

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN P. BUSHOUSE

Appeal No. 1998-1964
Application No. 08/518,784¹

ON BRIEF

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 20, which are all of the claims pending in this application.

We REVERSE.

¹ Application for patent filed August 24, 1995.

BACKGROUND

The appellant's invention relates to a clamp assembly. An understanding of the invention can be derived from a reading of exemplary claims 1, 8 and 16 (the independent claims on appeal), which appear in the appendix to the appellant's brief.

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

Powell 1937	2,093,210	Sept. 14,
Engman 1967	3,340,581	Sept. 12,

Claims 1 through 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Engman in view of Powell.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the final rejection (Paper No. 9, mailed March 20, 1997) and the examiner's answer (Paper No. 12, mailed October 24, 1997) for the examiner's complete

reasoning in support of the rejection, and to the appellant's brief (Paper No. 11, filed July 21, 1997) and reply brief (Paper No. 13, filed December 31, 1997) 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 1 through 20 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, 9 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).

With this as background, we turn to the rejection of the claims on appeal. The examiner determined for the reasons set forth on page 2 of the final rejection that the subject matter of claims 1 through 20 would have been obvious to one of ordinary skill in the art at the time the invention was made.

In the brief (pp. 4-6), the appellant argues that the rejection set forth by the examiner is improper for the following three reasons.

1. Use of the rivet connection described by Powell with the Engman et al. clamp would not result in the claimed invention.
2. Use of the Powell rivet connect to [sic, to connect] the clamp members 12 and 14 of Engman et al. would change the principle of operation of the clamp disclosed by Engman et al.
3. One having ordinary skill in the art would not be [sic, have been] motivated to use a rivet connection with the clamp of Engman et al. to prevent separation of the parts.

We agree with reasons 2 and 3 above. We see no evidence, as shown by some objective teaching in the applied prior art or by knowledge generally available to one of ordinary skill in the art, that would have suggested to one of ordinary skill in the art at the time the invention was made to have provided Engman's clamp with the claimed pivot attachment between the yoke and the U-bolt/elongate member (i.e., the pin 32). Instead, it appears to us that the examiner relied on

impermissible hindsight in reaching the determination of obviousness.²

Since all the limitations of claims 1 through 20 are not taught or suggested by the applied prior art, we will not sustain the 35 U.S.C. § 103 rejection of claims 1 through 20.

² The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 20 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
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APPLICATION NO. 08/518,784

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APJ ABRAMS

APJ COHEN

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 22 Apr 99

FINAL TYPED: