

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DENNIS W. MARTIN and TARIQ M. AFZAL

Appeal No. 1998-2512
Application No. 08/618,593¹

HEARD: December 9, 1999

Before COHEN, ABRAMS, and BAHR, ***Administrative Patent Judges.***

ABRAMS, ***Administrative Patent Judge.***

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1-45, which constitute all of the claims of record in the application.

¹ Application for patent filed March 20, 1996.

The appellants' invention is directed to a spring motor. The claims before us on appeal have been reproduced in an appendix to the Appeal Brief.

THE REFERENCE

The reference relied upon by the examiner to support the final rejection is:

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|-------|-----------|---------|
| Kuhar | 5,482,100 | Jan. 9, |
| 1996 | | |

THE REJECTIONS

Claims 1-45 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as their invention.

Claims 1-45 also stand rejected under 35 U.S.C. § 103 as being unpatentable over Kuhar.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and the appellants regarding the rejections, we make reference to the

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Examiner's Answer (Paper No. 17) and the Appellants' Briefs
(Papers Nos. 15 and 19).

OPINION

The Rejection Under 35 U.S.C. § 112, Second Paragraph

It is the examiner's position that all of the claims are indefinite because "storage drum means" (claim 1), "second control means" (claim 14), and "drum gear means" and "idler gear means" (claim 25) are not in proper means-plus-function format. The appellants argue that these "means" terms are not intended to define elements presented in means-plus-function format, and therefore need not be accompanied by a recitation of the functions they perform. We agree. This manner of defining the elements in a claim is entirely proper and is distinct from the means-plus-function format. See Section 2181 of the Manual of Patent Examining Procedure (Seventh Edition, July 1998).

This rejection is not sustained.

The Rejection Under 35 U.S.C. § 103

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, *In re Keller*, 642 F.2d 413, 425,

208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See ***Ex parte Clapp***, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, ***Uniroyal, Inc. v. Rudkin-Wiley Corp.***, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

The appellants' spring motor system is particularly suitable for use in conjunction with assisting the elevating and lowering of Venetian blind type window coverings. For reasons explained in the specification, the appellants' invention has a number of advantages in such a use. As manifested in independent claim 1, the invention comprises, *inter alia*, storage drum means having a first axis, an output

drum rotatable about a second axis parallel to and spaced from the first axis, a spring member coiled on the storage drum means and having a free end connected to the output drum, drive means adjacent one side of the spring member for rotating the output drum about the second axis, and control means laterally aligned with said drive means.

Kuhar discloses a Venetian blind motor having a storage drum means (20) and an output drum (10) that are rotatable on first and second axes parallel to and spaced from one another, and a spring member coiled on the storage drum means and attached to the output drum. The control means (30) disclosed by Kuhar is mounted coaxially with the storage drum means and thus rotates about the same (the second) axis. Kuhar fails to disclose or teach drive means for rotating the output drum, much less a drive means adjacent one of the sides of the spring member, as is required by the appellants' claim 1.

The examiner has taken the position that it would have been "an obvious matter of design choice" to one of ordinary skill in the art to modify the Kuhar system so that it meets the terms of the claim 1 *et al.* "based on factors such as preference, design criteria, space optimization, and costs,

providing no new or unexpected results" (Answer, page 4). We cannot subscribe to this reasoning. It is axiomatic that the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See, for example, **In re Gordon**, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). We fail to perceive any such suggestion, teaching or incentive, noting that the changes proposed by the examiner would result in a wholesale reconstruction of the Kuhar invention. From our perspective, the only suggestion to do so resides in the luxury of the hindsight afforded one who first viewed the appellants' disclosure which, of course, is not a proper basis for a conclusion that an invention would have been obvious. See **In re Fritch**, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

A *prima facie* case of obviousness therefore has not been established with regard to the subject matter of claim 1, and we will not sustain the Section 103 rejection of claim 1 or, it follows, of claims 2-24, which depend therefrom.

Among the requirements of the spring motor system described in independent claim 25 is that there be a storage drum means, an output drum, and control gear means mounted on three separate parallel axes which are spaced from one another. This clearly is not taught by Kuhar, in which these three elements are mounted on only two axes. Claim 25 also specifies that there be several sets of gear means mounted between the various drum means, which also is not taught by Kuhar, whose system has no gear means at all. Again, and for the same reasons as were expressed above with regard to the rejection of claim 1, we do not agree with the examiner's conclusion that it would have been obvious to modify the Kuhar system in the manner he proposed.

It is our view that a *prima facie* case of obviousness has not been established with regard to independent claim 25 and dependent claims 26-38, and we will not sustain this rejection.

We reach the same conclusion with regard to independent claim 39 and dependent claims 40-45. The manifestation of the invention set forth in claim 39 comprises a plurality of spring motors arranged between a pair of parallel spaced apart plates having opposite ends with each motor including storage drum

means and an output drum arranged sequentially in the direction of from one of the opposite ends to the other, rotatable gear trains drivingly interconnecting the plurality of spring motors, and control gear means in meshing interengagement with at least one of the gears in the gear trains. Kuhar discloses a plurality of spring motors working in unison (Figure 3) by virtue of being interconnected through a common bar (62). They are not, however, interconnected by means of gear trains, nor does the disclosed system include control gear means in meshing interengagement with a gear of the gear train, as required by claim 39. The examiner has presented no evidence in support of his conclusion that it would have been obvious to substitute the claimed gear arrangement for the bar disclosed by Kuhar. In the absence of such evidence, and in view of the fact that Kuhar already has solved the problem of coordinating the operation of multiple spring motors by the system disclosed in the patent, we fail to perceive any suggestion to make such a modification other than by way of hindsight.

As with the rejection as applied to the other independent claims, it is our opinion that a *prima facie* case of

obviousness has not been established, and we therefore will not sustain this rejection of claims 39-45.

SUMMARY

Neither of the rejections is sustained.

The decision of the examiner is reversed.

REVERSED

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| IRWIN CHARLES COHEN |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| NEAL E. ABRAMS |) | APPEALS |
| Administrative Patent Judge |) | AND |
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| JENNIFER D. BAHR |) | |
| Administrative Patent Judge |) | |

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VICKERS DANIELS & YOUNG
TERMINAL TOWER
TWENTIETH, OH 44113