

The opinion in support of the decision being entered today was **not** written for publication in a law journal and 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 ANDREW J. KEENAN

Appeal No. 1998-1716
Application No. 08/526,942

ON BRIEF

Before CALVERT, NASE, and GONZALES, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 16, 17 and 21-26, as amended subsequent to the final rejection. These claims constitute all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a noise abatement wall (specification, p. 1). A substantially correct copy of the claims under appeal is set forth in the appendix to the appellant's brief.¹

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Atterbury 14, 1906	828,833	Aug.
Wolfe 1921	1,389,803	Sept. 6,
Ham 1926	1,598,131	Aug. 31,
Stout 1967	3,307,822	March 7,
Williams 1971	3,584,088	June 8,
Vaughan 1973	3,743,232	July 3,
Scholz et al. 1976 (Scholz)	3,954,377	May 4,
Myers et al. 1993 (Myers)	5,202,132	Apr. 13,
Bryant 1993	5,246,640	Sep. 21,

¹ A minor error in claim 26 is set forth on page 3 of the examiner's answer.

Claims 16, 17 and 21-26 stand rejected under 35 U.S.C. § 103 as being unpatentable over Myers in view of any one of Scholz, Stout, Williams, Vaughan, Wolfe, Ham, Bryant or Atterbury, or vice versa, any one of Scholz, Stout, Williams, Vaughan, Wolfe, Ham, Bryant or Atterbury, each in view of Myers.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (Paper No. 15, mailed December 11, 1997) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 13, filed September 4, 1997) and reply brief (Paper No. 17, filed February 9, 1998) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the

examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 16, 17 and 21-26 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill

in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the

claimed invention from the isolated teachings of 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).

With this as background, we analyze the prior art applied by the examiner in the rejection of the claims on appeal.

Myers discloses production line equipment which is utilized in producing many large concrete panels, in an initial horizontal position with these panels preferably being later installed vertically with other like panels to form a sound barrier alongside a vehicle way. As shown in Figure 3-6, the preferred concrete panel 42 has integral pilasters 126, 128 formed at each side of an integral central planar body 130. The community view side 160 of the concrete panel 42 is illustrated in Figure 3. The vehicle way view side 162 of the concrete panel 42 is shown in Figure 4. A tongue edge 164 and a groove edge 166 of each concrete panel 42 is observable in Figures 5 and 6. As shown in

Figures 11 and 15, the poured concrete panel 42 includes wire mesh reinforcing 132, reinforcing bars 134 and rods 138, and tension bars 146.

Scholz, Stout, Williams, Vaughan, Wolfe, Ham, Bryant and Atterbury each teach a method of making a wall section by vertically casting the wall section.

The examiner ascertained (answer, p. 5) that Myers taught the claimed invention "except for it being formed in a vertical mold assembly." The examiner then determined (answer, p. 5) that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to form the wall section (i.e., panel 42) of Myers "by casting it within a vertical mold assembly in the shape of the wall section" as taught by any one of the secondary references (i.e., Scholz, Stout, Williams, Vaughan, Wolfe, Ham, Bryant or Atterbury), or to use the process of each of the secondary references to shape the wall section of Myers.

While we agree with the examiner that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to form the wall section (i.e., panel 42) of Myers "by casting it within a vertical mold assembly in the shape of the wall section" as taught by any one of the secondary references, the combined teachings of the applied prior art are not suggestive of the claimed invention. In that regard, it is our view that secondary references would have suggested vertically casting Myers' wall section in an

orientation wherein the pilasters 126, 128 which are formed at each side of the planar body 130 are located at the sides of the vertical mold assembly. Absent the use of impermissible hindsight, the secondary references would not have suggested vertically casting Myers' wall section in an orientation wherein the pilasters 126, 128 are located at the top and bottom of the vertical mold assembly. All the claims under appeal require the vertical mold assembly to have a lower first section and **an enlarged top section**. It is our determination that the claimed enlarged top section of the vertical mold assembly is not suggested by the applied prior art. Accordingly, the decision of the examiner to reject claims 16, 17 and 21-26 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 16, 17 and 21-26 under 35 U.S.C. § 103 is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JOHN F. GONZALES)	
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