

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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 THOMAS E. JEWETT, and JOHN YAPUNDICH

Appeal No. 1998-2096
Application No. 08/586,966

ON BRIEF

Before COHEN, STAAB, and GONZALES, Administrative Patent Judges.

GONZALES, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 20 through 28 and 31 through 35.¹ Claims 1 through 3,

¹ An amendment was filed on February 5, 1997 (Paper No. 6), subsequent (continued...)

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5 through 19 and 36 have been allowed. Claims 29 and 30, the only other claims remaining in the application, are objected to as being dependent upon a rejected claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

We REVERSE.

The subject matter on appeal is directed to a ground anchor which is intended to be driven into the ground to anchor guy rods, cables or the like. See specification, p. 1. A copy of the appealed claims is reproduced in an appendix to the brief.²

¹(...continued)
to the final rejection. In an Advisory Action mailed February 25, 1997 (Paper No. 7), the examiner approved entry of the amendment, indicated that the 35 U.S.C. § 103 rejection of claims 26 through 28 based on Chandler and Habib made in the final rejection had been overcome and that claims 26 through 28 were objected to. Nevertheless, the answer indicates at pages 2, 3 and 7 that claims 26 through 28 stand rejected under 35 U.S.C. § 103 based on Chandler and Habib. No objection to the examiner's apparent change in position with respect to claims 26 through 28 was raised by the appellants in the Reply Brief. Thus, we consider the rejection of claims 26 through 28 to be before us for our review.

² The following errors are worthy of correction upon return of the application to the jurisdiction of the examiner: claim 20, line 2, "number"
(continued...)

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

Chandler	4,802,317	Feb. 7, 1989
Habib et al. (Habib)	5,026,213	Jun. 25, 1991

Claims 20, 21, 23 through 25 and 31 through 35 stand rejected under 35 U.S.C. § 103 as being unpatentable over Chandler.

Claims 22 and 26 through 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chandler in view of Habib.

The full text of the examiner's rejections and response to the arguments presented by the appellants appears in the answer (Paper No. 12, mailed December 9, 1997), while the complete statement of the appellants' arguments can be found in the Main Brief (Paper No. 11, filed October 2, 1997) and the Reply Brief (Paper No. 13, filed February 13, 1998).

OPINION

²(...continued)
should read --member--; claim 24, line 1, "and" should be deleted.

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In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

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 rejections of claims 20 through 28 and 31 through 35 under 35 U.S.C. § 103.

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 arrive at the claimed invention. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

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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 35 U.S.C. § 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).

The appellants' invention is directed to certain improvements to the ground anchor disclosed in the Chandler reference. Specifically, the invention is intended to reduce the energy required to place the anchor at its optimum depth in the ground. See the appellants' specification, p. 1. To

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this end, the appellants modify the leading edges of the cruciform star leg 13 shown in Figures 1-5 of Chandler by providing multiple sharpened leading edges which are longitudinally offset with respect to each other. Id. at 2 and see the appellants' Figures 1-5, edges 14a, 14b. The ground anchor disclosed in the Chandler reference includes a curved tip or lip portion 19 (see Figure 4) which facilitates titling of the anchor to a transverse position in the ground. See col. 5, ll. 8-12. The appellants have discovered that a second curved lip 27 opposite the eye portion 24 not only provides additional leverage for titling the ground anchor within the soil, but also aids the anchor in maintaining a linear path as the ground anchor is driven through the ground and facilitates penetration of the anchor through hard soil. See the appellants' specification, p. 3.

Claims 20 and 23, the only independent claims, stand rejected under 35 U.S.C. § 103 in view of Chandler. Claim 20 is directed to a ground anchor including, inter alia, a first curved lip portion [26] extending from the back end of the ground anchor body and

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a second curved lip portion [27] extending transversely outward from the body portion and being positioned forwardly of the first curved lip portion for further facilitating rotation of the anchor in the ground, said first and second curved lips being positioned along a bottom face of the body portion and said first curved lip portion extending transversely outward from the body portion a greater distance than said second curved lip.

Claim 23 is drawn to a ground anchor comprising a rigid plate member [10] having a tubular longitudinal central body portion [11], wings [12] radiating laterally from the body portion and

a central axial leg portion [13] projecting from the front end of the body portion forwardly of the wings and having radiating side edges [14], said side edges of said leg portion each having a plurality of sharpened leading side edges [14a, 14b] which are each longitudinally offset with respect to each other.

