

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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 RAYMOND E. HOYT, III, JERRY L. HAUCK and TOM ARTUNIAN

Appeal No. 98-1239
Application No. 08/742,372¹

ON BRIEF

Before McCANDLISH, ***Senior Administrative Patent Judge***,
MEISTER and FRANKFORT, ***Administrative Patent Judges***.

MEISTER, ***Administrative Patent Judge***.

DECISION ON APPEAL

Raymond E. Hoyt, III, Jerry L. Hauck and Tom Artunian

(the

¹ Application for patent filed November 1, 1996. According to appellants, this application is a continuation of Application 08/693,568 filed August 7, 1996, now abandoned; which is a continuation of Application 08/321,516 filed October 12, 1994, now abandoned.

appellants) appeal from the final rejection of 1, 3-7 and 9-17, the only claims remaining in the application.

We REVERSE.

The appellants' invention pertains to a flexible coupling apparatus. Independent claim 1 is further illustrative of the appealed subject matter and a copy thereof may be found in the APPENDIX to the brief.

The references relied on by the examiner are:

Louette 1968	3,362,191	Jan. 9,
Davidson et al. (Davidson) 1979	4,176,815	Dec. 4,

Claims 1, 3-7 and 9-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Louette in view of Davidson. According to the examiner it would have been obvious to one of ordinary skill in the art to add a circumferential groove to the joint of Louette as taught by Davidson so as

to allow the pin to be locked in place and prevent the metal retainer band from coming off of the belt which would allow for a safer assembly. [Answer, page 4.]

We will not support the examiner's position. Even if we were to agree with the examiner that Davidson, which is

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directed to a spring hanger assembly for supporting a portion of a pipe, line, would have commended itself to the attention of one of ordinary skill in the art of flexible couplings, we cannot agree that there is any suggestion to combine the teachings of Louette and Davidson in the manner proposed. The mere fact that the addition of a circumferential groove to the joint of Louette

would prevent Louette's metal retainer from coming off, and thus result in a safer assembly, does not serve as a proper motivation to combine the teachings of Louette and Davidson as the examiner apparently believes. Instead, it is well settled that it is the teachings of the prior art taken as a whole which must provide the motivation or suggestion to combine the references. **See In re Fritch**, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992) and **Uniroyal, Tnc. v. Rudkin-Wiley Cozp.**, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988).

Davidson, as we have noted above, is directed to a spring hanger assembly for supporting a portion of a pipe line. Included in this hanger assembly is a flat lower plate 14 that (1) retains a spring 16 within a cylindrical housing 10

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and (2) is attached to the cylindrical housing by a bayonet-type connection that includes orthogonally arranged slots which cooperate with a finger 52 on the plate 14. There is simply nothing in the combined teachings of Louette and Davidson that would have led one of ordinary skill in the art to provide Louette's flexible coupling with a "circumferential groove" in view of the disparate teachings of Davidson. In our view, the only suggestion for the examiner's combination of the disparate teachings of the applied references improperly stems from the appellants' disclosure, and not from the prior art. As the court in *Uniroyal*, 837 F.2d at 1051, 5 USPQ2d at 1438 stated "it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention."

As a final matter, we note that the appellants have submitted evidence of nonobviousness in the form of a declaration by Hauck. However, since the prior art relied on by the examiner fails to establish a *prima facie* case of obviousness, we need not consider the appellants' evidence of nonobviousness. *In re Fine*, 837 F.2d 1071, 1076, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

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The decision of the examiner to reject claims 1, 3-7 and
9-17 under 35 U.S.C. § 103(a) based on the combined teachings
of
Louette and Davidson is reversed.

REVERSED

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge))
)	
)	
JAMES M. MEISTER)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS
)	AND
)	INTERFERENCES
)	
)	
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	

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