

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILMER F. ALLES

Appeal No. 1996-1561
Application No. 08/230,075

HEARD: January 12, 2000

Before McCANDLISH, ***Senior Administrative Patent Judge***, ABRAMS,
and GONZALES, ***Administrative Patent Judges***.

ABRAMS, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1-8, which constitute all of the claims of record in the application.

The appellant's invention is directed to a water closet having a restriction member inserted into the end of the

flexible tube which supplies water to fill the bowl. The claims on appeal have been reproduced in an appendix to the Brief.

THE APPLIED REFERENCES

Baird 1909	928,237	Jul. 20,
Preston 1973	3,744,064	Jul. 10,

THE REJECTION

Claims 1-8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Preston in view of Baird.¹

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejection and the conflicting viewpoints advanced by the examiner and the appellant regarding the rejection, we make reference to the

¹In the final rejection (Paper No. 9), claims 1-8 were rejected under 35 U.S.C. § 103 as being unpatentable over Preston in view of Farrar, and claims 1-7 as being unpatentable over Preston in view of Baird. In the Answer, the former rejection was withdrawn, and claim 8 was added to the latter one.

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Examiner's Answer (Paper No. 13) and to the Appellant's Briefs
(Paper Nos. 12 and 14).

OPINION

The guidance provided by our reviewing court with regard to the evaluation of rejections under 35 U.S.C. § 103 is as follows: A *prima facie* 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, for example, ***In re Bell***, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)). This is not to say, however, that the claimed invention must expressly be suggested in any one or all of the references, rather, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art (see, for example, ***Cable Elec. Prods. v. Genmark, Inc.***, 770 F.2d 1015, 1025, 226 USPQ 881, 886-87 (Fed. Cir. 1985)), considering that 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)). Insofar as the references themselves are concerned, we are bound to consider the disclosure of each 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, 965, 148 USPQ 507, 510 (CCPA 1966) and *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968)).

We find ourselves in agreement with the examiner that all of the subject matter recited in independent claim 1 is disclosed by Preston, except for the manner in which Preston's restriction member (regulator 44) is mounted on the end of the flexible bowl refill tube (42). In Preston, this is accomplished by means of an annular protrusion around the upstream end of the restriction member which is of greater diameter than the inside of the bore of the flexible tube, whereby pressing the end of the restriction member into the tube distends the tube to hold the member in place (see Figure 10). The system recited in claim 1 differs, in that it requires that the restriction member be provided with screw threads for the same purpose.

Baird discloses a coupling member for attaching together two pieces of flexible hose. The coupling member is provided with external threads having a tooth crest outer diameter that is greater than the inner diameter of the bore of the hose. The coupling is installed by screwing it into the end of the hose, which distends the hose and causes the hose to "snugly embrace" the coupling member (page 1, line 96).

It is our view that one of ordinary skill in the art would have found it obvious to modify the Preston regulator by substituting screw threads for the annular protrusion on the outer periphery of the restriction member, in view of the teaching of Baird. Suggestion for such is found in the self evident advantages of easy installation and effective attachment that are achieved by using screw threads, which would have been known to the artisan, who is presumed to possess skill rather than lack it (see *In re Sovish*, 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985)).

It is our conclusion that a *prima facie* case of obviousness has been established with regard to the subject matter recited in claim 1, and we therefore will sustain this

rejection. Furthermore, in view of the appellant's election to group claims 1-7 together,² the rejection of claims 2-7 also is sustained.

We reach the opposite conclusion, however, with regard to claim 8. This independent claim additionally requires the presence of "tool receiving means formed in said restriction member at one end to permit inserting the restriction member in said thermoplastic tube at a tube end" (emphasis added). Neither of the two references applied against claim 8 shows a tool receiving means of any kind, much less one that is formed "in" one end of the restriction member, and we are not persuaded otherwise by the examiner's argument.

A *prima facie* case of obviousness therefore has not been established with regard to the subject matter of claim 8, and we will not sustain the rejection.

We have carefully considered the arguments the appellant has directed to the rejection of claim 1. However, they have not persuaded us that the examiner's position with regard to claim 1 was in error. The fact that Preston discloses a

² See Brief, page 3, considering that the rejection of claim 8 has been separately argued in the Reply Brief.

different system for insuring that sufficient water is supplied to the bowl for refill after flushing does not alter the fact that it discloses a restriction member at the end of the flexible refill tube which meets the terms of claim 1, except for the manner in which it is attached.

We also disagree with the appellant that Baird is nonanalogous art (Brief, pages 6-7). The test for analogous art is first whether the art is within the field of the inventor's endeavor and, if not, whether it is reasonably pertinent to the problem with which the inventor was involved. See **In re Wood**, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). A reference is reasonably pertinent if, even though it may be in a different field of endeavor, it logically would have commended itself to an inventor's attention in considering his problem because of the matter with which it deals. See **In re Clay**, 966 F.2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992). Baird is not directed to a water closet. However, it is concerned with the problem of attaching a rigid flow-through member to the end of a flexible hose and thus, from our perspective, it logically would have commended itself to an

inventor who was dealing with this problem, such as one who wished to attach a member to the end of the bowl fill hose of a water closet.

SUMMARY

The rejection of claims 1-7 as being unpatentable over Preston and Baird is sustained.

The rejection of claim 8 as being unpatentable over Preston and Baird is not sustained.

The decision of the examiner is affirmed-in-part.

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

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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