

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 43

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LESLIE A. MECK

Appeal No. 1999-1746
Application No. 08/827,841¹

ON BRIEF

Before NASE, CRAWFORD, and GONZALES, Administrative Patent Judges.

NASE, Administrative Patent Judge.

¹ Application for patent filed April 11, 1997. According to the appellant, the application is entitled to benefit under 35 U.S.C. § 120 of an earlier filing date of August 4, 1993.

Appeal No. 1999-1746
Application No. 08/827,841

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claim 1, as amended subsequent to the final rejection. Claim 1 constitutes the only claim pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a wall fixture. A copy of claim 1 appears 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:

Hoegger 1927 (Hoegger '364)	1,636,364	July 19,
Koering 1930	1,773,586	Aug. 19,
Pudliner 1933	1,897,913	Feb. 14,
Hoegger 1934 (Hoegger '739)	1,962,739	June 12,
Shea et al. 1939 (Shea)	2,146,654	Feb. 7,

Claim 1 stands rejected under 35 U.S.C. § 103 as being unpatentable over Pudliner in view of Hoegger '364, Shea and Koering.

Claim 1 stands rejected under 35 U.S.C. § 103 as being unpatentable over Hoegger '739 in view of Hoegger '364 and Shea.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 42, mailed February 17, 1999) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 41, filed December 15, 1998) 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 claim, 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 claim 1. Accordingly, we will not sustain the

examiner's rejections of claim 1 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).

The appellant argues (brief, pp. 5 and 7) generally that the applied prior art does not suggest the claimed subject matter. We agree.

The claim under appeal requires "an anti-rotation pad between the room wall and the front wall of said bracket portion." However, this limitation is not suggested by the

applied prior art. In that regard, while Shea does teach a resilient ring 13 formed of insulating material as rubber positioned between the cowl 2 and the knob 12, it is our opinion that Shea would not have suggested modifying either Pudliner's bracket or the fixture attachment of Hoegger '739 to include an anti-rotation pad between the room wall and the front wall of said bracket portion.

In our view, the only suggestion for modifying either Pudliner's bracket or the fixture attachment of Hoegger '739 in the manner proposed by the examiner to meet the above-noted 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, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejections of claim 1.

CONCLUSION

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

REVERSED

JEFFREY V. NASE)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
MURRIEL E. CRAWFORD)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JOHN F. GONZALES)	
Administrative Patent Judge)	

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APPLICATION NO. 08/827,841

APJ NASE

APJ CRAWFORD

APJ GONZALES

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 19 Jul 99

FINAL TYPED: