

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANE R. OLSEN

Appeal No. 1999-1044
Application No. 08/778,392

ON BRIEF

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

GONZALES, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 12 and 14. Claims 2 through 11, 13 and 15 through 20 have been canceled.

We REVERSE.

Appeal No. 1999-1044
Application No. 08/778,392

The appellant's invention relates to a post-mounted sign holder. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's brief (Paper No. 11).

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

Neuendorf et al. 1992 (Neuendorf)	5,088,672	Feb. 18,
Schmanski et al. 1993 (Schmanski)	5,189,822	Mar. 2,

Claims 1, 12 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Neuendorf in view of Schmanski.

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. 12) for the examiner's complete reasoning in support of the rejection, and to the brief for the appellant's arguments thereagainst.

OPINION

Appeal No. 1999-1044
Application No. 08/778,392

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, 12 and 14 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,

Appeal No. 1999-1044
Application No. 08/778,392

1016, 173 USPQ 560, 562
(CCPA 1972).

The rejection of claims 1, 12 and 14 is based on the examiner's determination (answer, p. 3) that Neuendorf "shows the basic structure of the claimed sign holder . . . , but does not show sign portion 17 to comprise a hollow housing."

With regard to this difference, the examiner determined (answer, p. 4) that it would have been obvious to one skilled in the art to have substituted Schmanski's housing for the sign 17 of Neuendorf in order to facilitate sign changing as taught by Schmanski.¹

The appellant argues that the prior art as applied does not arrive at the claimed invention. Specifically, the appellant argues (brief, pp. 3-6) that neither Schmanski nor Neuendorf teaches or suggests a hollow sign housing having an open end for sign insertion when the sign is fully assembled and ready for use or a rotatable sign support as required by independent claim 1.

¹ The specific teachings of Neuendorf and Schmanski relied upon by the examiner are set forth on pages 3 and 4 of the answer.

Appeal No. 1999-1044
Application No. 08/778,392

We agree.

The examiner responded to these arguments (answer, pp. 4-5) by stating that Schmanski's end caps (32, 34) are removable and the sign holder is, thus, capable of assuming an open-ended arrangement as claimed. As to the Neuendorf reference, the examiner maintains that "each of Neuendorf's clamps 10 is inherently pivotally mounted to the sign structure via pivot pins 21, 56" (answer, p. 5).

With regard to the removal of the end caps, Schmanski teaches that

[t]he fins 40 and projections 42 fit snugly against the flanges 18 and back wall 12 to effectively form frictional wedges that are held in place between the flanges 18 and the back wall 12. A bonding agent is preferably used to bond the fins 40 and projections 42 of the upper end cap 32 to the flanges 18 and back wall 12 to lock the upper end cap 32 in place. The lower end cap 34 is releasably locked in place by a retaining fastener as will be described more fully hereinafter.

Col. 4, ll. 60-68. Also, Schmanski teaches that

. . . the upper end cap 32 is preferably bonded permanently in place by a bonding agent. It is not advantageous to permanently bond the lower end cap 34 in place inasmuch as it is often necessary to access the insert panel 30 in the sign to change or add information shown thereon.

Appeal No. 1999-1044
Application No. 08/778,392

Col. 6, ll. 3-8. As evidenced by the text reproduced above, it is clear that when Schmanski's sign is fully assembled and ready for use, the upper end cap 32 permanently closes the top edge (as viewed in Fig. 1) of the hollow sign housing and the lower end cap closes the bottom edge. Thus, neither edge is open as required by claim 1.

Moreover, we agree with the appellant's argument that "said hollow sign housing being rotatable about said pivot pin so that said hollow sign housing is positionable in a plurality of preselected rotational positions of adjustment relative to said flat base" as recited in claim 1 under appeal is not suggested by the applied prior art. In that regard, neither Neuendorf nor Schmanski teaches or suggests that the sign housing is rotatable

about a pin so that the housing is capable of being positionable in a plurality of preselected rotatable positions.

The examiner maintains that "each of Neuendorf's clamps 10 is inherently pivotally mounted to the sign structure via pivot pins 21, 56" (answer, p. 5). When an examiner relies

Appeal No. 1999-1044
Application No. 08/778,392

upon a theory of inherency, "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Int. 1990). Inherency simply cannot be established based on probabilities or possibilities. See In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981).

In the present case, the examiner has not met the burden of furnishing an adequate factual foundation and/or technical reasoning to show that the structure taught in Neuendorf necessarily results in the sign being rotatable about pin 21 or 56 so that the sign is positionable in a plurality of preselected rotational positions as claimed in claim 1.

In our view, the only suggestion for modifying Neuendorf in the manner proposed by the examiner to meet the rotatable limitation stems from hindsight knowledge derived from the appellant's 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 Associates, Inc. v. Garlock, Inc., 721 F.2d 1540,

Appeal No. 1999-1044
Application No. 08/778,392

1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Since the prior art as combined by the examiner in the rejection before us in this appeal fails to arrive at the claimed invention for the reasons set forth above, the decision of the examiner to reject claims 1, 12 and 14 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject

Appeal No. 1999-1044
Application No. 08/778,392

claims 1, 12 and 14 under 35 U.S.C. § 103 is reversed.

REVERSED

IAN A. CALVERT)
Administrative Patent Judge))
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) BOARD OF PATENT
NEAL E. ABRAMS))
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)
JOHN F. GONZALES)
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Appeal No. 1999-1044
Application No. 08/778,392

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