

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(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT D. DANNENBERG,
LEONARD P. LACHMANN and
THOMAS V. LOZITO

Appeal No. 1997-0500
Application 08/404,704¹

HEARD: November 4, 1999

Before JERRY SMITH, LALL and GROSS, Administrative Patent
Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed March 15, 1995. According to applicants,
this application is a continuation-in-part of Application 08/037,941, filed
March 26, 1993, now abandoned.

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This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-31, which constitute all the claims in the application.

The disclosed invention pertains to an arrangement on an instrument panel of an instrument gauge and a bezel means. More particularly, the bezel means has first and second retention means attached to fingers which extend rearwardly of the bezel means. The retention means can be positioned so that in one position the bezel can be removed by itself whereas in the other position the instrument gauge is removed along with the bezel.

Representative claim 1 is reproduced as follows:

1. In combination:

A) an instrument panel having an aperture that extends axially in said instrument panel and that is bounded by a marginal edge portion of said instrument panel that is disposed peripherally about said aperture;

B) an instrument gauge that comprises:

1) electrical input terminal means for receiving an electrical input signal that represents the value of an input to said gauge; and

2) a front display at which said gauge presents the value of such an electrical input signal;

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C) electrical supply terminal means for separable mating with said input terminal means of said gauge for supplying such an electrical input signal to said input terminal means;

D) means defining an installed position for said gauge relative to said instrument panel wherein said gauge is disposed in registration with said aperture for removal from the installed position by being extracted via said aperture, and wherein said electrical supply terminal means are separably mated with said input terminal means; and

E) bezel means comprising:

1) a front bezel portion that is disposed axially forward of and overlaps both said aperture and said marginal edge portion of said instrument panel and that allows said front display to be viewed by an observer with said gauge being in the installed position; and

2) gauge extraction means that extends axially rearward from said front bezel portion through said aperture, and, upon said bezel means being bodily displaced axially forward, engages the installed gauge to cause said gauge to be bodily displaced axially forward, and thereby extracted from the installed position.

The examiner relies on the following references:

Leone	3,807,236	Apr. 30, 1974
Wetterhorn et al. (Wetterhorn)	4,753,112	June 28, 1988

Claims 1-31 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Leone in view of Wetterhorn.

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Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-31. Accordingly, we reverse.

At the outset, we dispose of the issue related to the examiner's objection of the claims under 37 CFR § 1.75 as being unduly multiplied. Although we do not agree with the

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examiner's position that the claims are unduly multiplied, we have no jurisdiction to decide this question. Our jurisdiction is limited to the rejection of claims. This issue must be resolved with the examiner and petition to the Commissioner if necessary. Thus, we have no additional comment on the examiner's objection of the claims.

Therefore, we only consider the rejection of the claims under 35 U.S.C. § 103. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044,

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1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to

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make in the brief have not been considered [see 37 CFR § 1.192(a)].

With respect to independent claim 1, the examiner observes that "Leone suggests the limitations of claim 1, except for the use of a screw-type connection instead of the disclosed (but not claimed) 'finger' means. Leone does provide a bezel which may be removed from the gauge, and a gauge which may be removed by hand following the removal of the bezel" [final rejection, page 2]. Wetterhorn teaches use of a bayonet ring as a bezel retaining means. The examiner concludes that it would have been obvious to the artisan to replace the screw-type fastening means of Leone with the bayonet fastener of Wetterhorn [id.].

Appellants argue that the examiner has failed to conduct a fact-intensive comparison between the claimed invention and the applied prior art so that the examiner's rejection is deficient as a matter of law [brief, page 8]. Appellants also argue that a fact-intensive analysis of Leone shows that Leone lacks any teaching or suggestion that the bezel be used to extract the gauge from the housing.

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According to appellants, replacing the screw-type bezel of Leone with the bayonet fastener of Wetterhorn would still not teach or suggest using the bezel to remove the gauge from the housing [id., pages 9-10]. The examiner responds that it "is self-evident that the entire Leone device may be extracted by grasping the bezel and pulling the gauge from the panel" [answer, page 3].

After a careful consideration of the record in this case, we agree with appellants that the examiner has failed to establish a prima facie case of the obviousness of the appealed claims. As noted from positions discussed above, the examiner in the final rejection stated that the gauge in Leone could be removed by hand, but in the answer the examiner now states that the bezel in Leone can remove the entire Leone device including the gauge.

The bezel in Leone is not adapted to remove the gauge when it is removed. When the bezel 14 in Leone is unscrewed from external threads 36, the bezel is removable by itself or with the attached crystal 16. The mechanism case 10 and the overlap portion 28 of Leone are not connected to the bezel in

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a manner which would allow the gauge to be removed with the bezel. In fact, Leone specifically states that his arrangement "permits the mechanism case to be firmly and safely gripped around its periphery by the fingers when it is desired to remove it for setting" [column 2, lines 25-27]. Thus, Leone clearly contemplates that the gauge be removable by hand but not by the bezel.

Although the examiner noted that the gauge was removable by hand in the final rejection, the examiner now takes the position that the entire Leone device can be removed by the bezel. It appears to be the position of the examiner that the screwed on bezel of Leone could be forcibly removed from the base 18 in such a manner that it would take the gauge 10 and housing 12 with it. Although there is no evidence in Leone that the entire device is removable from base 18, such a feature of Leone would not have suggested the claimed invention anyway.

Each of the independent claims on appeal has language which requires that the bezel have means thereon for removing the gauge. In claim 1 the "gauge extraction means" is part of

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the bezel means. Claims 15 and 30 recite the "bezel means extracting said gauge from the instrument panel." Independent claim 16 recites that the bezel means has a retention means for coaction with the gauge. Thus, all the claims on appeal clearly require that the bezel act to extract the gauge from the instrument panel under certain circumstances. In claim 1, the gauge extraction means must extend through the aperture which is not suggested by Leone even if the entire device is removable from base 18. Claims 15 and 31 recite that the gauge is removed based on different circumferential positions of the bezel. Leone's bezel has no gauge extraction means which are a function of the circumferential position of the bezel. Claim 16 recites that the finger means of the bezel means must extend through the aperture. Even if the entire device of Leone was removable from the base, there would be no finger means in the aperture for coaction with the gauge means.

Since the bezel of Leone does not have a gauge extraction means associated with it as recited in each of the independent claims, and since the bayonet fastener of

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Wetterhorn would only affect the manner in which the bezel is attached to housing 12 and not to gauge 10 or overlap 28, the applied prior art fails to teach or suggest the bezel means having a gauge extraction means as recited in each of the independent claims. Therefore, the examiner has failed to establish a prima facie case of the obviousness of the claims on appeal.

In summary, we do not sustain the examiner's rejection of claims 1-31 under 35 U.S.C. § 103. Therefore, the decision of the examiner rejecting these claims is reversed.

REVERSED

PATENT

	Jerry Smith)	
	Administrative Patent Judge)	
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	Parshotam S. Lall)	BOARD OF
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