

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte GORAN HALLSTEDT et al.

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Appeal No. 1998-2921  
Application No. 08/511,451

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ON BRIEF

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Before STAAB, NASE, and JENNIFER D. BAHR, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 19 to 26, as amended subsequent to the final rejection. These claims constitute all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a method of manufacturing at least two different types of sealing rings for sealing a space between an inner surface of a socket provided with an annular groove and an outer surface of a spigot end introduced into the socket in a pipe joint (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

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

Cyriax 1983	4,410,479	Oct. 18,
Valls 1987	4,693,483	Sep. 15,
Vassallo et al. 1989 (Vassallo)	4,826,028	May 2,
Wright 1982	GB 2,092,241	Aug. 11,

Claims 19 to 26 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cyriax in view of Vassallo or Valls, and further in view of Wright.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 32, mailed January 21, 1998) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 31, filed August 15, 1997) and reply brief (Paper No. 33, filed March 26, 1998) for the appellants' arguments thereagainst.

OPINION

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. 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 19 to 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 would have led one of ordinary skill in the art 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) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Claim 19 (the only independent claim on appeal) reads as follows:

A method of manufacturing at least two different configurations of sealing rings adapted for sealing a space between an inner surface of a pipe socket provided with an annular groove and an outer surface of a spigot end introduced into the socket at a pipe joint, each said sealing ring comprising a first annular element and a second annular element that are bound to each other and with each element being of differing hardness, said method comprising:

providing at least two said second annular elements and two substantially identical said first annular elements, said first elements each having at least two binding surfaces having respective first and second locations on said first element,

attaching one said second element to one of said binding surfaces on one of said first annular elements, said one binding surface on said first element being at said first location so as to form a first sealing ring of a first configuration; and

attaching another second annular element to a said binding surface at the second location on the other of said first annular elements so as to form a second sealing ring of a second configuration different than said first configuration, whereby said first sealing element may form different configurations of sealing rings dependent on the binding surface selected and the shapes of the second elements attached thereto.

We agree with the appellants that the applied prior art does not suggest the claimed invention. Moreover, it appears to us that even if the applied prior art were modified in the manner set forth by the examiner (answer, pp. 3-4), it would not result in the claimed invention. In that regard, the applied prior art does not teach or suggest attaching one of the second elements to a binding surface at a first location on one of the first annular elements so as to form a first sealing ring of a first configuration and attaching another second annular element to a binding surface at a second location on another first annular element so as to form a second sealing ring of a second configuration different than the first configuration.

In our view, the only suggestion for modifying the applied prior art to arrive at the claimed invention stems from hindsight knowledge derived from the appellants' own disclosure. 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 Assocs., Inc.

v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13  
(Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Additionally, we do not agree with the position set forth by the examiner (answer, p. 7) that the cases of In re Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and In re Otto, 312 F.2d 937, 136 USPQ 458 (CCPA 1963) support the proposition that in a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.

For the reasons set forth above, the decision of the examiner to reject claims 19 to 26 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 19 to 26 under 35 U.S.C. § 103 is reversed.

REVERSED

LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
JEFFREY V. NASE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

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