower terminus of said depression for collecting excess liquid surface coating applied to the panel and for preventing the liquid surface coating from running onto surfaces directly beneath said reinforcement.

The reference relied upon as evidence in a 35 U.S.C. § 103 obviousness rejection is:

DeRees

4,848,835

July 18, 1989

THE REJECTION

The examiner has rejected claims 1-13 under 35 U.S.C. § 103 as unpatentable over appellants' admitted prior art in view of DeRees. According to the examiner, figures 1 and 2 of appellants' drawings illustrate, and the accompanying portion of

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appellants' specification states, that it is old and well known to reinforce a tooling hole in an automotive body panel with a surrounding circular depression. The examiner further states, that DeRees teaches the formation of a depression in a body panel which may be noncircular. The examiner specifically refers to DeRees' depressions 120 or 112 which have bases parallel to the main panel and canted side portions 122 extending between the parallel portion and the panel surface. The examiner concludes that it would have been obvious to provide, in the prior art as admitted by appellants, a reinforcing depression of the shape taught by DeRees with a nonfunneling bottom surface. The examiner states as motivation the argument that a larger size depression of the shape suggested by DeRees would add additional strength to the body panel.

We have carefully reviewed the rejection on appeal in light of the arguments of the examiner and the appellants. As a result of this review, we have determined that the applied prior art does not establish a prima facie case of obviousness with respect to the claims on appeal. Therefore, the rejection of these claims is reversed. Our reasons follow.

Appellants' first argument is that the examiner has failed to state what constitutes the scope and content of the

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admitted prior art. We disagree with this argument of the appellants. The examiner has clearly referred to figures 1 and 2 of appellants' drawing and appellants' specification pertaining thereto. This portion of appellants' disclosure clearly conveys that frusto-conical depressions are known as reinforcement around tooling holes in an automotive body panel.

The appellants' second argument is that there is no teaching or suggestion that would have motivated one of ordinary skill to combine the collective teachings of DeRees and the admitted prior art. We are in agreement with this argument of appellants. The examiner has argued that the motivation for combining the teaching of DeRees with admitted prior art is that the larger depressions shown at 120 or 112 in DeRees would add additional strength when used around the tooling hole 14 of appellants' admitted prior art. The examiner considers that such shapes as 120 and 112 in DeRees would inherently not funnel paint and therefore eliminate runs or drips. The examiners states that nonfunneling comes along with the larger depression added for strength as "free for the ride". We disagree with the examiner's rationale for three reasons.

First of all, the examiner has offered no evidence or reasonable basis for the assumption that a larger depression

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would necessarily add additional strength. This assumption is not supported by any evidence adduced by the examiner. It is an additional assumption on the examiner's part that added strength is desirable or necessary. Furthermore, it might be expected that a larger depression would have other adverse consequences.

Secondly, the disclosure of DeRees is actually related to fabricating beams or rails out of sheet metal, and the combined teachings of the admitted prior art and DeRees do not suggest using the configurations disclosed in DeRees on vehicle body panels as opposed to beams.

Thirdly, we are of the view that the examiner's combination of references is based on hindsight, particularly, inasmuch as the examiner has picked depression shapes 112 and 120 of DeRees while disregarding DeRees' other disclosure of additional reinforcement shapes. We note that the configuration shown at 112 in DeRees would prevent funneling in only half of the occurrences, for when the point of the configuration 112 is facing downwardly, the configuration actually increases funneling.

Since DeRees is completely silent with respect to any teaching or suggestion regarding eliminating paint drips or runs, and the examiner has chosen from all the reinforcement shapes of

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DeRees, only the shapes that would eliminate funneling, we must conclude that the examiner's selection of the shapes in DeRees results only from a hindsight review of appellants' own disclosure. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. In re Gorman, 933 F.2d 982, 987, 18 USPQ 1885, 1988 (Fed. Cir. 1991). Our reviewing court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

The rejection of claims on appeal is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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NEAL E. ABRAMS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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WILLIAM F. PATE, III)
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