The examiner acknowledges that Chandler does not explicitly teach the second curved lip portion of claim 20 or the central axial leg portion having a plurality of sharpened leading side edges which are each longitudinally offset with respect to each other as recited in claim 23. However, it is the examiner's position that it would have been obvious to one of ordinary skill in the art to add a second curved lip to the

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ground anchor disclosed by Chandler, if one determined that a single lip was insufficient to stabilize the anchor during installation. See Answer, p. 6. The examiner also contends that the exact location and dimensions of the second lip would have been "an obvious design consideration." Id. As to the recitation in claim 23 of a leg portion having longitudinally offset side edges, the examiner maintains (id.) that

[u]se of first and second leading edges on Chandler's leg would have been obvious to one of ordinary skill in the art, to increase the anchor's ability to penetrate the earth with as little resistance as possible. If one determines that a single leading edge or "cutting surface" is insufficient to penetrate soils of various densities, one of ordinary skill in the art would have found it obvious to add additional cutting surfaces on the leading edge of the anchor to facilitate insertion of the device into the ground. The exact orientation of these cutting surfaces would have been obvious to one of ordinary skill in the art, based upon knowledge of various soils and what types of cutting surfaces work best in those soils.

With respect to claims 20 and 23, the appellants argue (Main Brief, pp. 13 and 14 and Reply Brief, pp. 3 and 4) that the examiner has failed to cite any prior art that recognizes or teaches the advantages of providing either a second curved lip portion extending from the body portion or multiple

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cutting edges to the central axial leg portion and that the examiner's proposed modifications of Chandler are based on hindsight. We agree.

In this regard, we share the appellants' view that there is nothing in the cited Chandler reference to suggest the claimed invention. Chandler is concerned, as is the appellants, with reducing the energy required to drive known plate or wing type ground anchors into the ground. Chandler's disclosed solution is to provide the ground anchor with an axially extended chisel or star drill having sharpened edges. According to Chandler, the chisel point facilitates penetration of the ground anchor into hard soil, breaks obstructions and reduces the energy required to advance the anchor into the soil. See col. 1, ll. 48-52 and col. 2, ll. 11-21. We find no teaching or suggestion in Chandler that further ease of penetration or reduction in driving energy would be obtained by providing a plurality of smaller leading chisel or drill edges longitudinally offset with respect to each other. Further, while Chandler provides a first curved lip portion 19 at the back end of the central body to facilitate tilting of the anchor in the ground, there is no

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teaching or suggestion in Chandler that a second curved lip portion positioned forwardly of the first curved lip portion and with the first lip portion extending transversely outward from the body portion a greater distance than the second curved lip would further facilitate rotation of the anchor in the ground. We must point out the mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. See In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992) and In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Absent the appellants' own disclosure we can think of no reason why one of ordinary skill in the art would have been motivated to make the modifications to Chandler's ground anchor proposed by the examiner. The evidentiary record before us is totally devoid of any suggestion or motivation that would have led one of ordinary skill to make such modifications. The subjective opinion of the examiner as to what would have been obvious, without evidence in support thereof, is not a basis upon which the legal conclusion of obviousness may be reached. Note In

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re GPAC Inc, 57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995) and In re Warner, supra.

In light of the foregoing, we will not sustain the standing 35 U.S.C. § 103 rejection of independent claims 20 and 23 and dependent claims 21, 24, 25 and 31 through 35.

We have also reviewed the Habib reference applied along with Chandler by the examiner against dependent claims 22 and 26 through 28. However, we find nothing in Habib which makes up for the deficiencies of Chandler discussed above regarding claims 20 and 23.

Accordingly, we will also not sustain the standing 35 U.S.C. § 103 rejection of dependent claims 22 and 26 through 28.

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CONCLUSION

To summarize, the decision of the examiner to reject claims 20 through 28 and 31 through 35 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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LAWRENCE J. STAAB)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND

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) INTERFERENCES
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JOHN F. GONZALES)
Administrative Patent Judge)

jg/rwk

HILL STEADMAN & SIMPSON
85TH FLOOR SEARS TOWER
CHICAGO IL 60606